



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

Citation: 2013 TMOB 50
Date of Decision: 2013-03-27

**IN THE MATTER OF AN
OPPOSITION by Coors Brewing
Company to application No. 1,168,021
for the trade-mark COORS in the name
of Robert Victor Marcon**

FILE RECORD

[1] On February 18, 2003, Robert Victor Marcon filed an application to register the trade-mark COORS, based on proposed use in Canada, in association with the following wares and services:

wares

water, still water, mineral water, spring water, aerated water, carbonated water, sparkling water, ice water, iceberg water, ice, crushed ice, juices, flavoured drinks, nutrient drinks, non-alcoholic beverages, beers, coolers, spritzers.

services

bottling, warehousing, distribution, marketing, advertising, sales training, sales, graphic designs.

[2] On November 4, 2003, the Examination Section of the Canadian Intellectual Property Office (“CIPO,” under whose aegis this Board operates) notified the applicant of its objections to the subject 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 COORS, owned by Coors Brewing Company, (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 resulted in the applicant deleting the services and some wares, including beers, coolers and spritzers from the application. The remaining wares were amended to read as follows:

packaged drinking water; non-alcoholic fruit juices, and mixtures thereof; vegetable juices and mixtures thereof; lemonade; non-alcoholic fruit flavoured drinks; carbonated soft drink beverages; sports drinks; non-alcoholic coffee based beverages; grain or chicory based coffee substitutes; and tea, herb tea and herbal tea.

[4] The application as amended was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 18, 2009 and was opposed on December 23, 2009 by Coors Brewing Company, the owner of the marks initially cited by the Examination Section. The Registrar forwarded a copy of the statement of opposition to the applicant on February 4, 2010, 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 (which the applicant refers to as a “Statement of Response”) generally denying the allegations in the statement of opposition.

[5] The opponent’s evidence, filed on July 29, 2010, consists of the affidavits of Aline Labaki; Versona Zaremba; Lori Ball; Jill Roberts; Marisa Hood; and certified copies of the originally filed application and revised application which is the subject of this proceeding. The applicant’s evidence, filed on November 29, 2010, consists of the affidavit of the applicant Robert Marcon. The opponent requested, and was granted, an order requiring Mr. Marcon to appear for cross-examination, which was conducted on June 22, 2011. The transcript of cross-examination and exhibits thereto form part of the evidence of record. The opponent’s reply evidence, filed on August 22, 2011, consists of a further affidavit of Jill Roberts. Both parties filed a written argument, however, only the opponent was represented at an oral hearing.

STATEMENT OF OPPOSITION

[6] The opponent pleads that it is the owner of a family of Canadian trade-mark registrations and applications which includes the marks COORS, ORIGINAL COORS, and COORS LIGHT covering the wares beers (and promotional items). The opponent has

also used COORS as a trade-name to carry on business in Canada. The opponent further pleads that it has had extensive sales of its beer in Canada in association with its COORS marks.

[7] Various grounds of opposition are pleaded, a number of which allege that the applied-for mark COORS for use in association with the wares specified in the subject application is confusing with the opponent's trade-mark COORS. Based on the grounds of opposition pleaded, the earliest material date to consider the issue of confusion is the date of filing of the application, that is, February 18, 2003, and the latest material date is the date of my decision.

[8] The opponent also alleges, at paragraph 3(a) of the statement of opposition, shown below, that the application contravenes s.30(i) of the *Trade-marks Act*:

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)

[9] For ease of reference, s. 30(i) is reproduced below:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing

.

(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the wares or services described in the application.

OPPONENT'S EVIDENCE

Aline Labaki

[10] Ms. Labaki identifies herself as a student-at-law employed by the firm representing the opponent. Her affidavit serves to introduce into evidence various exhibits including:

Exhibit A

[11] A copy of a statement of opposition filed by Cerverceria Modelo, S.A. de C.V. against trade-mark application No. 1,168,019 for the mark CORONA, filed in the name of the present applicant Robert Victor Marcon, covering wares similar to the wares specified in the subject application. As in the instant case, the application as initially filed included beer in the wares.

[12] The statement of opposition pleads that on the same day that Mr. Marcon applied for the mark CORONA, he also applied for numerous other marks including ABSOLUT; HEINEKEN; FINLANDIA; BEEFEATER; CANADIAN CLUB; COORS; BUDWEISER; JACK DANIEL'S; and DOM PERIGNON all specifying wares similar to the wares specified in the instant application.

[13] I believe I may take judicial notice that various third parties have established significant reputations in Canada for the above-mentioned marks in association with alcoholic beverages.

Exhibit C

[14] A copy of the opposition case *Cerverceria Modelo, S.A. de C.V. v. Marcon* (2008), 70 CPR (4th) 355 concerning Mr. Marcon's application for the mark CORONA, referred to above. I note that the opposition succeeded on the allegations that the application was not in compliance with s.30(i) and that the applied-for mark was confusing with Cerverceria Modelo's mark CORONA. The Board's discussion of s.30(i) is of particular interest:

at p. 365

Although the applicant's original application was not filed as evidence in the present proceedings, given that the relevant date for s. 30(i) is the date of filing of the application, and that an application must be considered in order to assess formal compliance with s.30(i) at such date, I consider it both relevant and necessary to review the contents of the original application.

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), 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).

at p. 369

I am not aware of any jurisprudence that describes what "bad faith" is in the context of s.30(i). While I am not sure whether this term applies in the present circumstances, 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)

Versna Zaremba

[15] Ms. Zaremba identifies herself as a legal assistant employed by the firm representing the opponent. Her affidavit serves to introduce into evidence, by way of exhibits, 24 trade-mark applications (for a variety of wares and services) filed on or before April 19, 2010 in the name of Robert Victor Marcon. Those marks include, for example, BAYER; CHANEL; EVIAN; L'OREAL PARIS; NESCAFÉ ; NESTLÉ; NUTRADENT; SENSODYNE; SOUTHERN COMFORT; and TIM HORTONS.

[16] I believe I may take judicial notice that various third parties have established significant reputations in Canada for the above-mentioned marks applied for by Mr. Marcon. Not surprisingly, the evidence shows that the above-mentioned applications in the name of Mr. Marcon have been abandoned or opposed or refused.

Lori Ball

[17] Ms. Ball identifies herself as a senior executive with Molson Canada 2005 ("Molson"). Molson is one of the oldest brewing companies in Canada. Coors Brewing Company ("Coors") has been brewing alcoholic beverages in the USA for over 130 years. COORS brand beer has been sold in Canada since 1985 by way of a license granted to Molson to brew, distribute, promote and sell the COORS brand of beer in Canada, including COORS brand and COORS LIGHT brand. Coors is the owner of the various Canadian trade-mark registrations relied on in the statement of opposition.

Molson has sold the COORS brand of beer through distribution agencies such as The

Beer Store and LCBO stores in Ontario; through Brewers Distribution Ltd. in the Western provinces; through grocery and convenience stores in Quebec and other provinces; as well as through pubs, restaurants and taverns. Since 1990, the volume of COORS brand beer sold annually in Canada has never been less than 700,000 hectolitres – one hectolitre is equivalent to 293 bottles of beer (341 ml size). From the mid-1990s to 2004, the estimated cost for advertising and promoting COORS beer in Canada was in excess of \$10 million annually.

Jill Roberts

[18] Ms. Roberts identifies herself as an assistant bailiff in Ottawa. She was retained by the firm representing the opponent to attend at retail locations in Quebec and in Ontario to determine whether beer, and in particular COORS beer, was available in the same retail outlets as drinking water, fruit juices fruit and vegetable juices, lemonades, carbonated soft drinks and various types of tea and coffee drinks.

[19] In July of 2010 Ms. Roberts attended at a Quickie Dépanneur (in Quebec); a Super C Grocery Store (in Quebec); Mulligan's Grocery Store (in Ontario); and Innisville Ultramar (in Ontario). The Quickie Dépanneur sold COORS beer as well as the types of beverages specified in the subject application. The Super C store sold COORS beer as well as the types of beverages specified in the subject application. Mulligan's Grocery Store is a convenience store/beer store and LCBO outlet store. The store has one main entrance and to access the beer, liquor and wine, one would walk through the convenience store area to the back of the store. The store sold COORS beer as well as the types of beverages specified in the subject application. The Innisville Ultramar store also sold COORS beer as well as the types of beverages specified in the subject application.

Marissa Hood

[20] Ms. Hood identifies herself as a law clerk employed by the firm representing the opponent. Her affidavit serves to introduce into evidence, by way of exhibit material, (i) copies of the trade-mark registrations relied on by the opponent in the statement of opposition, (ii) copies of the third party registrations for marks that Mr. Marcon had applied for as discussed in paragraph 15, above.

APPLICANT'S EVIDENCE

Robert Marcon - Affidavit

[21] Mr. Marcon's affidavit serves to introduce into evidence, by way of exhibit material, (i) copies of the opponent's trade-mark registrations, (ii) printouts from various websites indicating that the term "Coors" is a surname, (iii) copies of Canadian trade-mark jurisprudence, (iv) copies of various registered trade-marks, standing in the name of more than one owner, for several well-known marks such as BARBIE, TRIUMPH, CORONA, and APOLLO, and (v) material filed en liasse "regarding Applicant's past commercial activities regarding previously applied for trade-marks."

[22] As noted by the opponent at paragraphs 65 and 66 of its written argument, the applicant's evidence does not address the issue of confusion raised by the opponent in the statement of opposition, nor does the evidence show that the applicant commenced use of the applied-mark COORS at any material time.

Robert Marcon - Transcript of Cross-Examination

[23] At cross-examination, Mr. Marcon admits that he was aware of the opponent's trade-mark COORS used in association with beer, and that he chose it, and other marks, because they "sound good" (p.87, line 9-29, Q. 464-466).

[24] A portion of page 83 of the transcript of cross-examination is shown below:

- 441 Q. . . . Actually, before we that, just, ah -- yeah -- actually, let's proceed with page number 35 of the Corona transcript. Its question 189, do you see that?
- A. Yes, I do.
- 442 Q. And the question is -- Question: "You were basically trying to get as close as you possibly can to a well-established trade-mark. And my submission to the trade-mark's office will be that you are doing it with the intention of relying on a reputation that has already been established?" Answer: "Fair enough." Did I read that correctly?
- A. Yes, you did.
- 443 Q. And was that -- that was your evidence then, and it has not changed?
- A. That is not part of the evidence which I submitted, so I respectfully decline to answer.

[25] Mr. Marcon is of course correct that question 443, above, does not relate to evidence he has submitted in the instant case. However, the question does relate to evidence submitted by the opponent and may elucidate his choice for the subject mark COORS.

OPPONENT'S REPLY EVIDENCE

Jill Roberts

[26] Ms. Robert's affidavit provides some evidence that, in Ontario, COORS LIGHT; BUDWEISER; HEINEKEN and CORONA are among the ten top selling brands of beer.

CONSIDERATION OF THE S.30(I) GROUND OF OPPOSITION

[27] At paragraph 92 of its written argument the opponent notes that this Board came to the following conclusion *Cerverceria Modelo* case, above, at p. 68:

In view that Mr. Marcon admitted that he was familiar with CORONA beer when he filed his application for CORONA for various beverages including beer, and in view of his understanding that confusion would not occur unless someone is using the identical trade-mark on an identical product, it appears that Mr. Marcon understood that it was inappropriate for him to file the present application for beer.

[28] Mr. Marcon in his written argument in the instant case appears to be providing the same rationale to defend his actions that was rejected by the Board in *Cerverceria Modelo*, namely, (i) that he is not in violation of s.30(i) because the wares in the instant case have been amended to exclude alcoholic beverages, and (ii) confusion would not occur because the amended wares do not include alcoholic beverages.

[29] 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. The opponent therefore succeeds on the ground of opposition alleging non-compliance with s.30(i).

[30] 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) where Mr. Marcon's applications for the marks HEINEKEN and DOM PERIGNON, respectively, for use in association with non-alcoholic beverages, were refused on a finding of confusion with the opponent's marks HEINEKEN and DOM PERIGNON, respectively.

DISPOSITION

[31] In view of the foregoing, the application is refused. This decision has 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.