



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

Citation: 2011 TMOB 101
Date of Decision: 2011-06-30

**IN THE MATTER OF AN OPPOSITION
by Demerara Distillers Ltd. to application
No. 1,206,738 for the trade-mark
DEMERARA GOLD in the name of
Bedessee Imports Ltd.**

[1] On February 18, 2004, Bedessee Imports Ltd. (the Applicant), filed an application for the trade-mark DEMERARA GOLD (the Mark) based upon use of the Mark in Canada since at least as early as January, 1984, in association with the following wares: sugar, glucose, rice and coconut oil. The Applicant disclaimed the right to the exclusive use of DEMERARA apart from the trade-mark as a whole in respect of the wares “sugar and glucose”.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 22, 2004.

[3] On February 22, 2005, Demerara Distillers Ltd. (the Opponent) filed a statement of opposition against the application. The grounds of opposition are that the Applicant’s application does not conform to the requirements of s. 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Mark is not registrable pursuant to s. 12(1)(b) as it is deceptively misdescriptive of the character or quality or place of origin of the Applicant’s wares, the Mark is not registrable under s. 12(1)(e) because it has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind and quality of certain wares which emanate from Guyana or a particular region in Guyana and is prohibited by s. 10, the

Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(a), s. 16(1)(b) and s. 16(1)(c) because it was confusing with one or more of the trade-marks DEMERARA, DEMERARA GOLD and DEMERARA GOLD RUM and/or one or more of the trade-names Demerara Distillers and Demerara Distillers Limited as of the Applicant's claimed date of first use, and the Mark is not distinctive because of the prior use and or making known of the trade-marks and trade-names identified above by the Opponent and the fact that it is deceptively misdescriptive of the character, quality and/or place of origin of the Applicant's wares.

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

[5] The Opponent's evidence consists of the affidavit of Bradley Warden and the affidavit of Jennifer Stecyk. While the Opponent also submitted the affidavit of Ramona Vansluytman, such affidavit is deemed not to form part of the evidence because of Ms. Vansluytman's failure to attend for cross-examination [see s. 44(5) of the *Trade-mark Regulations*].

[6] The Applicant's evidence consists of the affidavits of Rayman Bedessee, and Robert W. White, as well as a certified copy of registration No. 273027 for the mark CABOT TOWER and Design.

[7] Both Ms. Stecyk and Mr. Warden were cross-examined on their affidavits.

[8] Both the Applicant and the Opponent filed a written argument. An oral hearing was conducted at which both parties were ably represented.

Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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*

Ltd v. Molson Companies Ltd. (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).

[10] 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)(b) - the filing date of the application [see *Shell Canada Ltd. v. P.T. Sari Incofood Corp.* (2005), 41 C.P.R. (4th) 250 (F.C.T.D.); *Fiesta Barbeques Ltd. v. General Housewares Corp.* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)];
- s. 12(1)(e) – the date of decision [see *Canadian Olympic Assn. v. Allied Corp.* (1989), 28 C.P.R. (3d) 161 (F.C.A.)];
- s. 16(1) - the Applicant's date of first use [see s. 16(1)];
- 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.)].

Section 12(1)(b) Ground

[11] The Opponent has pleaded that the Mark is not registrable as it is deceptively misdescriptive of: 1) the character or quality of the Applicant's wares; or 2) the place of origin of the Applicant's wares. As I understand it, it is the Opponent's position that the Mark is deceptively misdescriptive of the character or quality of the Applicant's sugar because the word DEMERARA combined with the word GOLD operate to indicate to consumers that the Applicant's products emanate from the Demerara region of Guyana and are characterized by a golden hue. The Opponent's second argument under this ground is that DEMERARA is a region of Guyana with a reputation for sugar and products derived from sugar including rum. As the Applicant's wares do not emanate from Guyana, the Opponent argues that the Mark is deceptive and is likely to mislead consumers.

[12] On August 7, 2009, the Opponent requested leave to file an amended statement of opposition to include the allegation that the Mark is clearly descriptive of the character or quality of the wares or their place of origin. On September 28, 2009, the Board refused to grant leave as it was not satisfied that it was in the interests of justice to do so having regard to all of the surrounding circumstances.

[13] Relying on the decision in *Canadian Council of Professional Engineers v. APA – Engineered Wood Association* (2000), 7 C.P.R. (4th) 239 (F.C.T.D.), rev'g (1998) 86 C.P.R. (3d) 513 (T.M.O.B.) (*APA Wood*), the agent for the Opponent submitted at the oral hearing that the Board has jurisdiction to decide whether the applied for mark offends s. 12(1)(b) otherwise than as alleged in the statement of opposition. In that case, the opponent alleged that the proposed marks were unregistrable by virtue of being clearly descriptive or deceptively misdescriptive of the persons employed in the production of the wares and services. In the Opposition Board decision, the Registrar would have allowed the opposition on the basis that the term THE ENGINEERED WOOD ASSOCIATION was clearly descriptive of an association which promotes the interests of producers in the industry, had he not concluded that he was without jurisdiction to consider a ground of opposition other than as set out in the statement of opposition.

[14] On appeal, the Court stated the following at para. 63:

I am, however, also of the view that the Registrar must not unduly limit his inquiry upon opposition proceedings. The appellant in the case at bar had placed registrability under paragraph 12(1)(b) squarely in issue in its statement of opposition. It would not be reasonable for the Registrar to allow what he apprehends to be an unregistrable mark to be registered, merely because the narrow grounds for non-registrability under paragraph 12(1)(b) advanced by the opponent were not successful. *Having said that, such broadened inquiry must consider the extent to which the applicant for registration would be prejudiced by such actions, and its right to have notice of the grounds of opposition, so that it may effectively exercise its rights to make submissions in the form of a counterstatement.* (emphasis added)

[15] The present case is similar to the decision in *APA Wood* because the Opponent has put registrability under s. 12(1)(b) in issue in its statement of opposition. The present case can be distinguished from the decision in *APA Wood*, however, because the Opponent in the

present case did not originally plead that the Mark was either clearly descriptive *or* deceptively misdescriptive. In addition, the Opponent in the present case had already requested leave to amend its statement of opposition to broaden its s. 12(1)(b) ground to include an allegation that the Mark was clearly descriptive of the character or quality of the wares or place of origin and such request was denied. I therefore do not consider that it would be either fair or reasonable for me to broaden the ground at this stage in the proceedings because the Applicant has not been given notice that this ground would be broadened and therefore has not been able to effectively exercise its rights to make submissions in response to such ground. Further, for the reasons that follow, I do not consider the applied for Mark to be an “unregistrable mark”. Therefore, in the circumstances of the present case, I will only consider the s. 12(1)(b) ground as it has been pleaded.

[16] Considering first the Opponent’s second argument under this ground, the test to be applied in determining the merits of deceptive misdescription is stated by Mr. Justice Cattanach in *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R. (3d) 183 at p. 186 (F.C.T.D.), (*Atlantic Promotions*), as follows:

In my view the proper test to be applied to the determination as to whether a trade mark in its entirety is deceptively misdescriptive must be *whether the general public in Canada* would be misled into the belief that the product with which the trade mark is associated had its origin in the place of a geographic name in the trade mark. (emphasis added)

[17] Mr. Cattanach went on to state that if a geographical name is attached to wares made in that geographical region, it is “clearly descriptive of the origin”. If the wares are not made there then the word is misdescriptive and may be deceptively so depending on the circumstances. Further, as the test indicates, it is the trade-mark in its entirety that must be examined when determining its registrability rather than its segregated component parts [see *Canadian Schenley Distilleries Ltd. v. Registrar of Trade Marks* (1974), 15 C.P.R. (2d) 1 at p. 8 (F.C.T.D.); and *Molson Cos. Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157, 129 D.L.R. (3d) 201 (F.C.T.D.)]. Finally, whether a trade-mark is deceptively misdescriptive

within the meaning of s. 12(1)(b) is a question of fact, see *Atlantic Promotions*, supra, at p. 187.

[18] The type of evidence used to show that there is a reputation of a particular geographic area for a certain type of ware was explained by Fox in *The Canadian Law of Trade Marks and Unfair Competition*, 4th ed. (2002), as follows at p. 5-46:

In some cases, judicial notice can be taken that a certain region has a reputation for producing a ware. Although in most cases, while the Registrar can have regard to certain reference material to ascertain the meaning of a word's geographic significance, evidence must be led to establish a reputation for a particular region or locale in Canada among the relevant population. In attempting to evidence whether a particular geographic area is known among Canadians, it is generally insufficient to merely produce the existence of certain reference books in libraries discussing such geographic region, without more. Evidence must be led to establish that the geographic region in question, or attributes of that region, are known among Canadians.

[19] Attached as Exhibit D to the Stecyk affidavit are copies of the printouts of pages from various websites which contain information about the history or origin of DEMERARA sugar. Hearsay deficiencies aside, I consider this evidence relevant insofar as it states that Demerara is a region in the country of Guyana and that DEMERARA sugar originated in Demerara, Guyana. However, absent information about the number of Canadians who may have accessed these websites, there is no evidence that the information from these websites has been brought to the attention of any consumers in the marketplace in Canada [see *Candrug Health Solutions Inc. v. Thorkelson* (2007), 60 C.P.R. (4th) 35 (F.C.), reversed (2008), 64 C.P.R. (4th) 431 (F.C.A.)]. Furthermore, it appears that several of these websites emanate from the United Kingdom as opposed to Canada.

[20] Therefore, while the Opponent's evidence may show that Demerara is a region located in the country of Guyana, there is no evidence that Canadians are aware of this geographic fact, or that this region has a reputation for sugar in the Canadian marketplace. Further, while the evidence may show that Demerara style sugar originated in, and was named after, Demerara, Guyana, the evidence also shows that it is now produced in many different locations including Mauritius, Malawi and Jamaica (see Stecyk Affidavit, Exhibit

D), as is the Applicant's sugar (see Bedessee Affidavit, para. 7). Finally, many of the other Demerara style sugars evidenced by the Applicant indicate that they were refined in Canada and none indicate that they emanate from Guyana (see Bedessee Affidavit, Exhibits M-U).

[21] I am therefore of the view that DEMERARA is a style of sugar which is not particularly associated with a single source location.

[22] In considering this issue, I had regard to the London Magistrate's decision in *Anderson v. Britcher* (1913), King's Bench Division, wherein Justice Darling stated that the word DEMERARA, as applied to sugar, does not refer to sugar grown only in Demerara. The King's Bench stated as follows, at p. 64:

It is stated and admitted that, with regard to Demerara sugar, the word "Demerara" as applied to sugar, does not mean sugar grown only in Demerara; it means sugar grown in Demerara, or in Grenada, Martinique, or St. Kitts, or Tobago, or Barbadoes, or Dominica, or in many other islands of the West India group, and therefore the case really is hardly distinguishable from that of a Brussels carpet, which nobody supposes to be necessarily a carpet made in Brussels, or the case of a Cambridge sausage, which I suppose nobody believes to come necessarily from Cambridge.

[23] Based on the evidence before me, I cannot conclude on a balance of probabilities that the general public in Canada would be aware that DEMERARA was a region located in the country of Guyana or that Demerara, Guyana was known as a source for sugar. Without such knowledge, there is no reason to believe that the average Canadian, upon seeing the Mark DEMERARA GOLD, would be misled into the belief that the Applicant's wares emanated from such geographic location.

[24] This part of this ground of opposition is therefore unsuccessful.

[25] The Opponent has relied on the decisions in *Havana Club Holding S.A. v. Bacardi & Co.* (2004), 35 C.P.R. (4th) 559 (T.M.O.B.) and *Havana Club Holding, Inc. v. Matusalem* (2009), 79 C.P.R. (4th) 332; aff'd 86 C.P.R. (4th) 437, in which applications for the marks OLD HAVANA and THE SPIRIT OF CUBA, were rejected on the basis that these marks were deceptively misdescriptive of the place of origin of the rum associated with each trade-

mark. These decisions can be distinguished from the present case, however, because in each of those decisions the applied for wares were rum, and Board Member Carriere was satisfied that Cuba was well known to Canadians as an island in the Caribbean and the Caribbean had a reputation in Canada as a source of origin of rum.

[26] The next issue to be decided under this ground is whether the Mark is deceptively misdescriptive of the character or quality of the Applicant's wares. The Opponent submitted that the Mark is deceptively misdescriptive of the character or quality of the Applicant's wares because the word DEMERARA combined with the word GOLD operate to indicate to consumers that the Applicant's products emanate from the DEMERARA region of Guyana and are characterized by a golden hue.

[27] The Applicant's evidence shows that DEMERARA is a style of sugar with particular characteristics or physical properties. In this regard, the articles attached as Exhibits K1-K8 to the Bedessee affidavit all describe the properties of DEMERARA type sugar. For example, it has been described as a specialty raw cane sugar that is normally yellow/golden brown in colour and has a rich aroma. As noted above, evidence of other DEMERARA style sugars by several other companies in Canada has also been filed as evidence (see Bedessee Affidavit, Exhibits M-U).

[28] The Mark in its entirety, however, is DEMERARA GOLD. While it is not contested that DEMERARA is both the name of a geographic region in Guyana and descriptive of a style of sugar, the issue is what would be the first impression of the mark DEMERARA GOLD in its entirety and as a matter of first impression upon the ordinary user of sugar.

[29] In considering this issue, the Opponent submits that the Applicant's intention, as shown by its choice of label, is a relevant surrounding circumstance [see *Der Stabilisierungsfonds Fur Wein v. Andres Wines Ltd.* (1986), 14 C.P.R. (3d) 225 at 230 (T.M.O.B.)]. The Opponent argues that the Applicant in the present case has intentionally adopted packaging for its sugar which depicts a map of Guyana. To support this argument, attached to the affidavit of Ms. Stecyk as Exhibit B is a print-out of the map of Guyana as found on the website www.mapquest.com. Attached as Exhibit A to the affidavit of Mr. Warden is a sample of the Applicant's label used in association with its sugar.

[30] I am not convinced that the Applicant's intention, as shown by its choice of label, is a relevant consideration under this issue. In any event, I agree with the Opponent that the irregular shape comprising the background of the principal display panel of the said Exhibit A to the affidavit of Bradley Warden appears to constitute a representation of a map of the country of Guyana.

[31] However, while the Applicant's packaging for its sugar may arguably show an outline of the country of Guyana, there is no evidence that it would be recognized as such by the ordinary consumer. In addition, there is no evidence of any ordinary consumer being deceived, despite the extensive use of the Mark in Canada as evidenced by the Bedessee Affidavit. Further, while the evidence also shows that Demerara, Guyana is a geographic location where DEMERARA style sugar originated, the evidence is also clear that the Applicant's sugar is not made in Demerara, Guyana, but rather is produced in Mauritius and such is indicated on the Applicant's packaging.

[32] With respect to the meaning of the word "GOLD", I consider that I can take judicial notice of the various definitions for the word GOLD as found in dictionary definitions. I have noted that in addition to describing a deep yellow colour, the word GOLD also describes a precious metal as well as a standard of quality. The Mark in the present case could therefore either be suggestive of a style of sugar that may have a golden hue, or suggest that the Applicant's sugar is of superior in quality to the other DEMERARA style sugars on the market. The fact that a mark may be suggestive (or mis-suggestive) of the character, quality or place of origin of the wares does not preclude registration under s. 12(1)(b) of the Act. More importantly, the fact that there are several possible likely reactions to the mark means that there is no single reaction, much less one which is deceptively misdescriptive of the wares. Thus, this part of the s. 12(1)(b) ground is therefore also unsuccessful.

Section 12(1)(e) and s. 10 ground of opposition

[33] The third ground of opposition alleges that the Mark is not registrable, pursuant to s.12(1)(e) and 10 of the Act. In particular, the Opponent alleges the following:

i) that the word DEMERARA has by ordinary and bona fide commercial usage become recognized in Canada as designating the kind and quality of certain wares which emanate from Guyana or a particular region of Guyana. As such the adoption and use of the Mark in association with wares that do not emanate from Guyana is prohibited by Section 10 and the Mark is not registrable;

ii) that the adoption and use of the Mark by the Applicant is likely to mislead. The term DEMERARA which forms part of the Mark is likely to mislead or deceive the public into believing that the wares covered by application No. 1,206,738 emanate from Guyana, or a particular region of Guyana, which is not the case. As such, the adoption of the Mark is prohibited by s.10 and the Mark is not registrable.

[34] Section 10 reads as follows:

10. Where any mark has by ordinary and *bona fide* commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production of any wares or services, no person shall adopt it as a trade-mark in association with such wares or services or others of the same general class or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor.

[35] In my view, the evidence in this case does not establish that the Mark falls within the above prohibition. In this regard, the Opponent has not demonstrated that the average Canadian would recognize the Demerara region of Guyana as designating the place of origin for DEMERARA sugar. If the Opponent was of the view that Canadians have been educated to recognize that the word DEMERARA designates the place of origin of DEMERARA style sugar, it could have introduced evidence from Canadian consumers to that effect in the form of survey evidence. In the absence of evidence from consumers indicating that they would be, or have been, deceived by the use of a DEMERARA prefixed mark for a sugar that does not emanate from there tends to undermine the Opponent's case. Further, as noted by the Applicant's agent, the Opponent's own evidence shows that DEMERARA type sugar is known to emanate from Malawi, Jamaica and Mauritius (see Stecyk affidavit, Exhibit D).

[36] I would like to add that even if DEMERARA had been established as a mark prohibited by s. 10, the Mark DEMERARA GOLD does not so nearly resemble the word

DEMERARA as to be likely to be mistaken for it [see *Scotch Whiskey Assn. v. Glenora Distillers International Ltd.* (2009), 75 C.P.R. (4th) 1 (F.C.A.)]. Thus, this ground of opposition is also unsuccessful.

Section 30(b) Ground of Opposition

[37] The Opponent submits that the application does not comply with s.30(b) of the Act by reason of one or more of the following:

- i) the Applicant has not used the trade-mark in Canada from the date of first use claimed therein;
- ii) the Applicant has not used the trade-mark in Canada in association with all of the wares as of the filing date of the application; and
- iii) the Applicant has not continuously used the trade-mark in Canada in association with the wares listed in the application from the date of first use claimed therein.

[38] The Opponent has an evidential burden when alleging non-compliance to the provisions of s. 30(b) of the Act, but it has been characterized as a light one. In this regard, the Opponent's burden can be met by reference not only to the Opponent's evidence, but also to the Applicant's evidence [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.); *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. In such a case however, the Opponent must show that the evidence is clearly inconsistent with the Applicant's claim [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156 (T.M.O.B.); *Williams Telecommunications Corp. v. William Tell Ltd.*, (1999), 4 C.P.R. (4th) 107 (T.M.O.B.); and *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.)].

[39] In its argument, I note that the Opponent has relied, in part, upon its own evidence filed under the Warden affidavit to support its position that the Applicant does not use its Mark in association with glucose. It also submits that the packages for the Applicant's rice and coconut oil products do not display the Mark. However, without commenting on the

merit of such evidence, I note that the evidence filed under the Warden affidavit pertains to use of the Mark as at November 2005. As the material date for assessing this ground of opposition is the date of filing of the application, I will not have regard to such evidence. Accordingly, the Opponent will be limited to relying on the Applicant's own evidence, which I will now discuss, in order to meet its burden of proof.

[40] To begin with, in respect of the Opponent's second reason for non-compliance with s. 30(b) of the Act as stated above, the Opponent specifically questions the Applicant's evidence of use of its Mark in association with glucose and rice. As for glucose, it argues that the evidence pertaining to such use is ambiguous, as the copy of the label provided under Exhibit E of Mr. Bedessee's affidavit is alleged to have been used in association with glucose, whereas the label itself identifies the goods as "glucose powder". Respectfully however, I see no ambiguity. Mr. Bedessee has clearly attested that these products are one and the same. Furthermore, regardless of such clarification, it is reasonable in my view to consider that the product identified on the packaging in Exhibit E is glucose; it is simply glucose in powdered form.

[41] With respect to rice, the Opponent argues that the Applicant has not provided labels to demonstrate use of the Mark in association with rice. I agree that it may be curious that the Applicant has not provided labels to demonstrate use of the Mark in association with such wares, when it has done so for each of the remaining wares. However, this fact alone in my view does not raise any doubt about the veracity of the Applicant's claim that it has used its Mark since as early as January 1984 with each of the registered wares.

[42] As for the Opponent's remaining reasons for non-compliance with s.30(b) of the Act, the Opponent argues that aside from the bald assertions contained in the Bedessee Affidavit, no invoices or other evidence have been provided to substantiate the date of first use as claimed in the Application or to substantiate the claim of continuous use since 1984. However, the Opponent has not shown that the Applicant's evidence is clearly inconsistent with the alleged use of the Mark in association with each of the wares identified in the application. Consequently, the Applicant was not obliged to evidence the use of its trademark since such date. In other words, the absence of invoices or other such evidence does

not suffice for the s. 30(b) ground of opposition to succeed where the Opponent's evidential burden has not been satisfied. This ground of opposition is therefore unsuccessful.

Section 16 grounds

[43] With respect to the non-entitlement ground of opposition based on prior use or making known of the trade-marks DEMERARA, DEMERARA GOLD and DEMERARA GOLD RUM and/or one or more of the trade-names Demerara Distillers and Demerara Distillers Limited, the Opponent has an initial burden in view of the provisions of s. 16(5) and 17(1) of the Act, of establishing its alleged prior use or making known of such trade-marks and trade-names in Canada in association with rum as well as non-abandonment of the trade-marks and trade-names in association with this ware as of the date of advertisement of the Mark in the *Trade Marks Journal*. As no evidence of use or making known of any of these marks or names has been filed by the Opponent in this opposition, the Opponent has failed to establish its alleged prior use or making known of such trade-marks and trade-names and these grounds of opposition are therefore rejected.

[44] The Opponent has also relied upon its previously filed application for the trade-mark DEMERARA, application No. 1,172,524, in challenging the Applicant's entitlement to registration. A copy of this application was attached to the affidavit of Ms. Stecyk as Exhibit A. I note that the filing date of this application was March 27, 2003. As this application was not pending as of the Applicant's date of first use, the Opponent has not met its burden under this ground and it is therefore unsuccessful.

Distinctiveness Ground of Opposition

[45] The Opponent's distinctiveness ground of opposition has been pleaded as follows:

The trade-mark is not distinctive of the applicant because it does not distinguish, nor is it adapted to distinguish, the wares of the applicant from the wares or services of others, including those of the Opponent, having regard to: (i) the prior use and/or making known of the trade-marks and trade-names identified above by the Opponent in association with rum; and 2) the fact that the trade-mark is deceptively misdescriptive of the character, quality and/or place of origin of the Applicant's wares.

[46] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition, February 22, 2005, the Opponent's marks and names had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)].

[47] The Opponent has not filed any evidence of use or making known of any of its trade-marks or trade-names in this opposition. The Opponent has therefore failed to meet its burden under the first part of this ground of opposition and this part of this ground is unsuccessful.

[48] With respect to the second part of this ground of opposition, the reasons above which support the conclusion that the Mark is not deceptively misdescriptive of the character, quality or place of origin of the Applicant's wares are equally applicable to this ground of opposition. This part of this ground is therefore also unsuccessful.

Disposition

[49] In view of the above, and 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.

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