



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

Citation: 2015 TMOB 73
Date of Decision: 2015-04-15

**IN THE MATTER OF AN OPPOSITION
by Viking River Cruises (Bermuda) Ltd.
to application No. 1,525,675 for the trade-
mark VIKING MEAD in the name of
GeVeMa GmbH**

FILE RECORD

[1] On April 29, 2011, GeVeMa GmbH filed an application to register the mark VIKING MEAD, based on proposed use in Canada, in association with the wares
alcoholic beverages, namely wines.

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated January 4, 2012 and was opposed by Viking River Cruises (Bermuda) Ltd. on June 4, 2012. The Registrar forwarded a copy of the statement of opposition to the applicant on June 14, 2012, as required by section 38(5) of the *Trade-marks Act*, R. C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. The opponent was granted leave on March 10, 2014 to correct a typographical error in the statement of opposition.

[3] The opponent's evidence consists of the affidavits of Torstein Hagen and David Morrison, as well as certified copies of its registered marks VIKING KD & Design; VIKING

EXPLORING THE WORLD IN COMFORT & Design; and VIKING LEGEND. The two logo marks are illustrated below:



[4] The opponent refers to its registered marks as the “VIKING Trade-marks” and I will do likewise. I note that the opponent’s VIKING Trade-marks are for use in association with travel agency services, arranging boat cruises and ancillary services.

[5] The applicant’s evidence consists of the affidavit of Katherine Lam, who was cross-examined on her affidavit. The transcript of her cross-examination forms part of the evidence of record. Only the opponent filed a written argument and only the opponent was represented at an oral hearing held on December 4, 2014.

STATEMENT OF OPPOSITION - SUMMARY

First Ground of Opposition - Section 30(i)

[6] The opponent alleges that the applicant could not have been satisfied that it is entitled to use the mark VIKING MEAD because the applicant would have been aware that the term “refers to a type of wine originating from a historic wine recipe.” The opponent further alleges that the applicant is attempting to monopolize a “generic reference to a recipe for a type of wine.”

Second Ground of Opposition - Section 12(1)(b)

[7] The opponent alleges that the applied-for mark VIKING MEAD “is clearly descriptive of a character of the associated wares as the combination ‘viking mead’ is a type of and/or recipe for a honey based wine.”

Further Grounds - Sections 12(1)(d) and 16

[8] The third, fourth and fifth grounds of opposition, pursuant to Sections 12(1)(d) and 16, turn on the issue of whether the applied-for mark VIKING MEAD is confusing with

(i) one or more of the opponent’s registered marks (see para. 3, above), and

(ii) one or both of the opponent's marks VIKING RIVER CRUISES and VIKING previously used in Canada in association with cruise services "extending to wine tasting events and excursions to wine regions as well as VIKING brand cocktails and alcoholic beverages," and
(iii) one or both of the opponent's trade-names Viking River Cruises (Bermuda) Ltd. and Viking River Cruises.

Sixth Ground of Opposition - Section 2

[9] The last ground of opposition alleges that the applied-for mark is not distinctive and cannot function as a trade-mark in view of the opponent's above assertions.

[10] The last ground, as pleaded, is derivative of the other grounds and does not stand alone. Presumably, the applied-for mark VIKING MEAD cannot function as a trade-mark if it is clearly descriptive and cannot be distinctive of the applicant's wares if it is confusing with the opponent's marks.

[11] Before addressing the grounds of opposition, I will review the evidence submitted by the parties, the evidential burden on the opponent and the legal onus on the applicant.

OPPONENT'S EVIDENCE

Torstein Hagen

[12] Mr. Hagen identifies himself as the Chairman of the opponent company. The opponent is the world's leading river cruise company and operates a fleet of 30 river cruising vessels along the rivers of Europe, as well as Russia, Egypt, China and other countries. The opponent company was founded in 1997 and has continuously expanded its business to include additional routes and vessels. Its present fleet of 30 vessels provide about 5,000 passenger berths. Throughout its history, the opponent has won numerous awards for the services it provides.

[13] The opponent uses its VIKING Trade-marks as well as the mark VIKING and VIKING RIVER CRUISES in association with alcohol products and services offered to cruise customers. The opponent also operates its business under the trade-names Viking River Cruises (Bermuda) Ltd. and Viking River Cruises.

[14] Mr. Hagen refers to the opponent's "various VIKING Trade-marks and trade names" collectively as the opponent's "Viking brand" and states that the Viking brand has been used continuously in Canada since the year 2000. The opponent's cruise customers may purchase a number of Viking brand alcohol products including vodka, a cocktail, wine and beer. Further, at paragraph 17 of his affidavit, Mr. Hagen emphasises the opponent's connection to wine:

Wine and wine-making is such an important part of the VIKING cruising and dining experience that the company has its own vintner, located in Austria's Wachau Valley, who produces the distinctive and exclusive VIKING private-label wines. Viking is the only cruise line in the world with its own wine maker, and the wines produced exclusively for Viking are served to customers on board VIKING vessels to be paired with the cuisine created by VIKING chefs . . .

[15] Since 2007, over 28,000 Canadians have purchased river cruise packages from the opponent. Annual revenues from "sales of Viking's products and services to Canadians" was about \$5.4 US million in 2007 rising steadily to over \$41.9 US million in 2012. The opponent advertises its VIKING brand through newspapers, brochures, flyers, radio, television, magazines, e-mail and the Internet. The annual spending to advertise "Viking brand products and services in Canada" averaged about \$340,000 US for the period 2008-2010 inclusive, and about \$1.85 million US for the two year period 2011-2012.

[16] Mr. Hagen expresses the opponent's concerns with the applied-for mark VIKING MEAD in paragraph 26 of his affidavit:

In view of our long history of use and significant reputation in the VIKING brand in Canada for our cruise services and products, including alcohol products, alcoholic beverages and other alcohol-related services, we are very concerned that the trade-mark VIKING MEAD will be confusing for our Canadian customers who are accustomed to seeing our VIKING brand used in association with such products and will assume we have sponsored or endorsed such products, when we have not. (my emphasis)

[17] In my view, claiming a long history of use and a significant reputation for the VIKING brand in Canada for "alcoholic beverages and other alcohol-related services" is somewhat overreaching. From my review of Mr. Hagen's testimony and the exhibits attached to his affidavit, it appears to me that it is more accurate to say that the VIKING brand has a significant reputation in Canada for river cruise services (the cruises taking place outside of Canada), but

not for any other goods or services. Although the Viking brand has a significant reputation in Canada for cruise services, it does not follow that it has an equal reputation for any other goods or services. In my view the opponent's evidence does not establish that the VIKING brand has any more than some reputation in Canada for alcohol products, alcoholic beverages and other alcohol-related services. That lesser reputation derives from Canadians having experienced VIKING cruises abroad, where Canadian cruise customers would have been exposed to some use of the VIKING brand in association with alcohol products, alcoholic beverages and alcohol related services. The evidence does not establish that the opponent's VIKING Trade-marks have acquired any reputation from use of the VIKING brand for alcohol products, alcoholic beverages and other alcohol-related services in Canada.

David Morrison

[18] Mr. Morrison identifies himself as a student-at-law employed by the firm representing the opponent. His affidavit serves to introduce into evidence, by way of exhibits, materials collected from dictionaries and Internet searches, summarized below:

Exhibits 1 - 14

[19] The materials include various dictionary definitions for the words "viking" and "mead." Viking refers to Scandinavian seafaring pirates and traders who raided and settled in parts of northwest Europe in the 8th to 11th centuries. Mead refers to an alcoholic fermented drink made from honey and water.

Exhibits 15 - 24

[20] The materials consist of print-outs from webpages located by searching the phrase "viking mead." The exhibits include an explanation of the beverage mead from Wikipedia, shown below, as well as various recipes for making mead:

Mead . . . , also called honey wine, is an alcoholic beverage that is produced by brewing a solution of honey and water. It may also be produced by brewing a solution of water and honey with grain mash, which is strained after fermentation. Depending on local traditions and specific recipes, it may be flavored with spices, fruit, or hops (which produce a bitter, beer-like flavor). The alcoholic content of mead may range from about 8% ABV to 18%. It may be still, carbonated or naturally sparkling, and it may be dry, semi-sweet or sweet . . . It can be regarded as the ancestor of all fermented drinks . . . antedating the cultivation of the soil.

Exhibits 25 - 34

[21] The materials consist of print-outs from webpages located by searching the phrase “viking mead recipe.” The exhibits include historical background about mead, its connection to the Vikings, and recipes for making mead.

[22] Some of the exhibit materials particularly germane to the second ground of opposition are discussed below:

Exhibit 19 - The document is titled “Authentic Ancient Viking Mead Ale Recipe from Norse Force.” It is a recipe for a “type of mead . . . made by the Vikings during their take over[sic] of Britian[sic] and Ireland.” The recipe includes various ingredients including honey and water.

Exhibit 20 - The document is titled “Make your own Viking Mead.” It is a recipe for “traditional” mead requiring only honey, water, yeast and yeast nutrient.

Exhibit 21- The document is titled “Halfdan’s Viking Mead Recipe.” It refers to mead as a honey wine. The recipe calls for various ingredients including honey and water.

Exhibit 23 - The document is an article titled “Viking Mead with Mandy.” It describes home brewing two batches of mead, as an experiment with different ingredients. The first batch is referred to as Viking Mead.

APPLICANT’S EVIDENCE

Katherine Lam

Affidavit

[23] Ms. Lam identifies herself as a paralegal employed by the firm representing the applicant. In April, 2013, she (1) called the telephone number appearing on the opponent’s website and was advised that the opponent (i) does not have an office in Canada, and (ii) does not operate any cruise vessels in Canada; (2) attended at the Liquor Control Board of Ontario in Mississauga where she was advised that although mead was sold on the premises, there was no product known as “Viking Mead” sold by the Liquor Control Board of Ontario.

[24] Exhibit B of her affidavit provides some historical information concerning the beverage mead namely, that prior to the 14th century it was an alcoholic drink common in northern Europe where grapevines do not flourish.

Cross-Examination

[25] Ms. Lam confirmed that she would have been able to book a cruise with the opponent, by phone, had she wished to do so. The premises she attended (see para. 23, above) was a Liquor Control Board retail store, where she observed a mead product available on the shelves.

EVIDENTIAL ONUS AND LEGAL BURDEN

[26] In accordance with the usual rules of evidence, there is an evidential burden on the opponent to prove the facts inherent in the allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. There is also a legal onus on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponents in the statement of opposition (for those allegations for which the opponents have met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion, based on the usual civil balance of probabilities standard, cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

First Ground

[27] An allegation based on section 30(i) is established by showing that the applicant has acted in bad faith or fraudulently or is in non-compliance with a Federal statute: see, for example, *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB) at 155 and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (FCTD).

[28] In the instant case, the opponent supports its allegation by pleading that the applicant was aware that the term VIKING MEAD refers to a type of wine. However, even if the opponent could establish such knowledge by the applicant (which the opponent has not done), that circumstance, by itself, does not preclude the applicant from genuinely and accurately making the statement required by section 30(i) that the applicant was satisfied that it was entitled to use the mark: see, for other circumstances inadequate to support section 30(i), *Lorillard, Inc. v. Fabriques de Tabac Reunies S.A.* (1990), 30 CPR(3d) 406 at p. 408 (TMOB); *Taverniti S.A.R.L. v. D.G.G.M. Britton Holdings Inc.* (1986), 8 CPR(3d) 400 at pp. 404-405 (TMOB).

[29] Accordingly, the first ground is rejected because the opponent has not pleaded sufficient facts to support a ground of opposition based on section 30(i).

Second Ground

[30] The opponent addresses the second ground of opposition at paras. 71-73 of its written argument, which deal with the legal principles pertaining to section 12(1)(b), and at paras. 74-76, which deal with the factual support for the allegation that the applied-for mark is clearly descriptive of the applicant's goods namely, wines:

71. Paragraph 12(1)(b) of the Act provides that a trade-mark is not registrable if it is clearly descriptive or deceptively misdescriptive of a character or quality of the wares in association with which it is sought to be registered, or the conditions of or the persons employed in their production or their place of origin. The registrability of a trade-mark pursuant to s. 12(1)(b) is to be assessed as of the date the application for registration was filed.

Fiesta Barbecues Ltd. v General Housewares Corp. (2003), 28 CPR (4th) 60 (FCTD)

72. The question of whether a mark is clearly descriptive or deceptively misdescriptive is to be assessed from the point of view of the average purchaser of the wares associated with the purported trade-mark, as a matter of first impression. "Character" means a feature, trait or characteristic of the product and "clearly" means easy to understand, self-evidence, or plain.

Atlantic Promotions Inc. v Registrar of Trade-marks (1984), 2 CPR (3d) 183 (FCTD)

73. Moreover, in determining whether a trade-mark falls afoul of paragraph 12(1)(b), the Opposition Board must not only take into account the available evidence filed in the proceeding, but must also apply its own common sense, recognizing that the test is one of first impression, considered in light of the product in question.

Ontario Teachers' Pension Plan Board v Canada (Attorney General)
(2010), 89 CPR (4th) 301 (FC), affd (2012), 99 CPR (4th) (FCA)

74. Dictionary definitions for the words "Viking" and "mead" entered into evidence in this proceeding indicate that "Viking mead" would be understood by Canadians as being an alcoholic beverage relating to or characteristic of the Vikings.

Morrison Affidavit at para 2 and Exhibits 1-14.

75. These dictionary definitions alone are sufficient to establish that the VIKING MEAD trade-mark is clearly descriptive of a type and/or recipe for a honey-based wine, i.e., a Viking-style mead.

76. In any event, the evidence in this proceeding further shows that the beverage mead is closely associated with the history and culture of the Vikings. Numerous internet articles show the availability to Canadians of recipes for or information concerning such "Viking meads".

Morrison Affidavit at Exhibits 16-34.

77. It can therefore be inferred that Canadian consumers would easily understand that the Applicant's wares are of a style or prepared according to a recipe for a "Viking mead".

[31] I agree with the opponent's above submissions regarding the relevant legal principles. I also find that the opponent's evidence is sufficient to put into issue whether the average consumer, seeing the term VIKING MEAD used in association with wine, would understand that the wine has certain characteristics or traits of wine made by following historic Viking recipes. The applicant, for its part, has not filed evidence to address the issue under section 12(1)(b), has not filed a written argument and did not appear at the oral hearing. Accordingly, there is no basis for me to find that the applicant has met its legal onus with respect to showing the applied-for mark VIKING MEAD is not clearly descriptive of wines. The opponent therefore succeeds on the second ground of opposition.

Further Grounds

[32] As the opponent has succeeded on the ground of opposition alleging that the applied-for mark is clearly descriptive, it is not necessary for me to decide the grounds of opposition where confusion between the applied-for mark and the opponent's marks (and trade-names) are in issue. However, it appears to me unlikely that the opponent would have succeeded on the issue of confusion. In this regard, it should be noted that when the opponent refers to its "Viking brand" used in association with alcoholic beverages, it is referring to alcoholic beverages offered

to cruise customers under the opponent's various marks and trade-names (its VIKING brand) rather than the mark VIKING *per se* (see paras. 3, 4 and 17, above). For the most part, the opponent's marks (and trade-names), considered in their entireties, do not closely resemble the applied-for mark and, as mentioned in para. 17 above, the opponent has not established a significant reputation for its "Viking brand" used in association with alcoholic wares or related services in Canada. Thus, a consideration of the factors in section 6(5) would likely have led to the conclusion that the applied-for mark is not confusing with one or more of the opponent's marks or trade-names.

DISPOSITION

[33] As the opponent has succeeded on the second ground of opposition, the subject application is refused. This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under section 63(3) of the *Trade-marks Act*.

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