



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

Citation: 2011 TMOB 193
Date of Decision: 2011-10-17

**IN THE MATTER OF AN OPPOSITION
by Molson Canada 2005 to application
No. 1,365,023 for the trade-mark 24 du 24
in the name of Labatt Breweries of
Canada**

[1] On September 18, 2007, Labatt Breweries of Canada (the Applicant) filed an application to register the trade-mark 24 du 24 (the Mark) based on proposed use of the Mark in Canada.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 27, 2008. The statement of wares reads “alcoholic brewery beverages; signs; banners; posters; packaging for beverages, namely containers for bottles or cans of beer”.

[3] On January 27, 2009, Molson Canada 2005 (the Opponent) filed a statement of opposition.

[4] The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

[5] In support of its opposition, the Opponent filed an affidavit of D. Jill Roberts and a certified copy of Canadian trade-mark application No. 1,360,916. In support of its application, the Applicant filed an affidavit of Keith Gregory Hunt and an affidavit of Brett Reynolds. No cross-examinations were conducted.

[6] Only the Opponent filed a written argument. An oral hearing was not held.

Grounds of Opposition and Related Material Dates

[7] The Opponent has pleaded the following grounds of opposition pursuant to the indicated sections of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. s. 38(2)(a)/30: i) the Applicant could not have been satisfied that it was entitled to use or register the Mark;

ii) the Applicant did not intend to use the Mark as alleged in the application or at all;

iii) the expression “24 du 24” does not serve to function as a trade-mark as it is a descriptive term;
2. s. 38(2)(b)/12(1)(b): the Mark is not registrable in that it is clearly descriptive in that the wares are packaged in containers having 24 by 24 bottles or cans. If the wares are not so packaged, the trade-mark is deceptively misdescriptive;
3. s. 38(2)(c)/16: the Applicant is not the person entitled to registration of the Mark – at the date of filing of the application, the Mark was confusing with the trade-mark THE OFFICIAL BEER OF MAY 2-4 that is the subject of the Opponent’s previously filed application No. 1,360,916;
4. s. 38(2)(d): the Mark is not distinctive in view of the facts alleged in the statement of opposition and also since it is not adapted to distinguish the wares in association with which it is proposed to be used by the Applicant from the wares/services of others including the wares/services of the Opponent. The Opponent, and other manufacturers of beer, advertise and sell beer in connection with descriptive terms which include the term “24” and sell beer in containers containing twenty-four bottles or cans.

[8] The material date for assessing the first three of the four above-mentioned grounds is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.); *Shell Canada Limited v. P.T. Sari Incofood Corporation* (2005), 41 C.P.R. (4th) 250 (F.C.); s. 16(3)(b) of the Act]. The material date for assessing the fourth ground is the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Onus

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

Section 12(1)(b) Ground of Opposition

[10] I will begin my analysis with the s. 12(1)(b) ground of opposition as descriptiveness appears to be a key issue in this proceeding.

[11] Before considering the evidence and the argument, I want to address the pleading itself. The Opponent bases this ground on the allegation that the Mark clearly describes that the wares are packaged in containers having 24 by 24 bottles or cans. Such an allegation only makes sense with respect to the Applicant's alcoholic brewery beverages; it does not seem applicable to the Applicant's other wares (signs, banners, posters, packaging for beverages, namely containers for bottles or cans of beer). I also want to point out that based on my reading of the statement of opposition, the Opponent's reference to "containers having 24 by 24 bottles or cans" means containers having 576 bottles/cans (i.e. 24 x 24).

[12] The evidence from the Opponent on the issue of descriptiveness is the affidavit of Ms. Roberts, an Assistant Bailiff, who was asked to perform Internet searches to determine whether beer is sold in cases containing 24 cans or bottles in Canada. She provides multiple exhibits that refer to cases of 24 beers, all of which were printed from the Internet in 2009.

[13] Ms. Roberts also states, “as a beer drinker, I am also aware that in some instances, cases of 24 bottles or cans of beer have been sold for \$24.00.” She provides three exhibits on this point; each of these was printed from the Internet in 2009, but they appear to be items that were originally posted on April 25, 2007, July 5, 2007 and December 21, 2008.

[14] Ms. Roberts’ evidence does not support the allegation made by the Opponent under s. 12(1)(b), namely that the Mark clearly describes or deceptively misdescribes that the Applicant’s wares are packaged in containers having 24 by 24 bottles or cans.

[15] The Opponent also refers to some of the Applicant’s evidence in its discussion of the s. 12(1)(b) ground of opposition, namely the affidavit of Mr. Reynolds. Mr. Reynolds, a student-at-law employed by the Applicant’s agents, provides certain print-outs that he obtained from the Internet in 2009, as well as one photograph of some beer that he purchased in person that year. Mr. Reynolds does not indicate what he was instructed to search for on the Internet, but it appears that his evidence is directed to both evidencing i) that beer is sometimes sold in 24 oz. containers and ii) that various numbers appear in association with beer. With regard to the former, he provides pages from the Internet that display someone’s collection of 24 oz. beer cans, pages from *www.crownimportsllc.com* that refer to some beers being available in 24 oz. bottles/cans or in packs containing twenty-four 7 oz. or 12 oz. bottles (but notably not in packs containing twenty-four 24 oz. containers), and numerous individual 24 oz. beer containers offered for sale by auction on ebay. With regard to the latter, he provides a photograph of a can prominently displaying 50 and Internet pages from *www.thebeerstore.ca* showing what appear to be beer labels that prominently display the following numbers: 6.0; 67, 40 oz., 800, 5.5, 2.5 g, and 9.5.

[16] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive must be considered from the point of view of the average purchaser of the associated wares. Furthermore, the Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks*, 40 C.P.R. (2d) 25 at 27-8 (F.C.T.D.); *Atlantic Promotions Inc. v. Registrar of Trade Marks*, 2 C.P.R. (3d) 183 at 186 (F.C.T.D.)]. Character means a feature, trait or characteristic of the product and “clearly” means “easy to understand,

self-evident or plain” [see *Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 C.P.R. 29 at 34 (Ex. Ct.)].

[17] At paragraph 75 of its written argument, the Opponent submits:

In this instance the evidence shows clearly that beer is sold in cases of 24 cans or bottles and in addition that beer is sold in 24 oz cans and/or bottles. From a common sense point of view, it is obvious that on seeing the expression 24 du 24, the average Canadian consumer would assume that the product is packaged in 24 oz cans and/or bottles and in cases containing 24 bottles or 24 cans of beer. It is further submitted that the quantities in which a product is typically sold constitutes an element in the essential quality and character of the wares.

[18] There are several problems with such submissions. First, the Opponent did not plead that the Mark clearly describes that the wares are sold in cases containing twenty-four 24 oz. bottles/cans. Second, there is no evidence that at the filing date of the application anyone sold beer in 24 oz. containers (nor is there evidence that at any time anyone has sold 24 oz. containers of beer in cases containing 24 bottles/cans). Third, the Opponent has itself pointed out that while the numbers on beer bottles/cans often refer to the number of ounces, they may also refer to the number of calories, the alcoholic content, or some other characteristic of the beer such as glucide content (paragraphs 60 and 72, Opponent’s written argument). In addition, the Opponent has introduced evidence that sometimes 24 bottles/cans of beer have been sold for \$24.

[19] Overall, it is not apparent what the immediate impression of the Mark would have been on the average Canadian beer consumer as of September 18, 2007, or as of any other date. In particular, it is not apparent that the immediate impression would be that set out in the statement of opposition. Nor is it apparent that the Mark would cause consumers to be deceived in any way. Accordingly, the Mark cannot be held to be clearly descriptive or deceptively misdescriptive and the s. 12(1)(b) ground of opposition is dismissed.

Section 30 Grounds of Opposition

[20] The Opponent has submitted in its written argument that the opposition should succeed because the application does not comply with s. 30(b) of the Act. It submits that the Opponent has met its initial burden with respect to such ground through reliance on the evidence of the Applicant’s affiant, Mr. Hunt. Mr. Hunt, the Applicant’s Legal Counsel and Assistant Secretary,

attests that at the time of filing the application, the Applicant “did intend to use the trade-mark 24 du 24 by applying it to the wares listed in the [application], to packaging therefore, and/or on point-of-purchase advertising brought to consumers’ attention at the time the listed wares are sold in Canada.” As noted earlier, Mr. Hunt was not cross-examined on his affidavit.

[21] The Opponent submits:

[Mr. Hunt’s affidavit] raises questions as to the ongoing intent of the Applicant to use the applied-for trade-mark as a trade-mark. The affiant uses the past tense throughout the affidavit which leads to a conclusion that at the date of application, there was an intent to use the phrase on packaging, on the wares and point of sale materials. The use of the past tense would seem to suggest that there was not an ongoing intent to use the subject phrase as a trade-mark. This is particularly the case when dealing with a sophisticated affiant such as Mr. Hunt. In addition, the mere use of the wording of section 4 of the Act indicating that the word 24 du 24 will appear on packaging, on the wares themselves or on point of purchase advertising does not constitute evidence of an intent to use of these words as a trade-mark. The words in question could just as easily be used as a descriptor on labeling and packaging given the highly descriptive nature of the words in question. The affidavit of Brett Reynolds provides multiple examples of the use of numbers descriptively on packaging for beer.

[22] 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 as set forth in its application [see *Ivy Lea Shirt Co. v. 1227624 Ontario Ltd.* (1999), 2 C.P.R. (4th) 562 at 565-6 (T.M.O.B.), affirmed 11 C.P.R. (4th) 489 (F.C.T.D.)]. The Applicant’s evidence is not clearly inconsistent with its claims and therefore the Opponent has not met its initial onus, with the result that this ground is dismissed.

[23] I note that whether or not the Applicant may have abandoned its intent to use the Mark subsequent to filing the application is not relevant to this ground of opposition because the material date is the filing date of the application.

[24] The s. 30 pleading also appears to include a ground of opposition based on s. 30(i). Section 30(i) requires an applicant to include a statement that it is satisfied that it is entitled to use the applied-for mark in Canada in association with the applied for wares and services. As the Applicant has included such a statement, there is no basis on which a s. 30(i) ground could

succeed in the present case [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155].

Section 16 ground of opposition

[25] The Opponent has met its initial onus with respect to its s. 16 ground of opposition because application No. 1,360,916 was filed before September 18, 2007 and was pending when the Mark was advertised on August 27, 2008. However, the s. 16 ground does not succeed because of the lack of resemblance between THE OFFICIAL BEER OF MAY 2-4 and 24 du 24.

[26] 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.

[27] In applying the test for confusion, consideration must be given to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, but these enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

[28] In *Masterpiece*, the Supreme Court of Canada commented in para. 49:

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis (K. Gill and R. S. Jolliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition* (4th ed. (loose-leaf)), at p. 8-54; R. T. Hughes and T. P. Ashton, *Hughes on Trade Marks* (2nd ed. (loose-leaf)), at §74, p. 939). As Professor Vaver points out, if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar (Vaver, at p. 532). As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start (Vaver, at p. 532).

[29] In the present case, any resemblance between the marks at issue is minimal at best. The only common features between the marks are the numerals 2 and 4, and numbers are not

inherently distinctive but are weak trade-mark formatives [see *Noxzema Chemical Co. of Canada Ltd. v. Estee Lauder Cosmetics Ltd.* (1975), 23 C.P.R. (2d) 214 (T.M.O.B.)]. There is no evidence that either party's mark has been used or promoted and the fact that the parties both sell beer, which presumably would travel similar channels of trade, is not a significant factor when the marks are so different.

[30] I therefore find that confusion between the marks is not likely. The s. 16 ground is accordingly dismissed.

Distinctiveness Ground of Opposition

[31] In its written argument, the Opponent states that it has raised the issue of the non-distinctiveness of the Mark "on the grounds that the Opponent and other manufacturers of beer advertise and sell beer in connection with descriptive terms which include the term 24 and sell beer in cases containing 24 bottles or cans."

[32] The material date for assessing a distinctiveness ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)]. In order to meet its initial burden with respect to this ground, the Opponent must establish that the facts that it alleged existed as of January 27, 2009. The Opponent notes that the evidence of Ms. Roberts was collected and signed after January 27, 2009 but points out that some of the materials that she obtained from the Internet in August 2009 bear dates that indicate that they predated January 27, 2009. For example, her Exhibit 1, a printout obtained from *www.thebeerstore.ca* on 8/12/2009, indicates at the end, "Last Update: Feb. 11th, 2008", and Exhibit 29, printed on 8/12/2009 from *www.crossbordershopping.ca*, bears a 2007 copyright notice. In addition, the pages introduced in support of Ms. Robert's statement that 24 bottles/cans of beer have sometimes been sold for \$24 refer to dates that predate January 27, 2009 (Exhibits 33 and 34).

[33] If I accept that there is evidence that beer was sold in cases of 24 bottles/cans in Canada prior to January 27, 2009, the question then becomes whether such a fact renders the Mark non-distinctive. I do not see how such a conclusion follows. The Mark may not be an inherently

strong mark but that does not mean that 24 du 24 could not distinguish the Applicant's wares from other beers that are being sold in a case of 24.

[34] Although the Opponent has not argued it, I believe that the distinctiveness ground as pleaded also alleges that the Mark is not distinctive because it is descriptive. As previously discussed, the Mark is not clearly descriptive of the Applicant's wares. In fact the idea suggested by the Mark is somewhat obscure. While the Mark may be suggestive of several different ideas, suggestiveness does not render a mark non-distinctive.

[35] The distinctiveness ground is accordingly dismissed.

Disposition

[36] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition, pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office