

IN THE MATTER OF AN OPPOSITION by The
Molson Companies Limited (now Molson Breweries,
A Partnership) to application No. 529,080 for the
trade-mark RICARD & Design filed by Pernod Ricard
société anonyme

On September 26, 1984, the applicant, Pernod Ricard société anonyme, filed an application to register the trade-mark RICARD & Design, a representation of which appears below, based upon use of the trade-mark in Canada since 1954 in association with "vins, apéritifs à base d'anis, spiritueux anisés, boissons alcooliques à base d'anis".

The opponent, The Molson Companies Limited, filed a statement of opposition on April 23, 1986 in which it alleged that the applicant's application is not in compliance with Section 29(b) (now Section 30(b)) of the Trade-marks Act in that the applicant has not used the trade-mark in Canada since 1954, or at all. Further, the opponent asserted that the applicant's trade-mark is not registrable in view of Section 12(1)(a) of the Trade-marks Act in that it is primarily merely the surname of an individual who is living or has died within the preceding thirty years. As its final ground of opposition, the opponent has claimed that the applicant's trade-mark is not distinctive in that it is primarily merely a surname and the additional design portion of the trade-mark does not render the trade-mark, as a whole, distinctive.

The applicant served and filed a counter statement in which it denied the opponent's grounds of opposition and asserted that its trade-mark is registrable and distinctive, and that its application complies with Section 29(b) (now Section 30(b)) of the Trade-marks Act.

The opponent filed as its evidence the affidavit of J.David Lee who was cross-examined on his affidavit, the transcript of the cross-examination forming part of the record in this opposition.

During the Lee cross-examination (Q. 17-18, and responses thereto), the agent for the applicant pointed out that the copies of the exhibits annexed to the Lee affidavit as were served on the applicant were not properly notarized by the functionary who had sworn the affidavit. However, no formal objection was directed to the Opposition Board concerning this deficiency in the exhibits to the Lee affidavit prior to the oral hearing. Further, it is noted that the exhibits to the Lee affidavits as were filed with the Opposition Board were properly notarized and identified as exhibits to the Lee affidavit and that the applicant has not submitted that the content of the copies of the exhibits which were served on it differ from those as filed with the Trade-marks Office. Accordingly, I am not prepared to direct that the opponent serve copies of the notarized exhibits on the applicant at this stage of the opposition proceeding.

The applicant elected not to file evidence but did submit an amended application on January 4, 1988 in which it claimed that use of the trade-mark RICARD & Design in Canada since 1954 was "par la requérante que ses prédécesseurs en titre et distributeurs RICARD et SOCIETE DES GRANDES MARQUES (S.E.G.M.) en liaison avec toutes les marchandises spécifiques énumérées ...".

The opponent was granted leave to submit an amended statement of opposition (filed February 15, 1988) in which it amended its Section 30(b) ground of opposition to claim that neither the applicant nor its alleged predecessors in title have used the trade-mark in Canada since 1954, or at all and further that S.E.G.M. is not a predecessor in title to the applicant. In response, the applicant submitted a revised counter statement.

The opponent alone submitted a written argument and both parties were represented at an oral hearing.

At the oral hearing, the opponent repeated its request that it be granted leave to further amend its statement of opposition in the same manner as had previously been refused by the Opposition Board, as well as to file additional evidence pursuant to Rule 46(1) of the Trade-marks Regulations. No additional submissions were put forward by the opponent's agent at the oral hearing in support of the request for leave beyond those previously relied upon by the opponent. In refusing the opponent's previous request for leave under Rule 42, I indicated that the opponent had failed to explain the apparent delay of more than one year in requesting leave to amend its statement of opposition subsequent to the time when it ought to have been aware of the additional ground of opposition. As no further explanation was provided by the opponent, I advised the opponent's agent

at the oral hearing that I was not prepared either to reconsider the initial refusal of the request for leave or to consider a new request for leave under Rule 42 of the Regulations. Likewise, I refused the opponent's further request that it be granted leave to file additional evidence pursuant to Rule 46(1) of the Regulations.

The opponent's first ground of opposition is based on Section 30(b) of the Trade-marks Act, the opponent asserting that neither the applicant nor its alleged predecessors-in-title have used the trade-mark RICARD & Design in Canada since 1954 and further that S.E.G.M. is not a predecessor-in-title to the applicant. While the legal burden is on the applicant to demonstrate that its application is in compliance with Section 30 of the Trade-marks Act, there is an evidential burden on the opponent to establish the facts alleged by it in its statement of opposition in support of the Section 30 ground (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pg. 329). Further, as was pointed out by the hearing officer in Canadian Council of Professional Engineers v. Ontario Corp. No. 407,736 (carrying on business under the trading style Canadian Society for Professional Engineers), 15 C.P.R. (3d) 551, at pg. 553, the amount of evidence to discharge this evidential burden may be very slight.

In support of its position that it has met the evidential burden upon it in respect of the Section 30 ground, the opponent has relied upon the affidavit of Marc Nougayrol filed as evidence in a related opposition to registration of the trade-mark RICKARD'S RED, application No. 510,763, the parties to which are the same parties as are involved in the present opposition. However, this opposition must be decided on the basis of the evidence filed in this proceeding and not on evidence filed in other opposition proceedings.

The opponent further submitted that the Registrar can have regard to a registered user agreement between the applicant and S.E.G.M. which was filed in respect of the registered trade-mark RICARD, registration No. 157,477. While the Opposition Board is prepared to check the register to determine whether a registered trade-mark which has been relied upon by the opponent in its statement of opposition in support of a Section 12(1)(d) ground of opposition was on the register as of the material date in an opposition proceeding, the Board is not prepared to extend such a discretion to any and all records in the Trade-marks Office. In such a case, it is incumbent on the party wishing to rely upon such documentation to file evidence thereof in the opposition proceeding.

Additionally, the opponent sought to rely upon certain findings of fact by the learned trial judge in Pernod Ricard v. Molson Companies Ltd., 18 C.P.R. (3d) 160 in support of its submission

that S.E.G.M. is not a predecessor-in-title to the applicant. However, the Board cannot rely upon findings of fact based on evidence which was before the Court in a proceeding which, while involving the parties to the present opposition, related to an appeal from a decision of the Registrar rendered under Section 45 of the Trade-marks Act and therefore dealt with issues different from those involved in this opposition (see Cheerio Yo-Yo & Bo-Lo Co. Ltd. v. Cheerio Toys & Games Ltd., 28 C.P.R. (2d) 34, at pg. 35).

The opponent further argued that the Section 30(b) ground of opposition set forth in its amended statement of opposition as filed February 15, 1988 contemplated an allegation of abandonment by the applicant of its trade-mark. However, the opponent in its statement of opposition did not claim that the applicant had abandoned its trade-mark and I do not consider that wording of the Section 30(b) ground of opposition can be construed as raising the issue of abandonment as a basis for refusing the applicant's application under Section 30(b) of the Trade-marks Act.

In the alternative, the opponent submitted that the Registrar could nevertheless consider a Section 30 issue which has not been specifically pleaded in a statement of opposition in a situation where there is an inaccuracy or ambiguity in the applicant's application or where the applicant's own evidence points to non-compliance with Section 30 of the Trade-marks Act. In particular, the opponent alleged that the reference to use by predecessors in title and distributors in support of the applicant's claimed date of first use was ambiguous in that distributors could not be predecessors in title. With respect to its submission that the Registrar could consider an unpleaded Section 30 issue which is raised at an oral hearing, the opponent relied upon two decisions of the Opposition Board in Swift & Co. et al v. Monarch Fine Foods Co. Ltd., 79 C.P.R. (2d) 69 and Champagne Moët & Chandon v. Ridout Wines Ltd./ Les Vins Ridout Ltée., 77 C.P.R. (2d) 63. However, both of these decisions predated the decision of the Federal Court, Trial Division in Imperial Developments Ltd. v. Imperial Oil Limited, 79 C.P.R. (2d) 12 where Muldoon, J. pointed out that it was improper for a hearing officer to consider matters which are not pleaded as grounds of opposition in a statement of opposition. Accordingly, I do not consider that I have the authority to consider the issue of abandonment which was not specifically pleaded by the opponent in its amended statement of opposition of February 15, 1988.

The opponent's second ground of opposition is based on Section 12(1)(a) of the Trade-marks Act, the opponent alleging that the applicant's trade-mark RICARD & Design is primarily merely the surname of an individual who is living or has died within the preceding thirty years. There is an

evidential burden on the opponent in respect of this ground of opposition and I am satisfied that the opponent by way of the Lee affidavit has met the burden upon it of establishing the word RICARD does possess a surname significance. The issue, however, is whether there is sufficient subject-matter in the trade-mark RICARD & Design apart from the name RICARD to warrant registration as a trade-mark (see John Labatt Ltd. v. Registrar of Trade Marks, 79 C.P.R. (2d) 110, at pg. 115). In the present case, the design features of the applicant's trade-mark exist separate from the word RICARD and are such as to constitute a registrable trade-mark, unlike the situation in the John Labatt Ltd. case, referred to above. As a result, I find the opponent's second ground of opposition to be unsuccessful.

As its final ground, the opponent has claimed that the applicant's trade-mark is non-distinctive in view of the surname significance of the word RICARD. While the opponent has established that the word RICARD does have a surname significance and would likely be referred to orally as RICARD when ordering the applicant's wares, the opponent has nevertheless not met the evidential burden upon it of demonstrating that the applicant's trade-mark RICARD & Design when considered in its entirety is non-distinctive. In my view, the design features of the applicant's trade-mark are at least as dominant if not more dominant than is the word RICARD and the design features of the trade-mark are an integral part thereof which must be considered when determining whether or not the trade-mark is distinctive. In this regard, it would be unreasonable to conclude that the applicant's trade-mark might be registrable and distinctive without inclusion of the word RICARD but that the trade-mark would be neither registrable nor distinctive when the word RICARD is added to it in that the trade-mark would be identified orally as RICARD. As a result, I have rejected the opponent's final ground of opposition.

In view of the above, I reject the opponent's opposition pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF APRIL 1990.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.