

SECTION 45 PROCEEDINGS  
TRADE-MARK: CLASSIC  
REGISTRATION NO.: 179,028

On July 4, 2003 at the request of 88766 Canada Inc. the Registrar forwarded a Section 45 notice to Coca-Cola Ltd / Coca-Cola Ltee., the registered owner of the above-referenced trade-mark registration.

The trade-mark CLASSIC is registered for use in association with the following wares: “carbonated beverages”.

Section 45 of the Trade-marks Act requires the registered owner of a trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on the registration at any time within the three-year period immediately preceding the date of the notice, and if not, the date when it was last in use and the reason for the absence of use since that date. The relevant period in this case is any time between July 4, 2000 to July 4, 2003.

In response to the notice the registrant furnished the affidavit of Silvi Alzetta-Reali together with exhibits. Both parties filed a written argument. An oral hearing has not been requested.

A second affidavit of Silvi Alzetta-Reali sworn May 18, 2004 was furnished with the registrant's written argument. This second affidavit was filed to correct a typographical error made in her first affidavit concerning the name of the registrant. In her first affidavit, the registrant was identified as Coco-Cola Ltd. when in fact it is Coca-Cola Ltd.

In her initial affidavit Silvie Alzetta-Reali states that she is Vice-President, Secretary and Division Counsel of the registrant. She adds that the registrant has extensively used and advertised the trademark CLASSIC in association with carbonated beverages namely COCA-COLA brand soft drinks during the relevant period in Canada. She attaches the following as Exhibits:

Exhibit A: 591 mL POLYLABEL sample dated December 18, 2001;

Exhibit B: 591 mL POLY sample dated June 29, 2001;

Exhibit C: 355 mL CAN sample dated November 22, 2002;

- Exhibit D: 1L SCORE ONE/Alberta sample dated September 11, 2001;
- Exhibit E: 2L sample dated November 22, 2002;
- Exhibit F: 2L straightwall sample dated December 19, 2001;
- Exhibit G: 6 x 237 mL CARRIER (Grey Cup) sample dated July 30, 2001;
- Exhibit H: 12 PACK (New) sample dated November 22, 2002;
- Exhibit I: 12 CAN PACK OLYMPIC sample dated November 1, 2001;

Ms. Alzetta-Realì states that these samples are representative of the way in which the trade-mark CLASSIC has been used on the wares and its packaging by the registrant during the relevant period.

Ms. Alzetta-Realì further states that in excess of 300,000,000 (three-hundred million) unit cases of the wares were sold in association with the trade-mark CLASSIC in Canada during the period January 2000 to December 2002. In addition the wares have been extensively promoted and advertised by the registrant during the relevant period. She attaches as Exhibit J and K samples of “Sustaining Point of Purchase promotional materials” as well as advertisements used in restaurants and food courts for fountain programs during the 2002 and 2003. She states that these samples are

representative of the way in which the trade-mark CLASSIC has been promoted in association with the wares during the relevant period.

She explains that the wares bearing the trade-mark CLASSIC are distributed throughout Canada, including but not limited to, distribution through large grocery stores, fast-food chains and cinemas.

She provides a non-exhaustive list of the registrant's Canadian purchasers/distributors/retailers of the wares sold in association with the trade-mark CLASSIC. She states that the extensive use and advertising has made the CLASSIC trade-mark extremely well known in Canada.

The only argument of the requesting party is that the use shown by the evidence is not use of the trade-mark CLASSIC *per se*. It argues that this is in part substantiated by the fact that the mention “®/MD” on the packaging does not appear after the term “COCA-COLA” and after the term “CLASSIC” but rather underneath COCA-COLA CLASSIC. I reproduce below the manner in which the trade-mark CLASSIC appears in association with the wares as demonstrated by the evidence filed by the registrant:



The registrant on the other hand submits that CLASSIC is used in a font and size different from COCA-COLA and would, as a matter of first impression, be perceived as a separate trade-mark. It submits that that impression is enhanced by the trade-mark notice and legend, as found on Exhibit C to the affidavit. It adds that the ®/MD notice appears below the two trade-marks and the legend refers to “trade-marks of/marques de commerce de Coca-Cola Ltd.”. It relies on the cases *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535; *Registrar of Trade-Marks v. Compagnie Internationale pour l’Informatique CII Honeywell Bull S.A.* (1985), 4 C.P.R. (3d) 523 (F.C.A.) and *Standard Coil Products (Canada) Ltd. v. Standard Radio Corp. and Registrar of*

*Trade-Marks*, 1 C.P.R. (2d) 155.

Having considered the evidence, I agree with the requesting party that the use shown by the evidence is not use of the trade-mark CLASSIC *per se*. In the opposition decision *Nightingale Interloc v. Prodesign*, supra, the then Hearing Officer enunciated the following principle concerning trade-marks used with additional matter:

PRINCIPLE 1

Use of a mark in combination with additional material constitutes use of the mark *per se* as a trade mark if the public, as a matter of first impression, would perceive the mark *per se* as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example, by the use of different lettering or sizing . . . or whether the additional material would be perceived as purely descriptive matter or as a separate mark or trade name . . .

In the case *RTM v. CII Honeywell Bull*, supra, the Federal Court of Appeal addressed the issue of whether the composite mark “CII HONEYWELL BULL” constituted use of the registered trade-mark BULL. At page 525, the Court stated:

“That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identity and remained recognizable in spite of the differences

between the form in which it was registered and the form in which it was used.”

The Court concluded that the use of CII HONEYWELL BULL was not use of “BULL”.

In the case *Standard Coil v. Standard Radio Products*, supra, the Court addressed the issue of whether the word STANDARD “per se” was the trade-mark being used. The trade-mark STANDARD was being used with additional matter, however, the Court found that the word STANDARD was the dominant feature of the trade-mark used and that it overwhelmed all else and, consequently, it concluded that the trade-mark STANDARD had been used.

In the case at hand, I am of the view that as a matter of first impression the public would probably not perceive the word CLASSIC as forming a distinct trade-mark. I arrive at this conclusion even considering the difference in size and font of the words “COCA-COLA” and “CLASSIC”. In my view, the word CLASSIC does not really stand out and therefore I cannot conclude that it would create a separate impression in the minds of the public. Rather, I consider that the public would view

the word CLASSIC as being tied to the words COCA-COLA. Consequently, I am of the view that the public would probably perceive the trade-marks “COCA-COLA” and “COCA-COLA CLASSIC” as being used but not CLASSIC *per se*.

In a trade-mark opposition case involving the present registrant as opponent, that of *Coca-Cola Ltd. v. Southland Corp* (20 C.P.R. (4<sup>th</sup>) 537, the registrant (opponent) relied on several of its registered trade-marks in support of its ground of opposition based on confusion including CLASSIC (the instant trade-mark registration) and COCA-COLA CLASSIC & Design, Registration No. 371,451 shown below:



In considering whether the trade-mark covered by Registration 371,451 constituted use of the trade-mark CLASSIC “per se”, the Member of the TMOB David Martin stated the following at page 543:

“use of the trade-mark COCA-COLA CLASSIC & Design does not constitute use of the



trade-mark CLASSIC "per se" as the average consumer would not view that component as being used as a separate trade-mark. Consumers would view the non-distinctive component CLASSIC as referring to a character, quality or type of the opponent's COCA-COLA brand product: see *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535 and *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) 59 (FCA).”

Here, I arrive at the same conclusion concerning the word CLASSIC as used.

As for the trade-mark notice and legend appearing on the labels or packaging of the registrant’s product, I tend to agree with the requesting party that in view of the location of the ®/MD notice the public would probably interpret the legend as being in reference to the trade-marks COCA-COLA and COCA-COLA CLASSIC.

For all the above reasons I find that the registrant’s evidence fails to show use of the trade-mark CLASSIC *per se* in association with the registered wares. Consequently I conclude that the trade-mark registration ought to be expunged.

Registration No. 179,028 will be expunged in compliance with the provisions of Section

45(5) of the Trade-Marks Act (R.S. 1985, c. T-13).

DATED AT GATINEAU, QUEBEC THIS 8TH DAY OF FEBRUARY 2006.

D. Savard  
Senior Hearing Officer  
Section 45 Division