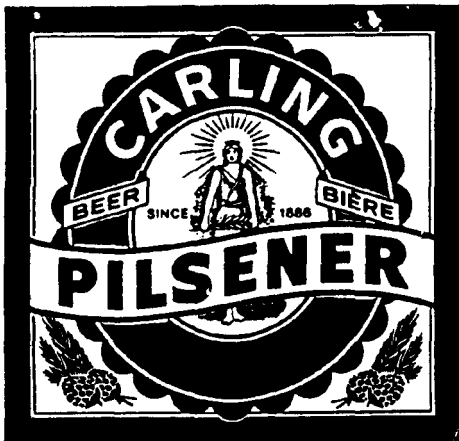


**IN THE MATTER OF AN OPPOSITION  
by Molson Breweries, A Partnership to applica-  
tion No. 779,115 for the trade-mark PILSENER  
LAGER & Design filed by Jebsen & Co., Ltd.**

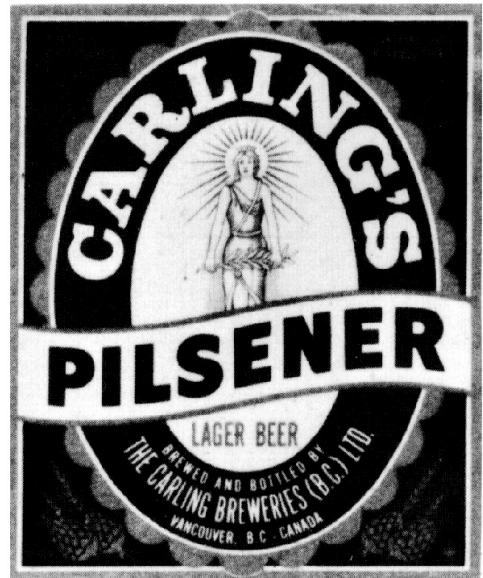
On March 30, 1995, the applicant, Jebsen & Co., Ltd., filed an application to register the trade-mark PILSENER LAGER & Design (illustrated below) for “beer, ale and porter” based on proposed use in Canada. The application was amended to include a disclaimer to the phrase PILSENER LAGER BIER and the word SCHUTZ. The application was advertised for opposition purposes on November 1, 1995.



The opponent, Molson Breweries, A Partnership, filed a statement of opposition on December 29, 1995, a copy of which was forwarded to the applicant on January 24, 1996. The first ground of opposition is that the applicant’s application does not conform to the requirements of Section 30(i) of the Trade-marks Act because the applicant could not have been satisfied that it was entitled to use the applied for trade-mark. The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the trade-mark CARLING’S PILSENER & Design (illustrated below) registered under No. 125,324 for “lager beer” and the trade-mark CARLING PILSENER & Design (illustrated below) registered under No. 352,372 for “brewed alcoholic beverages.” The third ground is that the applied for trade-mark is not distinctive because it is confusing with the opponent’s marks.



Registration No. 352,372



Registration No. 125,324

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Sandra M. Ward which introduces into evidence particulars of the opponent's two registrations. The applicant did not submit evidence. Both parties filed a written argument and an oral hearing was conducted at which only the opponent was represented.

Subsequent to the call for written arguments, the opponent requested leave on August 18, 1997 to amend its statement of opposition to rely on a third registration (No. TMDA43139). Due to (1) the late stage of the proceeding, (2) the failure of the opponent to explain why the amendment was not requested much earlier and (3) the potential prejudice to the applicant who had already commenced Section 45 proceedings against the opponent's other two registrations, I refused the opponent's request pursuant to Rule 40 of the Trade-marks Regulations on September 29, 1997.

At the commencement of the oral hearing, the opponent's agent reiterated the request for leave to amend the statement of opposition to include the third registration. She submitted that there was no prejudice to the applicant since the applicant had not, in fact, commenced

Section 45 proceedings against the opponent's third registration. There is, however, no evidence to support that submission. In any event, it would not be surprising to find that the applicant had not commenced Section 45 proceedings against the third registration given that the opponent's request for leave to rely on it in this opposition was refused. Since there was effectively no change in circumstances since the opponent's initial request for leave, I also refused the opponent's second request pursuant to Rule 40.

As for the first ground, the opponent failed to include any supporting allegations of fact. Thus, the first ground is not a proper ground of opposition and is unsuccessful.

As for the third ground of opposition, there was an initial burden on the opponent to evidence some reputation for its two registered marks in Canada. Since the opponent failed to file any evidence in this regard, the third ground is also unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Furthermore, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act. Finally, I will first consider the issue of confusion as between the applicant's mark and the opponent's mark CARLING'S PILSENER & Design registered under No. 125,324.

As for Section 6(5)(a) of the Act, the marks of both parties are inherently distinctive although both include non-distinctive elements. Based on the absence of evidence of use of either mark, I must conclude that neither mark has become known in Canada.

**The length of time the marks have been in use is not a material circumstance in the present case. The wares of the parties are the same and presumably the trades of the parties would also be the same.**

**As for Section 6(5)(e) of the Act, there is a fair degree of visual resemblance between the two marks. Both are dominated by an ornate oval frame which encloses a drawing of a woman with a sun design above her head. A dominant element of both marks is the word PILSENER. The ideas suggested by the two marks are also similar, namely an old style pilsener type beer. The degree of phonetic resemblance between the marks is not as great since the applicant's mark would likely be identified as PILSENER LAGER BIER and the opponent's mark would likely be sounded as CARLING'S PILSENER.**

**In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, trades and marks at issue, I find that I am left in a state of doubt respecting the issue. Given that the onus is on the applicant, I must resolve that doubt against it. Thus, the second ground of opposition based on registration No. 125,324 is successful. It is therefore unnecessary to consider the other aspect of the second ground based on registration No. 352,372.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application.**

**DATED AT HULL, QUEBEC, THIS 1st DAY OF APRIL, 1999.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**