



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

Citation: 2019 TMOB 25

Date of Decision: 2019-03-27

IN THE MATTER OF OPPOSITIONS

JTI-Macdonald TM Corp.

Opponent

and

John Player & Sons Ltd.

Applicant

1,605,729 and 1,605,733 both entitled

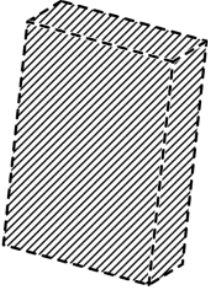
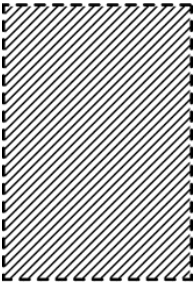
Applications

BROWN PACKAGE DESIGN

INTRODUCTION

[1] JTI-Macdonald TM Corp. (the Opponent) opposes registration of the trade-marks both entitled BROWN PACKAGE DESIGN (reproduced below) that are respectively the subject of application Nos. 1,605,729 and 1,605,733 based upon use in Canada since at least as early as November 5, 2012 in association with “manufactured tobacco products, namely cigarettes” (the Goods) filed by John Player & Sons Ltd. (the Applicant):

Application No. 1,605,729 (hereinafter sometimes referred to as the '729 Application)	Application No. 1,605,733 (hereinafter sometimes referred to as the '733 Application)
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<p>Description: The trade-mark consists of the colour brown having the appearance of unbleached paperboard applied to the visible surface of the particular packaging as shown in the attached drawing. The drawing has been lined for colour.</p>	<p>Description: The trade-mark consists of the colour brown having the appearance of unbleached paperboard applied to the visible surface of the particular packaging as shown in the attached drawing. The drawing has been lined for colour.</p>

[2] The only difference between the two applications is that the '729 Application depicts a three-dimensional design, while the '733 Application depicts a two-dimensional one. Unless indicated otherwise, I will collectively refer to these two design marks as the Mark.

[3] The oppositions were brought under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and raise grounds of opposition based upon sections 2 (non-distinctiveness); 12 (non-registrability); and 30 (non-conformity) of the Act.

[4] For the reasons that follow below, I find the applications ought to be refused.

THE RECORD

[5] The applications for the Mark were both filed on December 7, 2012 and were advertised for opposition purposes in the *Trade-marks Journal* on September 25, 2013 ('729 Application) and February 26, 2014 ('733 Application).

[6] The applications were opposed by the Opponent by way of statements of opposition filed with the Registrar on February 25, 2014 with respect to the '729 Application, and April 28, 2014 with respect to the '733 Application. Both statements of opposition were voluntarily amended by the Opponent on July 21, 2014 ('729 Application) and October 1, 2014 ('733 Application) with permission of the Registrar. Unless indicated otherwise, I will use the singular to refer to these two amended statements of opposition as they are essentially identical (except for the identification of the applied-for trade-mark and one additional section 30 ground of opposition

pleaded in respect of the 733 Application). For ease of reference, I reproduce the grounds of opposition as pleaded by the Opponent in respect of the '729 Application and the '733 Application respectively, at Schedules A and B to my decision.

[7] The Applicant filed and served a counter statement in each case denying the grounds of opposition set out in the statement of opposition.

[8] In support of each of its oppositions, the Opponent filed the following documents:

- The affidavit of Richard Sue, the Manager, Scenario Planning and Forecasting for the Opponent, sworn on July 17, 2014 ('729 Application) and September 25, 2014 ('733 Application) (hereinafter collectively referred to as the Sue affidavit);
- The affidavit of Simon Grenier, a Field Operations Manager for the Eastern Region (Quebec and Atlantic provinces) for the Opponent, sworn on July 17, 2014 ('729 Application) and September 22, 2014 ('733 Application) (hereinafter collectively referred to as the Grenier affidavit); and
- The affidavit of Camille Aubin, a law student employed by the Opponent's trade-marks agent, sworn on July 17, 2014 ('729 Application) and September 29, 2014 ('733 Application) (hereinafter collectively referred to as the Aubin affidavit).

[9] I will use the singular to refer to the two affidavits of each of these deponents as they are essentially identical. Mr. Sue was cross-examined on his affidavit and the transcript of his cross-examination and the responses to the undertakings made at the time of his cross-examination are on the record.

[10] In support of its opposition in respect of the '733 Application, the Opponent also filed certified copies of the following registrations and applications:

- Registration No. 591,146 for the trade-mark AMPHORA MELLOW BLEND & DESIGN;
- Registration No. 591,224 for the trade-mark AMPHORA ORIGINAL BLEND & DESIGN;
- Registration No. 686,970 for the trade-mark DJARUM SPICE ISLANDS & DESIGN;

- Registration No. 572,719 for the trade-mark TOSCANI & DESIGN;
- Application No. 1,317,127 for the trade-mark ORANGE PACKAGE DESIGN;
- Application No. 1,317,128 for the trade-mark ORANGE PACKAGE DESIGN;
- Application No. 1,580,255 for the trade-mark PURPLE PACKAGE DESIGN;
- Application No. 1,580,250 for the trade-mark PURPLE PACKAGE DESIGN; and
- Application No. 1,605,729 for the trade-mark BROWN PACKAGE DESIGN.

[11] I note that the particulars of these trade-mark registrations and applications are reproduced respectively under Exhibits MG-1 and MG-2 to the affidavit of Manon Goudreau, an employee in the trade-mark group of the Opponent's trade-marks agent, sworn on July 21, 2014 (the Goudreau affidavit), that was filed only in respect of the '729 Application.

[12] In support of each of its applications, the Applicant filed the following documents:

- The affidavit of Paul Furfaro, the Brand Portfolio Manager of Imperial Tobacco Canada Limited (ITCan), a related company to the Applicant, sworn on September 4, 2015 (the Furfaro affidavit)
- The affidavit of Jason B. Dinelle, a law clerk for the Applicant's trade-mark agent, sworn on September 2, 2015 (the Dinelle affidavit); and
- The affidavit of Gay Owens, a trade-mark searcher for the Applicant's trade-mark agent, sworn on September 2, 2015 (the Owens affidavit).

[13] I will use the singular to refer to the two affidavits of each of these deponents as they are essentially identical. Mr. Furfaro was cross-examined on his affidavit and the transcript of his cross-examination and the responses to the undertakings made at the time of his cross-examination are on the record. I note that Mr. Furfaro is no longer the Brand Portfolio Manager of ITCan, but is now the "Player's Brand Manager" [Transcript of the cross-examination of Paul Furfaro, p. 13, Q. 13].

[14] Both parties filed written arguments in each case and attended an oral hearing.

PRELIMINARY REMARK

Past opposition proceedings between the parties

[15] The parties to the present proceedings are not strangers. They are direct competitors in the Canadian cigarette market and have been involved in opposition proceedings concerning the Applicant's trade-mark application Nos. 1,317,127 (now TMA908,657) and 1,317,128 (now TMA908,626) both entitled ORANGE PACKAGE DESIGN, which applications were substantively identical to the present ones in terms of the manner of depiction and description of the applied-for trade-mark, other than the colour claimed, and which were opposed by the Opponent in the present cases as well as Rothmans, Benson & Hedges, Inc. on similar grounds of opposition. The Registrar's decisions dismissing both of the Opponent's oppositions and Rothmans, Benson & Hedges, Inc.'s oppositions [see *Rothmans, Benson & Hedges v Imperial Tobacco Products*, 2012 TMOB 226 (the *226 Decision*); *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2012 TMOB 116 (the *116 Decision*); and *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2012 TMOB 117 (the *117 Decision*)] were upheld by the Federal Court in *Rothmans, Benson & Hedges, Inc v Imperial Tobacco Products Limited*, 2014 FC 300 (the *FC 300 Decision*) and *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2013 FC 608 (the *FC 608 Decision*), as well as by the Federal Court of Appeal in *Rothmans, Benson & Hedges, Inc v Imperial Tobacco Products Limited*, 2015 FCA 111 (the *FCA 111 Decision*) (sometimes hereinafter collectively referred to as the *ORANGE Decisions*).

[16] Not surprisingly, the Applicant relies heavily on the *ORANGE Decisions* in the present cases. However, these prior decisions are not necessarily determinative of the issues. Suffice it to say that each case rests on its own merits. That being said, I will adopt some of the reasoning in the *ORANGE Decisions* where I consider it appropriate to do so.

THE PARTIES' RESPECTIVE BURDEN OR ONUS

[17] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

OVERVIEW OF THE EVIDENCE

The Opponent's evidence

The Sue affidavit

[18] In the introductory paragraphs of his affidavit, Mr. Sue explains his role within the Opponent and also provides background information about the Opponent's business as a manufacturer and distributor of cigarettes, cigars and other tobacco products.

[19] Mr. Sue explains that he is responsible for preparing sales forecasts, conducting market analysis regarding the tobacco industry in Canada, administering the Opponent's sales data, preparing detailed forecasts for strategic planning, and gathering and analyzing sales data from retailers, wholesalers, and third party service providers [para 1].

[20] Mr. Sue further explains that some wholesalers and retailers voluntarily provide the Opponent with data related to sales volumes of all tobacco products they sell, including products of third parties (the Sales Data). The Sales Data is provided to the Opponent directly from wholesalers and retailers and is inputted by the Opponent's employees into an internal database (the Database) on a weekly basis. The Database is one of the Opponent's business records, created and maintained in the ordinary course of its business [paras 2-6].

[21] Mr. Sue then provides the Sales Data retrieved from the Opponent's Database for the following third party tobacco products, together with photocopies of their associated packaging:

- Captain Black cigars [Exhibit RS-1, para 8];
- Bullseye vanilla-flavoured cigars [Exhibit RS-2, para 9];
- Backwoods Wild 'n Natural cigars [Exhibit RS-3, para 10];
- Honey T vanilla-flavoured cigars [Exhibit RS-4, para 11];
- Prime Time Plus vanilla-flavoured cigars [Exhibit RS-5, para 12];
- Prime Time Plus rum-flavoured cigars [Exhibit RS-6, para 13];

- Mac Baren Original Choice pipe tobacco [Exhibit RS-7, para 14];
- Toscano Classico cigars [Exhibit RS-8, para 15];
- Toscano Extra Vecchio cigars [Exhibit RS-8, para 16]; and
- Toscano Toscanello cigars [Exhibit RS-9, para 17].

[22] Mr. Sue explains that the Sales Data for the products discussed in his affidavit are based on sales volume information provided by tobacco wholesalers and tobacco retailers across all provinces in Canada, except Prince Edward Island. He further explains that these particular tobacco wholesalers represent approximately 90% of tobacco wholesalers in Canada, while these particular tobacco retailers represent approximately 20% of tobacco retailers. Accordingly, he asserts that total sales by tobacco retailers to adult consumers of these third party tobacco products in Canada would likely be significantly greater than the numbers reported [paras 18-19]

[23] Mr. Sue then turns to the Opponent's Export 'A' Smooth Taste cigarettes. He explains that these cigarettes are available in both king size and regular format, in packages of 20 or 25 cigarettes and are shipped in all provinces of Canada. He provides the amount of manufactured Export 'A' Smooth Taste cigarettes the Opponent ships to wholesalers by millions of sticks of cigarettes ("shipment data") based on the Opponent's invoiced sales to wholesalers. Mr. Sue further attaches as Exhibit RS-10 to his affidavit a photocopy of the Export 'A' Smooth Taste cigarette product packaging [para 20].

[24] Finally, Mr. Sue attests that the Opponent also manufactures and sells Tueros cigars. He provides the "shipment data" for this product and attaches as Exhibit RS-11 to his affidavit a photocopy of the packaging for same [para 21].

[25] The Applicant has objected to the evidence filed in the Sue affidavit on the basis that it constitutes hearsay evidence. As discussed later in my decision, I agree with the Applicant.

The Grenier affidavit

[26] Mr. Grenier asserts that as part of his role within the Opponent, he is "not only aware of its portfolio of tobacco products, but [that he is] also aware of competitors' tobacco products and how they generally compete or perform in comparison with [the Opponent's] brands". He is also

aware of competitors' programs and offers at retail. He explains that "[a] information is gathered and shared across all three regions [of Canada, i.e. the Quebec and Atlantic provinces, Ontario, and the provinces west of Ontario and the three territories] on a regular basis" and that "[i]nternally, [the Opponent] does not differentiate between Player's Company Inc., Imperial Tobacco Canada, Imperial Tobacco Company or any other affiliated company of British American Tobacco in Canada" and that the Opponent usually refers to these companies as "ITCO" and to Rothmans Benson & Hedges as "RBH" [para 3].

[27] Mr. Grenier provides evidence of the announced launch by ITCO of its PLAYER'S TRUE (in French PLAYER'S AUTHENTIQUE) cigarettes.

[28] More particularly, Mr. Grenier reproduces in his affidavit a copy of an advertisement that was shown to him "during the week of September 4, 2012 to September 11, 2013 [*sic*]" placed by Imperial Tobacco Company in Cstore Life, the official publication of the Canadian convenience stores associations, regarding premium tobacco consumers. Mr. Grenier attests that the advertisement mentions that the Canadian launch of PLAYER'S TRUE cigarettes took place on November 19, 2012 [para 7].

[29] Mr. Grenier asserts that one of the selling features of PLAYER'S TRUE cigarettes is that they are sold in packaging which is 100% recyclable. In support, he reproduces in his affidavit the following documents:

- A copy of Imperial Tobacco Company's marketing materials, in the form of a trade booklet "seen at retail" during the week of November 14, 2012 to November 20, 2012, distributed by its representatives to Canadian retailers regarding PLAYER'S TRUE line of cigarettes in which the following mention appears "100% recyclable packs" [para 8].
- A copy of an information sheet "seen at retail" during the week of January 16, 2013 to January 20, 2013, distributed by Imperial Tobacco Company's representatives to Canadian retailers regarding PLAYER'S AUTHENTIQUE cigarettes in which the following mention appears in French, in response to a query about one of the features of PLAYER'S AUTHENTIQUE cigarette packaging: "un emballage 100% recyclable" [para 9].

- A copy of an ITCO leaflet “left behind at retail” in February 2013 to explain a trade program at retail about PLAYER’S TRUE cigarettes in which the mention “100% recyclable packs and inner bundles” appears [para 10].

[30] Finally, Mr. Grenier attaches as Exhibit SG-2 to his affidavit samples packages of the Applicant’s PLAYER’S TRUE product.

The Aubin affidavit

[31] The Aubin affidavit contains information regarding “what ‘unbleached paperboard’ is, as well as its appearance in terms of the colour(s)”. Ms. Aubin attaches as Exhibits CA-1 to CA-4 to her affidavit various articles and documents identified by conducting a search on Google of the following words or their combination: “unbleached”, “paperboard”, “bleach”, “paper”, “production” and “pulp”. She also attaches as Exhibits CA-5 to CA-6 to her affidavit photocopies of documents from the *Bibliothèque et Archives Nationales du Québec* (BANQ) search engine that she identified by entering the words “pâte à papier”, “blanchiment”, “bleach”, “pulp” or their combination on any given book or publication in the BANQ’s collection [paras 1-7].

[32] Based on her above mentioned research, Ms. Aubin then proceeds to explain the composition of paper and paperboard, as well as the range of colours of unbleached paperboard [paras 8-16].

[33] The Applicant has objected to the Aubin affidavit as inadmissible opinion evidence of a member of the Opponent’s law firm on a contentious issue. As discussed later in my decision, I find that the Aubin Affidavit is admissible in part.

The Applicant’s evidence

The Furfaro affidavit

[34] In the introductory paragraphs of his affidavit, Mr. Furfaro provides some background information about the ownership and licensing of the PLAYER’S TRUE family of cigarettes. He explains that following the amalgamation of ITCan’s subsidiaries Player’s Company Inc.

(Player's Co.) and John Player & Sons Ltd. (John Player) on January 1, 2015, the ownership of the present applications was transferred from Player's Co. to the resulting amalgamated company, also named John Player & Sons Ltd. [para 2].

[35] Mr. Furfaro asserts that until January 1, 2015, John Player was licensed by Player's Co. to use all of Player's Co.'s trade-marks in association with the manufacture and sale of tobacco products. He explains that, pursuant to the licence agreement, Player's Co. had "direct and indirect control of the character and quality of the tobacco products manufactured and sold by John Player under the licence". More particularly, the licence "included terms that compelled John Player" to manufacture and package goods under Player's Co.'s trademarks strictly in accordance with Player's Co.'s specifications and standards, to submit production materials used in the manufacture of the relevant goods to Player's Co. for approval, to submit samples of final products to Player's Co. for approval, and to make its premises available to inspection by Player's Co. at any time. Mr. Furfaro asserts that the license granted to John Player the right to sub-licence its rights to others and that as such, John Player sub-licensed its rights to ITCan under the same terms as the licence between Player's Co. and John Player. He further asserts that since January 1, 2015, John Player & Son Ltd. has continued to license its trade-mark rights to ITCan under the same terms [para 3].

[36] Mr. Furfaro asserts that pursuant to the above mentioned licences, ITCan has manufactured, marketed and sold the PLAYER'S TRUE family of cigarettes in Canada since at least as early as November 5, 2012, via its distributor Imperial Tobacco Company Limited (ITCo), to cigarette retailers which sold the cigarettes to adult smokers [para 4]. Mr. Furfaro collectively refers to Player's Co., John Player, John Player & Sons Ltd., ITCan and ITCo as Player's, and I will do the same while reviewing his affidavit.

[37] Mr. Furfaro asserts that in November 2012, Player's launched the PLAYER'S TRUE family of cigarettes in Canada, along with a marketing campaign. He explains that "the PLAYER'S TRUE family of cigarettes are sold in a package which is brown in colour, having the appearance of unbleached paperboard (the 'BROWN PACKAGE')" [para 5]. As Mr. Furfaro thereafter refers throughout his affidavit to the "BROWN PACKAGE", I will do the same while reviewing his affidavit.

[38] Mr. Furfaro explains that the PLAYER’S TRUE (PLAYER’S AUTHENTIQUE in French) family of cigarettes includes three “variants”, namely, the PLAYER’S TRUE “Canadian Blend” cigarettes, the PLAYER’S TRUE “Special Blend” cigarettes, and the PLAYER’S TRUE “Plain” cigarettes (hereinafter collectively referred to as the PLAYER’S TRUE family of cigarettes unless indicated otherwise) and he attaches as Exhibit A.1 to A.3 to his affidavit photographs of representative examples of each of these variants marketed in the BROWN PACKAGE [para 6].

[39] Mr. Furfaro asserts that “[t]he colour brown having the appearance of unbleached paperboard was selected by Player’s [...] because the colour was considered to be highly distinctive, memorable and eye-catching, and because the colour was not being used for the packaging of cigarettes sold to adult smokers by any other manufacturer, importer, or distributor of cigarettes in Canada” at the time that the PLAYER’S TRUE cigarettes were launched in November 2012” [para 7].

[40] Mr. Furfaro then turns to the sales of the PLAYER’S TRUE family of cigarettes in the BROWN PACKAGE. He asserts that between November 4, 2012 and the dates of filing of the present statements of opposition (i.e. February 25 and April 28, 2014 respectively), Player’s “sold in excess of 1,900,000 packs (with each pack containing 20 cigarettes) of PLAYER’S TRUE cigarettes in the BROWN PACKAGE to cigarette retailers in Canada, representing sales in excess of [\$14,800,000/\$17,900,000 CAD]” [para 8]. The table below sets out the yearly breakdown of the number of packs, and total sales amount of PLAYER’S TRUE cigarettes sold in the BROWN PACKAGE in Canada between November 4, 2012 and June 30, 2015 [para 9].

Year	Packs of Cigarettes (in excess of)	Sales Amount (in excess of)
2012 (Nov. 4 to Dec. 31)	450,000	\$3,350,000
2013	1,275,000	\$10,275,000
2014	875,000	\$7,825,000
2015 (Jan. 1 to June 30)	375,000	\$3,475,000
TOTAL	2,975,000	\$24,925,000

[41] Mr. Furfaro asserts that although the national launch of the PLAYER’S TRUE cigarettes took place on or around November 19, 2012, Player’s began selling the PLAYER’S TRUE cigarettes in the BROWN PACKAGE in Canada to cigarette retailers during the weeks before the national launch and since at least as early as November 5, 2012. He explains that this is a

“very common practice in the industry” and “the best way to properly coordinate, activate and manage such an important national product launch” [para 10]. In support, Mr. Furfaro provides the following exhibits to his affidavit:

- Exhibit B: Copy of a report generated from ITCan’s sales database showing sales of PLAYER’S TRUE cigarettes in the BROWN PACKAGE in Ontario on November 4 and 5, 2012 [para 11].
- Exhibit C: Copies of representative invoices of sales of PLAYER’S TRUE cigarettes in the BROWN PACKAGE to various cigarette retailers in Canada [para 12].

[42] Turning to the permitted promotion of the PLAYER’S TRUE family of cigarettes in Canada, Mr. Furfaro asserts that from November 2012 to mid-2013, Player’s has spent “approximately \$900,000” communicating information regarding the PLAYER’S TRUE family of cigarettes in the BROWN PACKAGE to both cigarette retailers and adult smokers in Canada by “using materials that focus on the colour brown having the appearance of unbleached paperboard”, as is used on the BROWN PACKAGE [paras 13-14]. In support, Mr. Furfaro provides the following exhibits to his affidavit:

- Exhibit D: Images of a presenter box used by Player’s sales representatives to inform retailers about the PLAYER’S TRUE products across Canada. Mr. Furfaro asserts that approximately 75 presenter boxes were distributed [para 14a].
- Exhibit E: Images of representative backroom posters for retailers. Mr. Furfaro asserts that those posters would have shown the PLAYER’S TRUE products in the BROWN PACKAGE and were distributed to “over 20,000 retail locations throughout Canada” [para 14b].
- Exhibit F: Images of a representative brochure distributed to retailers describing the PLAYER’S TRUE cigarettes in the BROWN PACKAGE. Mr. Furfaro asserts that “such brochures were distributed to over 20,000 retail locations throughout Canada” [para 14c].
- Exhibit G: Images of a representative educational flip chart used by Player’s sales representatives to inform retailers about the PLAYER’S TRUE products. Mr. Furfaro asserts that “approximately 450 of such flip charts were distributed by Player’s to sales representatives to show retailers across Canada” [para 14d].

- Exhibit H: Copies of representative photographs of inside of a van used by sales representatives. The inside of the van “displayed the same colour brown having the appearance of unbleached paperboard, to educate retailers regarding the PLAYER’S TRUE family of cigarettes”. Mr. Furfaro asserts that around the time of PLAYER’S TRUE cigarettes’ launch in the BROWN PACKAGE, the van visited “well over 500 retail locations in Calgary, Toronto and Vancouver” [para 15].
- Exhibit I: Photographs of matchboxes distributed by Player’s for retailers “to sell to adult smokers which used the same colour brown having the appearance of unbleached paperboard, as is used on the BROWN PACKAGE”. Mr. Furfaro asserts that “over one million of these matchboxes were delivered to over 20,000 retail stores across Canada” around the national launch of PLAYER’S TRUE cigarettes in the BROWN PACKAGE [para 16].
- Exhibit J: Representative samples of posters displaying the PLAYER’S TRUE products in the BROWN PACKAGE “communicating information regarding PLAYER’S TRUE products to Canadian adult smokers”. Mr. Furfaro asserts that such posters were displayed in over 250 “adult-only establishments” in Canada from November 2012 to mid-2013 [para 17].

The Dinelle affidavit

[43] Mr. Dinelle attaches as Exhibit A to his affidavit a copy of the December 6, 2000 practice notice entitled “Three-dimensional Marks” (*Practice Notice on Three Dimensional Marks*) that he located on the Canadian Intellectual Property Office (CIPO) website. He also attaches as Exhibits B-D to his affidavit printouts of the definitions of “paperboard” and “bleached” from the *Merriam-Webster* online dictionary.

The Owens affidavit

[44] Ms. Owens attaches as Exhibit A to her affidavit details of 12 trade-mark registrations for colour marks for various products owned by third parties which she printed from the CDName Search Corp system on September 2, 2015.

ANALYSIS

Section 30(h) grounds of opposition pleaded in paragraphs 1(k), (l), and (m) of the amended statement of opposition

[45] The Opponent has pleaded that:

k) The drawing submitted in the application for the alleged TRADE-MARK is not an accurate or meaningful representation of the Applicant's TRADE-MARK in the context of the written description because the application identifies the TRADE-MARK applied for as the "colour brown having the appearance of unbleached paperboard" applied to the drawing. The wording "the colour brown having the appearance of unbleached paperboard" is not a colour; it is devoid of meaning [contrary to paragraph 30(h) of the Act]

l) The drawing submitted in the application for the alleged TRADE-MARK is not an accurate or meaningful representation of the Applicant's TRADE-MARK in the context of the written description appearing in the application. Together, the drawing and the written description of the claimed colour "brown having the appearance of unbleached paperboard" (in as much as this is considered to be a colour) is confusing or ambiguous as it does not allow the reader to readily ascertain precisely what colour is being claimed based on the vague, imprecise or indefinite reference to "brown having the appearance of unbleached paperboard" [contrary to paragraph 30(h) of the Act]

m) The drawing submitted in the application for the alleged TRADE-MARK is not an accurate or meaningful representation of the Applicant's TRADE-MARK in the context of the written description appearing in the application. The application is confusing and ambiguous in that the scope of the trade-mark has not been accurately described. In as much as they describe a colour, the words "the colour brown having the appearance of unbleached paperboard" are insufficiently specific to identify a single trade-mark because unbleached paperboard could describe a range of colours [contrary to paragraph 30(h) of the Act]

[46] In response, the Applicant submits that it is well-established that an application for a single colour trade-mark does not need to include a particular hue and that:

The description in the application very specifically describes both the colour (i.e. brown) and the specific finish (i.e. having the appearance of unbleached paperboard) in a manner that is readily understandable to both a layperson and a trader in the tobacco industry. Indeed, we note that while the Opponent claims in certain grounds of opposition that the description "brown having the appearance of unbleached paperboard" is devoid of meaning, in other grounds of opposition the Opponent has claimed that the same trademark is clearly descriptive under section 12(1)(b) of the Act of a product "made from unbleached paperboard".

It is quite common for a trademark applicant to use such a well-known reference item (such as unbleached paperboard in the present case) when seeking to describe a particular finish of a colour. Indeed, some of the third party trademark registrations on which the Opponent is seeking to rely in this opposition use such references to identify a specific finish of a colour, such as TMA591146 which includes the following colour claim:

Colour is claimed as a feature of the trade-mark. The top and bottom borders are in gold. The word AMPHORA is in white and the background is in smokyorange-to-brown colours represented in a marble-like fashion. The crest in the top centre is in gold, with the exception of the centre urn, which is white with a gold highlight accent.

[47] With respect, the Applicant's submissions do not convince me.

[48] I find the description "...the colour brown having the appearance of unbleached paperboard..." is ambiguous in that it does not clearly define what the applied-for Mark consists of for the following reasons.

[49] First, while the Applicant contends that the phrase "...brown having the appearance of unbleached paperboard" serves to describe "the specific finish of the colour brown", the description of the Mark in each of the applications does not expressly refer to the word "finish" *per se*.

[50] Second, contrary to the Applicant's position, it is not clear that the phrase "...having the appearance of unbleached paperboard" would necessarily be understood as being meant to describe a "specific type of finish", as opposed to describing something else, like for instance, a specific shade or hue of the colour brown, as discussed below.

[51] Third, what the Applicant's so-called "unbleached paperboard type of finish" is, or might be, remains unclear. "Unbleached paperboard" is not a "finish" *per se*. In fact, it is impossible to ascribe one single specific type of finish to "unbleached paperboard" as unbleached paperboard could come in an array of different types, grades and finishes, as shown by the various search results attached as Exhibits CA-1 to CA-6 to the Aubin affidavit [see, among others, Exhibits CA-2 and CA-3].

[52] In this regard, addressing the Applicant's objection to the admissibility of the Aubin affidavit, and except for those portions of Ms. Aubin's affidavit wherein she provides personal opinion as to what the colour of unbleached paperboard is or might be, which I have

disregarded, I have no reason to believe that the various excerpts from and/or printouts of reference books, handbooks, glossaries, and other scientific reference materials and trade publications relating to the production, composition, and characteristics of paperboard, and more particularly, unbleached paperboard, attached to Ms. Aubin's affidavit are not objective and reliable [see by analogy *Roots Corporation v YM Inc. (Sales)*, 2019 FC 16, at paras 14 and 23] . The search criteria used by Ms. Aubin are clear and transparent. It was open to the Applicant to cross-examine Ms. Aubin on her affidavit and/or to file evidence directed to the same subject. In this regard, I would observe that the dictionary definitions of the words "paperboard" and "bleached" attached to the Dinelle affidavit are of no assistance in determining what "the appearance of unbleached paperboard" is or might be.

[53] Reverting to the Applicant's so-called "unbleached paperboard type of finish", I note that Mr. Furfaro explained on cross-examination that what would be meant by the phrase "brown having the appearance of unbleached paperboard" is "that brown craft paper look" that "has a rough type of finish to it", as per the excerpt below of the transcript of his cross-examination. However, this is not what the description of the Mark indicates. Furthermore, Mr. Furfaro confirmed during his cross-examination that unbleached paperboard does not always look the same.

Ms. STYLIANI (STELLA) SYRIANOS:

Q. [41] Okay, I just noted it was the same, okay.
So let's go to paragraph 7 of your affidavit.
So in paragraph 7 you refer to:

"The colour brown having the appearance of unbleached paperboard."

So what is unbleached paperboard?

A. Unbleached paperboard is a combination of the colour and the finish that we're actually using on PLAYER'S TRUE, it is that brown craft-type look.

Q. [42] Okay, and by "brown craft-type look," we're referring to craft paper?

A. I'm referring, yes, to craft paper.

Q. [43] Okay, so what does unbleached paperboard

look like?

A. It's brown, it has a rough type of finish to it, and, again, it's that, it's that kind of light unbleached brown.

Q. [44] So does that mean that unbleached paperboard always looks the same?

A. No.

Q. [45] So if it doesn't look the same, what, how would it vary?

A. We were able to choose a specific colour of the unbleached paperboard that we wanted to use. Again, we'd be able to choose unbleached paperboard that was lighter or darker in colour and texture.

[54] Fourth, if the phrase "...brown having the appearance of unbleached paperboard" is interpreted as being meant to describe a specific shade or hue of the colour brown, what that specific shade or hue is remains unclear as "unbleached paperboard" is not a colour *per se* and could in fact take different colours (varying not only from very light brown to dark brown, but also grey or tan or yellowish colour) depending on the nature of the raw materials used in the manufacturing process and the method used for extracting fibers from their sources in the manufacturing process (i.e. the pulping method), as shown, again, by the various search results attached as Exhibits CA-1 to CA-6 to the Aubin affidavit [see, among others, Exhibits CA-1, CA-2, and CA-6].

[55] In this regard, it is not because there is no requirement in the Act or the *Trade-marks Regulations*, SOR 96/195 (the Regulations) that an applicant specifically reference the shade or hue of the colour claimed [*Novopharm Ltd v Pfizer Products Inc*, 2009 CarswellNat 4119 (TMOB) at para 23; *226 Decision, supra*, at para 46], that an applicant cannot elect to claim a specific shade or hue, like for instance referencing PANTONE, a standard language for colour identification. Likewise, it is not because there is no requirement in the Act or the Regulations that the Applicant specifically reference the shade or hue of the colour brown, that this necessarily renders the phrase "...brown having the appearance of unbleached paperboard" unambiguous and acceptable in the present cases.

[56] Indeed, the Applicant could have elected to claim simply “the colour brown applied to the visible surface of the particular packaging as shown in the attached drawing...” like it did for instance in its other trade-mark applications filed for the colours “orange” and “purple”, as evidenced by Exhibit MG-2 attached to the Goudreau affidavit. However, the Applicant has elected to describe further the colour brown by adding the unclear and ambiguous phrase “...having the appearance of unbleached paperboard...”

[57] As a result, for all the reasons given above, I find the description of the Mark does not clearly define what the trade-mark consists of. Indeed, I find the Applicant has not provided sufficient information to define the trade-mark claimed and used [see *Novopharm Ltd v Burroughs Wellcome Inc* (1994), 58 CPR (3d) 513 (FCTD); affg 52 CPR (3d) 263 at 268 (TMOB)]. As explained in *Novopharm Ltd v Astra Aktiebolag* (2000), 6 CPR (4th) 16 (FCTD), the written description must enable the determination of the limits of the trade-mark registration and the monopoly must be precise in terms of its scope. I do not find this to be the case here.

[58] Accordingly, the grounds of opposition pleaded in paragraph 1(k), (l) and (m) of the amended statement of opposition succeeds in both cases.

Section 2 ground of opposition pleaded in paragraph 3(f) of the amended statement of opposition

[59] The Opponent has pleaded that the Mark is not distinctive within the meaning of section 2 of the Act because it does not, and is not capable of distinguishing the Applicant’s Goods from the tobacco products of other traders whose tobacco products are sold in packages whose colour is similar to the alleged Mark.

[60] The material date for considering the circumstances respecting this ground of opposition is as of the filing date of the respective statements of opposition (i.e. February 25, 2014 with respect of the '729 Application, and April 28, 2014 with respect of the '733 Application) [*Andres Wines Ltd v E & J Gallo Winery* (1975), 25 CPR (2d) 126 (FCA) at 130; and *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA) at 424]. The Opponent has the initial evidential burden to prove the allegations of fact in support of its ground of non-distinctiveness. Once that burden is met, the legal burden or onus is on the Applicant to

show that the Mark is adapted to distinguish or actually distinguishes its Goods from those of others throughout Canada [*Muffin Houses Inc v Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[61] To meet its evidential burden in respect of this ground, the Opponent must show that there has been third party use of similar coloured packages to such an extent this would negate the distinctiveness of the Mark [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58].

[62] As outlined in the overview of the evidence above, the Opponent has submitted, through the Sue affidavit, evidence regarding various third party tobacco products sold in Canada. To be more specific, the Sue affidavit reports 12 such products, 10 of which, in my view, arguably display various shades of the colour brown on their packaging (three are flavoured cigars and the other seven tobacco goods, including two of the Opponent's own brands of cigars and cigarettes, are flavourless). The packaging of the two remaining products is not *per se* the colour brown.

[63] As indicated above, the Applicant has objected to the Sue affidavit on the basis that it comprises hearsay. While the Applicant has not objected to the Sales Data *per se*, the Applicant points out that Mr. Sue admitted on cross-examination that he did not know by whom, where or when the products shown in each of Exhibits RS-1 to RS-11 were purchased, that he had never seen the products advertised in Canada or displayed at the retail level in Canada, and that he does not know how the products would have been displayed at the retail level as of the material dates.

[64] While I might have been prepared to accept that the Sales Data provided by Mr. Sue satisfies the criteria of necessity and reliability, I find this is not the case for the photocopies of the specimens of packaging attached under Exhibits RS-1 to RS-11 to his affidavit. In this regard, I acknowledge that Mr. Sue confirmed in re-examination that it is not part of his job description to receive or review or analyze any of the Opponent's competitors' packaging and products and advertising. However, Mr. Sue also confirmed in his cross-examination that the Database he consulted in the preparation of his affidavit does not include images of the products described therein. I cannot but agree with the Applicant that the fact that Mr. Sue does not know how the products described in his affidavit would have been displayed at the retail level as of the

relevant dates raises questions about the reliability of his testimony. I therefore consider this evidence to be inadmissible hearsay evidence.

[65] In view of the above, I am not satisfied that the Opponent has met its evidential burden under section 38(2)(d) of the Act. The ground of opposition set out in paragraph 3(f) of the statement of opposition is accordingly dismissed in both cases.

[66] I would like to add though that had the Opponent requested and obtained leave to file additional evidence to remedy this issue, I would have found the non-distinctiveness ground of opposition successful for the following reasons.

a. Use of brown packaging in association with cigarettes

[67] The Opponent evidences sale in Canada of its own cigarette product – Export ‘A’ Smooth Taste cigarettes – which arguably displays a shade of the colour brown on its packaging. More specifically, at paragraph 20 of his affidavit, Mr. Sue explains that the Export ‘A’ Smooth Taste cigarette product is manufactured and sold by the Opponent to wholesalers throughout Canada and goes on to provide corresponding sales data and sample packaging [Exhibit RS-10].

[68] As mentioned above in the review of the record, Mr. Sue’s affidavits filed by Opponent in the '729 Application and the '733 Application were sworn on different dates. Due to the availability of the sales data used by Mr. Sue at the time of swearing his affidavits, I note that these documents report slightly different numbers. I note for instance that his affidavit in the '729 Application includes sales volumes for the first eight weeks of 2014 for most of the products discussed therein, whereas his affidavit in the '733 Application includes sales volumes for the first 35 weeks of 2014. In addition, specifically for the Export ‘A’ Smooth Taste cigarette product [Exhibit RS-10], Mr. Sue provides sales volumes in cigarette sticks without transposing them in package equivalent and explains that the data in question accounts for both king size and regular format packages of both 20 and 25 cigarettes. In my further review of this data, I note a lack of a more precise weekly breakdown for the sales in 2014 and that of a breakdown of stick volume for each of the sizes of cigarette packaging sold. To err on the side of caution, I have therefore only considered cigarette stick sales between 2010 and 2013, and have divided them

by 25 in transposing them into a more conservative package equivalent, as if only to account for the sale of 25-stick packages.

[69] That said, I nonetheless note that well over 86 million packages of Export ‘A’ Smooth Taste cigarettes were sold prior to the relevant dates.

[70] For its part, the Applicant contends that Export ‘A’ Smooth Taste cigarettes “have gold coloured packaging rather than brown”. With respect, I disagree with the Applicant’s position.

[71] In the absence of further representations on this point, I take note that the *Canadian Oxford Dictionaries* define the terms “brown” and “gold” as:

brown

“having the colour produced by mixing red, yellow, and black, as of dark wood or rich soil”;

“a brown colour or pigment”.

gold

“a yellow precious metal, the chemical element of atomic number 79, used especially in jewellery and decoration and to guarantee the value of currencies”;

“the colour of gold”;

“coloured like gold”; or as

“something precious, beautiful, or brilliant”.

[72] Although I can conceive that both gold and brown are colours that can come in an array of different shades and hues that may or may not eventually bear some similarities (the colour yellow being one of the components required to produce the colour brown), I do not see the above cigarette packaging as displaying mainly yellow, metallic or glittering tones characteristic of the colour gold and I am not convinced that consumers would perceive it as such either. Although some of the writing appearing on the packaging shown in Exhibit RS-10 is difficult to read, I note that there is nothing suggesting that it is another colour other than brown. In this regard, contrary to the Applicant’s contention, I find that the fact that its affiant Mr. Furfaro may have referred to the Export ‘A’ Smooth Taste cigarette product as “Export ‘A’ Gold” on cross-examination in the discussion relating to other brown cigarette packaging, is not in itself

sufficient to support the conclusion that said product is known as such in the marketplace. In any event, even if that were the case, it is conceivable that the reference to “gold” in such eventual product designation could also be perceived as laudatory in nature (for instance, one suggesting the grade/quality of the Export ‘A’ cigarettes). Either way, I am not persuaded that it would inevitably result in consumers perceiving the colour displayed on such packaging as being gold instead of brown. Mr. Furfaro himself, when asked on cross-examination if the colour brown was being used by any other tobacco trader at the time of the launch of the Mark, admitted that he was aware of the existence of the Opponent’s cigarette product above sold in “a more caramel dark lush brown type colour” packaging [Transcript of the cross-examination of Paul Furfaro, p 54-55, Q. 108-112].

[73] Moreover, having concluded that the Applicant’s colour description is ambiguous and does not clearly define what the Mark consists of, it is difficult to give any weight to the Applicant’s argument that “none of the product packages included in the Sue affidavit have the colour brown having the appearance of unbleached paperboard”, being uncertain of whatever said colour is or might be. In this regard, the Opponent submits that if, in examining the non-conformity grounds above, it is found that it is not mandatory for the Applicant to specifically reference the shade or hue of the colour claimed in its application for the Mark, then it ensues that all shades and hues of the colour in question, forming part of the Applicant’s colour claim, should be considered as relevant when examining third party use under the present ground. Subject to my following comments regarding flavours and in the context of assessing whether consumers would be accustomed to seeing tobacco products sold in brown coloured packages in the tobacco marketplace, I cannot but agree.

[74] To sum up, the quantity of Export ‘A’ Smooth Taste product evidenced by the Opponent appears important enough to substantiate the finding that consumers were accustomed to seeing cigarettes sold in brown coloured packages in the tobacco marketplace as of the relevant dates. I will return to this point later.

b. Use of brown packaging in association with other tobacco products

[75] The Opponent also introduces evidence relating to its own and other third party tobacco products other than cigarettes sold in various brown shaded packages, being mainly: cigars,

cigarillos and tobacco. As set out in the *ORANGE Decisions, supra*, cigarettes, cigars and tobacco are all related goods, all part of the tobacco industry and even if I were to assume that they would target a different demographic, customer or market segment within said industry, it does not change the fact that they are normally sold side by side through the same channels of trade. I thus consider the evidence of the non-cigarette products to be relevant to this ground.

[76] Considering first the Opponent's own such product, at paragraph 21 of his affidavit, Mr. Sue states that the Opponent manufactures and sells Tueros cigars [Exhibit RS-11] to wholesalers in Canada, which I note are displayed in brown-coloured packaging. Upon review of the relating sales data provided by Mr. Sue, I also note that approximately 6,667 packages of this product were sold between 2010 and 2013. While this number may appear minimal on its own, it should be kept in mind and considered with the other third party tobacco products discussed below.

[77] Turning to these third party tobacco products other than cigarettes, three of them bear flavour indications on their packaging, namely: vanilla and rum. In that regard, I do not consider it appropriate to envisage the mention "wild 'n natural" appearing on one of the cigar packages as a flavour in the same sense as the ones above as submitted by the Applicant, as I rather view the mention as one suggestive of the product's blend/taste profile (comparable to indications such as "smooth taste").

[78] In relying on the *ORANGE Decisions, supra*, the Applicant submits that all flavoured products are "irrelevant to the issue of distinctiveness [...] because consumers would understand the colour on the package as referring to the flavor rather than being used in a trademark sense" [my underlining]. In support of this contention, the Applicant more specifically refers to the *FC 608 Decision* at paragraph 58, reproduced below:

Second, much of JTI's evidence relates to products displaying the word "peach" on the packaging. In my view, it was open to the Board to conclude that these products will be associated with the colour peach, rather than the colour orange. This is a matter of weighing the evidence relating to an issue that lies at the heart of the Board's expertise. JTI does not address the irrelevance of the peach products. Therefore, deference is warranted with respect to this finding of fact. [My underlining.]

[79] I note that this excerpt from the *FC 608 Decision* reverts to the comments of Board Member Folz in the *116 Decision* at paragraph 48 and in the *117 Decision* at paragraph 42:

Of the five third party tobacco products for which Mr. Sue provided sales data for prior to the material date, three of them refer to the word “peach” on their packaging. This suggests to me that this is the flavour associated with the ware. In my view, it follows that consumers would view the colour being used on the packaging as the colour peach as opposed to the colour orange.

[80] With respect, I fail to understand how the citation of paragraph 58 of the *FC 608 Decision* supports the Applicant’s position that all flavoured tobacco products are irrelevant to the issue of distinctiveness because consumers would understand the colour on the packaging to refer to the flavour as opposed to as a trade-mark.

[81] First, I note that it is well established that third party use under the present ground does not necessarily have to qualify as use as a trade-mark within the scope of section 4 of the Act [*3M Co v Tape Specialities Ltd* (2008), 70 CPR (4th) 138 (TMOB); and *117 Decision, supra*, at para 38].

[82] Second, I do not read the *ORANGE Decisions, supra*, as necessarily discounting all flavoured tobacco products from the analysis under the present ground of opposition. Rather, it is only when a flavour description indicated on a product would arguably influence the public’s perception and designation of the colour appearing on a given product (e.g. the colour “peach” rather than orange), that such flavoured product may or not be discounted.

[83] In the present cases, while the *Canadian Oxford Dictionaries’* definitions of the term “vanilla” indicate that it can also serve as a colour designation, I cannot help but notice a difference regarding the term “rum”. Unlike the colour “peach” (defined as “a pinkish-yellow colour like that of a peach” and as “the orange-pink colour of a peach”) or the colour “vanilla” (defined as “of the creamy colour of vanilla ice cream”), the term “rum” is not a colour *per se*. Thus, while I can conceive that consumers would associate the flavour of rum to cigars purchased in a brown pack sporting the mention “rum”, I find it too far a stretch to conclude that consumers would also view such product packaging as being the colour “rum” or “wild rum” (there being no such thing) instead of the colour brown. Put another way, whether consumers would associate the flavour of rum with the corresponding tobacco product put into evidence

does not change the fact that the packaging for some displays shades of the colour brown, and is as such pertinent in the context of assessing whether consumers would be accustomed to seeing tobacco products sold in brown coloured packages in the tobacco marketplace.

[84] As a result, I discount only the remaining “vanilla” third party flavoured tobacco products, more specifically the vanilla-flavoured Honey T cigars [Exhibit RS-4] and the vanilla-flavoured Prime Time Plus cigars [Exhibit RS-5], as the packaging of which may be associated by consumers as the colour vanilla as opposed to the colour brown.

[85] The Applicant also contests the relevance of some of the third party tobacco products, namely: the Captain Black cigars [Exhibit RS-1], the rum-flavoured Prime Time Plus cigars [Exhibit RS-6] and the Mac Baren Original Choice pipe tobacco [Exhibit RS-7], contending that their packaging is “gold in colour rather than brown”. For reasons similar to those outlined above in the discussion on the same subject in the context of cigarette packaging, I tend to disagree.

[86] In my view, the Captain Black cigars’ package displays a vintage-looking world map reminiscent of a faded and/or stained paper-like colour that could arguably be viewed as a light shade of brown (or a pale yellowish brown). It does also contain the mention “GOLD • OR”, which however seems to bear a laudatory connotation, that is one suggesting the grade/quality of the product contained therein rather than the colour of the packaging that contains it. In other words, I believe that consumers may be more likely to perceive the presence of the terms “GOLD • OR” on this packaging as an indication that it contains cigars of a superior quality, rather than as an indication that the packaging is gold in colour instead of light brown. Upon review of Exhibits RS-6 and RS-7, I am also satisfied that their packaging displays different shades of the colour brown and would be perceived as such by consumers. More specifically, the rum-flavoured Prime Time Plus cigars’ package shows two shades of the colour brown (one lighter and one substantially darker), whereas the Mac Baren Original Choice pipe tobacco package appears to be made of corrugated cardboard of a light brown colour.

[87] Based on the foregoing, the sales data for the third party tobacco products I have retained in my analysis indicates that over 1,1 million packages were sold by retailers to consumers in Canada between 2010 and 2013. Here as well, out of caution, I have excluded the 2014 sales reported by Mr. Sue due to the lack of a more precise weekly breakdown that would have

allowed to accurately limit the relevant cut-off dates. In a more conservative fashion, where it was possible, I have also only considered the data reporting sales by retailers to consumers, rather than that reporting the larger amounts of sales by wholesalers to retailers. To be more precise, these include: 987,286 packages of Captain Black cigars [Exhibit RS-1]; 320 packages of Backwoods Wild 'n Natural cigars [Exhibit RS-3]; 141,711 packages of rum-flavoured Prime Time Plus cigars [Exhibit RS-6]; 558 packages of Mac Baren Original Choice pipe tobacco [Exhibit RS-7]; 517 packages of Toscano Extra Vecchio cigars [Exhibit RS-8]; and 729 packages of Toscano Toscanello cigars [Exhibit RS-9].

[88] As mentioned above, the remainder of the Opponent's evidence relates to two tobacco products in packaging that is not *per se* the colour brown.

[89] That said, had I accepted the Opponent's evidence, I would have found that it has adduced more than enough evidence establishing that brown coloured packages were common to the tobacco industry as of the material dates and would have therefore met its evidential burden.

[90] Although the case law is not clear as to the extent of sales that the Opponent must evidence in that sense, I believe that the above-described sales in excess of 86 million packages of cigarettes, as well as over 1,1 million packages of related tobacco products, all arguably displaying the colour brown on their packaging, are in no way minimal, but sufficient, to say the least, particularly when compared to the 1,9 million packages of the Applicant's cigarettes sold as of the relevant dates. As I do not believe the rest of the Applicant's evidence (including its advertising expenses and its reported distribution of promotional material) to be sufficient to meet the Applicant's legal onus of showing that the applied-for Mark was distinctive of source as of the material dates, I would have found the distinctiveness ground of opposition pleaded at paragraph 3(f) of the Opponent's amended statement of opposition successful in both cases.

Remaining grounds of opposition

[91] Having already determined that the Opponent was successful on three grounds of opposition relating to section 30(h) of the Act, I do not find it necessary to discuss the remaining grounds of opposition.

DISPOSITION

[92] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse each application pursuant to section 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Excerpts from the amended statement of opposition filed in respect of the '729 Application

“ [...]

CONFORMITY ISSUES

1. The Opponent bases its opposition on paragraph 38(2)(a) of the Act, namely that the opposed application does not comply with the requirements of section 30 of the Act, notably:

(a) The Applicant never used the alleged TRADE-MARK, as alleged in the opposed application, in association with the wares referred to in said application, since the alleged date of first use [contrary to paragraph 30(b) of the Act];

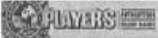

(b) Alternatively or cumulatively, the use (which is denied) of the alleged TRADE-MARK in association with the wares referred to in the opposed application, has not been continuous [contrary to paragraph 30(b) of the Act];


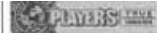
(c) The Applicant failed, as the case may be, to name all its predecessors in title [contrary to paragraph 30(b) of the Act];

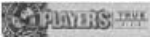
(d) The trade-mark allegedly used, is not the TRADE-MARK covered by the opposed application but another, different from the one depicted in the opposed application because it is never used in isolation but rather with other markings and indicia of source. The alleged TRADE-MARK does not stand out from the additional word/design elements or embellishments appearing on the packaging, such as the trade-mark PLAYER'S and/or the depiction of a sailor, in such a way that it remains recognizable [contrary to paragraph 30(b) of the Act];


(e) The TRADE-MARK allegedly used is not a trade-mark within the meaning of s.2 of the Act because the alleged colour described as ‘brown having the appearance of unbleached paperboard’ is not a colour; it is devoid of meaning [contrary to paragraph 30(b) of the Act];

(f) The Applicant is not using the TRADE-MARK covered by the opposed application, that is, the alleged colour as a trade-mark but rather the alleged colour claimed as a feature of its various PLAYER'S trade-marks (simply as the background colour featured on a small portion of commonly shaped cigarette packaging with other markings and indicia of source) as illustrated in the following design trade-marks on the Canadian trade-marks register filed in the name of the Applicant, on the basis of an allegation of use since at least as early as November 5, 2012 (the identical filing basis for the opposed TRADE- MARK application):

Trade-mark	Filing basis	Colour Claim
<p>AUTHENTIQUE PLAYER'S MÉLANGE CANADIEN & DESIGN</p>  <p>TMO 1,606,267 Filed on : December 11, 2012</p>	<p>Used in Canada since at least as early as November 5, 2012</p>	<p>Colour is claimed as a feature of the trade-mark. The background consists of the colour brown having the appearance of unbleached paperboard. To the left appears a blue life ring. The words "DEPUIS 1877" and the John Player signature within the life ring appear in brown having the appearance of unbleached paperboard. The banner at the bottom of the life ring is blue and outlined in brown having the appearance of unbleached paperboard. The sailor within the life ring has a face and neck appearing in brown having the appearance of unbleached paperboard, a blue hat with the word "HERO" appearing in brown having the appearance of unbleached paperboard, a blue tunic, as well as a blue beard, eyes and eyebrows. The rope design surrounding the inside and the outside of the life ring are blue with an outline in brown having the appearance of unbleached paperboard. The embellishment surrounding the outside of the life ring is blue. At the centre of the life ring are two blue boats and blue water scene within the brown background colour having the appearance of unbleached paperboard. The word "PLAYER'S" appears in brown having the appearance of unbleached paperboard with a blue outline and shading and a darker brown chevron shaped apostrophe. The one vertical and three horizontal lines on the right appear in darker brown. The word "AUTHENTIQUE" appears in blue. The words "MÉLANGE CANADIEN" appear in darker brown</p>
<p>AUTHENTIQUE, PLAYER'S MÉLANGE SPÉCIAL & DESIGN</p>  <p>TMO 1,606,263</p>	<p>Used in Canada since at least as early as November 5, 2012</p>	<p>Colour is claimed as a feature of the trade-mark. The background consists of the colour brown having the appearance of unbleached paperboard. To the left appears a darker brown life ring. The words "DEPUIS 1877" and the John Player signature within the life ring appear in brown having the appearance of unbleached paperboard. The banner at the bottom of the life ring is darker brown and outlined in brown having the appearance of unbleached paperboard. The</p>

<p>Filed on: December 11, 2012</p>		<p>sailor within the life ring has a face and neck appearing in brown having the appearance of unbleached paperboard, a darker brown hat with the word "HERO" appearing in brown having the appearance of unbleached paperboard, a darker brown tunic, as well as a darker brown beard, eyes and eyebrows. The rope design surrounding the inside and the outside of the life ring are darker brown with an outline in brown having the appearance of unbleached paperboard. The embellishment surrounding the outside of the life ring is darker brown. At the centre of the life ring are two darker brown boats and darker brown water scene within the brown background colour having the appearance of unbleached paperboard. The word "PLAYER'S" appears in brown having the appearance of unbleached paperboard with a darker brown outline and shading and a dark brown chevron shaped apostrophe. The one vertical and three horizontal lines on the right appear in dark brown. The word "AUTHENTIQUE" appears in darker brown. The words "MÉLANGE SPÉCIAL" appear in dark brown.</p>
<p>AUTHENTIQUE, PLAYER'S SANS FILTRE & DESIGN</p>  <p>TMO 1,606,271 Filed on: December 11, 2012</p>	<p>Used in Canada since at least as early as November 5, 2012</p>	<p>Colour is claimed as a feature of the trade-mark. The background consists of the colour brown having the appearance of unbleached paperboard. To the left appears a grey life ring. The words "DEPUIS 1877" and the John Player signature within the life ring appear in brown having the appearance of unbleached paperboard. The banner at the bottom of the life ring is grey and outlined in brown having the appearance of unbleached paperboard. The sailor within the life ring has a face and neck appearing in brown having the appearance of unbleached paperboard, a grey hat with the word "HERO" appearing in brown having the appearance of unbleached paperboard, a grey tunic, as well as a grey beard, eyes and eyebrows. The rope design surrounding the inside and the outside of the life ring are grey with an outline in brown having the appearance of unbleached paperboard. The embellishment surrounding the outside of the life ring is grey. At the centre of the life ring are two grey boats and grey water scene within the brown background colour having the appearance of unbleached paperboard. The word "PLAYER'S" appears in brown having the appearance of unbleached paperboard with a grey outline and shading and a darker brown chevron shaped apostrophe. The one vertical and three horizontal lines on the right appear in darker brown. The word "AUTHENTIQUE" appears in grey. The words "SANS FILTRE" appears in darker brown.</p>
<p>TRUE, PLAYER'S CANADIAN BLEND & DESIGN</p> 	<p>Used in Canada since at least as early as November 5, 2012</p>	<p>Colour is claimed as a feature of the trade-mark. The background consists of the colour brown having the appearance of unbleached paperboard. To the left appears a blue life ring. The words "SINGE 1877" and the John Player signature within the life ring</p>

<p>TMO 1,606,265 Filed on: December 11, 2012</p>		<p>appear in brown having the appearance of unbleached paperboard. The banner at the bottom of the life ring is blue and outlined in brown having the appearance of unbleached paperboard. The sailor within the life ring has a face and neck appearing in brown having the appearance of unbleached paperboard, a blue hat with the word "HERO" appearing in brown having the appearance of unbleached paperboard, a blue tunic, as well as a blue beard, eyes and eyebrows. The rope design surrounding the inside and the outside of the life ring are blue with an outline in brown having the appearance of unbleached paperboard. The embellishment surrounding the outside of the life ring is blue. At the centre of the life ring are two blue boats and blue water scene within the brown background colour having the appearance of unbleached paperboard. The word "PLAYER'S" appears in brown having the appearance of unbleached paperboard with a blue outline and shading and a darker brown chevron shaped apostrophe. The one vertical and three horizontal lines on the right appear in darker brown. The word "TRUE" appears in blue. The words "CANADIAN BLEND" appear in darker brown.</p>
<p>TRUE, PLAYER'S PLAIN & DESIGN </p> <p>TMO 1,606,269 Filed on: December 11, 2012</p>	<p>Used in Canada since at least as early as November 5, 2012</p>	<p>Colour is claimed as a feature of the trade-mark. The background consists of the colour brown having the appearance of unbleached paperboard. To the left appears a grey life ring. The words "SINGE 1877" and the John Player signature within the life ring appear in brown having the appearance of unbleached paperboard. The banner at the bottom of the life ring is grey and outlined in brown having the appearance of unbleached paperboard. The sailor within the life ring has a face and neck appearing in brown having the appearance of unbleached paperboard, a grey hat with the word "HERO" appearing in brown having the appearance of unbleached paperboard, a grey tunic, as well as a grey beard, eyes and eyebrows. The rope design surrounding the inside and the outside of the life ring are grey with an outline in brown having the appearance of unbleached paperboard. The embellishment surrounding the outside of the life ring is grey. At the centre of the life ring are two grey boats and grey water scene within the brown background colour having the appearance of unbleached paperboard. The word "PLAYER'S" appears in brown having the appearance of unbleached paperboard with a grey outline and shading and a darker brown chevron shaped apostrophe. The one vertical and three horizontal lines on the right appear in darker brown. The word "TRUE" appears in grey. The word "PLAIN" appears in darker brown.</p>
<p>TRUE, PLAYER'S SPECIAL BLEND &</p>	<p>Used in Canada since at least as early as</p>	<p>Colour is claimed as a feature of the trade-mark. The background consists of the colour brown having the appearance of unbleached paperboard. To the left</p>

<p>DESIGN</p>  <p>TMO 1,606,254 Filed on: December 11, 2012</p>	<p>November 5, 2012</p>	<p>appears a darker brown life ring. The words "SINCE 1877" and the John Player signature within the life ring appear in brown having the appearance of unbleached paperboard. The banner at the bottom of the life ring is darker brown and outlined in brown having the appearance of unbleached paperboard. The words "PRIDE IN TASTE" within the banner appear in brown having the appearance of unbleached paperboard. The sailor within the life ring has a face and neck appearing in brown having the appearance of unbleached paperboard, a darker brown hat with the word "HERO" appearing in brown having the appearance of unbleached paperboard, a darker brown tunic, as well as a darker brown beard, eyes and eyebrows. The rope design surrounding the inside and the outside of the life ring are darker brown with an outline in brown having the appearance of unbleached paperboard. The embellishment surrounding the outside of the life ring is darker brown. At the centre of the life ring are two darker brown boats and darker brown water scene within the brown background colour having the appearance of unbleached paperboard. The word "PLAYER'S" appears in brown having the appearance of unbleached paperboard with a darker brown outline and shading and a dark brown chevron shaped apostrophe. The one vertical and three horizontal lines on the right appear in dark brown. The word "TRUE" appears in darker brown. The words "SPECIAL BLEND" appear in dark brown.</p>
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(g) In the alternative, if the alleged use of the TRADE-MARK is found not to be different from the one referred to in the opposed application, the TRADE-MARK is not used within the meaning of s. 4 of the Act as there is no notice of association of the alleged TRADE-MARK with the subject wares given to the person to whom the property or possession is transferred. The alleged TRADE-MARK is simply the background colour featured on a small portion of the packaging, the packaging being a commonly shaped cigarette package on which other markings and indicia of source appear. The alleged TRADE-MARK is not indicative of source [contrary to paragraph 30(b) of the Act];

(h) In as much as it is considered to be a colour, the trade-mark allegedly used is not the TRADE-MARK covered by the opposed application but another, different from the one referred to in the opposed application because the TRADE-MARK falls within the definition of a

distinguishing guise under section 2 of the Act. [contrary to paragraphs 30(b) and 30(h) of the Act];

(i) In as much as it is considered to be a colour, the TRADE-MARK allegedly used is not a trade-mark within the meaning of s.2 of the Act because the TRADE-MARK is solely functional and/or ornamental or decorative, rather than an indicator of source [contrary to paragraph 30(b) of the Act];

(j) The application for the alleged TRADE-MARK does not contain an accurate drawing and representation of the alleged TRADE-MARK in so far as the subject matter for which registration is sought is a distinguishing guise (as defined by section 2 of the Act) as THE TRADE-MARK claimed and described is a mode of packaging wares [contrary to paragraph 30(h) of the Act];

(k) The drawing submitted in the application for the alleged TRADE-MARK is not an accurate or meaningful representation of the Applicant's TRADE-MARK in the context of the written description because the application identifies the TRADE-MARK applied for as the "colour brown having the appearance of unbleached paperboard" applied to the drawing. The wording "the colour brown having the appearance of unbleached paperboard" is not a colour; it is devoid of meaning [contrary to paragraph 30(h) of the Act];

(1) The drawing submitted in the application for the alleged TRADE-MARK is not an accurate or meaningful representation of the Applicant's TRADE-MARK in the context of the written description appearing in the application. Together, the drawing and the written description of the claimed colour 'brown having the appearance of unbleached paperboard' (in as much as this is considered to be a colour) is confusing or ambiguous as it does not allow the reader to readily ascertain precisely what colour is being claimed based on the vague, imprecise or indefinite reference to 'brown having the appearance of unbleached paperboard' [contrary to paragraph 30(h) of the Act];

(m) The drawing submitted in the application for the alleged TRADE-MARK is not an accurate or meaningful representation of the Applicant's TRADE-MARK in the context of the written description appearing in the application. The application is confusing and ambiguous in that the scope of the trade-mark has not been accurately described. In as much as they describe a colour, the words 'the colour brown having the appearance of unbleached paperboard' are insufficiently specific to identify a single trade-mark because unbleached paperboard could describe a range of colours [contrary to paragraph 30(h) of the Act];

(n) The drawing submitted in the application for the alleged TRADE-MARK does not accurately represent the alleged trade-mark, as there is no definition to the size or dimensions of the 'package', with the result that the application is simply an application to register an alleged colour alone without association to a defined shape or size of package [contrary to paragraph 30(h) of the Act];

(o) The statement that the applicant is satisfied as to its entitlement to the use of the alleged TRADE-MARK in Canada is false in view of the content of the present opposition, including the knowledge of the applicant that the alleged TRADE-MARK is not a trade-mark for the reasons outlined above. In addition, the Applicant and its related company Imperial Tobacco Products Limited have adopted a modus operandi of filing trade-mark applications solely for colours, as claimed in application numbers TMO 1317127 and 1317128 (ORANGE PACKAGE DESIGN); TMO 1580255 and 1580250 (PURPLE PACKAGE DESIGN); TMO 1605733 (BROWN PACKAGE DESIGN) and the opposed application under TMO 1605729, in an attempt to obtain an exclusivity on their use, despite being aware that any such grant is contrary to the proper scope of trade-mark legislation and policy as leading to an exhaustion of the colour availability to others [contrary to paragraph 30(i) of the Act];

(p) The statement that the applicant is satisfied as to its entitlement to the use of the alleged TRADE-MARK in Canada is false in so far as it is untenable for the Applicant to take the position that it is using the alleged TRADE-MARK as a trade-mark in view of its alleged use of the alleged colour as a feature of its various PLAYER'S trade-marks identified in paragraph 1(f) above (the alleged TRADE-MARK is simply the background colour featured on a small portion

of a cigarette package on which other markings and indicia appear [contrary to paragraph 30(i) of the Act];

(q) The statement that the applicant is satisfied as to its entitlement to the use of the alleged TRADE-MARK in Canada is false in view of the knowledge of the applicant that any grant of exclusivity in the TRADE-MARK may prevent the Opponent and other tobacco traders from producing, marketing and selling tobacco products in packaging which is recyclable and/or made from unbleached paperboard and/or recycled paper and may require the Opponent and other manufacturers of tobacco products to sell tobacco products in packaging where dyes or bleaches have been added to avoid infringement of the TRADE-MARK.

REGISTRABILITY ISSUES

2. The opponent bases its opposition on paragraph 38(2)(b) of the Act, namely that in view of subsection 12(1) of the Act, THE TRADE-MARK is not registrable since:

(a) the TRADE-MARK, whether depicted, written or sounded, is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which the TRADE-MARK is alleged used. More particularly, the TRADE-MARK clearly describes or deceptively misdescribes that the applicant's wares are sold in packaging which is recyclable and/or made of unbleached paperboard and/or recycled paper [contrary to paragraph 12 (1)(b) of the Act].

(b) pursuant to section 12 of the Act, if the alleged TRADE-MARK is a mark at all, which is denied, the TRADE-MARK is a distinguishing guise as defined in section 2 of the Act. Compliance with the registrability requirements of section 12 of the Act are subject to the provisions set out in section 13 of the Act. The TRADE-MARK has not been used by the Applicant as to have become distinctive at the date of filing of the application (December 20, 2012), as required by paragraph 13(1)(a) of the Act as a precondition of registrability [contrary to paragraphs 12(1) of the Act and paragraph 13 (1)(a) of the Act]; and

(c) any grant to the Applicant of exclusivity in the use of the alleged TRADE-MARK is likely to unreasonably limit the development of the industry, more particularly, the production, marketing and sale of tobacco products in Canada, in packaging which is recyclable and/or made from unbleached paperboard and/or recycled and may require the Opponent and other manufacturers of tobacco products to sell tobacco products in packaging where dyes or bleaches have been added to avoid infringement of the TRADE-MARK [contrary to paragraphs 12(1) of the Act and paragraph 13 (1)(b) of the Act].

(d) The alleged TRADE-MARK as applied to the wares identified in the application is confusing with the registered trade-marks: AMPHORA MELLOW BLEND & Design (TMA591146), AMPHORA ORIGINAL BLEND & Design (TMA591224), DJARUM SPICE ISLANDS & Design (TMA686970), and TOSCANI (TMA527719) [contrary to paragraph 12 (1)(d) of the Act].

DISTINCTIVENESS ISSUES

3. The opponent bases its opposition on section 38(2) d) of the Act, namely that in view of section 2 of the Act (definition of ‘distinctive’), the TRADE-MARK is not distinctive of the wares of the applicant since:

(a) the TRADE-MARK (in as much as it is considered to be a colour) is clearly descriptive or deceptively misdescriptive as set out in paragraph 2(a) above;

(b) TRADE-MARK is not distinctive of the applicant as it does not actually distinguish and is not adapted to distinguish the tobacco products in association with which the TRADE-MARK is allegedly used by the applicant from the tobacco products of other tobacco traders since the TRADE-MARK does not identify a distinctive trade-mark in so far as the alleged colour (in as much as it is considered to be a colour) is nothing other than a natural result of the manufacturing process of cigarette packaging made of unbleached paperboard;

(c) In as much as it is considered to be a colour, the alleged TRADE-MARK is not distinctive of the applicant as it does not actually distinguish the tobacco products in association with which the TRADE-MARK is allegedly used by the applicant nor is it adapted to so distinguish them because the TRADE-MARK is never used in isolation but simply as a background colour featured on a small portion of a commonly shaped cigarette package on which other markings and indicia of source appear.

(d) In as much as it is considered to be a colour, the alleged TRADE-MARK is used by John Player & Fils and therefore outside the scope of the licensed use provided for by section 50 of the Act;

(e) In as much as it is considered to be a colour, the alleged TRADE-MARK does not or is not adapted to distinguish the tobacco products of the Applicant from those of tobacco traders, being solely functional or merely decorative/ornamental rather than an indicator of source.

(f) In as much as it is considered to be a colour, the TRADE-MARK does not or is not adapted to distinguish the tobacco products in association with which the alleged TRADE-MARK is allegedly used by the Applicant (whose use is in any event denied) from the tobacco products of other tobacco traders whose tobacco products are sold in packages whose colour is similar to the alleged TRADE-MARK as claimed by the applicant in its application, including tobacco products sold in Canada in association with the trade-marks Captain Black, Backwoods, Prime Time, Bullseye, Export 'A', Tueros, M Mini Colts & design, Raw, Honey T, Amphora, Toscano, Djarum and Original Choice.”

SCHEDULE B

Excerpts from the amended statement of opposition filed in respect of the '733 Application

[Only the section 30 grounds of opposition that differ in content or numbering from those reproduced in Schedule A in respect of the 729 Application are hereinafter reproduced]

“CONFORMITY ISSUES

1. The Opponent bases its opposition on paragraph 38(2)(a) of the Act, namely that the opposed application does not comply with the requirements of section 30 of the Act, notably:

[...]

(o) The drawing submitted in the application for the alleged TRADE-MARK is not a meaningful representation of the Applicant's TRADE-MARK in the context of the written description appearing in the application because the entire package is not displayed. The applicant does not contain a sufficient number of representations (perspectives) so as to set out all the features of the TRADE-MARK. The application is confusing and ambiguous because it does not enable the determination of the limits of the abject to which colour is applied

(p) The statement that the applicant is satisfied as to its entitlement to the use of the alleged TRADE-MARK in Canada is false in view of the content of the present opposition, including the knowledge of the applicant that the alleged TRADE-MARK is not a trade-mark for the reasons outlined above. In addition, the Applicant and its related company Imperial Tobacco Products Limited have adopted a modus operandi of filing trade-mark applications solely for colours, as claimed in application numbers TMO 1317127 and 1317128 (ORANGE PACKAGE DESIGN); TMO 1580255 and 1580250 (PURPLE PACKAGE DESIGN); TMO 1605729 (BROWN PACKAGE DESIGN) and the opposed application under TMO 1605733, in an attempt to obtain an exclusivity on their use, despite being aware that any such grant is contrary to the proper

scope of trade-mark legislation and policy as leading to an exhaustion of the colour availability to others [contrary to paragraph 30(i) of the Act];

(q) The statement that the applicant is satisfied as to its entitlement to the use of the alleged TRADE-MARK in Canada is false in so far as it is untenable for the Applicant to take the position that it is using the alleged TRADE-MARK as a trade-mark in view of its alleged use of the alleged colour as a feature of its various PLAYER'S trade-marks identified in paragraph 1(f) above (the alleged TRADE-MARK is simply the background colour featured on a small portion of a cigarette package on which other markings and indicia appear [contrary to paragraph 30(i) of the Act];

(r) The statement that the applicant is satisfied as to its entitlement to the use of the alleged TRADE-MARK in Canada is false in view of the knowledge of the applicant that any grant of exclusivity in the TRADE-MARK may prevent the Opponent and other tobacco traders from producing, marketing and selling tobacco products in packaging which is recyclable and/or made from unbleached paperboard and/or recycled paper and may require the Opponent and other manufacturers of tobacco products to sell tobacco products in packaging where dyes or bleaches have been added to avoid infringement of the TRADE-MARK.”

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2018-10-11

APPEARANCES

Stella Syrianos and Barry Gamache

FOR THE OPPONENT

Timothy Stevenson

FOR THE APPLICANT

AGENTS OF RECORD

ROBIC

FOR THE OPPONENT

SMART & BIGGAR

FOR THE APPLICANT