

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

**Citation: 2011 TMOB 40**  
**Date of Decision: 2011-03-04**

**IN THE MATTER OF AN OPPOSITION  
by Brown-Forman Corporation, Jack  
Daniel's Properties, Inc., Finlandia Vodka  
Worldwide Ltd., and Southern Comfort  
Properties, Inc. to Application No.  
1,202,335 for the trade-mark JACK  
DANIEL'S filed by Robert Marcon**

[1] On December 29, 2003, Robert Marcon (the Applicant) filed an application to register the trade-mark JACK DANIEL'S (the Mark), based upon proposed use of the Mark in Canada in association with "salsa" and "barbecue sauce" (the Wares).

[2] The application was advertised for opposition purposes in the Trade-marks Journal of October, 24, 2007. On January 2, 2008, a statement of opposition was filed by Brown-Forman Corporation, Jack Daniel's Properties, Inc. (JDPI), Finlandia Vodka Worldwide Ltd., and Southern Comfort Properties, Inc., (collectively referred to as the Opponent). The Applicant filed and served a counter statement on February 7, 2008 in which it denied the Opponent's allegations.

[3] The Opponent filed the affidavits of corporate representatives David S. Gooder, Jeremy Shepherd, market researcher Sarah Carnegie (Nos.1 and 2), trade-mark searchers Mary P.

Noonan (Nos.1 and 2) and Generosa Castiglione, as well as Robert White. The Applicant filed the affidavit of Robert V. Marcon, in support of its application.

[4] Mr. Marcon was cross-examined on his affidavit and the transcript and answers to undertakings were filed.

[5] The Opponent filed reply evidence, namely the affidavits of Mary P. Noonan and Shirley Sereney.

#### Grounds of opposition

[6] The grounds of opposition are summarized as follows:

(1) Section 38(2)(a) of the Act

The Application does not conform to the requirements of Section 30(e) and s.30(i) because the Applicant falsely stated that it had an intention to use the Mark in Canada and the Applicant falsely stated that it was satisfied that it was entitled to use the Mark applied for in Canada in association with the Wares when in fact at the date of filing of the Application, the Applicant:

- had no legitimate business
- likely intends to “traffic” in trade-marks
- has no bona fide history
- had actual knowledge of well known brands
- seeks to trade on the goodwill of well known brands including JACK DANIEL’S;
- is acting in bad faith, and
- could not be satisfied of his entitlement to use

(2) Section 38(2)(b) of the Act

The Application is not registrable in view of s. 12(1)(d), on the ground that the Mark applied for is confusing with each of the Opponent’s registered trade-marks (referred to throughout as the Opponent’s trade-marks or the JACK DANIEL’S trade-marks and set out in Appendix A).

(3) Section 38(2)(a) and (c) of the Act

Contrary to s. 16(3)(a) and (c) the Applicant is not the person entitled to the registration since at the date of filing, the Mark was confusing with each of the Opponent's trade marks as set out in Appendix A, as well as the trade name JACK DANIEL'S, all of which had been previously used and made known in Canada by the Opponent and of which the Applicant was or should have been aware.

(4) Section 38(2)(b) of the Act

Contrary to s. 16(3)(b) the Applicant is not the person entitled to the registration since at the date of filing, the Mark was confusing with each of Opponent's applications that had been previously filed in Canada (as set out in Appendix A).

(5) Section 38(2)(d) of the Act

The Mark applied for is not distinctive of the Applicant.

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. There is however an initial 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 [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[8] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- s. 16(3) - the filing date of the application [see s. 16(3)];

- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

### Opponent's Evidence

#### *Affidavit of David S. Gooder*

[9] The affidavit of David Gooder sets out that he is Managing Director of JDPI and is responsible for the protection, enforcement and licensing of its trade-marks. JDPI is a wholly-owned subsidiary of Brown-Foreman (BFC) and is the global marketing agent for JACK DANIEL'S whiskey. JDPI licenses Jack Daniel Distillery to produce JACK DANIEL'S alcoholic beverages and to sell them to BFC, who then markets them globally.

[10] Mr. Gooder's affidavit provides historical background that is directed towards establishing the notoriety of the Opponent's trade-mark in Canada and elsewhere. He provides that the Jack Daniel Distillery was the first registered distillery in the United States; it has been producing whiskey since 1866. All JACK DANIEL'S brand whiskey sold since then has been produced and bottled at that distillery. This product is sold in more than 150 countries including Canada; other products sold by the Distillery are JACK DANIEL'S COUNTRY COCKTAILS, GENTLEMAN JACK and JACK DANIEL'S Single Barrel Tennessee whiskey.

[11] Mr. Gooder provides that JACK DANIEL'S whiskey is the best selling whiskey in the U.S. Sales of JACK DANIEL'S black label whiskey in the United States are in excess of US \$4.7 billion since 1995. JACK DANIEL'S whiskey has been sold in Canada since at least as early as 1970; total sales in Canada, from 2001 to date, exceed U.S. \$60 million; since 1996, more than 8, 300,000 cases of JACK DANIEL'S alcoholic beverages have been sold in Canada. Globally, sales of the whiskey since 1995 have been in excess of US \$7.7 billion and the brand is currently the second biggest selling whiskey in the world.

[12] The affiant states that JACK DANIEL'S trade-marks have also been used under license in the United States and Canada and elsewhere for many years on a wide variety of non-beverage products, including food products such as grilling and other sauces, clothing such as t-shirts and sweatshirts and other items such as lighters and shot glasses. The worldwide retail sales of non-

beverage licensed products are in excess of US \$1.5 million annually. The JACK DANIEL'S brand has been recognized as one of the top brands worldwide by publications such as *Impact*, *Business*, *Week*, *Adweek*, *Brandweek* and *Mediaweek*, with a brand valuation in excess of US \$1 billion.

[13] The JACK DANIEL'S trade-marks have been licensed in Canada and internationally for many years for use on a wide variety of products including:

- Food products such as grilling sauces, barbeque sauce, steak sauce, marinades, rubs, mustard, other sauces, pecans and peanuts, coffee cakes and confectionary;
- Food related products such as mugs, jugs, flasks, glassware servingware, barbeque tools and gourmet good wraps for baking, steaming and grilling;
- Clothing and footwear including t-shirts, baseball caps, polo shirts, woven shirts, sweatshirts, jackets, flying jackets, leather coats, briefs, bandanas, shorts, boxer shorts, kimonos, pyjamas vests, ties, socks, sweatpants tank tops, hats, bracelets belt buckles, motorcycle and cowboy boots;
- Personal and collectors items such as lighters, replica bottles, die cast miniature replica cars and trucks flags, key chains, casino chips, golf equipment and bowling balls;
- Bar room furniture and accessories such as bar stools, shot glasses, wall mirrors, signs and lights, tables, billiard tables and accessories, dart boards and accessories, and coasters; and
- Motorcycle parts such as primary cover, timer cover, air cleaner cover, battery cover, license plate cover, horn cover, hand bar grips, sissy bar inserts, sissy bar pad, foot pegs, oil tank covers, mirrors, floorboard tool kit, mud flaps, handlebar cover and other parts.

[14] The licensing program has over 70 licensees that are based in the United States, Canada, Europe and Australia. On an annual basis, the worldwide value at retail of non-beverage licensed products is in excess of US \$15 million.

[15] In Canada, the JACK DANIEL'S brand is licensed for sauce for food as part of the TGI Friday's restaurant menu which has its own JACK DANIEL'S grill section listing various types of steak and other grilled food that is served with JACK DANIEL'S branded sauce. TGI Friday's has been licensed since 1999. Mr. Gooder attaches an example of the menu section - JACK DANIEL'S GRILL (Exhibit DG-26), and I note that it lists menu items such as "Jack Daniel's Ribs & Shrimp" and "Jack Daniel's Glazed Ribs". The description on the page reads "a little help from our good friend Jack to get that rich, smoky Tennessee flavour into our food". The ribs are described as "mouthwatering Jack Daniel's Glazed Ribs". I note that there is at least one TGI Friday's in Canada (affidavit of Sarah Carnegie discussed below).

[16] With respect to advertising and promotion, it appears that advertising of JACK DANIEL'S whiskey has been undertaken continuously since 1955. Since then, more than \$469 million (US) has been expended on advertising and promotion of JACK DANIEL'S in the U.S. More than \$976.4 million has been expended globally on advertising and promoting the JACK DANIEL'S brands since 1996 and such advertisements have appeared in Canada for many years.

[17] The evidence reveals that JACK DANIEL'S has been promoted and advertised in Canada (and throughout the world) in at least the following ways:

- Advertisements in print magazines distributed in the U.S. Canada and other countries (Exhibit DG-29); some examples are *Cosmopolitan*, *EXPN Total Sports*, *Food & Wine*, *Fortune*, *Golf Illustrated*, *Maxim*, *Newsweek*, *Playboy*, *Rolling Stone*, *Ski*, *Sports Illustrated*, *Time*, *TV Guide* and *US*.
- Point of purchase advertising distributed to on-premise and off-premise trades in Canada and the U.S., including items such as shelf talkers, case cards, endcap displays, and posters for the off-premise trade and table tents, banners, posters, mirrors, neon signs, novelty items, "giveaways" and merchandise such as lighters, t-shirts, watches, key chains and sunglasses for the on-premise trade ( Exhibit DG-30).
- On the Internet via the following websites, all of which are accessible from within Canada:

- *www.jackdaniels.com* that provides information specifically directed to Canadians and has had Canada in the top three countries of origin for unique visitor counts since at least as early as 2002 (Exhibit DG-34);
  - *www.jackdanielssauces.com* which is focused on the variety of available JACK DANIEL'S brand sauces and marinades and their use;
  - *www.jackdanielsracing.com* and *www.jackdanielsgoods.com*.
- General internet advertising since at least as early as 1999 which is available to Canadians (Exhibit DG-35).
  - Events and sponsorships such as the annual *JACK DANIEL'S World Championship Invitational Barbecue* has been held in Lynchburg, Tennessee for nearly 20 years. Canadian teams have been invited to take part (a Canadian team recently won a prize).
  - Product placement in movies seen by millions of viewers around the world, including in Canada. A long list of films is provided as Exhibit DG-38, with a DVD of film clips. Some examples include popular films, such as "Pearl Harbor", "Almost Famous", "A Few Good Men", "Bridges of Madison County", "Scent of a Woman", "Casino", "Jerry Maguire", "Waterworld" and "Basic Instinct".

*Affidavit of Jeremy Shepherd*

[18] Mr. Shepherd's affidavit relates to specific activities of the Opponent in Canada. Mr. Shepherd is the Country manager, Canada for the Opponent BFC and has been since May 2008. Prior to that time he held the position of Commercial Manager, Canada within BFC and was previously Brand Manager and Regional Sales Manager, Atlantic Canada at Bacardi Canada Inc., the appointed distributor at that time for BFC within Canada. Mr. Shepherd is and has been responsible for all aspects of BFC's global brand strategy within Canada including strategic brand development, brand management and management of the sales and commercial marketing team. Mr. Shepherd has also been responsible for managing M2Universal, the advertising agency

appointed by BFC through which all commercial media advertising for the JACK DANIEL'S brand in Canada is booked and placed.

[19] He provides that JACK DANIEL'S whiskey has been sold continuously across Canada since at least as early as 1970. Since then a wide variety of JACK DANIEL'S branded products have been introduced into Canada and elsewhere at various times, including liquor such as JACK DANIEL'S COUNTRY COCKTAILS, food items such as JACK DANIEL'S barbeque sauces and JACK DANIEL'S BRANDED items such as clothing, accessories and home furnishings.

[20] Since May 2001, sales of JACK DANIEL'S whiskey in Canada have totaled more than US \$60 million. The Opponent's whiskey is sold through Canada on a province by province and territory by territory basis, and has been since 1970. From April 1997 to April 1998 sales were in excess of US \$80 million, and for the fiscal year ended 2008 alone, exceeded US \$14.5 million. Total gross sales of whiskey across Canada have exceeded US \$3 million for every fiscal year since the year ended April 1997.

[21] Mr. Shepherd provides that JACK DANIEL'S whiskey has been actively promoted and advertised in Canada in at least the following ways:

- Annual promotion plans distributed to sales agents across Canada to ensure a uniform and controlled approach, in particular:
- For the years 2007 – 2009, a specific objective in the on-premise market has been menu item placement in 50% of accounts that serve food, such as the JACK DANIEL'S branded food items used by the TGI Fridays restaurant chain.
- Other promotions run throughout the years 2007-2009 have included "JACK & COKE", "paint the town JACK", and "JACK DANIEL'S Namedropper" campaigns, a key feature of which is the production of promotional items branded with the JACK DANIEL'S trade-marks to be distributed at the point of sale.



- The use, since at least as early as 2000, of point of purchase displays and promotional merchandise to be distributed at retail and on-premise locations, for example during the promotional campaigns mentioned above as well as during barbeque specific promotions which have been undertaken. The list of JACK DANIEL'S branded promotional items made available for distribution is extensive and includes mustards jars, barbeques, smoking pellets, coasters, key chains, clothing, mirrors and playing cards to name but a few.
- The use of barbeque specific contests and promotions since at least as early as 2000, in particular (Exhibits JS 12-15);
  - A campaign in which a barbeque specific gift pack containing a bottle of JACK DANIEL'S whiskey, barbeque tongs, smoking pellets and a barbeque related recipe booklet was used in a promotion;
  - A campaign only open to residents of Canada in which a Napoleon brand grill was awarded as a prize and where entry was through neck tags on bottles of JACK DANIEL'S whiskey sold in Canada or through a specific Canadian website dedicated to the competition; and
  - A campaign in 2007 in which *Caseys' Bar and Grill* offered JACK DANIEL'S inspired cocktails and food sauces at its restaurant locations throughout the campaign, including a barbeque sauce made with JACK DANIEL'S whiskey in Canada and a JACK DANIEL'S relish, and during which participating bottles of JACK DANIEL'S whiskey bore a neck tag which contained a recipe for JACK DANIEL'S Stillhouse Barbeque Sauce.
- On the Internet since at least 1995 through (a) the *www.jackdaniels.com* website accessible from within Canada, which, from time to time, contains Canadian specific pages only accessible from within Canada as part of Canada specific promotions, as well as through (b) other Internet sites which offer licensed JACK DANIEL'S branded goods such as: *www.jackdanielsapparel.ca*, *www.ebay.ca* and *www.thegameroomstore.com*.

- Advertising that enters Canada from the United States and elsewhere such as magazine advertisements that are published in the US based magazines circulated in Canada, advertising on US television channels broadcast into Canada, the signs, billboards, point of sale materials and promotions that take place in the United States and are experienced by Canadians travelling in the United States and Canadians that visit the Jack Daniel's distillery in Lynchburg, Tennessee.
- Paid advertising placed in printed publications in Canada, including:
  - *Food & Drink Magazine* and *Flavours Magazine* which are produced by the Provincial Liquor Control Boards of Ontario and British Columbia, Alberta, Saskatchewan and Manitoba respectively;
  - The official game day programs of sports teams such as the Toronto Blue Jays MLB team, Vancouver Canucks, Calgary Flames, Edmonton Oilers and Ottawa Senators NHL Hockey teams; and the official yearbook 2006/7 of the Toronto Maple Leafs NHL Hockey team.
- Television advertising undertaken in Canada in both French and English on a wide variety of both conventional and specialty or digital channels, including *Sportsnet*, *The Discovery Channel*, the *Showcase* movie channels, the *Comedy* and the *Much Music* channels.
- Radio advertising undertaken in Canada, in particular *JACK fm* in each of Toronto, Vancouver and Calgary, *The Fan 590* and *The Fan 960* in Toronto and Calgary respectively, and *102.1 The Edge* in Toronto. Typically such advertising is run in conjunction with a contest to win various prizes, such as a trip to the Jack Daniel Distillery in Tennessee.
- Billboard advertising promoting the JACK DANIEL'S brand on the outside of buildings within Canada since at least as early as 2000.

- Event sponsorship in Canada since at least as early as 2000, in particular:
  - The Calgary Stampede, as an official sponsor in 2000 and 2001 and as an unofficial sponsor since 2002, with brand sponsorship typically in excess of US \$60,000 per year.
  - The Professional Bull Riders events, which take place across North America and are often internationally televised, as an official sponsor with brand sponsorship typically in excess of US \$60,000 per year.
  - The Harley Show, an annual 2 day event which takes place in Montreal, Québec and has been running for approximately 30 years, as an official sponsor with brand sponsorship typically in excess of US \$10,000 per year; and
  - Through sponsorship of a NASCAR racing team, with some NASCAR races taking place in Canada and in any event, NASCAR races are broadcast in Canada, as well as through a website dedicated to the sponsored team located at [www.jackdanielsracing.com](http://www.jackdanielsracing.com).

*Affidavit of Sarah Carnegie No.1*

[22] Ms. Carnegie is a PhD candidate in Anthropology and has seven years of experience conducting, presenting and reporting on observational and literature research.

[23] Ms. Carnegie conducted research directed to establishing the connection between JACK DANIEL'S and other spirits and food products and cooking. She provides that there are 2 TGI Fridays restaurant located in Niagara Falls, Ontario, both offering for sale bags of JACK DANIEL'S glaze for use in cooking. She attaches menus from a number of restaurants which offer items such as JACK DANIEL'S Grainy Mustard Jus with steak, JACK DANIEL'S Green Peppercorn Sauce with steak, and/or JACK DANIEL'S Maple Glaze BBQ Sauce. The affiant also includes a menu from TGI Fridays which includes an entire section entitled JACK DANIEL'S Grill (Exhibits SC 2-8).

[24] Ms. Carnegie provides evidence that a number of retail stores in Toronto sell food products that include whiskey or other spirits as an ingredient, including barbeque sauces which contain whiskey and mustards that contain gin, tequila or vodka. She evidences numerous websites that provide recipes that include JACK DANIEL'S whiskey as an ingredient (Exhibits SC 12 -16). The affiant also provides evidence of the online version of the Liquor Control Board of Ontario (LCBO) magazine *Food & Drink*, which includes recipes that include spirits as an ingredient, including whiskey and rum.

[25] There are numerous books and cookbooks available for sale in Canada dedicated to cooking with JACK DANIEL'S brand whiskey or that contain recipes that include JACK DANIEL'S whiskey as an ingredient. I note that publication and/or copyright dates of the title pages provided pre-date the date of filing the subject application. Some examples of cookbooks dedicated to the use of JACK DANIEL'S are *JACK DANIEL'S Spirit of Tennessee Cookbook*; *JACK DANIEL'S Old Time Barbecue Cookbook* and *JACK DANIEL'S Hometown Celebration Cookbook*. As well she provides evidence of cookbooks in which some recipes call for other types of spirits (rather than specifically the Opponent's whiskey as an ingredient), including other types of whiskey (Exhibits SC 21-35).

[26] Ms Carnegie's research also reveals that non-food related items branded with JACK DANIEL'S are available through the internet on websites such as *www.ebay.ca*, *www.craigslist.ca*, and *www.buysell.ca*. She states that a song has been written about JACK DANIEL'S brand, and a wide variety of articles and discussion threads relating to JACK DANIEL'S brand are available online and accessible from within Canada.

*Affidavit of Sarah Carnegie No.2*

[27] Ms. Carnegie's second affidavit is directed towards Internet searches conducted in May 2008 in relation to Robert Marcon, Robert V. Marcon and Robert Victor Marcon in connection with JACK DANIEL'S (and other arguably well known brand names for which the Applicant has applied to register as trade-marks in Canada). The affiant states that she was unable to find any link between the Applicant and the Mark online; similarly, searches were conducted looking for a

connection between barbeque sauce, salsa and the Applicant's name, which search did not reveal any such links.

[28] Ms. Carnegie also provides copies of magazines circulated in Canada during 2003 located at the Toronto Public Library in which JACK DANIEL'S advertisements were placed, including issues of *Rolling Stone Magazine*, *Sports Illustrated* and *Field and Stream*.

*The Affidavit of Mary P. Noonan No. 1*

[29] Ms. Noonan is a trade-mark searcher employed by the agents for the Opponent. Ms. Noonan attaches copies of registrations and applications for the JACK DANIEL'S trade-marks as well as two applications filed by the Applicant, one of which is the subject of the current opposition proceeding.

*The Affidavit of Mary P. Noonan No.2*

[30] Ms. Noonan provides evidence regarding the link between spirits and food stating that a number of third party trade-marks have been registered in Canada in relation to both spirits and food items. Some examples are: CANADIAN CLUB registered in association with whiskey as well as sauces; SOUTHERN COMFORT registered for liqueurs as well as mustard and sauces, namely barbeque sauces and marinades; and GOLDEN SUN registered in relation to spirits, namely whisky, gin and liqueur as well as mustard and sauces, namely barbeque sauces.

[31] In this connection I observe that the list of Opponent's trade-mark applications in Appendix A includes an application for JACK DANIEL'S for "barbecue sauces, marinades, steak sauces, grilling sauces."

[32] Ms. Noonan provides information regarding the Applicant's filing history, noting that as of May 2008, the Applicant had filed twenty-four trade-marks in Canada, nine of which had been abandoned, and, of the remaining active marks, seven had been opposed. The affiant provides that of the seven trade-marks filed in Canada by the Applicant that have been opposed, each of the opponents in question is the owner of numerous trade-mark registrations and applications in

Canada that are identical to, or contain as an element the opposed Mark applied for by Mr. Marcon. Ms. Noonan provides evidence that the situation is similar with respect to the Applicant's trade-mark applications in the United States.

[33] Ms. Noonan also conducted a search in May 2008 using the NUANS database, an Internet based search system that compares a proposed trade-mark or corporate name with databases of existing trade-marks and corporate bodies in Canada; she was unable to locate reference to any activity by anyone with the name Robert Marcon, Robert V. Marcon or Robert Victor Marcon, nor any website with such a domain name.

*Cross- Examination of Mr. Marcon*

[34] The transcript of cross-examination was filed as an attachment to the affidavit of Shirley Sereney. During his cross-examination it was apparent that Mr. Marcon was aware of the brand JACK DANIEL'S at the time of filing the subject application, and the fact that the brand was available in restaurants and bars in Canada prior to 2003. The cross-examination confirms that Mr. Marcon has not made any use of the Mark and that no manufacturing is taking place with respect to any products bearing the Mark. Nor did he have a specific recipe in mind for salsa or barbecue sauce to be sold under the Mark; he states that he was unsure whether to manufacture and sell the wares himself or to proceed through a licensee.

*Affidavit of Generosa Castiglione*

[35] Ms. Castiglione is a trade-mark searcher employed by the agents for the Opponent. Attached to her affidavit are copies of statements of opposition and the respective opponent's affidavits (without evidence) from opposition proceedings relating to a number of Mr. Marcon's applications, including the following: BEEFEATER (Application No. 1,168,023); CORONA (Application No. 1,168,019); L'OREAL PARIS (Application No. 1,201,383); CHANEL (Application No. 1,202,435); EVIAN (Application No. 1,188,155); and BAYER (Application No. 1,201,366).

[36] I would observe at this juncture that decisions have been rendered in all of the above proceedings; in all cases, the oppositions were successful [see *Allied Domecq Spirits & Wine Ltd. v Marcon* (2009) 74 C.P.R. (4th) 311 (T.M.O.B.)(BEEFEATER); *Cerverceria Modelo, S.A. v. Marcon* (2009), 70 C.P.R. (4th) 355 (T.M.O.B.)(CORONA); *L'Oréal v. Marcon*, 85 C.P.R. (2010) (4th) 381 (T.M.O.B.)(L'OREAL PARIS); *Chanel S. de R.L. v. Marcon* (2010), 85 C.P.R. (4th) 399 (T.M.O.B.)(CHANEL); *Société Anonyme des Eaux Minerales D'Evian v. Marcon*, (2010) T.M.O.B. 83 (EVIAN); and *Bayer Aktiengesellschaft v. Marcon* (2011) T.M.O.B. 9 (BAYER)].

#### *The Affidavit of Robert White*

[37] Mr. White is the Senior Vice President, Canada, of the Audit Bureau of Circulations. He provides supporting circulation data for the various publications referred to in the evidence as carrying ads for JACK DANIEL'S whiskey, confirming substantial circulation of such publications in Canada.

[38] In view of all of the foregoing evidence I have no trouble concluding that JACK DANIEL'S is a well known trade-mark in Canada for whiskey, and that its substantial reputation transcends the alcohol industry, specifically with respect to food preparation, barbeque related items, barbeque sauces and the like.

#### Evidence of the Applicant

#### *The Affidavit of Robert Marcon*

[39] Mr. Marcon is the owner of the subject trade-mark application. His affidavit appears to be directed toward establishing that the Mark has little inherent distinctiveness. He provides definitions of the names "Jack, John and Daniel", and provides telephone listings with the names Daniel and Daniels as a surname in Canada and the United States. I note that in his cross-examination he acknowledged that none of the people listed in the telephone listings are in any way affiliated with him or related to his selection of the name Jack Daniel in relation to the

application, and that to his knowledge there is no Jack Daniel as a living person who is connected to the application.

[40] He provides printouts from the Internet of several corporations or businesses that use the name “Jack Daniel” as part of the corporate or trade name. I note that these businesses appear to relate to public safety and wireless communications, court reporting services, an automobile dealership and a motor inn. There is no evidence of the extent of operations or reputation, if any, of these businesses in Canada.

[41] Mr. Marcon presents evidence of other identical marks owned by different owners for differing wares to support his argument that his Mark and that of the Opponent should be allowed to co-exist as there would be no confusion between “whiskey” and “salsa, barbeque sauce” given the difference in the nature of the wares and their channels of trade, or “market niches”, as he puts it. I have not given this evidence much weight as clearly such examples are irrelevant in view of the absence of evidence surrounding use of said marks, or the extent of use and their acquired distinctiveness and possibilities for transcending the typical nature of the wares and channels of trade. Similar evidence provided by the Applicant in the other above noted opposition proceedings has been accorded the same treatment; the issue of confusion between the Mark and the Opponent’s trade-marks is a decision to be made on the particular facts of the case; each case must be decided on its own merits [see the comments of Chairperson Carreau in *L’OREAL PARIS supra* at para. 19].

#### Section 12(1)(d) Ground of Opposition

[42] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and the Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-marks as set out in Appendix A; I have exercised the discretion of the Registrar to confirm that these are in good standing. The Opponent has therefore met its initial burden with respect to s. 12(1)(d) of the Act.



[43] The Applicant must establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-marks. The Opponent's strongest case is in relation to its trade-marks that consist of the words only - JACK DANIEL'S - and for the purposes of the analysis of the grounds relating to confusion, I will refer to the Opponent's trade-marks simply as the JACK DANIEL'S trade-mark.

[44] The test for confusion is one of first impression and imperfect recollection on the part of a hurried consumer. Section 6(2) of the Act indicates that 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.

[45] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily given equal weight. The weight to be given to each depends on the circumstances [see in general *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349]. In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. The prospective purchaser in mind is described as the casual consumer somewhat in a hurry (*Mattel* at para 58). The question is whether this mythical consumer with a vague recollection of the first mark will, on seeing the second comer's mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares bearing the first mark [*United States Polo Assn. v. Polo Ralph Lauren Corp.*, [2000] 9. C.P.R. (4th) 51 (F.C.A.) at 58].

[46] Taking into consideration the strong evidence of reputation of the Opponent's trade-mark, the fact that the trade-marks at issue are identical, that the Opponent has established that the

JACK DANIEL'S trade-mark has a presence in the food industry, and that, in general, there is some overlap in trade between whiskey, spirits and food preparation, the following analysis of confusion is consequently brief and to the point.

[47] Clearly, despite any argument that might be made that the Mark lacks inherent distinctiveness, the evidence demonstrates that Opponent's trade-mark has become well known in Canada and as such must be found to have a high degree of acquired distinctiveness. The Applicant, however, has not used the Mark at all.

[48] The Opponent's trade-mark has been in use in Canada since 1970 and licensed for use with barbeque sauces and other products since 1999. Substantial and varying types of print, television, Internet and event promotion advertising have taken place in Canada; millions of dollars have been spent on such advertising and promotion. With respect to the nature of the wares and trade, I am satisfied that the Opponent has established an overlap between the alcoholic beverage industry and the use of liquor in barbecue sauces, condiments and food preparation. In this regard, I note the evidence of restaurants in Canada that serve food with JACK DANIEL'S sauces, and the numerous JACK DANIEL'S cookbooks and other cookbooks that include whiskey and spirits in their recipes. The link between the Opponent's trade-mark and the food industry, and use of the trade-mark on barbeque sauces and the like, is clearly established; the fact that its application for JACK DANIEL'S for use with "barbecue sauces, marinades, steak sauces, and grilling sauces" was filed subsequent to the instant filing date is irrelevant. In the absence of any evidence as to how/if the Applicant intends to use the Mark in a manner that might differ from that of the Opponent, I see no basis for concluding that wares and the channels of trade would not overlap. In sum, given that the marks at issue are identical in appearance, sound and idea suggested, the Applicant has clearly failed to establish that there is no reasonable likelihood of confusion; in fact it would appear that there is a strong likelihood, if not certainty, of confusion.

[49] Having considered all of the surrounding circumstances, the s. 12(1)(d) ground of opposition accordingly succeeds.

### Section 16(3) Grounds of Opposition

[50] The material date for assessing entitlement pursuant to s. 16(3) is the filing date of the subject application (December 29, 2003). The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a)(b) and (c) on the basis that the Mark is confusing with the Opponent's registered trade-marks, its trade-name JACK DANIEL'S which had been previously used and made known in Canada by the Opponent, and its trade-mark applications filed prior to the filing date of the subject application.

[51] In order for these grounds of opposition to be considered at all, the Opponent must meet an initial evidentiary burden establishing that the relied on trade-mark(s) (s.16(3)(a)) and trade-name (s.16(3)(c)) were used, and the applications (s.16(3)(b)) were filed, prior to the filing date of the subject application. The Opponent must also establish non-abandonment of its mark(s) as of the date of advertisement of the Applicant's application (s. 16). Although I am not convinced that the Opponent has established trade-name use in Canada, the evidence clearly demonstrates that the Opponent has met the burden with respect to s. 16(3)(a) and (b). In making this determination I have, of course, given no consideration the Opponent's applications filed subsequent to the Applicant's filing date.

[52] As the difference between the relevant dates for the grounds of opposition based on s. 12(1)(d) and s. 16(3) does not affect my earlier analysis following which I determined that there is a likelihood of confusion pursuant to s.6(5) between the marks under review, the s. 16(3)(a) and (b) grounds of opposition also succeed.

### Non-distinctiveness

[53] Regarding the ground of opposition based on lack of distinctiveness pursuant to s. 2 of the Act, the Opponent needs to have shown that as of the filing of the opposition, JACK DANIEL'S had become known sufficiently to negate the distinctiveness of the applied-for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.), *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); *Bojangles International, LLC v Bojangles Café Ltd* (2006), 48 C.P.R. (4th) 427)]. As outlined above, the

Opponent has met this burden well. In view of the evidence provided and having already decided on the issue of confusion (the difference in relevant dates not affecting that analysis), the non-distinctiveness ground of opposition succeeds.

*Section 30(e) and 30(i)*

[54] With respect to the grounds of opposition based on s. 30(e) and s. 30(i), the Opponent has gone to great lengths to establish that the Applicant had no intention of using the Mark and that the Applicant's activities constitute bad faith; however, since the Opponent has already succeeded on the grounds of confusion, the existence of bad faith will not alter the outcome of these proceedings. Further, as I have already ruled on the other grounds of opposition it is not necessary to make a determination under this ground.

Disposition







[55] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.




---

P. Heidi Sprung  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

APPENDIX A  
TABLE OF TRADE-MARKS OWNED BY OPPONENT JDPI

Trade-mark	Registration No.	Registration date	Wares/Services
JACK DANIEL'S	TMA276,433	February 11, 1983	<p><b>WARES:</b></p> <p>(1) Whiskey.</p> <p>(2) Distillery memorabilia, namely - key rings, metal boxes, pocket knives, thermometers, electric lamps, clocks, watches, flasks, playing cards, suit bags, tote bags, mirrors, wooden chests, serving trays, drinking glasses, jugs, decanters, cups, sponges, pitchers, coasters, pennants, towels, caps, jackets, aprons, sweaters, belts, shirts, T-shirts, overalls, jeans, belt buckles, rugs, poker kits, poker chips, golfing tee and towel kits, match cases, matches and lighters.</p> <p>(3) Alcoholic beverages containing distilled spirits.</p> <p>(4) Decorative magnets; switch plate covers.</p> <p><b>SERVICES:</b></p> <p>(1) Hardware and general store retailing carried on by mail order.</p> <p>Used in CANADA since at least as early as 1970 on wares (1).</p> <p>Used in CANADA since at least as early as 1976 on wares (2) and on services.</p> <p>Used in CANADA since at least as early as March 14, 1996 on wares (3).</p>
JACK DANIEL'S	TMA712,882	April 25, 2008	<p><b>WARES:</b></p> <p>(1) Motorcycle parts</p>
JACK DANIEL'S COUNTRY COCKTAILS	TMA520,008	November 29, 1999	<p><b>WARES:</b></p> <p>(1) Alcoholic beverages namely, pre-mixed alcoholic cocktails.</p> <p>Used in CANADA since at least as early as March 13, 1996.</p>
JACK DANIEL'S & DESIGN	TMA475,223	April 25, 1997	<p><b>WARES:</b></p> <p>(1) Whiskey.</p> <p>Used in CANADA since at least as early as 1970.</p>
JACK DANIEL'S & DESIGN	TMA460,137	July 12, 1996	<p><b>WARES:</b></p> <p>(1) Clothing, namely, caps, jackets, aprons, sweaters, belts, shirts, t-shirts, sweatshirts, overalls and jeans.</p> <p>Used in CANADA since at least as early as 1976.</p>
JACK DANIEL'S COUNTRY COCKTAILS & DESIGN	TMA483,799	October 8, 1997	<p><b>WARES:</b></p> <p>(1) Alcoholic beverages containing distilled spirits.</p>

Trade-mark	Registration No.	Registration date	Wares/Services
JACK DANIEL'S OLD NO. 7 & DESIGN 	TMA643,280	June 29, 2005	<b>WARES:</b> (1) Decorative magnets; switch plate covers.
GENTLEMAN JACK & DESIGN (Label 2007) 	TMA711,516	April 9, 2008	<b>WARES:</b> (1) Alcoholic beverages, namely whiskey.
GENTLEMAN JACK & DESIGN (Logo 2007) 	TMA708.787	March 4, 2008	<b>WARES:</b> (1) Alcoholic distilled beverages and spirits, namely whiskey.
GENTLEMAN JACK & DESIGN 	TMA484,860	October 29, 1997	<b>WARES:</b> (1) Distilled alcoholic beverages.  Used in CANADA since at least as early as June 1996.
GENTLEMAN JACK & DESIGN 	TMA465,172	October 25, 1996	<b>WARES:</b> (1) Whiskey.
JACK LIVES HERE	TMA561,620	May 9, 2002	<b>WARES:</b> (1) Alcoholic beverages namely distilled spirits.
GENTLEMAN JACK	TMA460,523	July 26, 1996	<b>WARES:</b> (1) Whiskey.
JACK DANIEL'S & Cartouche Design (Black Logo) 	TMA677,031	November 16, 2006	<b>WARES:</b> (1) Motorcycle parts.
JACK LIVES HERE	TMA562,451	May 24, 2002	<b>WARES:</b> (1) Footwear namely socks; headgear namely caps, hats, headbands, straw hats, visors, bandannas; clothing namely aprons, sleeve garters, t-shirts, golf shirts, baseball shirts, tops, tank tops, sweatshirts, sweatpants, jogging suits, pants, jackets, coats, belts, neckties, neckwear, scarves, suspenders, braces, leather jackets, rainsuits, vests, parkas, gloves, ties.

Trade-mark	Application No.	Filing date	Wares/Services
JACK DANIEL'S	1,335,194	February 13, 2007	<b>WARES:</b> (1) Barbecue sauces, marinades, steak sauces, grilling sauces.
JACK DANIEL'S & Design (Black Label 2001) 	1,255,930	April 29, 2005	<b>WARES:</b> (1) Distilled alcoholic beverages, namely, whiskey.  Used in CANADA since at least as early as January 01, 2002.
GENTLEMAN JACK BOTTLE (with 2007 label) 	1,335,196	February 13, 2007	<b>WARES:</b> (1) Alcoholic beverages; namely whiskey.
MISC. DESIGN - JACK DANIEL'S BOTTLE (w/label 2001) 	1,299,709	April 28, 2006	<b>WARES:</b> (1) Alcoholic beverages, namely whiskey