



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

Citation: 2013 TMOB 191
Date of Decision: 2013-11-06

**IN THE MATTER OF TWO OPPOSITIONS
by Brown-Forman Corporation; Jack Daniel's
Properties, Inc.; Finlandia Vodka Worldwide
Ltd.; and Sothern Comfort Properties, Inc. to
application Nos. 1,168,016 and 1,168,024 for
the trade-marks JACK DANIEL'S and
FINLANDIA, respectively, in the name of
Robert Victor Marcon**

JACK DANIEL'S - APPLICATION NO. 1,168,016

FILE RECORD

[1] On February 18, 2003, Robert Victor Marcon filed an application to register the mark JACK DANIEL'S, based on proposed use in Canada, for a number of alcoholic and non-alcoholic beverages, and for related services.

[2] The Examination Section of the Canadian Intellectual Property Office (under whose aegis this Board operates) notified the applicant of its objections to the application on the bases that (i) the applied-for mark was confusing with several registered trade-marks comprised in whole or in part of the component JACK DANIEL'S, covering alcoholic beverages, owned by Jack Daniel's Properties, Inc., (ii) some of the wares and services were not stated in sufficiently specific terms.

[3] A protracted series of communications between the applicant and the Examination Section, lasting until August 28, 2006, resulted in the applicant deleting the services and all of the wares except “electrolyte drinks.”

[4] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 15, 2009 and was opposed by Brown-Forman Corporation; Jack Daniel’s Properties, Inc.; Finlandia Vodka Worldwide Ltd.; and Sothern Comfort Properties, Inc. on May 27, 2009. The Registrar forwarded a copy of the statement of opposition to the applicant on October 1, 2009, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[5] The opponent’s evidence consists of the affidavits of David Gooder, Jeremy Shepherd, Jane Griffith, Sarah Carnegie, Joan Steele, Daniel Sterescu and Mary Noonan (two affidavits). The applicant’s evidence consists of the affidavit of Robert Victor Macron. The opponent’s reply evidence consists of the affidavit of Shirley Sereney. Both parties filed a written argument, however, only the opponent was represented at an oral hearing held on October 29, 2013.

PREVIOUS CASES INVOLVING MR. MARCON

[6] There have been a number of recently decided opposition cases involving the applicant, some of which I will review briefly, beginning at paragraph 8 below. As will be seen, the previous cases involve fact situations similar to each other and similar to the instant case. That is, in each case (i) the applied-for mark was identical to the opponent’s mark and (ii) the opponent’s evidence established that its mark was well known if not famous in Canada. The issues raised in the prior cases were (i) the applied-for mark was confusing with the opponent’s mark, pursuant to s.12(1)(d) and s.16 of the *Trade-marks Act*; the applied-for mark was not adapted to distinguish the applicant’s wares, pursuant to s.2 of the *Act*; and the applicant could not have been satisfied that he is entitled to use the mark, pursuant to s.30(i).

SUMMARY TREATMENT OF THE PRESENT CASE

[7] The legal issues raised by the opponents in the instant case and the type of evidence filed by the opponents in the instant case are the same as or analogous to the issues and evidence in prior cases involving Mr. Marcon. The legal principles that apply to the issues, and the findings of fact that can be made from the parties' evidence, have been thoroughly canvassed in the prior cases. I therefore do not see that anything is to be gained by a further detailed analysis of the evidence filed in the instant case or the legal principles that apply in the instant case. Rather, I propose to treat the instant opposition in a somewhat summary manner by merely acknowledging that the evidence

(i) demonstrates that the mark JACK DANIEL'S relied on by the opponents was, at all material times, well known if not famous in Canada for whiskey and (ii) raises doubts that the applicant had a *bona fide* intention to use the applied-for mark in Canada. Such a summary treatment is admittedly atypical of decisions ordinarily issued by this Board, however, the profusion of similar cases involving Mr. Marcon are also atypical of those ordinarily reviewed by this Board.

RECENT CASES INVOLVING THE APPLICANT

L'Oréal v. Marcon (2010) 85 CPR (4th) 381

[8] The case involved an application for the mark L'OREAL PARIS, based on proposed use in Canada, in association with vitamin supplements and aloe vera drinks. The opponent was the owner of the marks L'OREAL and L'OREAL PARIS used in Canada in association with cosmetics and perfumes.

[9] The Board summarized the first ground of opposition, alleging non-compliance with s.30(i), as follows:

The application does not conform to the requirements of section 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the " Act ") on the basis that the Applicant could not have been satisfied that he was entitled to use the Mark in Canada because the Applicant has adopted a " *modus operandi* " of filing applications for known trade-marks in identical or related fields in Canada and [sic]United States.

[10] The Board noted that on the same day that the application for L'OREAL PARIS was filed, Mr. Marcon also filed applications for the following marks: BUDWEISER; COORS; CORONA; DOM PERIGNON; BEEFEATER; FINLANDIA; HEINEKEN; JACK DANIEL'S; SENSODYNE; TIM HORTONS; ABSOLUT; and CANADIAN CLUB.

[11] The Board agreed with the reasoning in the CORONA case (see paragraphs 10-11, below) and found for the opponent on the ground of opposition pursuant to s.30(i), as well as on the issue of confusion.

Cerverceria Modelo, S.A. de C.V. v. Marcon (2008) 70 CPR (4th) 355

[12] The case involved an application for the mark CORONA, based on proposed use in Canada, in association with various non-alcoholic beverages and for alcoholic coolers. The opponent was the owner of the mark CORONA used in Canada in association with beer. This Board found that the evidence “raises suspicion about his [Mr. Marcon’s] good faith in submitting the present application.” The Board found for the opponent on the ground of opposition pursuant to s.30(i), as well as on the issue of confusion:

. . . I question how any reasonable person would be satisfied that he/she was entitled to file trade-mark applications for over 18 arguably well known marks for arguably related wares and/or services. I also question the underlying intent of such an applicant in doing so. In my view, the activity of attempting to coat-tail on the established reputation of so many well known marks should be the type of activity that s.30(i) is designed to prevent.

(emphasis added)

[13] I would add that it is quite unusual for the Board to refuse an application on the basis of non-compliance with s.30(i), as implied by the Board in the CORONA case, above, at p. 366:

. . . s.30(i) requires the applicant to indicate as part of its application that the applicant is satisfied that it is entitled to use the trade-mark in Canada in association with the listed wares and/or services . . . Where an applicant has provided the statement required by s.30(i) (i), a s.30(i) ground should only succeed in exceptional cases, such as when there is evidence of bad faith on the part of the applicant (*Sapodilla Co. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155).

(emphasis added)

Allied Domecq Spirits & Wine Ltd. v. Marcon (2009) 75 CPR (4th) 311

[14] The case involved an application for the mark BEEFEATER, based on proposed use in Canada, in association with coffee and tea. The opponent was the owner of the mark BEEFEATER used in Canada in association with alcoholic beverages including gin. Section 30(i) was not raised as a ground of opposition, rather, the opponent was successful on the issue of confusion.

[15] The Board found that the opponent's mark BEEFEATER was well known in Canada and discussed the nature of the parties' wares as follows:

On this issue of the nature of the parties' respective wares . . . , I refer to comments made by my colleague . . . 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]

[16] Similarly, in the instant case, the applicant gains little advantage in having its wares restricted to a non-alcoholic beverage.

Heineken Brouwerijen B.V. v. Marcon (2012) 105 CPR (4th) 468

[17] The case involved an application for the mark HEINEKEN, based on proposed use in Canada, in association with coffee, tea, milk and cream. The opponent was the owner of the mark HEINEKEN used in Canada in association with beer. Section 30(i) was raised as a ground of opposition, however, the Board found it unnecessary to

consider the s.30(i) ground as the opponent was successful on the issues of confusion and distinctiveness.

MHCS v Marcon, [2012] TMOB 195 (CanLII)

[18] The case involved an application for the mark DOM PERIGNON, based on proposed use in Canada, in association with nutrient drinks, coffee, tea and lemonade. The opponent was the owner of the mark DOM PERIGNON used in Canada in association with champagne. Section 30(i) was raised as a ground of opposition, however, the Board found it unnecessary to consider the s.30(i) ground as the opponent was successful on the issues of confusion and distinctiveness.

Robert Victor Marcon (Re), 2013 TMOB 50 (CanLII)

[19] The case involved an application for the mark COORS, based on proposed use in Canada, in association with various non-alcoholic beverages. The opponent was the owner of the mark COORS used in Canada in association with beer.

[20] Various grounds of opposition were pleaded including non-compliance with s.30(i):

The Opponent bases its opposition on the ground set out in Section 38(2)(a), namely, that the application does not comply with the requirements of section 30(i) in that in view of the facts contained in paragraph 2, the Applicant could not have been satisfied that it was entitled to use or register its trade-mark. In fact, the Applicant was well aware of the Opponent, the Opponent's COORS Trade-marks and registrations in Canada, and the Opponent's extensive use of its COORS Trade-marks in Canada. The Applicant is merely trying to wrongfully appropriate the Opponent's COORS Trade-marks for itself and to profit by such actions. The Opponent further notes that the Applicant has historically engaged in a pattern of similar behavior.

(emphasis added)

[21] The Board found for the opponent on the basis of s.30(i):

In my view the opponent has met its evidential burden to put into issue whether the applicant has complied with s.30(i). Further, I draw a negative inference from Mr. Marcon's refusal to explain his answer in the CORONA case that it is "fair enough" to accuse him of relying on the reputation of another person's mark. It is reasonable to suspect that he had

that same motivation in choosing the mark COORS and the other marks he has applied for. The applicant, on the other hand, has not provided any evidence to meet its legal burden to demonstrate, on a balance of probabilities, that he has complied with s.30(i). I therefore conclude that Mr. Marcon was in fact intending to rely on the reputation of the mark COORS that had already been established by the opponent. It is the type of behaviour that s.30(i) is intended to prevent.

[22] The Board would also have found for the opponent on the issue of confusion:

It is not necessary to consider the remaining grounds of opposition, however, given the acquired distinctiveness of the opponent's mark, that the opponent is the senior user of the mark COORS, that the parties' channels of trade overlap and that the marks are identical, I likely would have found for the opponent on the issue of confusion at all material times: in this regard see the analogous opposition cases *Heineken Brouwerijen B. V. v. Marcon* (2012), 105 CPR (4th) 468 and *MHCS v. Marcon* 2012 TMOB 195 (CanLII) . . .

Bowman et. al. v. Marcon, [2011] TMOB 40

[23] The above referenced unreported decision concerns Mr. Marcon's application for the same mark that is the subject of the present opposition, that is, JACK DANIEL'S. The application was based on proposed use in Canada in association with "salsa" and "barbecue sauce." The opponents in the case were the same opponents as in the present opposition.

[24] Section 30(i) was pleaded as a ground of opposition, however, as the Board found for the opponents on the issues of confusion and distinctiveness, the Board did not consider the s.30(i) ground. The Board noted at para 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.

CONCLUSION

[25] In view of the evidence of record in the present case, and in view of the precedents involving Mr. Marcon which are "on all fours" with the present case, I find for the opponents on the issues of confusion, non-distinctiveness and non-compliance with s.30(i) raised in the statement of opposition.

FINLANDIA - APPLICATION NO. 1,168,024

[26] The second opposition case involves Mr. Marcon's application for the mark FINLANDIA, based on proposed use in Canada, in association with coffee beverages and tea. The case was heard on October 29, 2013 together with the JACK DANIEL'S case discussed above. The FINLANDIA case is in all respects analogous to the JACK DANIEL'S case and to the other cases involving Mr. Marcon discussed above. That is, the opponents are relying on their identical mark FINLANDIA used in association with an alcoholic product (vodka); the opponents' evidence establishes that their mark was well known if not famous in Canada at all material times; and the evidence of record raises doubts that the applicant had a *bona fide* intention to use the applied-for mark in Canada. Accordingly, I find that the opponents succeed on the issues of confusion, non-distinctiveness and non-compliance with s.30(i) raised in the statement of opposition.

DISPOSITION OF APPLICATION NOS. 1,168,016 FOR JACK DANIEL'S AND 1,168,024 FOR FINDLANIA

[27] In view of the foregoing, the applications are refused. These decisions have been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office