

IN THE MATTER OF AN OPPOSITION by Molson
Breweries, A Partnership to application No. 607,048
for the certification mark KOKANEE & Design standing
in the name of Labatt Brewing Company Limited (originally
filed in the name of Labatt Brewing Company Limited)

On May 16, 1988, the original applicant namely, John Labatt Limited, filed an application to register the certification mark KOKANEE & Design, illustrated below,

based on use of the mark by the applicant's licensees since at least as early as January 1, 1987 in association with:

wearing apparel, bags, glassware, bottle openers, headware, stationery, mirrors, coasters, clocks, lighters, posters and umbrellas.

As a result of objections at the examination stage, the words GLACIER and PILSENER were disclaimed apart from the mark as a whole and the description of wares was amended as follows:

wearing apparel for men and women namely T-shirts, shorts, vests, jackets, sweaters, sweatshirts, pants;
bags namely handbags, sports bags, cooler bags, shoulder bags;
glassware namely glasses and cups;
bottle openers;
headware namely hats;
stationery namely envelopes and cards;
mirrors, coasters, clocks, lighters, posters and umbrellas

A further objection raised at the examination stage concerned paragraph 5 of the application, shown below, which sets out the "defined standard" represented by the certification mark:

5. The use of the certification mark indicates that the specific wares listed above in association with which it is used are *of a standard defined by the applicant with respect to their character and quality.*

(emphasis added)

The examiner expressed her views in the following terms [see the Office letter dated September 2, 1988]:

The applicant responded to the examiner in its letter dated February 1, 1989, as follows:

The Office Practice Notice of February 17, 1982, has not been evidenced in this proceeding although it has been referred to in the applicant's written argument. In any event, I am able to infer from the Examiner's comments that the Examination Branch accepted certification mark applications which included some reference to a defined standard.

The subject application was subsequently approved and advertised for opposition purposes in the Trade-marks Journal issue dated November 21, 1990. Molson Breweries, A Partnership, filed a statement of opposition on March 21, 1991, a copy of which was forwarded to the applicant on April 12, 1991. The applicant responded by filing and serving a counter statement. The opponent was subsequently granted leave to file an amended statement of opposition: see the Board ruling dated June 30, 1992. The file record indicates that Labatt Brewing Company Limited was inscribed as the applicant of

record on February 9, 1996.

The first ground of opposition, pursuant to Sections 38(2)(b) and 23(1) of the Trade-marks Act, is that the applied for mark is not registrable as a certification mark because the applicant is engaged in the manufacture and sale of the wares specified in the application. The second ground of opposition, pursuant to Section 12(1)(d), is that the applied for certification mark is not registrable because it is either clearly descriptive or deceptively misdescriptive of the place of origin of the wares specified in the application. The third ground of opposition, pursuant to Sections 38(2)(b) and 25, is that the applied for certification mark is not registrable because it is confusing with the mark KOKANEE, registration No. 121,392, standing in the name of John Labatt Limited, for use in association with bottled beer. The fourth ground of opposition, pursuant to Sections 38(2)(c) and 25, is that the applied for certification mark is not registrable. In this regard, the opponent pleads that the applied for mark is descriptive of the place of origin of the applicant's wares and that the applicant does not come within the exception permitting registration for such marks, that is, the opponent alleges that the applicant is not an administrative authority nor a commercial association having an office or representative in the locality known as "Kokanee."

The fifth ground of position, pursuant to Sections 38(2)(a) and 30(f), is that notwithstanding the Examination Branch practice referred to earlier, the subject application should be refused because the applicant has failed to provide particulars of the defined standard that the certification mark is intended to indicate.

The sixth ground of opposition, pursuant to Sections 38(2)(d) and 2, is that the certification mark is not distinctive of the applicant. In this regard, the opponent alleges that the applied for certification mark has functioned as a trade-mark for the applicant

(and its predecessor in title) and that “the average consumer would not recognize the change of status of the well-known trade-mark to a certification mark for certain wares and simply a trade-mark for other wares.” The seventh and final ground of opposition, pursuant to Section 38(2)(a), is that the applied for certification mark was not in use on all of the wares identified in the subject application from a time prior to the filing of the application.

The opponent’s evidence consists of certified copies of various trade-mark applications as well as registration No. 121,392; the affidavits of Alain D. Bourassa, student at law; Mitchell B. Charness, student at law; and Linda M. Wright, lawyer. The applicant’s evidence consists of the affidavit of Andrea Billingham, librarian, which affidavit merely serves to introduce into evidence various trade-mark registrations (belonging to the opponent). Both parties filed a written argument and both were represented at an oral hearing.

The opponent’s evidence in this proceeding is fairly summarized in paragraphs 5 to 7 of the applicant’s written argument, reproduced below:

The opponent has not met the evidential burden on it to put into issue the allegation in the statement of opposition that the applicant is engaged in the manufacture and sale of the wares specified in the subject application. Further, a review of the Billingham affidavit evidence indicates that it is not unique to the applicant for companies in the beer industry to own similar trade-marks and certification marks for different wares. The first ground of opposition is therefore rejected.

The second ground of opposition alleges that the applied for mark is not registrable because it is clearly descriptive or deceptively misdescriptive of the place of origin of the wares specified in the application. In this regard, the opponent's evidence establishes that there is a region named Kokanee Glacier Park and Recreation Area in the Selkirk Mountains of British Columbia. Kokanee Glacier Park and Recreation Area lies due south of Glacier National Park, between Valhalla Park to the east and Kootenay Lake to the west. The applicant has comprehensively canvassed the law regarding geographical names as trade-marks at pages 6-9 of its written argument. As noted by the applicant, the intent of the prohibition in Section 12(1)(b) against geographical names is to prevent any one person from acquiring a monopoly on a word that is generally recognized as a locality connected to the wares or services in issue. However, the mere fact that words may also be geographical names does not preclude registration. In the instant case, the opponent has not met the evidential burdens on it necessary to put into issue the allegations inherent in the second ground of opposition namely, that the wares specified in the subject application are actually produced in a region known as KOKANEE or that the term KOKANEE is generally recognized as a locality connected to the wares specified in the application. In other words, the opponent has failed to adduce sufficient evidence from which it may reasonably be concluded that the applied for certification mark is either

clearly descriptive or deceptively misdescriptive of the place of origin of the wares in issue. The second ground of opposition is therefore rejected.

The third and fourth grounds of opposition allege that the subject application contravenes Section 25 of the Act, shown below:

Section 25 DESCRIPTIVE CERTIFICATION MARK

A certification mark descriptive of the place of origin of wares or services, and not confusing with any registered trademark, is registrable if the applicant is the administrative authority of a country, state, province or municipality including or forming part of the area indicated by the mark, or is a commercial association having an office or representative in that area, but the owner of any mark registered under this section shall permit the use of the mark in association with any wares or services produced or performed in the area of which the mark is descriptive. R.S., c. T10, s. 25.

The opponent alleges that the applied for certification mark is (i) descriptive of the place of origin of the wares, and (ii) confusing with regn. No. 121,392 for the mark KOKANEE covering the wares bottled beer. The opponent further alleges that the applicant does not fall within the statutory exception permitting descriptive certification marks to be registered. Again, I find that the applicant has not met the evidential burden on it to put either (i) or (ii) above in issue. With respect to the former, the opponent has not adduced sufficient evidence from which I might reasonably infer that the term KOKANEE *per se* or that the certification mark as a whole would be recognized by a significant segment of the public to refer to a particular locality in British Columbia. With respect to (ii) above, the mere existence on the register of the mark KOKANEE owned by the present applicant (or by a third party) for wares *significantly different from those specified in the subject application* is not, by itself, sufficient to permit me to reasonably conclude that the applicant's certification mark is confusing with the registered mark KOKANEE. In any event, even if the applied for certification mark is

confusing with the mark KOKANEE, then as long as the applicant is not engaged in the engaged in the manufacture, sale, leasing or hiring of wares such as those in association with which the certification mark is used, the applicant's ownership of the registered mark KOKANEE is irrelevant to the applicant's right to register the subject certification mark: see *Mister Transmission (Intl) Ltd. v. Reg. T. M.* (1978), 42 C.P.R.(2d) 123 at 127 (F.C.T.D.). In view of the foregoing, it is not necessary to enquire whether the applicant falls within the statutory exception provided for in Section 25. The fourth ground of opposition is rejected.

I will next consider the sixth and seventh grounds of opposition and then return to the fifth ground of opposition. In my view there is no evidence whatsoever to support the allegations in the sixth ground and at the oral hearing counsel for the opponent admitted that there was no evidence to support the seventh ground. The sixth and seventh grounds of opposition are therefore rejected.

The fifth ground of opposition pertains to the necessary contents of a trade-mark application. Relevant portions of Sections 30 and 38 of the Act are reproduced below:

Section 30. Contents of Application

An applicant for the registration of a trade-mark
shall file with the Registrar an application containing

...

(f) in the case of a certification mark,
*particulars of the defined standard that
the use of the mark is intended to
indicate* and a statement that the
applicant is not engaged in the
manufacture, sale, leasing or hiring of
wares or the performance of services
such as those in association with
which the certification mark is used;
(emphasis added)

Section 38 STATEMENT OF OPPOSITION

...

GROUND

(2) A statement of opposition may be based on

any of the following grounds:

- (a) that the application does not conform to the requirements of section 30;

I note in passing that Form 5 of the Trade-marks Regulations illustrates the contents of an application for the registration of a certification mark. In particular, paragraphs 5 and 6 of the form (in respect of wares) and paragraphs 7 and 8 (in respect of services) direct the applicant to set out the defined standard that the use of the certification mark is intended to indicate.

This Board has in the past differentiated between formal and substantial compliance in respect of Section 30 of the Act. For example, an application may formally comply with Section 30(a) by specifying the wares or services in association with which the mark has been used. However, if the Board makes a determination that the description of the wares or services are not “in ordinary commercial terms,” then the application will be refused because the application does not substantively comply with the Act [provided, of course, that the opponent has properly pleaded Section 38(2)(a) as a ground of opposition]. Similarly, an application may formally comply with Section 30(b) by specifying the date from which the applicant has used the trade-mark. However, if the Board makes a determination that the applicant did not begin to use the mark until after the date specified in the application, then the application will be refused. Further, applications have been refused pursuant to Section 30(e) where, in the case of a proposed mark, the Board made a determination that the applicant did not intend to use the trade-mark.

I do not mean to suggest by the foregoing that any minor variance from the requirements of Section 30 will necessarily result in a refusal of the application nor is it my view that the Board has adopted too rigid an approach in the interpretation of

compliance with Section 30. Each allegation by an opponent of non-compliance with a particular sub-section of Section 30 has been considered on its own merits and in accordance with the usual rules of statutory interpretation.

The opponent's submissions regarding non-compliance with Section 30(f) in the instant case are set out, in part, at paragraphs 63-65 of its written argument, reproduced below:

In my view, the unambiguous language of Section 30(f), as well as the scheme of the Act as a whole, requires an application for a certification mark to set out the particulars of the defined standard in a meaningful way. Firstly, the definition of a certification mark, found in Section 2 of the Act, itemizes the aspects of the wares and/or services to which the defined standard may apply. Secondly, Section 41(1) permits the owner of a certification mark to update the particulars of the defined standard [for a fee of

\$25.] in the same way that owners of registered marks may enter a change of address. It would not be imposing too onerous a burden on an applicant to furnish a meaningful “defined standard” when the certification mark application is initially filed or to update the defined standard as the need arises. Further, easy access to the standard which a certification mark symbolizes would appear to be in the public interest. Presumably, the particulars of the defined standard need not be set out in its entirety in the trade-mark application as long as reference is made to the titles of published manuals, or the like, where the standard may be found. Of course, each case is different and must be dealt with differently to ascertain whether or not a certification mark application contains a meaningful standard.

I also note that, unlike the case of other licensed trade-marks governed by Section 50, no presumptions as to the character or quality of the goods or services are raised by the licensee of a certification mark giving public notice that the use of the certification mark is licensed use. As noted by counsel for the opponent at the oral hearing, even if Section 50 encompasses certification marks (and it is not clear that this is the case), Section 30(f) requires from the owner of a certification mark something more than is required from the owners of other registered marks.

In the instant case, I find that there has not been substantial compliance with Section 30(f).

Further, the applicant has not taken any steps to amend its application to comply with Section 30(f) although it might have done so at any time prior to the issuance of my decision and after the issue was raised in the statement of opposition.

The applicant argues that even if the application does not comply substantively

with Section 30(f), I am nevertheless prevented from refusing the application in view of *Consolboard Inc. v. MacMillan Bloedel (Saskatchewan) Ltd.* (1981), 56 C.P.R.(2d) 145 (S.C.C.). *Consolboard* concerned an action for patent infringement and the “double patenting” of a single invention. The applicant herein relies on the Court’s finding at page 169 of the reported decision, shown below, for the proposition that I cannot refuse the subject application because the applicant conformed with the practice of the Examination Branch concerning certification mark applications:

(emphasis added)

Of course, the instant case is distinguishable from *Consolboard* on its facts. More importantly, the Registrar in the instant case did not require and in no way forced the applicant to follow the practice of the Examination Branch namely, to process applications for certification marks as long as there was some type of formal compliance with Section 30(f). While I am not without sympathy for the applicant’s position, I find that there is a distinction between the Registrar permitting an applicant to draft its (trade-mark) application in a certain manner, as in the instant case, and requiring the applicant to draft its (patent) application in a certain manner, as in *Consolboard*. Unlike *Consolboard*, the applicant in the instant case had a choice to follow the Examination

Branch practice or to follow its own interpretation of what was required by the Trade-marks Act. The applicant might have chosen the latter. Further, the existence of an established practice at the examination stage does not preclude a fresh deliberation of the issue at the opposition stage.

In view of the above, I find that the opponent succeeds on the fifth ground of opposition and the applicant's application is therefore refused.

DATED AT HULL, QUEBEC, THIS 13 DAY OF MAY , 1996.

Myer Herzig,
Member,
Trade-marks Opposition Board