

**IN THE MATTER OF AN OPPOSITION by MOLSON
BREWERIES, A Partnership to application No. 738,428 for the
trade-mark EXTREME ICE filed by JOHN LABATT
LIMITED/JOHN LABATT LIMITEE, now standing in the name
of LABATT BREWING COMPANY LIMITED/LA
BRASSERIE LABATT LIMITEE**

On September 10, 1993, the applicant, JOHN LABATT LIMITED/JOHN LABATT LIMITEE, filed an application to register the trade-mark EXTREME ICE based on proposed use of the trade-mark by itself and/or through a licensee in association with various wares. The applicant amended its statement of wares at the examination stage to cover “alcoholic brewery beverages”.

The application was advertised for opposition purposes in the *Trade-marks Journal* of July 5, 1995 and the opponent, MOLSON BREWERIES, A Partnership, filed a statement of opposition on August 23, 1995, a copy of which was forwarded to the applicant on October 2, 1995. The applicant served and filed a counter statement on October 19, 1995. The opponent submitted as its evidence the affidavits of Katherine Davie, Elizabeth Elliott, Noel Courage, two affidavits of Michel Morency dated October 17, 1995 and July 11, 1995 and five affidavits of Christine Hasbani dated June 29, 1995, July 4, 1995, August 30, 1995, November 2, 1995 and February 12, 1996. The applicant submitted as its evidence photocopies of the affidavits of Sherrie L. Merz, Kathleen M. Ames and Kevin J. Weichman, photocopies of two affidavits of Bernard Beasley dated December 11, 1995 and June 21, 1995, a photocopy of a notarially certified copy of the file wrapper and contents for trade-mark cancellation No. 24,944 for registration No. 1,936,343, and a photocopy of a certified copy of extracts relating to the trade-mark registered under No. 326,792. The opponent submitted as evidence in reply the affidavit of Theresa M. Corneau.

The parties agreed that the following would also form part of the opposition record: a photocopy of the transcript of the cross-examination of Bernard Beasley held on May 29, 1997; a photocopy of the transcript of the cross-examination of Bernard Beasley held on November 28 and 29, 1995, together with the exhibits thereto, as well as photocopies of documents entitled “Answers to Questions Taken Under Advisement on the Cross-examination of Bernard Beasley Which Took Place November 28.29, 1995 On His Affidavit Sworn June 21, 1995”; a photocopy of the transcript

of the cross-examination of Bernard Beasley held on November 13, 1996, relating to application No. 721,576; and a photocopy of the transcript of the cross-examination of Bernard Beasley held on July 16, 1996, relating to application No. 721,577.

Both parties filed a written argument and both were represented at an oral hearing. Further, during the opposition proceeding, the applicant submitted an amended application in which it disclaimed the right to the exclusive use of the word ICE apart from its trade-mark as a whole. As well, as a result of a change of title recorded by the Trade-marks Office, the present application now stands in the name of LABATT BREWING COMPANY LIMITED/LA BRASSERIE LABATT LIMITEE.

The following are the grounds of opposition relied upon by the opponent:

a) The applicant's trade-mark is not registrable in view of the provisions of Paragraph 12(1)(d) of the *Trade-marks Act* in that trade-mark EXTREME ICE is confusing with the following registered trade-marks:

<u>Trade-mark</u>	<u>Registration No.</u>	<u>Wares</u>
ICE CAP	352,383	Beer based alcoholic beverages, namely a beer cooler
ICE CAP LAGER	180,701	Alcoholic brewery beverages namely, beer, ale, lager, porter and stout
DRY ICE	432,106	Brewed alcoholic beverages

b) The trade-mark EXTREME ICE is not registrable in view of the provisions of Paragraphs 12(1)(b) and 12(1)(c) of the *Trade-marks Act* in that the applicant's use of the words "ICE BEER" and of the word "ICE" have been in such a manner that the word "ICE" has become clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's alcoholic brewery beverages or of their mode or method of production. Furthermore, the words "ICE BEER" are generic in nature and have been used by the applicant and others to define a category of beer and that, as a result, the word "ICE" has become generic in nature and has been used by the applicant and others to define a category of beer. Furthermore, the trade-mark EXTREME ICE is clearly descriptive or deceptively misdescriptive of the character or quality of a particular "ice beer";

c) The present application does not comply with the requirement of Section 30 of the *Trade-marks Act* as the applicant could not have been satisfied that it was entitled to use or register its trade-mark EXTREME ICE in view of the facts set forth in the statement of opposition. Further, the applicant does not intend to use the trade-mark as alleged in the application or at all. Furthermore, the applicant did not and does not intend to use the words EXTREME ICE as a trade-mark;

d) The applicant is not the person entitled to registration of the trade-mark EXTREME ICE in that, at the filing date of the present application, and at all other times, the applicant's mark was confusing with the opponent's trade-marks referred

to in the first ground and as set out below which had previously been used in Canada and/or applications for which were previously filed in Canada:

<u>Trade-mark</u>	<u>Application No.</u>	<u>Wares</u>
BLACK ICE	723,960	Brewed alcoholic beverages, namely, beer
BLACK ICE & Design	730,041	Brewed alcoholic beverages, namely, beer
BLACK ICE DRAFT	721,496	Brewed alcoholic beverages
BLACK ICE FILTRAGE GLACE & Design	725,117	Brewed alcoholic beverages, namely, beer
BLUE ICE	721,504	Brewed alcoholic beverages
CARLING BLACK LABEL ICE DRAFT	721,497	Brewed alcoholic beverages
CLEAR ICE	721,698	Brewed alcoholic beverages
ICE ALE	721,502	Brewed alcoholic beverages
ICE CLEAR	721,499	Brewed alcoholic beverages
ICE DRAFT	721,578	Brewed alcoholic beverages
ICE DRY	721,576	Brewed alcoholic beverages
ICE FILTERED	721,505	Brewed alcoholic beverages
ICE LAGER	721,501	Brewed alcoholic beverages
ICE MALT	721,500	Brewed alcoholic beverages
MOLSON CANADIAN ICE DRAFT	721,579	Brewed alcoholic beverages
MOLSON CANADIAN ICE FILTERED & Design	725,097	Brewed alcoholic beverages, namely, beer
MOLSON ICE DRAFT	721,577	Brewed alcoholic beverages
MOLSON ICE Label Design	732,736	Beer
MOLSON'S BLUE ICE	721,503	Brewed alcoholic beverages
ICE	728,139	Jackets, sweaters, toques, shirts, T-shirts, pants, shorts, pyjamas, socks, slippers, handkerchiefs, scarves, ties, belts, headbands, wristbands, hats, caps, visors; mittens, gloves; sports bags, shoulder bags, tote bags, club bags, cooler bags, racquet bags, garment bags, back packs, ski binding covers, ski boot carrying straps; stadium cushions and blankets; towels, sheets, pillowcases, umbrellas, aprons, bibs; glassware, namely glasses, cups, mugs, steins, stemware, plastic cups, steins made of plastic, pewter or glass, ashtrays, travel kits, golf balls, scoresheets, cribbage boards, dart cabinets, puzzles; key chains, letter openers, lighters, matches, badges, pins, buttons, watches, business card cases,

		trinket boxes, pencil holders, pens, pen and pencil sets, markers, telephone, flashlights, brochures, paper weights, book marks, note magnets, plaques, medallions, flags, posters, banners, bumper stickers, calendars, maps, post cards, place mats, decals, crests, coasters; trays, clocks, cheese boards, openers, bottle openers, patio tables, draught signs, tap handles.
MOLSON CANADIAN ICE Label Design	749,882	Earrings. Shirts, sweatshirts, T-shirts, tops, sweaters, jackets, shorts, pants, umbrellas, watches, caps, tote bags, sports bags, cooler bags, golf bags, glasses, steins, cups, towels, ice buckets, buttons, key chains, bottle openers, lighters and playing cards. Socks. Housewares namely, tap handles.
BLACK ICE Label Design	750,021	Earrings. Shirts, sweatshirts, T-shirts, jackets, bathing suits, umbrellas, caps, sports bags, cooler bags, glasses, key chains and bottle openers. Clothing namely, tops, sweaters, vests, rain suits, pyjamas, robes, bustiers, shorts, pants and underwear; accessories namely, wallets, watches, slippers, suspenders, headbands, hats, scarves, mittens, gloves, ties, visors, belts, socks and sunglasses; bags namely, tote bags, suit bags, golf bags, briefcases, back packs and hip packs; glassware and related accessories namely, steins, mugs, cups, sports bottles, coasters and insulated beverage holders; housewares namely, towels, aprons, napkins, placemats, oven mitts, cushions, ice chests, ice buckets, beer tubs, tap handles, ashtrays, serving trays and framed pictures; novelties namely, buttons, pins, lighters, playing cards, mirrors, pens, signs, dancing cans, darts, dart accessories, clocks, baseballs, volleyball nets, golf balls, golf tees, ball markers, fishing lures, posters, sand bottle sculpture, puzzles, games, paper weights, note magnets, calendars, business card cases, stickers; food namely, packaged nuts and spices.
OV ICE Label Design	757,038	Brewed alcoholic beverages, namely, beer
MOLSON ICE & Design	763,427	Clothing, namely, sweatshirts, T-shirts, jackets; accessories, namely, watches, caps; bags, namely, sports bags; glassware and related accessories, namely, coasters; housewares, namely, ice buckets.

e) The applicant's trade-mark is not distinctive in view of the facts alleged in the statement of opposition and also since it is not adapted to distinguish nor does it distinguish the wares in association with which it is proposed to be used by the applicant from the wares of others including the wares of the opponent. The opponent has extensively sold brewed alcoholic beverages, namely, beer in Canada and advertised same in association with its aforementioned trade-marks all of which contain the word ICE. The opponent has a family of trade-marks which have been used extensively by the opponent and which include the word "ICE" and accordingly

the trade-mark EXTREME ICE cannot be distinctive of the applicant.

f) The applicant has never intended to use the word “ICE” or the words EXTREME ICE as a trade-mark. The applicant has not licensed or authorized the use of the trade-mark EXTREME ICE in the manner specified in the *Trade-marks Act* and accordingly, the applicant’s trade-mark cannot be distinctive of it in view of its use by others. Furthermore, such use and advertising or the word “ice” is such that when it is utilized by the applicant and also in conjunction with the word “extreme”, the mark cannot possibly function as a trade-mark in that it cannot distinguish the alcoholic brewery beverages of the applicant from those of others.

Considering initially the second ground of opposition, the opponent has alleged that the trade-mark EXTREME ICE is clearly descriptive or deceptively misdescriptive of the character or quality of a particular “ice beer” and therefore is not registrable in view of Paragraph 12(1)(b) of the *Trade-marks Act*. In support of this ground, the opponent further alleged that the applicant’s use of the words “ICE BEER” and of the word “ICE” have been in such a manner that the word “ICE” has become clearly descriptive or deceptively misdescriptive of the character or quality of the applicant’s alcoholic brewery beverages or of their mode or method of production and that the words “ICE BEER” are generic in nature and have been used by the applicant and others to define a category of beer and that, as a result, the word “ICE” has become generic in nature and has been used by the applicant and others to define a category of beer.

In determining whether the trade-mark EXTREME ICE is clearly descriptive of the character or quality of alcoholic brewery beverages, the trade-mark must not be dissected into its component elements and carefully analyzed, but rather must be considered in its entirety as a matter of immediate impression from the point of view of the average consumer of those wares [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25, at pp. 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183, at p. 186)]. The material date for considering a Paragraph 12(1)(b) ground of opposition is as of the date of decision [see *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers*, 41 C.P.R. (3d) 243 (F.C.A.)] and, while the legal burden is upon the applicant to show that its trade-mark EXTREME ICE is registrable, there is an initial evidential burden on the opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of its allegations that the trade-mark is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant’s

“alcoholic brewery beverages”, or of the conditions of their production.

In the present case, the applicant’s disclaimer of the word ICE apart from its trade-mark is arguably an admission by the applicant that the word ICE is either clearly descriptive of the character or quality of such wares, or otherwise is common to the trade or is the name of such wares [see *Andres Wines Ltd. v. Les Vins La Salle Inc.*, 3 C.P.R. (3d) 272, at p. 275]. Further, in paragraph 19 of its written argument, the applicant admits that the word “ice” is not distinctive when used in association with alcoholic brewery beverages. In any event, the opponent’s evidence supports the conclusion that the word “ice” describes a type or category of beer. However, the issue is whether the trade-mark EXTREME ICE is, when considered as a matter of immediate impression from the point of view of the average consumer of alcoholic brewery beverages, clearly descriptive or deceptively misdescriptive of the character or quality of those wares, or of the conditions of their production. In this regard, I would note that the opponent’s allegations in relation to this ground point to the descriptive significance of the word ICE and not to the trade-mark EXTREME ICE.

The applicant submitted at the oral hearing that the Registrar can take judicial notice of the fact that there are a number of trade-marks on the register for the mark EXTREME. In this regard, the Registrar, acting in the public interest to maintain the purity of the register, may check the register to confirm the existence of a registration or pending application referred to in a statement of opposition. However, I do not consider there to be any public interest in assisting an applicant to register its trade-mark by checking Office records and thereby doing what the applicant ought to have done by filing evidence in the opposition [see, in this regard, *John Labatt Ltd./ John Labatt Ltée v. W.C.W. Western Canada Water Enterprises Inc.*, 39 C.P.R. (3d) 442, at pp. 445-446]. On the other hand, the Registrar can have regard to dictionary definitions to assist in the determination of a Paragraph 12(1)(b) ground. Thus, the word “extreme” as an adjective is defined in the WWWebster Dictionary as follows:

1 a : existing in a very high degree <extreme poverty> b : going to great or exaggerated lengths : RADICAL <went on an extreme diet> c : exceeding the ordinary, usual, or expected <extreme weather conditions>
2 archaic : LAST
3 : situated at the farthest possible point from a center <the country's extreme north>
4 a : most advanced or thoroughgoing <the extreme political left> b : MAXIMUM
synonym see EXCESSIVE

- ex·treme·ness noun

Considering the dictionary meanings of the word “extreme”, I do not consider that the average consumer of alcoholic brewery beverages would, as a matter of immediate impression, react to the trade-mark EXTREME ICE as being either descriptive or misdescriptive of either the character or quality of such wares, or of the conditions of their production. Indeed, the word EXTREME does not appear to convey any meaning in relation to alcoholic brewery beverages. I have therefore dismissed this ground of opposition.

The opponent also alleged that the applicant’s trade-mark is not registrable in view of the provisions of Paragraph 12(1)(d) of the *Trade-marks Act* in that it is confusing with the registered trade-marks: ICE CAP, registration No. 352,383, covering “Beer based alcoholic beverages, namely a beer cooler”; ICE CAP LAGER, registration No. 180,701, covering “Alcoholic brewery beverages namely, beer, ale, lager, porter and stout”; and DRY ICE, registration No. 432,106, as applied to “Brewed alcoholic beverages”. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all of the surrounding circumstances including those specifically set forth in Subsection 6(5) of the *Trade-mark Act*. Further, the Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of decision, the material date with respect to the Paragraph 12(1)(d) ground [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

Considering the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)] and the extent to which the marks have become known [Para. 6(5)(a)], the applicant’s trade-mark EXTREME ICE and the opponent’s registered trade-marks ICE CAP and ICE CAP LAGER possess some measure of inherent distinctiveness when considered in their entireties as applied to alcoholic brewery beverages even though the word ICE in each of the marks is descriptive and is common to the trade. Further, the trade-mark DRY ICE is comprised of descriptive elements and therefore possesses little inherent distinctiveness. No evidence has been furnished by the parties relating to

their use of the trade-marks EXTREME ICE, ICE CAP, ICE CAP LAGER and DRY ICE and the marks of both parties must therefore be considered as not have become known to any extent in Canada. As a result, neither the extent to which the trade-marks have become known nor the length of time the marks have been in use [Para. 6(5)(b)] are particularly relevant surrounding circumstances in assessing the likelihood of confusion in relation to the Paragraph 12(1)(d) ground.

With respect to the nature of the wares [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] of the parties, the applicant's alcoholic brewery beverages and the wares covered in the opponent's registrations are essentially the same, as would be their respective channels of trade. As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], I find there to be a minor degree of similarity in appearance and in sounding between the trade-marks EXTREME ICE and the registered trade-marks ICE CAP, ICE CAP LAGER and DRY ICE when the marks are considered in their entireties. Further, while all four marks suggest some connection with "ice", I do not consider that either party is entitled to a monopoly in respect of such an idea as applied to alcoholic brewery beverages.

As a further surrounding circumstance in assessing the likelihood of confusion between the trade-marks at issue, the applicant has adduced evidence which points to the existence of SCHLITZ ICE beer and OLD MILWAUKEE ICE beer being available in the marketplace in Canada.

Having regard to the foregoing and, in particular, to the fact that there is only a minor degree of similarity in sounding and in appearance between the trade-marks at issue, and having regard to the use of the third party trade-marks SCHLITZ ICE and OLD MILWAUKEE ICE in the marketplace in Canada as applied to beer, I find that there would be no reasonable likelihood of confusion between the applicant's trade-mark EXTREME ICE and the opponent's registered trade-marks ICE CAP, ICE CAP LAGER and DRY ICE. I have therefore rejected this ground of opposition.

The opponent also alleged that the present application does not comply with the requirement of Section 30 of the *Trade-marks Act*. While the legal burden is on the applicant to show that its

application complies with Section 30 of the *Trade-marks Act*, there is an initial evidential burden on the opponent to adduce sufficient evidence which, if believed, would support the truth of the allegations relating to the Section 30 grounds [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. To meet the evidential burden upon it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293, at p. 298]. Further, the material time for considering the circumstances respecting the issue of non-compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R.(3d) 469, at p. 475]. Finally, the opponent's evidential burden can be met by reference not only to the opponent's evidence, but also to the applicant's evidence [see, in this regard, *Labatt Brewing Company Limited v. Molson Breweries, a Partnership*, 68 C.P.R.(3d) 216, at p. 230]. However, while the opponent may rely upon the applicant's evidence to meet its evidential burden in relation to this ground, the opponent must show that the applicant's evidence is 'clearly' inconsistent with the applicant's claims set forth in its application.

As a second aspect of its Section 30 ground, the opponent asserted that the applicant does not intend to use the trade-mark as alleged in the application or at all and does not intend to use the words EXTREME ICE as a trade-mark. No evidence has been furnished by the opponent to show that the applicant, as of the filing date of the present application, either did not intend to use the trade-mark as alleged in the application or at all or did not intend to use the words EXTREME ICE as a trade-mark. Further, there is nothing in the applicant's evidence which is clearly inconsistent with its claim that it intended to use the trade-mark EXTREME ICE in Canada by itself and/or through a licensee in association with wares covered in the application as filed and as subsequently amended. Moreover, the subsequent assignment by the applicant of its trade-mark does not alter this conclusion. I have therefore dismissed this aspect of the Section 30 ground.

The first aspect of the Section 30 ground is based on Subsection 30(i) of the *Trade-marks Act*, the opponent alleging that the applicant could not have been satisfied as to its entitlement to use or register its trade-mark EXTREME ICE in association with alcoholic brewery beverages. No

evidence has been furnished by the opponent to show that the applicant could not have been satisfied that it was entitled to use the trade-mark EXTREME ICE in Canada. Moreover, to the extent that the Subsection 30(i) issue is founded upon allegations set forth in the remaining ground of opposition, the success of the Subsection 30(i) ground is contingent upon a finding that the applicant's trade-mark EXTREME ICE is not registrable or not distinctive, or that the applicant is not the person entitled to its registration, as alleged in those grounds [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at p. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at p. 155]. I will therefore consider the remaining grounds of opposition.

As its fourth ground, the opponent alleged that the applicant is not the person entitled to registration of the trade-mark EXTREME ICE in that, at the date of filing the present application, the applicant's mark was confusing with the opponent's trade-marks referred to in the Paragraph 12(1)(d) ground, as well as with the trade-marks identified in paragraph (d) of the statement of opposition which had previously been used in Canada and/or applications for which were previously filed in Canada. No evidence of prior use of any of its trade-marks identified above has been adduced by the opponent. Rather, the opponent sought to rely on the transcript of the Beasley cross-examination of November 28/29, 1995 as establishing its use of its trade-marks MOLSON CANADIAN ICE DRAFT and BLACK ICE in Canada prior to the applicant's filing date [September 10, 1993]. The transcript of Mr. Beasley's cross-examination points to the opponent's use of the MOLSON CANADIAN ICE DRAFT mark prior to September of 1993 although it is somewhat unclear as to whether the opponent's use of the BLACK ICE mark prior to September of 1993 has been shown to have been established by the transcript. However, I will proceed on the basis that the opponent has met its burden under Subsections 16(5) and 17(1) of the *Trade-marks Act* in relation to these two marks but has otherwise failed to meet its burden in relation to the remainder of the marks being relied upon in relation to the Paragraph 16(3)(a) issue.

In view of the above, the legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between its trade-mark EXTREME ICE and the opponent's trade-marks MOLSON CANADIAN ICE DRAFT and BLACK ICE as of the applicant's filing date. Again, in determining whether there would be a reasonable likelihood of confusion between the

applicant's mark and the opponent's trade-marks, the Registrar must have regard to all of the surrounding circumstances including those specifically set forth in Subsection 6(5) of the *Trade-mark Act*. Further, the Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the filing date of the present application, the material date with respect to the Paragraph 16(3)(a) ground.

Considering the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)] and the extent to which the marks have become known [Para. 6(5)(a)], the applicant's trade-mark EXTREME ICE and the opponent's trade-marks BLACK ICE and MOLSON CANADIAN ICE DRAFT possess some measure of inherent distinctiveness when considered in their entirety as applied to alcoholic brewery beverages even though the word ICE in each of the marks is descriptive. As no evidence has been furnished by the applicant relating to its use of the trade-mark EXTREME ICE, its mark must be considered as not having become known to any extent in Canada. It is unclear from the transcript of the Beasley affidavit as to the extent to which the opponent's trade-marks have become known as of September of 1993 although I am prepared to find that these marks had become known to some extent in Canada as of that date. As a result, the extent to which the trade-marks have become known and the length of time the marks have been in use [Para. 6(5)(b)] both weigh in the opponent's favour.

With respect to the nature of the wares [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] of the parties, the applicant's alcoholic brewery beverages and the beer associated with the opponent's marks are essentially the same, as would be their respective channels of trade. As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], I consider there to be relatively little similarity in appearance or in sounding between the trade-mark EXTREME ICE and the opponent's trade-mark MOLSON CANADIAN ICE DRAFT although there is a fair degree of similarity in appearance between the applicant's mark and the opponent's trade-mark BLACK ICE although there is relatively little similarity in the sounding between the applicant's mark and the BLACK ICE trade-mark. While all three trade-marks suggest some connection with "ice", I do not consider that either party is entitled to a monopoly in respect of such an idea when applied to

alcoholic brewery beverages.

As there is relatively little similarity either in sounding or in appearance between the trade-mark EXTREME ICE and the opponent's trade-mark MOLSON CANADIAN ICE DRAFT, and even bearing in mind that the wares and channels of trade of the parties are the same, I have concluded that there would be no reasonable likelihood of confusion between these marks. Likewise, with respect to the opponent's trade-mark BLACK ICE, and again bearing in mind that the wares and channels of trade associated with these marks and the applicant's trade-mark would be the same, I am satisfied that the degree of resemblance between these marks is not such that there would be a reasonable likelihood of confusion between them. As a result, I have rejected this aspect of the fourth ground.

The opponent has also relied upon its previously filed applications in challenging the applicant's entitlement to registration under Paragraph 16(3)(b) of the *Trade-marks Act*. The opponent has not submitted copies of its pending applications as evidence in this opposition. However, as noted in *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.*, 11 C.P.R. (3d) 410, the Registrar does have the discretion, in view of the public interest to maintain the purity of the register, to check the register in order to confirm the existence of registrations relied upon by the opponent in support of its Paragraph 12(1)(d) ground. Likewise, having regard to the potential public interest in assessing a Paragraph 16(1)(b), 16(2)(b) or 16(3)(b) ground, the Registrar will exercise his discretion to check the Trade-marks Office records to confirm the existence of a pending application or pending applications being relied upon in support of such a ground [see *Royal Appliance Mfg. Co. v. Iona Appliances Inc.*, 32 C.P.R. (3d) 525, at p. 529]. In doing so, I noted that four of the opponent's applications for registration of the trade-marks MOLSON CANADIAN ICE Label Design (application No. 749,882), BLACK ICE Label Design, (application No. 750,021), OV ICE Label Design, (application No. 757,038) and MOLSON ICE & Design, (application No. 763,427) were filed subsequent to the filing date of the present application and therefore do not qualify as previously-filed applications. Furthermore, the opponent has abandoned its applications for the following trade-marks: CLEAR ICE; ICE ALE; ICE CLEAR; ICE DRAFT; ICE DRY; ICE FILTERED; ICE LAGER; ICE MALT; ICE; and MOLSON'S BLUE ICE.

However, the abandoned applications, as well as the remainder of the applications relied upon by the opponent, qualify as previously filed applications and all were pending as of the date of advertisement of the present application [July 5, 1995]. The opponent has therefore met its burden under Subsection 16(4) in relation to this ground as it applies to these applications. As a result, the legal burden is on the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark EXTREME ICE and one, or more, of the following trade-marks: BLACK ICE, (application No. 723,960); BLACK ICE & Design, (application No. 730,041); BLACK ICE DRAFT, (application No. 721,496); BLACK ICE FILTRAGE GLACE& Design, (application No. 725,117); BLUE ICE, (application No. 721,504); CARLING BLACK LABEL ICE DRAFT, (application No. 721,497); CLEAR ICE, (application No. 721,698); ICE ALE, (application No. 721,502); ICE CLEAR, (application No. 721,499); ICE DRAFT, (application No. 721,578); ICE DRY, (application No. 721,576); ICE FILTERED, (application No. 721,505); ICE LAGER, (application No. 721,501); ICE MALT, (application No. 721,500); MOLSON CANADIAN ICE DRAFT, (application No. 721,579); MOLSON CANADIAN ICE FILTERED & Design, (application No. 725,097); MOLSON ICE DRAFT, (application No. 721,577); MOLSON ICE Label Design, (application No. 732,736); MOLSON'S BLUE ICE, (application No. 721,503) and ICE, (application No. 728,139).

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all of the surrounding circumstances including those specifically set forth in Subsection 6(5) of the *Trade-mark Act*. Further, the Registrar must bear in mind that the onus or legal burden is on the applicant to show that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the filing date of the present application, the material date with respect to the Paragraph 16(3)(b) ground.

Considering the inherent distinctiveness of the trade-marks at issue [Para. 6(5)(a)] and the extent to which the marks have become known [Para. 6(5)(a)], the applicant's trade-mark EXTREME ICE and the opponent's trade-marks BLACK ICE, BLACK ICE & Design, BLACK ICE DRAFT, BLACK ICE FILTRAGE GLACE& Design, BLUE ICE, CARLING BLACK LABEL ICE DRAFT, CLEAR ICE, ICE CLEAR, MOLSON CANADIAN ICE DRAFT, MOLSON CANADIAN

ICE FILTERED & Design, MOLSON ICE DRAFT, MOLSON ICE Label Design and MOLSON'S BLUE ICE all possess some measure of inherent distinctiveness when considered in their entireties as applied to alcoholic brewery beverages even though the word ICE in each of the marks is descriptive. On the other hand, the opponent's trade-marks ICE ALE, ICE DRAFT, ICE DRY, ICE MALT, ICE LAGER and ICE FILTERED comprise descriptive elements and therefore possess little inherent distinctiveness as applied to the wares covered in these applications. Further, the opponent's trade-mark ICE as applied to clothing and various merchandising items covered in application No. 728,139 is inherently distinctive.

As noted above, it is unclear from the transcript of the Beasley affidavit as to the extent to which the opponent's trade-marks MOLSON CANADIAN ICE DRAFT and BLACK ICE had become known as of September of 1993 although I am prepared to find that these marks had become known to some extent in Canada as of the applicant's filing date. As a result, the extent to which the trade-marks have become known and the length of time the marks have been in use [Para. 6(5)(b)] both weigh in the opponent's favour in relation to these two marks only. However, as no evidence has been furnished by the applicant relating to its use of the trade-mark EXTREME ICE and as no evidence has been adduced relating to the opponent's use of the remainder of its marks prior to the applicant's filing date, these marks must therefore be considered as not having become known to any extent in Canada and, in relation to these mark, neither the extent to which the trade-marks have become known nor the length of time the marks have been in use [Para. 6(5)(b)] are particularly relevant surrounding circumstances in assessing the likelihood of confusion in relation to the Paragraph 16(3)(b) ground.

With respect to the nature of the wares [Para. 6(5)(c)] and the nature of the trade [Para. 6(5)(d)] of the parties, the applicant's alcoholic brewery beverages and the wares covered in the opponent's applications with the exception of application No. 728,139 are essentially the same, as would be their respective channels of trade. As for the degree of resemblance between the trade-marks at issue [Para. 6(5)(e)], I consider there to be relatively little similarity in appearance or in sounding between the trade-mark EXTREME ICE and the opponent's trade-marks: BLACK ICE &

Design; BLACK ICE FILTRAGE GLACE & Design; CARLING BLACK LABEL ICE DRAFT; MOLSON CANADIAN ICE DRAFT; MOLSON CANADIAN ICE FILTERED & Design; MOLSON ICE DRAFT; MOLSON ICE Label Design and MOLSON'S BLUE ICE when these marks are considered in their entireties. However, I find there to be a fair degree of similarity in appearance between the applicant's trade-mark and the opponent's marks BLACK ICE, BLACK ICE DRAFT, BLUE ICE, CLEAR ICE, ICE CLEAR, ICE ALE, ICE DRAFT, ICE DRY, ICE MALT, ICE LAGER and ICE FILTERED although there is relatively little similarity in the sounding of the applicant's mark and these trade-marks. Finally, I consider the applicant's trade-mark and the opponent's trade-mark ICE to be similar in appearance and in sounding in that the applicant's mark incorporates the entirety of the opponent's trade-mark. While all of the above trade-marks suggest some connection with "ice", I do not consider that either party is entitled to a monopoly in respect of such an idea when the mark is applied to alcoholic brewery beverages.

As a further surrounding circumstance in considering the likelihood of confusion between the trade-marks at issue in relation to this ground, the opponent, as noted above, abandoned its applications for the following trade-marks: CLEAR ICE; ICE ALE; ICE CLEAR; ICE DRAFT; ICE DRY; ICE FILTERED; ICE LAGER; ICE MALT; ICE; and MOLSON'S BLUE ICE. Having regard to the decision of the Federal Court, Trial Division in *Molson Breweries, A Partnership v. Labatt Brewing Co. Ltd.*, 68 C.P.R. (3d) 202, at pp. 221-213, the subsequent abandonment of an application is a relevant surrounding circumstance which can be taken into consideration in assessing the likelihood of confusion in relation to a Paragraph 16(3)(b) ground of opposition.

Having regard to the foregoing and, in particular, to the fact that the trade-marks ICE ALE, ICE DRAFT, ICE DRY, ICE MALT, ICE LAGER and ICE FILTERED are very weak marks and have not been shown to have acquired any measure of distinctiveness in Canada, and bearing in mind the subsequent abandonment by the opponent of its applications for these marks, I find there to be no reasonable likelihood of confusion between the applicant's trade-mark EXTREME ICE and the opponent's applications for the trade-marks ICE ALE, ICE DRAFT, ICE DRY, ICE MALT, ICE LAGER and ICE FILTERED. Further, as there is only a fair degree of similarity in appearance between the applicant's trade-mark and the opponent's marks CLEAR ICE and ICE CLEAR and

having regard to the subsequent abandonment by the opponent of its applications for these marks, I also find that there would be no reasonable likelihood of confusion between applicant's mark and either of these marks. Moreover, in view of the differences in the wares associated with the applicant's mark and the trade-mark ICE, and bearing in mind the subsequent abandonment by the opponent of application No. 728,139, there would in my view be no reasonable likelihood of confusion between the applicant's trade-mark EXTREME ICE and the opponent's application for the trade-mark ICE.

Considering that there is relatively little similarity either in sounding or in appearance between the trade-mark EXTREME ICE and the opponent's trade-marks BLACK ICE & Design, BLACK ICE FILTRAGE GLACE & Design, CARLING BLACK LABEL ICE DRAFT, MOLSON CANADIAN ICE DRAFT, MOLSON CANADIAN ICE FILTERED & Design, MOLSON ICE DRAFT, MOLSON ICE Label Design, MOLSON'S BLUE ICE, and even bearing in mind that the wares and channels of trade of the parties are the same, I have concluded that there would be no reasonable likelihood of confusion between these marks. As for the opponent's trade-marks BLACK ICE, BLACK ICE DRAFT and BLUE ICE, and even bearing in mind that the wares and channels of trade associated with these marks and the applicant's trade-mark would be the same, I am satisfied that the degree of resemblance between these marks is not such that there would be a reasonable likelihood of confusion between them. As a result, I have rejected the Paragraph 16(3)(b) ground of opposition.

The fifth ground relates to the alleged non-distinctiveness of the applicant's mark, the opponent asserting that it has extensively sold brewed alcoholic beverages, namely, beer in Canada and advertised same in association with its aforementioned trade-marks all of which contain the word ICE. Further, the opponent submitted that it has a family of trade-marks which have been used extensively by it and which include the word "ICE" and accordingly the trade-mark EXTREME ICE cannot be distinctive of the applicant. However, no evidence has been furnished by the opponent to show that its trade-marks had acquired any measure of a reputation in Canada or that it has a family of trade-marks in this country. Further, while the transcript of the Beasley cross-examination of November 28/29, 1995 indicates that Mr. Beasley was aware of certain of the opponent's trade-

marks such as MOLSON CANADIAN ICE DRAFT, BLACK ICE, CARLING ICE and MOLSON ICE being used in association with beer prior to the date of opposition, this evidence does not show the extent to which the opponent's marks had become known by the public in Canada as of that date. As a result, the Beasley affidavit of June 21, 1995 and the transcript of the November 28/29, 1995 cross-examination show that the applicant had established far more of a reputation in Canada for its "ICE" trade-marks as of the material date than had the opponent. In any event, the applicant's evidence significantly diminishes any alleged reputation which the opponent could possibly claim in its "ICE" marks or in the existence of a family of such marks in Canada as of the date of opposition. I have therefore dismissed this ground.

The final ground is also based on the applicant's trade-mark being non-distinctive, the opponent asserting that the applicant has not licensed or authorized the use of the trade-mark EXTREME ICE in the manner specified in the *Trade-marks Act* and accordingly, the applicant's trade-mark cannot be distinctive of it in view of its use by others. However, the applicant's evidence points to the fact that it had not yet used the trade-mark in Canada as of the date of opposition [see response to question 1624, transcript of Beasley cross-examination of November 28/29, 1995] and no evidence has been adduced by the opponent to otherwise show that there had been any use, whether unauthorized or otherwise, of the mark EXTREME ICE in this country. I have therefore dismissed this aspect of the final ground.

The opponent also asserted that such use and advertising or the word "ice" is such that when it is utilized by the applicant and also in conjunction with the word "extreme", the mark cannot possibly function as a trade-mark in that it cannot distinguish the alcoholic brewery beverages of the applicant from those of others. However, having rejected the Paragraph 12(1)(b) ground and having concluded that there would be no reasonable likelihood of confusion between the applicant's mark and the opponent's trade-marks being relied upon in this opposition, I have concluded that this aspect of the final ground is also unsuccessful.

The opponent submitted at the oral hearing that the assignment of the applicant's "ICE" marks prior to the date of opposition and the use by the assignee of these marks subsequent to the

assignment without notice to the public of the change of ownership has resulted in a loss of distinctiveness of the applicant's "ICE" marks in view of the decision in the *Wilkinson Sword* case. As a result, the applicant's trade-mark EXTREME ICE was not adapted to distinguish its "alcoholic brewery beverages" associated with the mark as of the date of opposition. However, no such allegation has been pleaded by the opponent in either of its non-distinctiveness grounds. Moreover, I am not prepared to infer that this issue is contemplated by the reference to the "use by others" in the final ground. I have therefore dismissed the final ground of opposition.

Having been delegated authority by the Registrar of Trade-marks pursuant to Subsection 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Subsection 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC THIS 28th DAY OF OCTOBER, 1999.

G.W.Partington,
Chairperson,
Trade-marks Opposition Board.