

**IN THE MATTER OF AN OPPOSITION
by Allied Domecq Spirits & Wine Limited
to Application No. 1168023 for the trade-
mark BEEFEATER filed by Robert Victor
Marcon**

I The Pleadings

On February 18, 2003, Robert Victor Marcon (the “Applicant”) filed an application to register the trade-mark BEEFEATER (the “Mark”), application number 1168023, in association with: coffee, grain or chicory based coffee substitute, tea, herb tea and herbal tea (the “Wares”). The application is based on proposed use in Canada and was advertised on February 9, 2005 in the Trade-marks Journal for opposition purposes.

Allied Domecq Spirits & Wine Limited (the “Opponent”) filed on July 7, 2005 a statement of opposition, which was forwarded on August 11, 2005 by the Registrar to the Applicant, raising the following grounds of opposition:

1. The Mark is not registrable pursuant to the provisions of s. 38(2)(b) and 12(1)(d) of the *Trade-marks Act* R.S.C. 1985, c. T-13, (the “Act”) since it is confusing with the following registered trade-marks:

BEEFEATER, registration TMA120981 in association with gin;
BEEFEATER & Design, registration TMA233539 in association with gin,
spirits, liqueurs and cocktails;
BEEFEATER & Design, registration TMA601921 in association with wines,
distilled spirits, liqueurs and prepared alcoholic cocktails;

2. The Applicant is not entitled to registration of the Mark in view of s. 16(3)(a) of the Act because, at the filing date of the application, the Mark was confusing with the above mentioned registered trade-marks that had been previously used in Canada by the Opponent since 1933 in association with gin, distilled spirits, liqueurs and prepared alcoholic cocktails;
3. The Applicant is not entitled to registration of the Mark in view of s. 16(3)(b) of the Act because at the filing date of the application the Mark was confusing with the Opponent’s following pending applications, which had been previously filed in Canada by the Opponent:

BEEFEATER WET, application no. 1150689 in association with wines,
distilled spirits namely gin, and prepared alcoholic cocktails and cocktail mixes;

WET BY BEEFEATER, application no. 1150687 in association with wines, distilled spirits namely gin, and prepared alcoholic cocktails and cocktail mixes; WET BY BEEFEATER & Design, application no. 1161561 in association with distilled spirits namely gin, prepared alcoholic cocktails and mixed cocktails containing flavoured gin;

4. The Applicant's Mark is not distinctive within the meaning of s. 2 of the Act because it is not distinguishing nor it is adapted to distinguish the Applicant's wares from the wares of others, and in particular the wares of the Opponent noted above, having regard to the previous use and registration of the above mentioned trade-marks in Canada and having regard to the Opponent's previously filed pending applications described above.

The Applicant filed a counter statement on September 7, 2005 in which in essence it denies all grounds of opposition listed above and contained evidence that will be disregarded as it was not filed in accordance with rule 42 of the *Trade-marks Regulations (1996)*.

The Opponent's evidence consists of the affidavit of John Nicodemo while the Applicant filed the affidavit of Robert Victor Marcon. The Opponent filed as reply evidence the affidavit of Kathleen Larone.

Both parties submitted written arguments and only the Opponent was represented at the oral hearing.

II Burden of Proof in Trade-mark Opposition Procedure

The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus 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 onus is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

III Relevant dates

The relevant dates for the analysis of the grounds of opposition are:

- Registrability of the Mark under s. 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 at 424 (F.C.A.)];
- Distinctiveness of the Mark: the filing date of the statement of opposition is generally accepted as the relevant date (July 7, 2005) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)];
- Entitlement to the registration of the Mark where the application is based on proposed use: the filing date of the application (February 18, 2003) [see s. 16(3) of the Act].

IV Registrability, Entitlement and Distinctiveness

The first, second and fourth grounds of opposition turn on the issue of the likelihood of confusion between the Mark and the Opponent's trade-mark BEEFEATER. The difference in the relevant dates would not have a bearing on my assessment of that question. I shall discuss the issue of registrability of the Mark and the conclusion reached shall apply equally to the second (entitlement) and fourth (distinctiveness) grounds of opposition if the Opponent meets its initial onus. I consider the Opponent's strongest case to be with its registered trade-mark BEEFEATER, certificate of registration TMA120981 for gin.

Mr. Nicodemo is the V.P. Finance and Chief Financial Officer of Corby Distilleries Limited which is the marketing and sales agent for the Opponent since 1991. He filed, as exhibits to his affidavit, a certificate of authenticity for each of the Opponent's registered trade-marks. Therefore the Opponent has met its initial onus with respect to the ground of opposition based on the registrability of the Mark under s. 12(1)(d) of the Act.

The test to determine if there exists a likelihood of confusion is set forth in s. 6(2) of the Act and I must have regard to all the surrounding circumstances, including those listed in s. 6(5):

- The inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- The length of time the trade-marks or trade-names have been in use;
- The nature of the wares, services, or business;
- The nature of the trade; and
- The degree of resemblance between the trade-marks or trade-names in appearance, or sound or any ideas suggested by them.

Those criteria are not exhaustive and it is not necessary to give each one of them equal weight. [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.), *Gainers Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

I refer to the decision rendered by the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321 for a detailed analysis of s. 6(5) of the Act.

Considering initially the inherent distinctiveness of the trade-marks in issue, the Applicant's Mark, as applied to the Wares, is distinctive. The registered trade-mark BEEFEATER is equally distinctive of gin. The fact that a trade-mark is a word found in a dictionary does not preclude it from being distinctive when used in association with wares or services unrelated to such word. The distinctiveness of a trade-mark can be enhanced through its use. Therefore I shall summarize the relevant evidence on this issue filed by both parties.

The Applicant has filed no evidence of use of the Mark. On the other hand Mr. Nicodemo explains that the Opponent is in the business of manufacturing distilled alcoholic beverages including gin bearing the trade-mark BEEFEATER. Such gin is distilled by the Opponent's subsidiary James Burrough and is sent in tanks to Allied Distillers Limited, another subsidiary of the Opponent in the United Kingdom, for bottling and shipping in Canada for distribution in Canada. He states that the Opponent's trade-mark BEEFEATER has been used in Canada in association with gin since 1933. To illustrate such statement he has provided the yearly sales

volume for the period of 1995 to 2005 that are at least over 144,000 cases of 9 litres as well as the yearly advertising figures for the period of 1998 to 2005 being at least over \$825,000.

He filed samples of labels appearing on the bottles of gin sold in Canada. He also filed samples of various promotional materials featuring the Opponent's trade-mark BEEFEATER displayed in retail stores such as the Liquor Control Board of Ontario ("LCBO"), licensed bars and through print materials.

Finally he filed samples of shipping invoices to illustrate the shipping from the United Kingdom to Canada of gin bearing the trade-mark BEEFEATER as well as purchase orders from the LCBO for such wares.

From this evidence I conclude that the Opponent's trade-mark BEEFEATER is well-known in Canada. Such factor favours the Opponent.

As for the length of time the trade-marks have been in use, this factor also favours the Opponent.

The trade-marks in issue are identical. Therefore the parties in their written arguments, and especially the Applicant, have put a lot of emphasis on the differences in the parties' respective wares and their channels of trade. The Applicant argues that there exists a distinction between the Wares and gin and their respective channels of trade. Therefore the average consumer would not likely be confused between the two trade-marks even though they are identical.

In paragraph 2 of his affidavit Mr. Nicodemo states:

2.(...) Specifically in Canada, there are a series of liquor control boards and it is those boards that purchase distilled alcoholic beverages from the Opponent and in turn provide them for sale to the general public. Further, the boards distribute the distilled alcoholic beverages to hotels, restaurants and other organizations.

On this issue of the nature of the parties' respective wares and their channels of trade, I refer to comments made by my colleague Jill Bradbury in *Moosehead Breweries Ltd. v. Stokely-Van Camp Inc.* (2001), 20 C.P.R. (4th) 181 where she stated:

The applicant's lager beer and the opponent's non-alcoholic, non-carbonated fruit flavoured drinks belong to the same general class of wares, namely beverages. The applicant argues that the parties' wares should be considered as two different general classes of wares, namely alcoholic beverages and non-alcoholic beverages. In any event, it must be remembered that Subsection 6(2) of the *Act* states that "the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class." [underlining added]

Board member David Martin in *T.G. Bright & Co. v. Blake* (1985), 4 C.P.R. (3d) 368 made the following comment:

There would appear to be a potential overlap between the channels of trade of the parties throughout Canada in that the wares of both parties could easily be sold through bars and restaurants. The possibility of confusion arising in such circumstances would seem to be greater since it is relatively easy to envision a customer ordering a glass of Spritzig and being given a glass of the applicants mineral water by mistake.

Mr. Marcon filed as an exhibit a copy of a letter from the LCBO addressed to him. By this letter the Applicant is arguing that the channels of trade of his Wares would be different than those used by the Opponent for the distribution of its wares. A similar letter was introduced in *Cerverceria Modelo, S.A. de C.V. v. Marcon* (2008), 70 C.P.R. (4th) 355 and the Registrar disposed of it in the following terms:

Attached as Exhibit 6 to his affidavit is a letter dated April 8, 2004, from the LCBO wherein the LCBO states that it does not sell non-alcoholic beverages. This evidence is inadmissible hearsay with respect to the truth of its contents and has therefore not been considered.

Therefore I conclude that there is a similarity in the parties' respective wares and their channels of trade. The Wares have been considered as part of the general class "beverages" and the Opponent's evidence reveals that its wares are sold in bars and restaurants that could also be selling the Wares.

I shall now discuss the content of Mr. Marcon's affidavit in the context of additional relevant circumstances being argued by the Applicant. Exhibit 1 is a list of twenty-eight (28) trade-marks taken from the Canadian Trade-marks database having as a component the word "Beefeater". A

similar list was filed in *Cerverceria Modelo, S.A. de C.V. op.cit.* and the Registrar rejected such evidence for the following reasons:

He further submits a print out of a CIPO website search for the query "CORONA" yielding 97 marks. No particulars of any of these marks are provided, such as status, dates, wares or owner. He also submits results from the CIPO database for the word "crown" that yielded 1,069 documents. Again, no information was provided as to the number of active registrations, and/or the particulars of these marks.

In the present case, particulars of the marks listed were also not provided. Without the particulars of the citations contained in Exhibit 1, such evidence is not helpful to the Applicant's case. However we find some information on nine (9) of those citations as part of Exhibit 5 to Mr. Marcon's affidavit. None of them cover beverages. The wares range from fish, meat, poultry, barbecues, frozen potatoes and snack food. Moreover the affidavit of Ms. Larone filed as the Opponent's reply evidence reveals that five (5) of those registrations are no longer in use and those nine (9) trade-mark registrations are owned by four (4) different owners. These numbers fall short from inferring widespread use in the market place of trade-marks incorporating the word "Beefeater" in association with beverages [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.) and *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

V Conclusion

The Applicant has not discharged his burden to prove, on a balance of probabilities, that there would be no likelihood of confusion between the Mark, when used in association with the Wares, and the Opponent's trade-mark BEEFEATER. I reach this conclusion on the basis that the Opponent's trade-mark BEEFEATER is distinctive and well-known in Canada. The Wares are in the same general class namely beverages, the parties' respective wares could be sold in the same restaurants and bars and the marks are identical. Therefore the first ground of opposition is maintained.

The Opponent has established use of its trade-mark BEEFEATER prior to the relevant dates associated with the second and fourth grounds of opposition. Consequently it has met its initial onus. The conclusion reached on the issue of likelihood of confusion between the parties'

respective trade-marks in my analysis of the first ground of opposition is likewise applicable to those two other grounds of opposition. They are also maintained.

As the Opponent has been successful on three separate grounds of opposition it is not necessary to dispose of the third ground of opposition.

Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act

DATED IN BOUCHERVILLE, QUEBEC, THIS 24th DAY OF MARCH 2009.

Jean Carrière,
Member, Trade-marks Opposition Board