

**IN THE MATTER OF FOUR OPPOSITIONS
by Anheuser-Busch, Incorporated to application
Nos. 1257441; 1257440; 1257439 and 1252736 for
the trade-marks SUPER COLD; EXTRA COLD;
EXTRA CHILLED and COLD PACK, respectively,
filed by Molson Canada 2005**

Application No. 1,257,441 for the mark SUPER COLD

THE RECORD

[1] On May 12, 2005, Molson Canada 2005 filed an application to register the trade-mark SUPER COLD, based on proposed use in Canada, in association with

brewed alcoholic beverages, namely beer.

The application disclaims the right to the exclusive use of the word SUPER apart from the mark as a whole. The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated December 28, 2005 and was opposed by Anheuser-Busch, Incorporated on June 20, 2006.

[2] The Registrar forwarded a copy of the statement of opposition to the applicant on August 15, 2006, as required by s. 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent was subsequently granted leave to amend the statement of opposition: see the Board ruling dated August 30, 2007.

[3] The opponent's evidence consists of the affidavits of Nick Gatehouse, Megan Langley-Grainger, and Robert White. The applicant requested cross-examination on the opponent's evidence prior to filing its own

evidence but subsequently withdrew its request and ultimately elected not to submit evidence in support of the application. Only the opponent submitted a written argument and only the opponent was represented at an oral hearing held on February 23, 2010.

STATEMENT OF OPPOSITION

[4] The first ground of opposition, pursuant to s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, alleges that the applicant could not have been satisfied of its entitlement to use the phrase SUPER COLD as a trade-mark in association with the wares beer because the phrase SUPER COLD “is not a trade-mark as defined in the Act” owing to its “descriptiveness and lack of distinctiveness.”

[5] The second ground, pursuant to s.12(1)(b) of the *Act*, alleges that the applied for mark SUPER COLD is not registrable because it is either clearly descriptive or deceptively misdescriptive of (i) the wares beer or of (ii) the conditions of their production. In this regard, the opponent pleads that beer may be produced through a process known as “cold filtering.” The opponent pleads that the phrase SUPER COLD indicates an extreme version of “cold filtering” and the extreme conditions of production of the wares, as well as a category of beer designed to be served at an extra chilled temperature.

[6] The third ground, pursuant to s. 38(2)(d), alleges that the applied for mark is not adapted to distinguish and does not actually distinguish the applicant’s beer from the beer of others because (a) the phrase SUPER COLD denotes a type or category of beer which is (i) produced through a brewing process which requires low temperatures or (ii) stored very cold or (iii) designed to be served very cold, (b) the phrase SUPER COLD or variations of it are terms commonly used in the trade which any brewer might wish to use to describe its wares.

OPPONENT’S EVIDENCE

Nick Gatehouse

[7] Mr. Gatehouse’s evidence may be summarized as follows. He has been employed by Anheuser-Busch International Inc. since 1994 and has been the Country Manager for Canada since 2004. Anheuser-Busch International Inc. and the opponent Anheuser-Busch Incorporated are both wholly owned subsidiaries of Anheuser-Busch Companies Inc. (collectively “Anheuser-Busch”). He worked in the United Kingdom and Ireland for 10 years prior to his current position. Mr. Gatehouse’s responsibilities primarily include overseeing the sales and marketing in Canada of Anheuser-Busch brands of beer including the brands BUDWEISER and BUD LIGHT.

[8] Various manufactures of beer have used phrases such as “extra cold” and “super chilled” in Canada, the U.K. and Ireland to describe draught beer that is served at a colder temperature than usual. Guinness began

selling GUINNESS Draught Extra Cold beer in the late 1990s. The phrase “extra cold” appeared on pouring taps for GUINNESS draught beer sold at pubs in the U.K. and Ireland. The phrase “serve extra cold” has appeared on cans of GUINNESS and KILKENNY beer sold in Canada beginning since at least April 2005. The following beers are available for purchase in pubs or stores in the U.K. or Ireland: BELHAVEN BEST Extra Cold; TETLEY Extra Cold Draught; FOSTER’S Super Chilled Draught; CARLING Extra Cold Draught; and JOHN SMITH’S Extra Cold Draught. In Canada, MILLER Genuine Draught Cold-Filtered beer has been available in pubs, bars and The Beer Store since at least 2004. In 2005 and 2006, Labatt marketed the CHILL CHECK beer can. Temperature sensitive inks on the outside of the can became clearly visible when the contents of the can are chilled to 3° C, revealing an image. Since at least 2004, The Beer Store has published and distributed in its stores a magazine called CHILL.

[9] Heating and cooling are required at various stages of the beer brewing process. Different styles and categories of beer will result depending on whether, when and to what extent cold temperatures are applied during the brewing process. Industry terms to describe various stages or processes of brewing include: chilling, chill, cold-aged, cooling, cold maturation, cold-fermentation, cold-storing, and cold-lagering. Refrigeration units are used to keep beer cold at every stage from brewing to distribution to storage. The stability of beer and its shelf life depend on the beer being kept at cold temperatures. The Beer Store has a sign reading ICE COLD EXPRESS above displays of beer. Since about 1999, technology developed to dispense beer in bars to serve all varieties of beer “extra cold” or “super cold” or “super chilled” or “extra chilled.” The cold beer dispensing technology may also display the term “sub zero.” The temperature at which a beer should be served depends on the type of beer. Many dark beers and stouts are typically served warm. Exhibit materials attached to Mr. Gatehouse’s affidavit serve to corroborate his testimony.

Megan Langley Grainger

[10] Ms. Grainger is a student-at-law employed by the firm representing the opponent. She visited web sites, libraries and stores for the purpose of researching how words and phrases such as “cold,” “extra cold,” “extra chilled,” and “super cold” are used in relation to beer and the beer brewing process. The results of her research are presented as exhibits to her affidavit comprising seven voluminous binders. From my review of the exhibit material, it would appear that as of May 12, 2005, phrases such as “super cold” and “super chilled” had entered the English lexicon to describe a particular type of beer. Further, such phrases have been used as a descriptive suffix to identify brands of beer of this type, for example, CARLING Extra Cold and BELHAVEN BEST Extra Cold. Ms. Grainger’s evidence also indicates that as of May 12, 2005, the public had become familiar with the terms “ice beer,” and “cold filtering” in connection with the emergence of a category of beers designed to be stored and served at a low temperature.

Robert W. White

[11] Mr. White is the Senior Vice President, Canada of the Audit Bureau of Circulations. He is therefore able to provide true statements of circulation for daily and weekly newspapers circulating in Canada. Mr. White has provided such figures for the various publications referred to in Ms. Grainger's affidavit including *The Economist, Maclean's, Forbes, Toronto Life* and *Canadian Business*. As noted by the opponent in its written argument, I may also take judicial notice that the major Canadian and U.S. newspapers circulate in Canada: see, for example, *Northern Telecom v. Nortel Communications Inc.* (1987), 15 C.P.R.(3d) 540 (TMOB) at p. 543. Such newspapers referred to by Ms. Grainger in her affidavit include *The Toronto Star, The Ottawa Citizen* and *The Globe and Mail*.

LEGAL ONUS AND EVIDENTIAL BURDEN

[12] The legal onus is on the applicant to show that its trade-mark application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponent in the statement of opposition. The presence of a legal onus on the applicant 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, in accordance with the usual rules of evidence, an evidential burden on the opponent to prove the facts inherent in its allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

SECOND GROUND OF OPPOSITION

[13] The second ground of opposition is based on s. 12(1)(b) which reads as follows:

12. (1) Subject to section 13, a trade-mark is registrable if it is not
.....
(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive . . . of the character or quality of the wares . . . in association with which it is used . . . **or of the conditions of or the persons employed in their production or of their place of origin;**
(emphasis added)

Thus, s. 12(1)(b) prohibits marks which are clearly descriptive or deceptively misdescriptive of (1) the character or quality of the wares themselves, or (2) the conditions of how the wares are produced, or (3) the type of persons employed in producing the wares, or (4) the geographical source of the wares.

[14] It appears to me that, at least in the circumstances of the instant case, the two issues raised by the second ground of opposition, that is, whether the applied for mark SUPER COLD is clearly descriptive or deceptively misdescriptive of (i) the conditions of how beer is produced and (ii) a category or type of beer, are closely related. In this regard, if the opponent can show that the mark is descriptive of a process of producing beer, then it will follow that the mark is descriptive of a character or quality of the beer, that is, the beer will have a certain character or quality because it was made by a certain process: see, for example, an excerpt from *Staffordshire Potteries Ltd. v. Registrar of Trade Marks* (1976), 26 C.P.R. (2d) 134 (FCTD) at para. [20], below. The material date to assess the second ground of opposition is the date of filing the application, in this case May 12, 2005: see *Fiesta Barbecues Ltd. v. General Housewares Corp.*, (2003) 28 C.P.R. (4th) 60 (FCTD) at para. 26.

[15] Whether the applied for mark SUPER COLD is clearly descriptive of beer must be considered as a matter of immediate impression from the point of view of the average consumer of beer. A mark is clearly descriptive if it describes a feature, trait or characteristic of the wares in a way that is "easy to understand, self evident or plain:" see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-8; *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186; *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34.

[16] I accept the opponent's submission at paragraph 24 of its written argument:

The purpose of the prohibition in s. 12(1)(b) is to prevent any single trader from appropriating words within the range of language that would ordinarily be used by traders to describe particular goods, and thereby placing legitimate competitors at an undue advantage (*General Motors Corp v. Bellows* (1949), 10 C.P.R. 101 (SCC) at pp. 112-3).

[17] The opponent further relies on *Home Juice Co. et. al. v. Orange Maison Limitée* (1970) 1 C.P.R.(2d) 14 (SCC) at p.16 to argue that the mark SUPER COLD is descriptive of a category of beer:

Respondent has contended that the current meaning in France is not to be considered, that regard must be had only to the meaning current in Canada and that, in the absence of any evidence, whether by dictionaries or otherwise, that the meaning in question was current in Canada at the date of registration, no account should be taken of a recent meaning found in France only. This contention would have serious consequences if it was accepted. One result would be that a shrewd trader could monopolize a new French expression by registering it as a trade mark as soon as it started being used in France or in another French-speaking country and before it could be shown to have begun being used in Canada.

In my opinion, the wording of s. 12 does not authorize such a distinction. It refers to a description "in the English or French languages". Each of these two languages is international. When they are spoken of in common parlance they are considered in their entirety and not as including only the

vocabulary in current use in this country, a vocabulary that is extremely difficult to define especially in these days when communication media are no longer confined within national boundaries.

[18] In my view, the opponent has met the evidential burden on it to put into issue whether the applied for mark SUPER COLD is clearly descriptive of the conditions of production of the applicant's wares. That is, there is sufficient evidence to support the opponent's contention that at the material date the public was aware of a relatively new type of beer in the marketplace and that the new product required low temperatures as part of the brewing process. In other words, the public would understand that when it was purchasing the applicant's SUPER COLD beer product, it was purchasing a beer brewed by a particular process or, in terms of s. 12(1)(b), "of the conditions of . . . their production." As the applicant has not filed any evidence in support of its application, or submitted any legal arguments to counter the opponent's arguments, I find that the applicant has failed to meet the legal onus on it to show, on a balance of probabilities, that the applied for mark SUPER COLD is not prohibited by s.12(1)(b).

[19] Further, in my view the evidence submitted by the opponent suffices to put into issue whether the phrase "super cold" had been adopted, especially in the U.K., as a descriptive term for a relatively new type of beer product. Again, the applicant has not filed any evidence in support of its application nor submitted any legal arguments to counter the opponent's arguments. In the result, I again find that the applicant has failed to satisfy, on a balance of probabilities, the legal onus on it to show compliance with Section 12(1)(b).

[20] There is some parallel between the instant case and *Staffordshire Potteries*, above at para. [14], where the Court, at pp.135-6, found that the term KILNCRAFT, for use in association with tableware, contravened s.12(1)(b):

The word "Kilncraft" is a combination of the two common English words kiln and craft, both of which, in my opinion, contribute to what the composite word suggests. Where used in association with or in relation to tableware, it has, so far as I am aware, no recognized meaning, but to my mind, it strongly suggests that the tableware in association with which, or in respect of which it may be used has been skilfully made by a kiln process. This is what I think it would connote, as a matter of first impression, to a member of the public who saw it on tableware or in the boxes in which such wares are sold, or who heard it spoken in relation to tableware by a store clerk or salesman.

I also think the person seeing or hearing the word [KILNCRAFT] on

such an occasion would probably regard it as assuring that the wares were the product of a kiln process and that they were of good quality. To my mind, the word represents to the viewers or listeners that the wares are so produced and are of such quality, and it is, therefore, clearly descriptive within the meaning of para. 12(1)(b), both of the conditions of production of the tableware in association with which it is used and of the quality of such wares, if not also of their character, as well.

(emphasis added)

[21] I would add that the opponent has brought to my attention *Registrar of Trade-marks v. Provenzano* (1978), 40 C.P.R.(2d) 288 (FCA); aff'g 37 C.P.R. (2d) 189 (FCTD) wherein the Court allowed an appeal from a decision of this Board. The Board had refused an application to register the trade-mark KOLD ONE for beer on the basis that the mark was clearly descriptive or deceptively misdescriptive of the character or quality of beer. The *ratio* of the Trial Division decision is found at p.190:

The adjective "cold", when applied to a "beer" is not in any way descriptive of the intrinsic character or quality of the product. Unlike such food products as ice cream, frozen foods, ices or juices or appliances such as refrigerators, stoves or toasters, the temperature at which it might or might not be delivered, sold or used has nothing to do with the character or quality of the product itself: see for example the word "frigidaire" in *General Motors Corp. v. Bellows* (1949), 10 C.P.R. 101 , [1950] 1 D.L.R. 569, [1949] S.C.R. 678, and words "Tastee Freeze" in *Tastee Freeze International, Ltd.'s Appln.*, [1960] R.P.C. 255. Although a majority of people might prefer to drink their beer cold, others may prefer it at room temperature. The word "cold" in such a case can refer only to the state at which the product, namely, the beer, may or may not be sold or consumed and not to any intrinsic quality or characteristic of the product. It, therefore, is not descriptive of the beer itself.

[22] I agree with the opponent that the *Provenzano* case is distinguishable from the instant case because (i) the prohibition in s.12(1)(b) against describing the conditions of production was not in issue in *Provenzano* and (ii) the cold filtering method of brewing beer was not prevalent in the beer industry at the time that the case was heard. Further, *Provenzano* offers little guidance in the instant case because there is no discussion by the Court of the evidence (if any) submitted by the parties.

Application Nos. 1257440; 1257439 and 1252736 for the Trade-marks EXTRA COLD, EXTRA CHILLED and COLD PACK, respectively

[23] The above referenced applications for the trade-marks EXTRA COLD, EXTRA CHILLED and COLD PACK are also based on proposed use in Canada in association with beer. The applications for EXTRA COLD and EXTRA CHILLED were filed on the same day as the application for SUPER COLD (on May 12,

2005), while the application for COLD PACK was filed shortly before, on April 4, 2005. The opponent's evidence in the three remaining cases consists of the same affidavits of Nick Gatehouse, Megan Langley-Grainger, and Robert White filed in the SUPER COLD case. The only evidence submitted by the applicant consists of the affidavit of Adam Marcus Tracey filed in the COLD PACK case. The opponent submitted a written argument in each of the three remaining cases while the applicant elected not to submit any written arguments. The pleadings, issues and material dates in respect of the oppositions against EXTRA COLD, EXTRA CHILLED and COLD PACK are entirely analogous to those discussed in respect of the opposition to SUPER COLD.

[24] Applying the same considerations and reasoning as in the opposition to the mark SUPER COLD, I find that the applicant has not met the legal onus on it to show that, on a balance of probabilities, the above referenced marks are not in contravention of s.12(1)(b) as alleged in the statements of opposition.

DISPOSITION

[25] In view of the foregoing, application nos. 1257441, 1257440, 1257439 and 1252736 are refused. These decisions have been made pursuant to a delegation of authority under s. 63(3) of the *Trade-marks Act*.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 15th DAY OF MARCH, 2010.

Myer Herzig,
Member,
Trade-marks Opposition Board