

## TRADUCTION/TRANSLATION

**IN THE MATTER OF AN OPPOSITION by  
Bacardi & Company Limited to application  
No. 1,219,838 for the trade-mark HAVANA CLUB  
filed by Havana Club Holdings S.A.**

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### **I The Pleadings**

- [1] On June 10, 2004, Havana Club Holdings S.A. (the “Applicant”) filed an application to register the trade-mark HAVANA CLUB (the “Mark”), No. 1,219,838, in association with rum (the “Wares”).
- [2] The application for registration is based on use in Canada since December 31, 1995. The Applicant has disclaimed the right to the exclusive use of the word “HAVANA” apart from the Mark.
- [3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 20, 2005. On September 20, 2005, Bacardi & Company Limited (the “Opponent”) filed a statement of opposition, which the Registrar forwarded to the Applicant on October 20, 2005.
- [4] On October 24, 2005, the Applicant filed a counter statement essentially denying the ground of opposition described below.
- [5] The Opponent filed the affidavit of Sharon Elliot. The Applicant filed the affidavit of Claude Boulay. Neither of the affiants was cross-examined even though the Opponent had obtained a cross-examination order for Mr. Boulay. Only the Opponent filed written arguments, and both parties were represented at the oral hearing.

## **II Statement of Opposition**

[6] There is only one ground of opposition, which can be summarized as follows:

The application for registration does not comply with the requirements of section 30(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the “Act”), in that the Applicant has not used the Mark in association with rum since December 31, 1995, as claimed in the application.

## **III Opponent’s Evidence**

[7] Ms. Elliot was employed as a clerk by the Opponent’s trade-mark agents at the time of execution of her affidavit. She alleges that she obtained a certified copy of an affidavit of Armando de Medeiros dated October 29, 2004, from the Registry of the Federal Court of Canada; the affidavit had been filed with the Registry of the Federal Court on November 10, 2004, in docket number T-720-04 between the Applicant and the Opponent. We have no information about the nature of the proceedings before that court.

[8] In his affidavit, Mr. de Medeiros describes himself as the chairman of Pernod Ricard Canada (“PR Canada”). He alleges that PR Canada is, among other things, responsible for representing the Applicant’s rums bearing the Mark in Canada. He therefore has access to information about the marketing of the products represented by PR Canada in Canada. He provided the sales figures in Canada per nine-litre case for rum bearing the Mark for the 1997 to 2003 period. Mr. de Medeiros also provided the retail price of this rum and of that sold by the Opponent under the trade-mark OLD HAVANA, even though this information is not relevant to this file.

## **IV Applicant’s Evidence**

[9] Mr. Boulay describes himself as PR Canada's secretary. He provided the number of cases of rum sold in Canada in association with the Mark in 1995 and 1996.

## **V Analysis of the Ground of Opposition**

[10] In proceedings to oppose the registration of a trade-mark, the opponent must present enough evidence concerning the grounds of opposition raised to show that there are facts supporting those grounds. If the Opponent satisfies this requirement, the Applicant must then satisfy the Registrar, on the balance of probabilities, that the grounds of opposition should not prevent its trade-mark from being registered [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53, *Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325, and *John Labatt Ltd. v. Molson Companies Limited* (1990), 30 C.P.R. (3d) 293].

[11] The relevant date for analyzing the ground of opposition is the filing date of the application (June 10, 2004) [See *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R. (3d) 293 and *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469].

[12] Despite the Opponent's initial evidentiary burden under a ground of opposition based on section 30(b) of the Act, it has been stated many times that this burden is "light". Moreover, the Opponent may meet its burden by referring to the Applicant's evidence [see *York Barbell Holdings Ltd. v. ICON Health & Fitness, Inc.* (2001), 13 C.P.R. (4th) 156]. However, in such a case, this evidence must cast serious doubt on the truthfulness of the date of first use stated in the application for registration [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986) 10 C.P.R. (3d) 84, *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216, and *Williams Telecommunications Corp. v. William Tell Ltd.*, (1999) 4 C.P.R. (4th) 107].

[13] In my opinion, the Opponent has not discharged its initial burden of proof, light as it may be, for the following reasons.

[14] The filing of a certified copy of an affidavit filed in another legal proceeding has already been accepted as evidence despite the best evidence rule. This was an exception, that is to say, the affidavit contained an admission against the Applicant's interest. The Opponent submits that Mr. de Medeiros's affidavit contains an admission against the Applicant's interest, namely that the Applicant only started using the Mark in Canada in 1997.

[15] The Opponent would like to read into this affidavit that the Applicant only began using the Mark in 1997 since the affidavit provides sales figures for rum bearing the Mark only for 1997 to 2003. Yet we do not know if the affidavit was tendered as evidence for all the Opponent's sales of rum bearing the Mark in Canada. Mr. de Medeiros does not state in his affidavit that he is providing the sales figures for rum bearing the Mark in Canada since the Mark was first used.

[16] As for Mr. Boulay's affidavit, it merely provides the sales figures for rum bearing the Mark for 1995 and 1996. Based on this affidavit, the Opponent would like me to conclude that the Applicant stopped using the Mark in 1997. I cannot attribute this intention to the affidavit. All that it provides as information is the sales figures for rum in Canada in association with the Mark during 1995 and 1996. I presume that the Applicant, presuming that the content was admissible, intended this affidavit to complement the affidavit of Mr. de Medeiros. In fact, the only issue in this opposition is to determine whether the evidence shows that the Applicant had not used the Mark in Canada in association with the Wares on the date of first use alleged in its application for registration.

[17] The Opponent argues that the Applicant did not file evidence of use of the Mark within the meaning of section 4(1) of the Act to dispel any doubts as to its use since December 31, 1995.

[18] Suffice it so say that in the context of this ground of opposition, the Applicant does not have the initial burden of proving use of the Mark from the date of first use alleged in its application for registration. The Opponent had to establish material facts to raise serious

doubts about the truthfulness of the date of first use of the Mark in Canada. If the Opponent casts serious doubt, the Applicant must prove use of the Mark from the date of first use stated in the application for registration. The evidence in the record does not allow me to conclude that there is any such doubt.

[19] The Opponent relies on *Community Credit Union Ltd. v. Registrar of Trade-marks*, 53 C.P.R. (4th) 296, to argue that the Applicant bears the onus of proving the date of first use alleged in its application for registration. Yet, in that same decision, the court did conclude so, but only after it noted, following a cross-examination of the applicant's representative, that the applicant's evidence raised serious doubts about the accuracy of the date of first use of the mark in Canada in association with the wares. In that context, it was completely logical for the applicant to have had the burden of establishing the accuracy of the date of first use claimed in its application for registration.

[20] I therefore dismiss the sole ground of opposition, since the Opponent did not discharge its initial burden of proof.

## **VI Conclusion**

[21] Based on the powers delegated to me by the Registrar of Trade-marks pursuant to the provisions of section 63(3) of the Act, I reject the opposition, pursuant to section 38(8) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 9TH DAY OF DECEMBER 2009.

Jean Carrière  
Member, Trade-marks Opposition Board

Certified true translation  
Johanna Kratz