

**IN THE MATTER OF AN OPPOSITION by
Molson Canada 2005 to Application No.
1196040 for the trade-mark 1 GREAT BEER
filed by Labatt Brewing Company Limited**

I The Proceedings

[1] On November 12, 2003 Labatt Brewing Company Limited/La Brasserie Labatt Limitée (the “Applicant”) filed an application to register the trade-mark 1 GREAT BEER (the “Mark”) based on proposed use in Canada in association with alcoholic brewery beverages (the “Wares”). The Applicant, after an office action, disclaimed the right to the exclusive use of the words GREAT BEER apart from the trade-mark.

[2] The application was advertised on January 4, 2006 in the Trade-marks Journal for opposition purposes. Molson Canada 2005 (the “Opponent”) filed a statement of opposition on June 2, 2006 and the Registrar forwarded it to the Applicant on June 15, 2006. The Applicant filed a counter statement on June 23, 2006, in which it admits none of the grounds of opposition pleaded.

[3] The Opponent filed the affidavit of Jérôme P. Bastien while the Applicant chose not to file any evidence. Only the Opponent filed a written argument and an oral hearing was not held.

II The Grounds of Opposition

[4] All grounds of opposition raised by the Opponent either under s. 30(i) of the Trade-marks Act, R.S.C. 1985, c. T-13 (the “Act”), distinctiveness or under s. 12(1)(b) of the Act are based on the argument that the Mark is either clearly descriptive or deceptively misdescriptive of the Wares.

[5] The Opponent has also pleaded that the Wares are not described in ordinary commercial terms pursuant to s. 30 (a) of the Act.

III The Relevant Dates

[6] The relevant date for grounds of opposition based on s. 30 of the Act is the filing date of the application [see *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469]. The filing date of the application is also the relevant date for the ground of opposition based on s. 12(1)(b) of the Act [see *Zorti Investments Inc. v. Party City Corporation* (2004), 36 C.P.R. (4th) 90; *Havana Club Holdings S.A. v. Bacardi & Company Limited*, (2004) 35 C.P.R. (4th) 541] and the date of filing of the statement of opposition is generally considered to be the relevant date to determine the issue of distinctiveness of the Mark [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317].

IV The Burden of Proof in Opposition Proceedings

[7] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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. Once this initial onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

[8] There are exceptions to this general principle. One of them relates to the ground of opposition based on s. 12(1)(b) of the Act. If the Opponent is alleging that the trade-mark is not registrable because it would be clearly descriptive or deceptively misdescriptive of the character or quality of the wares, it may rely on the ordinary meaning of the words comprising the trade-mark [see *Les Éditions Gesca Ltée. v. Time4 Media Inc.* (2007), 60 C.P.R. (4th) 55]. By analogy

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I am of the opinion that this exception would also be applicable to other grounds of opposition, the bases of which relate to the concept of clearly descriptive trade-marks.

V Ground of Opposition Based on s. 30(a) of the Act

[9] The Opponent did not file evidence to support its allegation that the Wares are not described in ordinary commercial terms. Nor were there any representations made on this issue in its written arguments. In view of the above, the Opponent has failed to meet its initial onus and consequently this ground of opposition is dismissed.

V Registrability of the Mark under s. 12(1)(b) of the Act

[10] The test under s. 12(1)(b) has been laid down in *Thomas J. Lipton Ltd. v. Salada Foods Ltd (no.3)* (1979), 45 C.P.R. (2d) 157 in the following terms:

Connotation means an implication or a suggestion. Even a "specific descriptive suggestion or implication" or "a clear implication or suggestion" that a mark is descriptive or misdescriptive is not sufficient to disqualify it for registration under s-s. 12(1)(b). That enactment admits of no mere implication or suggestion. Parliament used the word "clearly" before the word "descriptive" and "deceptively" before the word "misdescriptive" and the Registrar has made no finding that the word was either clearly descriptive or deceptively misdescriptive. As to whether a mere suggestive description suffices, one might refer to a decision of the former Exchequer Court of Canada in the case of *Kellogg Co. of Canada Ltd. v. Registrar of Trade Marks*, [1939] 3 D.L.R. 65, [1940] Ex. C.R. 163 at pp. 170 and 171.

The concept of clearness where the word is descriptive and of deception where it is misdescriptive are essential elements

[11] Mr. Bastien was a student-at-law working for the Opponent's agent firm when he executed his affidavit. He states that he visited on March 28, 2007 various websites on the Internet. Without discussing the admissibility of this evidence (exhibits 1 to 21 to his affidavit) over the issue that it may constitute hearsay evidence, these searches were conducted after the relevant date and the web pages filed all bear a date subsequent to the filing date of the application. For this reason alone this portion of the evidence will be disregarded. Even if I were

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to consider the later relevant date under distinctiveness (June 2, 2006), still this evidence would be inadmissible as subsequent to the filing date of the statement of opposition.

[12] As for the remainder of Mr. Bastien's affidavit he states having done research on the website of the Canadian Intellectual Property Office and has annexed to his affidavit some extracts of the register (see exhibits 22 to 30). No information has been provided on the parameters used to obtain those results and no analysis of these citations was provided either in the affidavit itself or in the written argument. Therefore this portion of the evidence is of little assistance to the Opponent. In any event, as it will appear hereinafter, it would not have an impact on my decision.

[13] The only issue to be adjudicated is whether the Mark, when sounded ("one great beer") is clearly descriptive or deceptively misdescriptive when used in association with the Wares.

[14] Ultimately it is the Applicant that has the burden to convince the Registrar that the Mark is not clearly descriptive or deceptively misdescriptive of the quality or character of the Wares. The absence of written argument or verbal representations at an oral hearing makes it difficult to foresee any argument to support the conclusion that the Mark would be, at best for the Applicant, simply suggestive or descriptive as opposed to clearly descriptive of the character or quality of the Wares.

[15] The number "1" when sounded means "a single unit"; the word "great" is a laudatory expression referring to the quality of the beer; and finally the word "beer" is encompassed in the Wares. When sounded, the Mark self-evidently describes a beer that is great. The Mark is therefore clearly descriptive, when sounded, of the character or quality of the Wares. The expression "1 great beer" should not be the subject of a monopoly such that it would prevent other traders in the beer industry to use that expression to describe products of the same nature than the Wares. The Applicant could have overcome this obstacle by filing evidence of use of the Mark such that it would have been distinctive of the Applicant's Wares at the filing date of the application (s. 12(2) of the Act). However the application was filed on the basis of proposed use.

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[16] The ground of opposition based on s. 12(1)(b) of the Act, namely that the Mark is clearly descriptive of the character or quality of the Wares is therefore maintained.

VI Other Grounds of Opposition

[17] If a trade-mark is clearly descriptive of the character or quality of the wares, it cannot serve to distinguish those wares from the wares of others [see *Canadian Jewellers Assn. v. Worldwide Diamonds Trademarks Ltd.* (2009), 74 C.P.R. (4th) 298]. In view of my findings with respect to the ground of opposition based on s. 12(1)(b) of the Act, which are equally applicable to these circumstances, the ground of opposition based on lack of distinctiveness of the Mark is also maintained.

[18] Given the fact that the Opponent has already been successful under two different grounds of opposition, I do not intend to rule on the ground of opposition based on s. 30(i) of the Act.

VII Conclusion

[19] Pursuant to the authority delegated to me by the Registrar of Trade-marks under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 24th DAY OF DECEMBER 2009.

Jean Carrière,
Member, Trade-marks Opposition Board