



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 079

Date of Decision: 2023-05-10

IN THE MATTER OF AN OPPOSITION

Opponent: Fort Garry Brewing Company LP

Applicant: Churchill Brewing Corp.

Application: 1,913,550 for NORTHERN LIGHT

INTRODUCTION

[1] Churchill Brewing Corp. (the Applicant) has filed application No. 1,913,550 (the Application) to register the trademark NORTHERN LIGHT (the Mark) in association with various alcohol-related goods and services, including beer.

[2] Fort Garry Brewing Company LP (the Opponent) has opposed the Application, based primarily on an allegation that the Mark is confusing with the Opponent's trademark FORT GARRY NORTHERN LITE, previously used in association with beer.

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] The Application was filed on August 7, 2018 in association with the following goods and services (the Goods and Services, respectively), set out together with the associated Nice class:

- CI 32 (1) Alcoholic beverages, namely, beer, and beer based beverages.
- CI 33 (2) Alcoholic beverages, namely, ciders and alcohol based coolers.
- CI 40 (1) Custom beer brewing services for others.
- CI 41 (2) Organizing beer tastings.

[5] The Application was advertised for opposition purposes in the *Trademarks Journal* on October 28, 2020. On December 10, 2020, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 as amended June 17, 2019 (the Act), raising grounds of opposition under sections 16(1)(a), 2 and 38(2)(e) of the Act.

[6] On December 31, 2020, the Applicant requested an interlocutory ruling to strike the entire statement of opposition under section 38(3)(a) of the Act. In response, the Opponent requested leave to amend its statement of opposition. However, this request was denied as the Opponent failed to enclose a copy of the proposed amended statement of opposition. No proposed amended statement of opposition was ever filed.

[7] The Registrar issued an interlocutory ruling on February 5, 2021, ordering that the ground of opposition based on section 38(2)(e) of the Act be struck on the basis that it was improperly pleaded, and that reference to the words "... others, including..." be deleted from the section 2 ground of opposition. The grounds of opposition as amended by the interlocutory ruling are set out below:

- a) Pursuant to section 38(2)(c), the Applicant is not entitled to the registration of the Mark as it is confusing with the Opponent's trademark (application No. 1,967,340) for use with beer, which was previously used and made known in Canada by the Opponent; and

b) Pursuant to section 38(2)(d), the Mark is not distinctive within the meaning of section 2 of the Act as it is not distinctive of the Applicant. The Applicant's Mark is not distinctive of the Applicant and does not distinguish and is not adapted to distinguish the Applicant's Goods and Services from the goods of the Opponent.

[8] The Applicant filed a counter statement denying the grounds of opposition.

[9] Only the Opponent filed evidence, which is discussed below.

[10] Only the Applicant filed written representations and attended a hearing.

OPPONENT'S EVIDENCE

[11] The Opponent's evidence consists of the affidavit of Scott Shupeniuk, General Manager with the Opponent, sworn June 9, 2021 (the Shupeniuk Affidavit).

[12] Mr. Shupeniuk describes Fort Garry as a microbrewery that is considered to be Manitoba's oldest microbrewery, starting in 1930. Following a number of changes in ownership, it was acquired by the Opponent in 2016 (paras 3, 4). Mr. Shupeniuk states that the brewery has been continuously brewing beer since 1930 (para 5).

[13] Mr. Shupeniuk states that the Opponent launched the FORT GARRY NORTHERN LITE beer in the summer of 2019 (para 6). Exhibit B is a copy of a mock-up beer bottle label displaying the Opponent's trademark prepared by the Opponent's marketing agency on June 28, 2019 (para 6). Exhibit C contains purchase orders by the Manitoba Liquor Control Commission (MLCC) for the Opponent's beer during July 2019 (para 7). The purchase orders include 25 orders of varying quantities of FORT GARRY NORTHERN LITE brand beer.

[14] Exhibit D contains a beer price list issued by the Manitoba Liquor and Lotteries Corporation (MLLC) dated October 7, 2019; the Opponent's FORT GARRY NORTHERN LITE beer is included on the list with a public sell price of \$3.58 per unit. Exhibit D also contains a purchase order issued by the MLLC on February 23, 2020 for various beers of the Opponent including its FORT GARRY NORTHERN LITE brand

beer (totaling approximately \$182). However, I note that the purchase order lists “Fort Garry Brewing Company Ltd” (which is not the name of the Opponent *per se*) in both the “supplier” and “ship to” fields. It also includes the notation “Confirmation PO Only – Do not Ship” in both the order’s “Ship Terms” and “Special Instructions/Route” fields.

[15] Mr. Shupeniuk states that the Opponent’s goods are distributed and sold in liquor stores, restaurants and bars in Manitoba and Saskatchewan (paras 9, 15). Copies of pictures showing the Opponent’s trademark as it appears on the Opponent’s goods (on cans and cases) as well as on display at liquor stores in Manitoba are attached as Exhibits G, H, and I (paras 12 to 14).

[16] Mr. Shupeniuk states that the Opponent has promoted the Opponent’s goods at events such as festivals and on social media (paras 10, 11). Exhibit E is a copy of an Instagram post of August 19, 2019 promoting the Opponent’s goods in conjunction with the “Summer of Sound Festival”. Exhibit F consists of copies of six posts from the Opponent’s Instagram account promoting the Opponent’s goods. Exhibit J contains excerpts from the Opponent’s website, *fortgarry.com*, printed on May 31, 2021, displaying the Opponent’s goods.

PARTIES' RESPECTIVE BURDEN OR ONUS

[17] The legal onus is on the Applicant to show that the Application complies with the provisions 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. Once this initial burden is met, the Applicant must satisfy the Registrar, on a balance of probabilities, that the grounds of opposition pleaded should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA*, 2002 FCA 29].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 16 Ground of Opposition

[18] Under this ground of opposition, the Opponent has an initial evidential burden of establishing that its FORT GARRY NORTHERN LITE trademark was used in Canada prior to August 7, 2018, the filing date of the Application, and had not been abandoned at the date of advertisement of the Mark (see section 16 of the Act).

[19] However, the Shupeniuk Affidavit clearly indicates that the Opponent's FORT GARRY NORTHERN LITE brand beer (the Opponent's goods) was not "launched" until the summer of 2019. Further, as set out the exhibited purchase orders, the earliest sales date for the Opponent's goods was July 3, 2019, which post-dates the filing of the Application by nearly 11 months. Mr. Shupeniuk's assertion that "Fort Garry has been continuously brewing beer since 1930" does not assist the Opponent since it is clear that the Opponent's sale of beer in association with the Opponent's trademark does not date back to that time.

[20] As the Opponent's evidence does not establish use of the Opponent's trademark prior to August 7, 2018, the Opponent has failed to meet its initial burden and this ground of opposition is rejected.

Section 2 Ground of Opposition

[21] The material date for this ground of opposition is the filing date of the statement of opposition, namely December 10, 2020 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[22] To meet its initial evidential burden under this ground of opposition, the Opponent is required to show that its trademark had become known sufficiently in Canada, as of the filing date of the statement of opposition, to negate the distinctiveness of the Mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427 (FC)]. The necessary reputation required for an opponent to meet its burden under this ground has been described as "substantial, significant or sufficient"

and clearly more than just a demonstration of use [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657].

[23] Based on the evidence submitted by the Opponent, I am not satisfied that it has met its initial evidential burden. The sales information provided by the Opponent is very limited as it demonstrates, at best, 25 sales of indeterminate value of the Opponent's goods that took place in July 2019 (Exhibit C). It is not clear what significance should be attributed to the purchase order in Exhibit D, in particular given the apparent indication that the Opponent or perhaps its related company is both supplier and recipient, as well as the "Do not ship" notation. Even if I was to consider this one additional purchase order, it would not materially assist the Opponent in establishing the requisite reputation. Notably, the Opponent has not provided information setting out the total dollar amount or volume of sales of the Opponent's goods.

[24] As for the evidence of promotion of the Opponent's trademark, the Opponent's Instagram posts and website suggest there has been some exposure to the public, however no information is provided as to the number of Canadians that may have viewed this media. The Shupeniuk Affidavit refers to three events at which the Opponent has promoted its FORT GARRY NORTHERN LITE branded beer but, apart from providing one Instagram post, no other information on the manner and extent of promotion is provided, nor has the Opponent provided any figures relating to advertising expenditures for the Opponent's goods.

[25] Accordingly, this ground of opposition is rejected.

DISPOSITION

[26] In view of the above and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

Jennifer Galeano
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-01-30

APPEARANCES

For the Opponent: No one appearing

For the Applicant: Paul Braunovan

AGENTS OF RECORD

For the Opponent: MLT AIKINS LLP

For the Applicant: PERLEY-ROBERTSON, HILL & MCDOUGALL LLP