

Federal Court



Cour fédérale

Date: 20161020

Docket: T-82-15

Citation: 2016 FC 1172

Ottawa, Ontario, October 20, 2016

PRESENT: The Honourable Mr. Justice Barnes

BETWEEN:

CEDC INTERNATIONAL SP. Z O.O

Applicant

and

UNDERBERG KG AND UNDERBERG AG

Respondent

JUDGMENT AND REASONS

[1] This is an appeal from a decision of the Trade-Marks Opposition Board [the Board] brought by CEDC International SP Z O.O [CEDC] under section 56 of the *Trade-marks Act*, RSC, 1985, c T-13 [Act]. The decision under appeal allowed an opposition by Underberg KG and Underberg AG [collectively Underberg] and refused CEDC's application to register a trade-mark for the word "Żubrówka" in association with a flavoured vodka product.

[2] In refusing the application, the Board applied section 12(1)(c) of the Act and found that CEDC had failed to meet its burden of proof on a balance of probabilities that “Żubrówka” is not the name of the wares in the Polish language. In other words, the Board was not satisfied, on the evidence before it, that “Żubrówka” is not a generic Polish word describing vodka flavoured with bison (or buffalo) grass.

[3] CEDC impugns the Board’s decision in several ways. It says that the Board erred by relying exclusively on non-Polish sources in finding “Żubrówka” to be “the name of the wares in Polish” (see para 30 of CEDC’s Memorandum of Fact and Law). CEDC also maintains that the Board erred by relying on non-authoritative references and because there was no evidence to support its conclusion “that ŻUBRÓWKA is the name of the wares in Polish” (see para 43 of CEDC’s Memorandum of Fact and Law). CEDC also criticizes the Board’s characterization of CEDC’s position in an unrelated trade-mark case as an “admission”.

[4] CEDC’s arguments are further particularized in the following passages from its Memorandum:

54. The Board’s decision was unreasonable:

(a) The Board was inconsistent. On the one hand, the Board found the foreign decisions filed by CEDC not to be persuasive because trade-mark regulations in foreign jurisdictions do not coincide with trade-mark law in Canada. Yet on the other hand, the Board accepted and was persuaded by evidence filed by the Opponents about what CEDC said in a foreign proceeding with different regulations.

(b) The Board’s decision is clearly wrong. The Board rejected CEDC’s evidence that the term ŻUBRÓWKA is a brand name in Poland. The basis for rejecting this evidence is that it did not preclude the term ŻUBRÓWKA from also

being a generic word in the Polish language. However, there was absolutely no evidence filed by the Opponents from which the Board could have concluded that ŻUBRÓWKA is a generic word in the Polish language.

55. The Board's decision does not explain why the Board preferred the Opponents' evidence from non-Polish sources over CEDC's evidence from Polish sources in deciding whether the word ŻUBRÓWKA is the name of the wares in Poland.

[5] No argument is advanced that the Board's statement of the standard to be applied to section 12(1)(c) of the Act evinces a legal error.

[6] What is common to all of CEDC's arguments is that they rest on the Board's assessment of the evidence. On appeal such matters must be examined on the standard of reasonableness: see *Engineers Canada v Rem Chemicals, Inc*, 2014 FC 644 at para 28, 125 CPR (4th) 245. In cases like this where the parties have tendered new evidence in support of their positions in accordance with section 56(5) of the Act, I adopt and apply the words of my colleague Justice James Russell in *Pfizer Products Inc v Canadian Generic Pharmaceutical Association*, 2015 FC 493 at para 140, 133 CPR (4th) 159, citing the Applicant's submissions in that case:

38. **Standard of review.** Section 56(5) of the *Act* provides that, on appeal, "evidence in addition to that adduced before the Registrar may be adduced and the Federal Court may exercise any discretion vested in the Registrar."
39. The standard of review is to be determined on an issue-by-issue basis. Where the record has been supplemented with additional evidence, the standard of review to be applied will depend on the materiality of the new evidence. If the new evidence is merely repetitive of the evidence adduced before the Registrar, deference is owed and reasonableness is the appropriate standard (meaning that if the outcome below falls within a range of alternatives or is not 'clearly wrong,' deference is to be afforded). Where, however, the evidence would have materially affected the

Registrar's finding of fact or her exercise of discretion, the Court must reach its own conclusions *as to the correctness of the decision*.

40. **Materiality of the new evidence.** This Court must assess whether the new evidence would have materially affected the Decision. In order to have a material effect, the new evidence must be substantial and significant, the test being one of quality, not quantity. If the additional evidence adds nothing of probative significance, is merely repetitive of existing evidence, is irrelevant, makes assumptions without specific support, or was filed only "to support the Registrar's decision", then a more deferential standard of review is afforded.
41. Where the Registrar has noted an absence of information or a deficiency, new evidence that responds to the cited deficiency may be considered (and which may result, if appropriate, in a less deferential review of the correctness of the decision).

[Citations removed.]

[7] CEDC asserts at paragraph 43 of its Memorandum of Fact and Law that the Board erroneously concluded that "Żubrówka" is the name of the wares in Polish. In fact, the Board made no such finding. What the Board held on "the evidence as a whole" was that CEDC did not meet its burden to establish that the proposed word-mark is not the name of the wares in Polish. The ultimate burden of proof rested with CEDC because, as the Board held, Underberg had met its evidentiary burden on this issue through the evidence of Mr. Barwinski. In the face of the record before the Board this was not an unreasonable finding. Indeed, the evidence adduced by CEDC to the Board on this issue was underwhelming, particularly when viewed along-side the evidence presented by Underberg.

[8] On the meaning of “Żubrówka”, CEDC relied mainly on the affidavit of its Vice President (Americas/Asia), Richard Roberts. Mr. Roberts’ affidavit only lightly addressed the lexicographical issue in the following paragraph:

6. The name ŻUBRÓWKA itself is a folk term derived from the word zubr, the Polish word for the aurochs or bison that are native to the region and feed on the hierochloa odorata grass. Attached as Exhibit “A” is an excerpt from the Oxford Polish-English Dictionary. The word ŻUBRÓWKA translates into English as follows: (1) Bot. Sweetgrass U; (2) (wódka) Bison Brand Vodka®.

[9] For the most part, Mr. Roberts’ affidavit dealt with CEDC’s commercial experiences in the production, branding and sales of its “Żubrówka” vodka in Canada and elsewhere. He also identified 59 countries where CEDC had obtained word-mark protection for “Żubrówka”, including Poland, Italy, Australia, New Zealand and Ireland.

[10] Mr. Roberts acknowledged that a number of other distilleries produce vodka flavoured with bison grass but he attested that they “do not use ŻUBRÓWKA on their label” (see Roberts’ affidavit at para 28).

[11] What was surprisingly lacking from Mr. Roberts’ affidavit was any disclosure of the countries where word-mark protection for “Żubrówka” was withdrawn in the face of opposition, disclaimed or refused. That list included the United States and many member-states of the European Union. Mr. Roberts’ assertion that other bison grass flavoured vodkas are not marketed as “Żubrówka” was also inaccurate, if not misleading. In a 2003 decision of the European Office for Harmonization in the International Market (Trade Marks and Designs), Russian vodka labels

bearing the word “Zubrówka” are depicted. Mr. Barwinski’s affidavit also addressed this point in the following way:

14. The descriptive and generic character of the term “Zubrówka” is evident from its use by numerous other buffalo grass flavoured vodkas. Such uses predate the filing date for the application that is the subject of this opposition proceeding. Worldwide, dozens of vodkas flavoured with buffalo grass are produced and marketed as Zubrówkas by different distilleries in numerous countries, in particular in Poland, Russia, Lithuania, the Czech Republic, Ukraine and Belarus. Attached as Exhibit “7” are pictures of 28 Zubrówka products that are or were available on the market in these countries.
15. Most products depicted in Exhibit “7” feature, on their labels, the word “Zubrówka” (or “Zubrovka” or “Zubrívka” or the phonetic equivalent spelled with Cyrillic letters). For a majority of these labels, the term Zubrówka is used in combination with other words and design elements on the bottle label. As such, the term “Zubrówka” only serves to indicate the type of vodka, namely its flavour, while it is the other elements that serve as source-identifiers. The following designations from Exhibit “7” serve as relevant examples of descriptive use of “Zubrówka” accompanied by other distinctive marks to indicate the origin:
 - BAK’s ZUBRÓWKA BISON BRAND,
 - BAK’S BISON GRASS VODKA ZUBRÓWKA,
 - Zubrovka Bison Vodka (Fruko Schulz),
 - BOTRAN Poland’s Zubrówka Formula VODKA SPECIAL,
 - POLMOS ZUBRÓWKA BISON BRAND VODKA,
 - Kord Zubrovka (Kord Destilleries),
 - Moskovskaya Zubrovka (Simex),
 - Zubrovka Bison Vodka (Borco),
 - Zubrivka Ripka,

- Brestskaya Zubrovka (Belaco),
- Mernaya Zubrivka (Knyazhyi Hrad),
- S. Tersa Paris Zoubrovka,
- Bulbash Zubrovka,
- Zlatogor Zubrivka,
- Velejemna Zubrovka.

16. The Opponent has, for many years, extensively used the term “Zubrówka” (spelled with a “v”) on the bottle labels of its bison grass flavoured vodka marketed under the trade-mark GRASOVKA, in order to indicate the type of vodka. Attached as Exhibit “8” are depictions of trade dresses used by the Opponent for its bison grass flavoured vodka since 1977.
17. The term “Zubrówka” (spelled with a “v”) is also used in Opponent’s most recent trade dress (current as of 2010) and in the corresponding current advertising materials in order to indicate the type of vodka. Attached as Exhibit “9” are the 2010 trade dress images and advertising materials for the Opponent’s GRASOVKA brand of Zubrówka.

[12] CEDC complains that the Board’s decision was unreasonable because the Board had “absolutely no evidence” to support a finding that “Zubrówka” is a generic word in Polish describing vodka flavoured with buffalo grass. CEDC argues that the following requisite evidence was absent from the record:

- (a) any evidence of the meaning of ZUBRÓWKA in the Polish language;
- (b) any evidence from any Polish/English or English/Polish dictionaries;
- (c) any evidence from any Canadian consumer who speaks Polish;
- (d) any evidence from Poland; or

- (e) any evidence of any commercial use of the term in Polish or Poland.

[13] In contrast, CEDC says it produced to the Board ample Polish references showing that “Żubrówka” is not a generic Polish word and was, therefore, open to trade-mark protection. In actual fact and as the Board noted, CEDC produced almost nothing on this issue (see paras 34 and 35 of the Board’s reasons).

[14] In order to properly assess CEDC’s further arguments, it is necessary to examine the entire evidentiary record before the Board. The Board mentioned only a few of the references cited in the Barwinski affidavit. That is not surprising inasmuch as Underberg carried only an evidentiary burden which was readily overcome by the evidence cited by the Board. Where deference is owed by a reviewing court, it is sometimes appropriate and necessary to consider evidence that is not addressed in the decision-maker’s reasons: see *Newfoundland and Labrador Nurses’ Union v Newfoundland and Labrador (Treasury Board)*, 2011 SCC 62 at paras 14 and 15, [2011] 3 SCR 708. In this case, the complete evidentiary record provides ample support for the Board’s finding that CEDC’s evidence was insufficient to meet the burden it carried.

[15] As noted above, the only evidence CEDC adduced to the Board in proof of the meaning in Polish of “Żubrówka” was a single reference from the Oxford Polish-English dictionary which provided an English translation of the word to mean (1) Bot. Sweetgrass *U*; (2) (wódka) Bison Brand Vodka®. However, numerous other references cited by the Underberg affiants attached far greater significance to the word in terms of its historical relationship to eastern European vodkas flavoured with buffalo grass. Some examples are the following:

- (a) Why is Zubrowka so special?

Zubrowka is a vodka specialty of the premium category that was the favourite drink of the Polish nobility as early as the 16th century.

The spirit owes its unique taste to a particular medical plant (buffalo grass, *Hierochloe odorata*) that grows in the meadows of the Bielewieze national park at the Polish-Belarusian border and is the favourite delicacy of the rare European buffalo. This buffalo breed is also shown on the label and in the logo of the Zubrowka vodka. Each bottle of Zubrowka contains a blade of buffalo grass that is the special sign of the vodka and adds a pleasant flavour, fragrance and subtle touch of green colour to it.

[p 814, volume 4, Applicant Record]

...

- (b) Oxford English Dictionary | The definitive record of the English language

zubrowka, *n.*

Pronunciation: (/zʊˈbrʊfkə/ , Russian /zʊˈbrofka/))

Forms: Also **zubrovka**.

Etymology: < Polish *źubrówka*, Russian *zubrovka*, derived forms of Polish *źubr* , Russian *zubr* European bison. The plant (a member of the cereal family) is said to be a favourite food of the animal. Compare ...

Vodka flavoured with the stalks of *Hierochloe australis*, a central and eastern European species of sweet-grass.

1944 W. S. MAUGHAM *Razor's Edge* v. 193 A tear of zubrovka could do Monsieur no harm. It's well known to be very good for the kidneys. We have just received a consignment from Poland.

1970 'E. QUEEN' *Last Woman* 1. 15 That retractable bar..[is] stocked with everything from absinthe to zubrovka.

1990 *Jazz FM* No. 1. (advt.) (recto rear cover), *Zubrowka* owes its specific delicate flavour to bison

grass which grows only in the Bialowieza Forest of Eastern Poland.

[p 828, volume 4, Applicant Record]

...

- (c) Aspects of the topic Zubrowka are discussed in the following places at Britannica.

Assorted References

• **characteristics** (*in vodka (distilled liquor)*)

Vodkas are sometimes flavoured. *Zubrówka*, yellowish in colour, highly aromatic, and with a somewhat bitter undertone, is produced by steeping several stalks of *Zubrówka*, or buffalo grass, in vodka. Other flavoured vodkas are made with such ingredients as lemon peel, berries, peppercorns, and caraway.

[p 830, volume 4, Applicant Record]

...

- (d) **Encyclopédie des Vins et des Alcools de Tous les Pays**

authored by the wine authority Alexis Lichine, contains the following entry for “Zubrówka” (French language in the original):

“Polish type of vodka. Pale greenish colour, it owes its flavour to the wild herb preferred by the zubra (Polish bison) which is displayed on the label. Each genuine bottle of Zubrowka contains a blade of this grass”

“Zubrówka, especially characteristic of Polish manufacture and very much appreciated abroad, carries on its label the picture of a bison. If it is authentic Zubrówka, it is flavoured by a certain “holy” grass with which the zubr (Polish aurochs) is besotted”.

[p 845, volume 4, Applicant Record]

...

- (e) **Zubrowka vodka**

Zubrowka, or **bison-grass vodka**, is made with rye grain and then infused with the flavor of “sweet grass” or *Hierochloe odorata* in Latin, from the primeval Bialowieza

Forest. The vodka is 40 percent alcohol, is greenish yellow in color and has an herbal sweet taste. The vodka's flavor is a result of the infusion of one or two kilograms of bison grass per one thousand liters of vodka. Then, a long blade of this grass is typically placed in each bottle. **Hierochloe odorata** contains coumarin, a naturally occurring chemical which was originally used to flavor tobacco and cakes and has been found to display various medicinal properties, such as a blood thinner. Zubrowka contains only about a dozen milligrams of coumarin per liter.

Zubrowka's origins date back to the eighth century when someone had perhaps accidentally combined alcohol with medicinal herbs. There is still much debate as to whether it originated in present day Poland or Russia since discerning this truth is made difficult by the frequently changing borders in the region throughout history. By the 16th century there were approximately seventy-two herbal vodkas. Rye, buckwheat and oats were used to create the vodka. Its impurity was masked by different spices, herbs and roots. Zubrowka itself became popular after the Polish-Lithuanian accord in 1569 when the Polish royal court would rest at various [sic] hunting lodges in the Bialowieza Forest on their way to the northeast. Zubrowka first became widely distributed by the J.A. Baczewski Liquor and Liqueur Distillery in Lvov in the seventeenth century.

[pp 895-896, volume 4, Applicant Record]

...

- (f) (2) The name for other distilled spirits which are distinctive products of a particular place or country, an example is Habanero, shall not be given to the product of any other place or country unless the designation for such product includes the word "type" or an adjective such as "American", or the like, clearly indicating the true place of production. The provision for place of production shall not apply to designations which by usage and common knowledge have lost their geographical significance to such an extent that the appropriate ATF officer finds they have become generic. Examples are Slivovitz, Zubrovka, Aquavit, Arrack, and Kirschwasser.

[p 959, volume 4, Applicant Record]

...

- (g) “A generic mark is generally a common description of the goods,” *W.W.W. Pharm. Co., v. Gillette Co.*, 984 F.2d 567, 572 (2nd Cir. 1993) “one that refers, or has come to be understood as referring, to the genus of which the particular product is a species.” *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2nd Cir. 1976). In the seminal case, *J. Canfield v. Honickman*, 808 F. 2d 291 (3rd Cir.), the court explained that “Whether the term that identifies the product is **generic** then depends on the competitors’ need to use it. At the least, if no commonly used alternative effectively communicates the same functional information, the term that denotes the product is **generic**.” (emphasis added) The *Canfield* doctrine is relevant in the present case. As demonstrated above, the word “zubrowka” is translated as “bison grass vodka”, which unquestionably describes the goods. *Canfield*, coupled with the doctrine of foreign equivalents as interpreted by McCarthy, supports the examining attorney’s proposition that “zubrowka” is generic because its foreign equivalence wholly describes the goods, and therefore, competitors clearly need to use such wording to describe its goods, particularly vodka with bison grass.

...

In addition to caselaw, the word zubrowka is used extensively in the media and other on-line publications and reviews. In many, if not most, of these publications, the word is not used to indicate source, but used descriptively to indicate a type of alcohol. In several of these exhibits, the author identifies a popular drink called Tatanka, made from zubrowka and apple juice. See attached exhibits 7-9. When examining the recipes for such drink, it is important to note that zubrowka is listed simply as another ingredient, like apple juice, and not as a trademark. The recipe is not indicating that zubrowka is the mark for this type of vodka but simply that zubrowka is a type of liquor used in this drink concoction. Otherwise, the recipe would indicate that Tatanka can only be made with this specific brand of bison grass vodka. However, nothing else in the publications would indicate that one can only use this brand when mixing a Tatanka. Secondly, news articles generally use the word zubrowka to designate a type of vodka, and not to designate a source. See attached news articles identified as Zubrowka 1-5.

...

- (h) The word in question here, “Zubrowka”, as already mentioned, comes from Polish and has been accepted as meaning mainly as a name for a specific type of vodka flavoured with Mary’s grass in the relevant reference books (cf. in particular, Langenscheidt’s Pocket Polish Dictionary, 14th edition, 1992, page 595, left hand column; Spirits dictionary: www.bsl-bonn.de/lexicon/s.htm; Brockhaus - Die Enzyklopädie in 24 Bänden, 19th edition, Volume 24, page 301, right hand column). Contrary to the opponent’s view it is not necessary for the domestic circles involved to find out the etymological derivation of the Polish word “zubr” (= Bison, buffalo, cf. Langenscheidt’s Pocket Polish Dictionary, 14th edition, 1992, page 595) in order to find out the meaning of the brand name “Zubrowka”. This comes directly from the brand name itself.

[p 1019, volume 4, Applicant Record]

...

- (i) The Board of Appeal finds that the mark ZUBROVKA lacks distinctiveness as a trademark for vodka (and thus for aquavits) and will be misleading as trademark for liqueur. In that connection the Board has taken into account that “zubr” and similar roots in several Slavonic languages describe the species of grass used in many countries in connection with manufacturing of a certain type of vodka. Therefore ZUBROVKA has – as documented – become a generic designation for this type of vodka in the relevant business circles, including in particular the actors in the market for spirits and the relevant authorities in e.g. the EU and the USA.

[p 1050, volume 5, Applicant Record]

...

- (j) We, Consiva Wine & Spirits, are the sole importers in Denmark of a vodka called ZUBROWKA bison vodka. We are importing this vodka from Poland and have been doing so for decades.

We were asked whether we are aware of other Zubrowka-type vodkas and can confirm that this is the case. We are aware of the fact that there are several Zubrowka-type

vodkas on the market in Europe coming from countries as diverse as the Czech Republic, Russia, The United States or Belorussia. Specifically, we know ZUBROWKA-Russian vodka which is exported to Western Europe from the Russian trading company SIP. We are familiar with MOSKOVSKAYA ZUBROWKA, distributed by the German company Simex as well as KORB ZUBROWKA manufactured and exported by the Czech company Kord. We have no doubts that there are other Zubrowka-type vodkas on the European market. Therefore we believe that Zubrowka is a generic term describing a particular type of vodka.

[p 1101, volume 5, Applicant Record]

...

- (k) You approached us as an authority on alcoholic beverages to request whether we are familiar with the term Zubrovka and its meaning. We can confirm that we are acquainted with this term which is utilised for a type of vodka aromatised with buffalo grass. The name originates from the Polish word for buffalo and buffalo grass (“Zubr”) and describes the traditional manufacture of this type of vodka: Zubrovka is actually aromatised with the aid of buffalo grass.

According to our knowledge of the market, we hold the opinion that this is a term denoting a particular type of vodka, i.e. a sort of vodka which has been aromatised with a blade of buffalo grass. The word Zubrovka has a direct connection with the aromatisation of the vodka as “Zubr” is the Polish word for buffalo or buffalo grass.

We have observed that a number of manufacturers have utilised the term Zubrovka for vodka which has been aromatised with buffalo grass. Zubrovka is manufactured in a number of different countries. Vodka of the type Zubrovka is for example available on the European market originating from countries such as Poland, the Czech Republic, Russia, the USA and Belarus, MOSKOVSKAYA ZUBROVKA is for example distributed by the German company Simex, KORD ZUBROVKA is distributed by the Czech company Kord, ZUBROVKA BISON VODKA by the Polish distributor Polmos Bialystock and GRASOVKA VODKA ZUBROVKA by Underberg AG. We are sure that further

brands of Zubrovka vodka are also distributed within Europe.

[p 1104, volume 5, Applicant Record]

...

- (l) I am hereby pleased to confirm that according to current knowledge the name “Zubrowka” is a generic term for the distilled product vodka. This matter was clarified a few years ago by the Association for the Protection of the Distilling Industry. A distilling company had applied for the term “Zubrowka” to be registered as a word mark for distilled products at the German Patent and Trademark Office [Deutsches Patent- und Markenamt]. On our request, the German Patent and Trademark Office cancelled this trademark on the grounds that this word was a generic term which would be unsuitable for identifying the origin of goods from a particular company and would therefore have to be kept free for freedom interests.

A typical characteristic of Zubrowka is the aroma produced from placing a blade of grass in the bottle. This aromatisation is considered here as typical of the generic group and is therefore permitted for all manufacturers and distributors of Zubrowka.

[p 1108, volume 5, Applicant Record]

...

- (m)
 - (1) Turówka wonna, Zubrówka (*Hierochloe odorata*), aromatic grass growing wild in Northern Europe, Siberia and North America, sometimes cultivated; medicinal plant; seasonal plant (used, among other things, for aromatising alcohol); its fragrance originates from coumarin contained in the herb.
 - (2) Żubrówka, dry aromatised herbal vodka; Polish name — Bison Brand Vodka; it is prepared by adding wild auroch’s grass (- aromatic grass of the genus *Hierochloe*) with a specific aroma; there is a blade of this grass in each original bottle of the vodka.

[p 826, volume 4, Applicant Record]

[16] CEDC's characterization of the above references as disparate and mistaken examples from non-Polish sources is disingenuous.

[17] Underberg's references show that "Żubrówka" is an old Polish word that has been adopted for use in other places. The question of whether the word is purely descriptive of the wares turns on how it would be perceived on first impression by the everyday consumer of vodka flavoured with buffalo grass: see *Technologies, Inc v WIC Television Ltd*, 2003 FC 1056 at para 81, 29 CPR (4th) 182, aff'd 2005 FCA 96, 38 CPR (4th) 481. The consumer in question need not be someone who understands or speaks Polish but need only be someone who understands the descriptive significance, if any, of the word in making a purchasing decision.

[18] The overwhelming weight of the evidence before the Board supported Underberg's case in opposition. It is of additional significance that CEDC did not attempt to directly contradict Underberg's evidence but only sought to challenge its probative value. That continued to be the case on this appeal where CEDC added very little to the evidentiary record in support of its case and certainly not enough to require the Court to reconsider the Board's decision on the merits.

[19] A finding that word-mark protection for "Żubrówka" has been obtained by CEDC in some countries including Poland is, as the Board correctly observed, not incompatible with a finding that the word could not be monopolized in Canada by virtue of section 12(1)(c) of our Act. Similarly, the grant of trade-mark protection in Canada for a design-mark incorporating the word "Żubrówka" is not determinative of whether word-mark protection is available. Indeed, the word frequently appears on the design labels of many other bison grass flavoured vodkas.

[20] The fact that a foreign word like “Żubrówka” is not universally included in English language dictionaries is not a particularly strong indication of its meaning or use in the English-speaking world or elsewhere. That is particularly so where the Board had before it numerous reference documents in several languages confirming that “Żubrówka” is a generic Polish word for bison grass flavoured vodka in those places where the product is produced and available.

[21] CEDC’s reliance on trade names like Bacardi, Kleenex and Martini that have found their way into the general lexicon is also misplaced. The exact reverse of that linguistic phenomenon was in operation here. As the evidence shows, CEDC was attempting to appropriate a word that had been in long use in Poland and elsewhere to describe a particular type of vodka, that is to say, a vodka flavoured with bison grass. Moreover, the undisputed evidence from Mr. Barwinski was that there is no other common word in Polish to describe buffalo grass flavoured vodka [see para 91].

[22] Having regard to the totality of the evidence the Board’s finding that CEDC failed to meet its burden of proof is reasonable. The evidence adduced by CEDC as to the meaning of “Żubrówka” was very weak and its case collapsed under the weight of the contrary evidence put forward by Underberg.

[23] For the foregoing reasons this appeal is dismissed with costs payable to Underberg in the agreed amount of \$15,000.00.

JUDGMENT

THIS COURT'S JUDGMENT is that this appeal is dismissed with costs payable to the Respondent in the amount of \$15,000.00.

"R.L. Barnes"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-82-15

STYLE OF CAUSE: CEDC INTERNATIONAL SP. Z O.O v UNDERBERG
KG AND UNDERBERG AG

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JUDGMENT AND REASONS: BARNES J.

DATED: OCTOBER 20, 2016

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