

IN THE MATTER OF AN OPPOSITION
by Joseph E. Seagram & Sons, Limited
to application No. 557,060 for the
trade-mark WILDBERRY BREEZE filed by
Holiday Juice Ltd. (now Everfresh Inc.)

On February 5, 1986, Holiday Juice Ltd. filed an application to register the trade-mark WILDBERRY BREEZE for "non-alcoholic beverages namely fruit juices and fruit drinks in still and carbonated form" based on proposed use in Canada. The applicant voluntarily amended the application to include a disclaimer to the word WILDBERRY. The application was subsequently advertised for opposition purposes on April 8, 1987. By virtue of an amalgamation, the application now stands in the name of Everfresh Inc.

The opponent, Joseph E. Seagram & Sons, Limited, filed a statement of opposition on September 8, 1987, a copy of which was forwarded to the applicant on September 24, 1987. The grounds of opposition include, among others, that the applied for trade-mark is not distinctive because it is confusing with the opponent's trade-mark WILDBERRY used in association with a distilled alcoholic beverage, namely a vodka cooler.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Peter Greenhough, Peter Macdougall, Alain Leclerc, Maureen Hanrahan, Margo Korneluk and Vicky Evans. As its evidence, the applicant filed the affidavits of John Curtis, Bernard Beasley, Michael J. Coleman and Ron Wood. As evidence in reply, the opponent filed the affidavit of Cecile K. Solomon and a second affidavit of Peter Greenhough. The second Greenhough affidavit is simply an update of Mr. Greenhough's first affidavit regarding the opponent's activities in relation to its WILDBERRY trade-mark. It is not strictly confined to matter in reply and is therefore inadmissible.

The opponent objected to the Curtis affidavit as not having been properly executed. The applicant requested leave to file a re-executed copy of the Curtis affidavit and the opponent did not object to that request. It appears, however, that the applicant's request was overlooked and I therefore granted leave at the oral hearing to the applicant pursuant to Rule 46(1) of the Trade-marks Regulations to file the replacement Curtis affidavit.

As for the ground of non-distinctiveness, there is an evidential burden on the opponent to evidence use of its mark WILDBERRY. This the opponent has done. The onus or legal burden is then on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of the opponent throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R. (3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. -September 8, 1987): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); Molnlycke Aktiebolag v. Kimberly-Clark Ltd. (1982), 61 C.P.R. (2d) 42 at 52 (F.C.T.D.); Work Wear Corp. v. Triple G. Manufacturing Inc. (1990), 32 C.P.R. (3d) 463 at 467 (F.C.T.D.); Murjani International Ltd. v. Universal Impex Co. Ltd. (1986), 12 C.P.R. (3d) 481 at 484 (F.C.T.D.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.).

In assessing the issue of distinctiveness in this case, it is useful to consider

the issue of confusion between the marks of the parties. The test for confusion between competing trade-marks is set out in Section 6(2) of the Act. In applying that test, all of the surrounding circumstances must be considered including those specifically set forth in Section 6(5) of the Act.

The opponent's trade-mark WILDBERRY is inherently weak when used in association with a vodka cooler: see Joseph E. Seagram & Sons, Ltd. v. Andres Wines Ltd. (1987), 16 C.P.R.(3d) 481 (F.C.T.D.). The applicant contends that the mark is clearly descriptive of a beverage flavored with "wild berries" and that "wildberry" is an accepted flavor designation in the beverage industry. Mr. Curtis identifies himself as Marketing Manager of Everfresh Inc. and states that he "believes" that "wildberry" is a flavor designation. However, Mr. Curtis does not provide any credible basis for his belief. Appended to his affidavit are copies of a product list from an American supplier and an invoice from another American supplier where the words "wild berry" or "wildberry" are used. However, these are American documents with no indication of any Canadian circulation. Furthermore, both documents are dated well after the material time.

In his affidavit, Mr. Beasley refers to an April 1989 publication which contains an article referring to "wild berries." This publication is well after the material time. Mr. Beasley also refers to the May 1986 edition of a magazine entitled Verve which contains a reference to TOFUTTI WILDBERRY SUPREME. However, there is no definition of the word "wildberry" in that ad and there is no indication of the extent of Canadian circulation (if any) of the magazine. Mr. Beasley also indicates that he purchased one of the opponent's products which had a neck label on it with the wording "Luscious wildberries" which points to descriptive use of the term "wildberry" by the opponent itself. However, this evidence is answered by the Solomon affidavit. She indicates that the neck label in question was being used on the opponent's WILDBERRY liqueur product, not on the WILDBERRY vodka cooler. Furthermore, she indicates that the label was used in error. Once she became aware of the situation in March of 1987, instructions were given to remove all such neck labels and they were never used after that time.

Thus, there is little or no admissible evidence as of the material time to show that "wildberry" refers to a particular type of berry or a specific flavor or combination of flavors. The mark WILDBERRY is undoubtedly highly suggestive of the opponent's wares since it points to a flavoring using a combination of one or more berries grown in the wild. However, the word "wildberry" does not appear to be a defined term and the evidence of record does not point to a defined class of berries that would fall within the designation "wild berry." Since "wildberry" does not appear to be a recognized and identifiable class of berries, it is not clearly descriptive of the character of the opponent's product. A similar finding was made respecting the trade-mark ORCHARD BLENDS in Welch Foods Inc. v. Del Monte Corp. (1991), 36 C.P.R. (3d) 562 (T.M.O.B.).

Notwithstanding the inherent weakness of the mark WILDBERRY, the opponent's evidence establishes that the opponent has effected very significant sales and advertising of its WILDBERRY vodka cooler throughout Canada since its introduction in January of 1986. The opponent's product met with such immediate success that I am able to conclude that it had become well known throughout Canada as of the filing of the opposition.

The applicant contends that the opponent's evidence shows use of a composite mark

and not use of the trade-mark WILDBERRY alone and that consequently any reputation accruing to the benefit of the opponent is in respect of the composite mark only. I disagree. A sample of the opponent's labelling used since February of 1987 was appended as Exhibit D to the first Greenhough affidavit and a copy of that label is reproduced below.

As stated in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 (T.M.O.B.) at page 538 as follows:

Use of a mark in combination with additional material constitutes use of the mark 'per se' as a trade mark if the public, as a matter of first impression, would perceive the mark 'per se' as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing...or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name.....

In the present case, the word WILDBERRY is the central and dominant element on the label. It appears in larger letters than the other wording on the label and it appears in a distinctive script and in an angled position. It is likely that consumers would view the words VODKA COOLER BOISSON A LA VODKA as a description of the product and the word SEAGRAM'S as the opponent's house mark. They would likely view the word WILDBERRY as the opponent's brand name for its vodka cooler. The inclusion of the subscripted designation "TM" after the word WILDBERRY underscores this conclusion to some extent.

In view of the above, I find that the use of the opponent's various labels constitutes use of the separate trade-mark WILDBERRY. Consequently, the reputation associated with the opponent's product points to an acquired reputation for the trade-mark WILDBERRY. This is reinforced to some extent by the opponent's advertising materials, a number of which reinforce the trade-mark status of the word WILDBERRY when presented to the public (see the various exhibits to the Macdougall affidavit).

The applicant's mark, too, is inherently weak. As before, the component WILDBERRY is highly suggestive of the applicant's proposed product. However, in view of the component BREEZE, the applicant's mark does possess a greater measure of inherent distinctiveness than the opponent's mark. There being no evidence of use of the applicant's mark, I must conclude that it had not become known at all in Canada as of the material time.

The length of time the marks have been in use favors the opponent although it is not a significant factor in this case. The wares of the parties are not identical although they are somewhat related. The opponent's product is a "cooler" which is an iced drink typically containing an alcoholic beverage as a base. Mr. Macdougall, Vice-President, Marketing of the opponent, states that "coolers" are usually carbonated beverages containing fruit juices and/or fruit flavorings often containing low levels of alcohol in the form of spirits, wine or beer. In the case of his company's WILDBERRY cooler, it contains natural fruit flavors, carbonated water and vodka. The applicant's proposed product appears to be similar to the opponent's product except that it will not contain alcohol.

The Leclerc affidavit establishes that there appears to be a continuum of fruit flavored carbonated beverages on the market having an alcohol content varying from a low of zero percent to a high of about five percent. More importantly, the Leclerc affidavit establishes that there is a potential overlap in the trades even in respect of those products containing zero percent alcohol and those containing five percent alcohol. Although Mr. Leclerc's investigations were made a number of months after the filing of the opposition, I consider that the extensive scope of his findings allows me to conclude that they are fairly reflective of the marketplace as of the earlier date.

Mr. Leclerc attended at various retail outlets in Ottawa, Ontario and in Hull, Quebec including government operated liquor stores. In government operated outlets in both cities, he was able to purchase a wide variety of coolers. In convenience and grocery stores in Hull, he was able to purchase carbonated fruit flavored beverages containing anywhere from zero to five percent alcohol. In convenience and grocery stores in Ottawa he was able to purchase similar products but none having an alcohol content greater than 1.6 percent. Thus, there would appear to be at least some overlap in the trades of the parties.

The applicant contended that the opponent's WILDBERRY vodka cooler is sold only through government operated liquor stores, that such outlets do not sell non-alcoholic beverages such as fruit juices and fruit drinks and that consequently the trades of the parties are distinct. In this regard, the applicant pointed out that the only outlet in which Mr. Leclerc was able to purchase the opponent's product was a government operated liquor store. I have also noted from a review of the first Greenhough affidavit that it would appear that all of the opponent's sales of its product are to provincial liquor boards or commissions. However, in the absence of additional evidence on point, I cannot necessarily conclude that such boards or commissions sell products only through government operated liquor stores or that the opponent is unable to sell its product through other retail outlets. It may well be that the channels of trade for distilled alcohol based coolers are more restricted than for other similar beverages perhaps as a consequence of legislative or regulatory provisions or the like. However, the applicant has failed to adequately evidence any such restricted trade. More importantly, the applicant has failed to evidence that consumers would be aware of any such fine distinctions in the channels of trade respecting different types of alcoholic coolers.

As for Section 6(5)(e) of the Act, I consider there to be a high degree of resemblance between the marks at issue in all respects. In fact, the applicant has adopted the entirety of the opponent's mark as the first and dominant component of its

proposed mark WILDBERRY BREEZE. As noted by the opponent, the degree of resemblance in the ideas suggested by the marks is underscored by the applicant's adoption of the word "breeze" which is similar in connotation to the word cooler.

The applicant relied on the opponent's own evidence to support its contention that trade-marks incorporating the word "berry" are common in the beverage industry. Based on the Hanrahan and Leclerc affidavits, I would agree to some extent with the applicant's contention. Thus, consumers would be expected to more easily distinguish such marks in the marketplace based on components other than the word "berry." However, that conclusion does not greatly assist the applicant in this case because the Hanrahan and Leclerc affidavits do not evidence third party use of trade-marks or product descriptions incorporating the word "wildberry." Mr. Wood, in his affidavit, does state that since December 1986 he has been aware of a grocery store believed to be A & P selling "Wild Berry Drink." However, in the absence of more specific detail from Mr. Wood and an indication of the availability and extent of sales of this product, I am unable to infer any measurable public awareness of that product in Canada as of the material time. Mr. Coleman, in his affidavit, attests to the purchase of the same product in June of 1989. However, in the absence of additional evidence on point, that is insufficient to allow me to conclude that there have been continuous and significant sales of that product from December 1986 to June of 1989.

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 extent to which the opponent's mark has become known, the potential overlap between the trades of the parties, the high degree of resemblance between the marks and the fact that the applicant's application is based on proposed use, I find that I am left in a state of doubt respecting the issue of whether or not the applicant's mark WILDBERRY BREEZE is confusing with the opponent's mark WILDBERRY. Since the onus or legal burden is on the applicant, I must resolve that doubt against it. Consequently, I find that the marks are confusing and that the applicant has therefore failed to show that its proposed mark is adapted to distinguish its wares from the opponent's wares. The ground of non-distinctiveness is therefore successful and the remaining grounds need not be considered. I should note, however, that if the applicant had been able to successfully evidence that the trades of the parties were distinct and that consumers were aware of such a distinction, my finding might have been different.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF December, 1991.

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