

IN THE MATER OF AN OPPOSITION BY
Molson Breweries, A Partnership to application
No. 625,528 for the mark BUDWEISER & Design
filed by Anheuser-Busch, Incorporated

On February 15, 1989, Anheuser-Busch, Incorporated filed an application to register the trade-mark BUDWEISER & Design, illustrated below, for the wares (1) clothing namely, shoes (2) socks (3) an extensive list of merchandise including clothing, sports equipment, and various novelty items. The application is based on the applicant's use and registration of the mark in the United States of America with respect to the wares numbered (1) and (2) [registration Nos. 1,516,463 and 1,537,465 respectively] and based on proposed use in Canada with respect to the wares numbered (3).

The subject application was advertised for opposition purposes in the Trade-marks Journal issue dated June 12, 1991 and opposed by Molson Breweries, A Partnership on October 15, 1991. A copy of the statement of opposition was forwarded to the applicant on December 2, 1991. The applicant responded by filing and serving a counter statement.

Paragraph 1 of the statement of opposition alleges the following facts:

Paragraph 2 of the statement of opposition pleads the following grounds of opposition:

The opponent's evidence consists of a certified copy of regn. No. TMDA 40809, illustrated and described below, for the wares "standard lager."

The applicant's evidence consists of the affidavit of Amalia M. Trister; certified copies of trade-mark regn. No. 168,703, illustrated below, for the wares "beer" standing in the name of the applicant Anheuser-Busch, Incorporated; and the file wrapper for application No. 345,475, illustrated below, filed by the opponent for lager beer [application No. 345,474 was refused by this Board on January 29, 1993; see *Anheuser-Busch, Inc. v. Molson Breweries, a Partnership* 49 C.P.R.(3d) 402]. Both parties filed a written argument and both were ably represented at an oral hearing.

regn. No. 168,703

appln. No. 345,475

The first the ground of opposition, pursuant to Section 12(1)(d), alleges that the applied for mark BUDWEISER & Design is not registrable because it is confusing with the opponent's mark DREWRYS & Design regn. No. TMDA 40809 for the wares standard lager. The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision: see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538 (TMOB).

The legal burden is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark BUDWEISER & Design and the opponent's registered mark DREWRYS & Design. In determining whether there would be a reasonable likelihood of confusion, I am to have regard to all the surrounding circumstances, including those enumerated in Section 6(5). The presence of a legal burden on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.).

The applied for mark and the opponent's mark both possess a fair degree of inherent distinctiveness owing to the combination of design features that comprise the marks. There is no evidence that either mark has become known to any appreciable extent in Canada. The length of time that the marks have been in use is not a factor that favours either party in the absence of evidence of use of the marks. The nature of the parties' wares are different since the opponent's registration No. TMDA 40809 covers a brewed alcoholic beverage while the subject application covers clothing, sports equipment and novelty items. There is no evidence that the wares covered in the subject

application are a natural extension of the wares covered in the opponent's registration namely, standard lager. Further, I have declined the opponent's invitation to take judicial notice that various of the wares specified in the subject application are merchandising items normally associated with the sale of beer. In my view, it was up to the opponent to prove its point by filing the appropriate evidence. In the absence of evidence to the contrary, I assume that the parties' channels of trade would not overlap since the parties wares are different. With respect to the degree of resemblance between the marks in issue, there are numerous design features common to both marks. Nevertheless, the word BUDWEISER is a prominent feature of the applied for mark while the words DREWRYS and STANDARD LAGER are prominent features of the opponent's mark. It is therefore likely that the applied for mark would be referred to by the public as BUDWEISER while the opponent's mark would be referred to as DREWRYS or DREWRYS STANDARD LAGER. As noted by the opponent at the oral hearing, there is no doubt that the marks in issue are beer labels. However, the applied for mark suggests a beer emanating from BUDWEISER while the opponent's mark suggests a lager emanating from DREWRYS.

As a further surrounding circumstance, the applicant relies on findings by the Federal Court of Appeal in *Anheuser-Busch v. Carling O'Keefe* (1986), 10 C.P.R.(3d) 433 (see pp. 13-14 of the applicant's written argument):

However, as noted by the opponent at the oral hearing, I am obliged to disregard the applicant's above submissions as this Board does not have jurisdiction to consider the law of equity.

The opponent points to the similarities between the applied for mark and regn. No. 168,703, and to the similarities between regn. No. TMDA 40809 and appln. No. 345,475, and submits that I am bound to find for the opponent in the instant case because (i) the Federal Court of Appeal found regn. No. 168,703 regn. confusing with regn. No. TMDA 40809 (ii) this Board found regn. No. 168,703 confusing with appln. No. 345, 475 [see *Anheuser-Busch v. Carling O'Keefe*, above; *Anheuser-Busch, Inc. v. Molson Breweries, A Partnership*, above, respectively]. However, the above cases relied on by the opponent are distinguishable from the instant case in that the applied for mark application No. 625,528 does not cover brewed alcoholic beverages. As noted by the applicant at p.11 of its written argument:

. . . in order for a registration covering standard lager to be afforded a wide scope of protection that would extend to wares other than beer or beverages, it is necessary that the opponent establish that the registered mark is so well-known that use of the same mark would lead consumers to infer that the wares associated with those trade-marks are manufactured or sold by the same person . . . there is no evidence which would support a conclusion that the opponent is even entitled to prevent the use or registration of [the mark which is the subject of regn. No. TMDA 40809] in association with unrelated wares . . .

I agree with the applicant that the opponent has not established why the ambit of protection accorded to regn. No. TMDA 40809 should include wares unrelated to alcoholic brewery beverages.

In view of my findings, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applied for mark is not confusing with regn. No. TMDA 40809. Thus, the first ground of opposition is rejected.

The second and third grounds of opposition (for which the material date is February 15, 1989) are based on (i) the opponent's use of its marks relied on in the statement of opposition and on (ii) the opponent's prior filing of application No. 345,475 which application was extant as of the date of advertisement (June 12, 1991) of the applied for mark. With respect to (i) above, the grounds of opposition based on the opponent's use of its marks are rejected because the opponent has not met the statutory requirements on it to evidence use of its marks before the applicant's filing date and non-abandonment of its marks as of the date of advertisement namely, June 12, 1991: in regard to the latter see Sections 16(5) and 17(1) of the Act. With respect to (ii) above, the grounds of opposition based on the opponent's prior filing of application No. 345,475 are rejected for essentially the same reasons that the first ground of opposition has been rejected, that is, because the applied for mark is not confusing with application No.

345,475 for lager beer. It may also be that an applicant cannot rely on a trade-mark application which is not extant at the date of my decision: in this regard see *W. R. Grace & Co. v. Union Carbide Corp.* (1987), 14 C.P.R.(3d) 337 at 345 (F.C.A.). The last ground of opposition is rejected because the opponent has not evidenced any reputation for its marks.

In view of the above, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 22 DAY OF November , 1995.

Myer Herzig,
Member,
Trade-marks Opposition Board