



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

Citation: 2010 TMOB 55
Date of Decision: 2010-04-28

**IN THE MATTER OF AN OPPOSITION
by Bacardi & Company Limited to
application No. 1,236,610 for the trade-
mark BREEZE ICE in the name of
Distribuidora Glasgow C.A.**

[1] On November 8, 2004, Distribuidora Glasgow C.A. (the Applicant) filed an application to register the trade-mark BREEZE ICE based upon proposed use of the trade-mark in Canada, by itself and/or through a licensee. The wares, as revised, are “alcoholic beverages namely, vodka based alcoholic cocktails”. The Applicant disclaims the right to the exclusive use of the word ICE apart from the trade-mark.

[2] The application was advertised for opposition purposes in the Trade-marks Journal of August 3, 2005.

[3] On January 3, 2006, Bacardi & Company Limited (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent’s allegations. The Opponent subsequently requested and was granted leave to file an amended statement of opposition on July 7, 2006. The grounds of opposition are based on non-compliance with s. 30(e) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), non-registrability pursuant to s. 12(1)(d), non-entitlement pursuant to s. 16(3)(a) and s. 16(3)(b), and non-distinctiveness pursuant to s. 38(2)(d). With the exception of the ground based on s. 30(e), each of the grounds of opposition in the statement of opposition as amended is based on confusion with the following marks of the Opponent: BREEZER, registration No.

TMA405,228, BACARDI BREEZER Label Profile Design, registration No. TMA656,922, BACARDI BREEZER Label Profile Design, registration No. TMA657,112, XTREME BREEZER (Design), registration No. TMA469,033. These marks will collectively be referred to as the Opponent's BREEZER marks, and are all based on previous use by the Opponent or its predecessor-in-title.

[4] In support of its opposition, the Opponent filed the affidavit of Lisa Jazwinski. In support of its application, the Applicant filed the affidavit of Dane Penney. Neither affiant was cross-examined.

[5] Only the Opponent filed a written argument. An oral hearing was held at which only the Opponent was represented.

Onus and Material Dates

[6] 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].

[7] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - 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.) at 475];
- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Preliminary Issue

[8] Relying on the decision in *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada* (2006) 53 C.P.R. (4th) 286 (F.C.A.) (*Cross Canada*), the Opponent submits that the Penney Affidavit is inadmissible in its entirety as it was prepared by a searcher working for the solicitor of record for the Applicant, and puts evidence of several points of substance and controversy in these proceedings.

[9] In *Mr. Lube Canada Inc. v. Denny's Lube Centre Inc.* (2008), 73 C.P.R. (4th) 308 (T.M.O.B.), former Board Member David Martin addressed a similar issue wherein the affiant who conducted what was essentially a state of the register search was the Executive Assistant to the applicant's trade-mark agent. In that decision, Mr. Martin found that the affidavit did not comprise contentious opinion evidence of the type adduced in the *Cross-Canada* case and therefore gave full consideration to it.

[10] I agree with Mr. Martin. Ms. Penney conducted a search of the trade-mark register for relevant applications or registrations. She did not later give any controversial evidence on any crucial issues in the case.

[11] While I agree with the reasoning in *Cross Canada* that it is not good practice for a law firm to cause its employees to act as investigators for the purpose of having them later give controversial evidence on the most crucial issues in the case, I do not think it is reasonable nor necessary to always expect law firms to hire third parties to investigate the state of the register and provide evidence of their results. In my view, while there may be a subjective element to how the state of the register evidence is compiled, as long as the affiant sets out the parameters of his or her search in the affidavit, the information presented in the search results is essentially a reflection of existing trade-mark office records within that parameter. For example, in the present case, the affidavit of Ms. Penney attaches registration pages for active trade-marks consisting of or containing the word "BREEZE", excluding Section 9 marks, in Class 33, using the Namereporter trade-mark database. I am therefore prepared to give full consideration to the affidavit of Ms. Penney.

Section 30(e) Ground of Opposition

[12] The Opponent presented no evidence or argument in support of this ground of opposition. It is therefore dismissed.

Section 12(1)(d) Ground of Opposition

[13] The Opponent has met its initial burden with respect to the s. 12(1)(d) ground by showing that each of its BREEZER trade-mark registrations are in good standing. I will assess the likelihood of confusion between the Applicant's BREEZE ICE mark and the Opponent's BREEZER trade-mark, registration No. TMA405,228, as that mark represents the Opponent's strongest case. The Opponent's BREEZER mark is registered for use in association with alcoholic beverages containing distilled spirits.

[14] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)].

[15] 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.

[16] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. 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.)]

[17] With respect to the inherent distinctiveness of the trade-marks at issue, the Applicant's trade-mark BREEZE ICE as applied to the wares covered in the present application and the Opponent's BREEZER trade-mark as applied to the wares covered in its registrations, are inherently distinctive. Only the Opponent has evidenced that its mark has acquired reputation through use or promotion. In this regard, the Opponent's evidence establishes that the Opponent has effected very significant sales and advertising of alcoholic beverages in association with its BREEZER marks throughout Canada since at least as early as June, 1988.

[18] With respect to the length of time each mark has been in use, this factor favours the Opponent as it has shown use of its BREEZER mark in Canada since at least as early as 1988 in association with alcoholic beverages containing distilled spirits while the Applicant has not shown any use of the Mark.

[19] The party's wares are essentially identical: alcoholic beverages containing distilled spirits and alcoholic beverages namely, vodka based alcoholic cocktails. It is therefore fair to assume that both parties' wares would travel through similar channels of trade.

[20] It is a well-accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction. [*Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.)] Given that the first component of the Applicant's mark comprises all but one letter of the Opponent's BREEZER mark, there is a high degree of visual and phonetic resemblance between the marks. Neither mark in my view suggests any idea in particular.

[21] As an additional surrounding circumstance, the applicant has relied on the state of the register evidence in the Penney affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R.(3d) 432 and the decision in *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that

inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

[22] Ms. Penney conducted a search based on the word BREEZE and found fourteen references. Further examination of these references, however, reveals that there are only seven third party registrations for marks consisting of or containing the word BREEZE that are arguably related to the wares at issue in the present case. Given such small numbers, I am not able to infer that any of them are in active use such that consumers would be used to seeing such marks in the field of alcoholic beverages. Thus, the Penney affidavit does little to assist the Applicant's case.

[23] The issue is whether a consumer who has a general and not precise recollection of the Opponent's BREEZER mark, will, upon seeing the Applicant's BREEZE ICE mark, be likely to think that the essentially identical wares share a common source. I find that a consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is a reasonable likelihood of confusion between the marks. I reach this conclusion based on the strong resemblance between the marks, the fact that the parties' wares are essentially identical as would be their channels of trade, and the distinctiveness acquired by the Opponent's mark through use and advertisement.

[24] The s.12(1)(d) of opposition is therefore successful.

Remaining Grounds of Opposition

[25] The remaining grounds of opposition also turn on a determination of the issue of the likelihood of confusion between the Mark and one or more of the Opponent's BREEZER marks. The material dates for assessing the likelihood of confusion in respect of the non-entitlement and non-distinctiveness grounds are, respectively, the Applicant's filing date and the date of opposition. In my view, the differences in material dates do not have any significant impact on the determination of the issue of confusion between the trade-marks of the parties. Thus, my finding above that the Applicant's BREEZE ICE trade-mark is likely to be confused with the Opponent's BREEZER trade-mark also applies to these grounds of opposition which also succeed.

Disposition

[26] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office