



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 87**

**Date of Decision: 2021-05-10**

**IN THE MATTER OF AN OPPOSITION**

**Montobacco Ltd.**

**Opponent**

**and**

**Marley Green LLC**

**Applicant**

**1,706,251 for MARLEY NATURAL**

**Application**

THE RECORD

[1] On December 8, 2014, the applicant Marley Green LLC (the Applicant) filed an application under No. 1,706,251 (the Application) to register the trademark MARLEY NATURAL (the Mark), based on proposed use in Canada in association with a range of goods and services including “medical marijuana” and “retail stores services in the field of confection, medical cannabis...”. A full list of the applied for goods and services is set out in Schedule A of this decision.

[2] The Application was advertised for opposition purposes in the *Trademarks Journal* issue dated December 7, 2016, and on May 8, 2017, Montobacco Ltd. (the Opponent) filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Opponent has pleaded grounds of opposition under sections 30(a), 30(e), 30(g), 30(i) and 2 of the Act. As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act

which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[3] On June 23, 2017, the Applicant filed and served a counter statement denying the grounds of opposition.

[4] In support of its opposition, the Opponent filed the affidavits of Michael Duchesneau and Karen Allen. The Applicant requested and received an order for the cross-examination of Mr. Duchesneau and Ms. Allen. However, the Opponent failed to make these affiants available for cross-examination. In view of this failure, the Duchesneau and Allen affidavits were deemed no longer part of the record pursuant to section 44(5) of the *Trademarks Regulations*.

[5] In support of the Application, the Applicant filed the affidavit of Dane Penney, sworn December 10, 2018. Mr. Penney is employed as a trademark search specialist by the agent for the Applicant. He searched for a number of terms in the Canadian Intellectual Property Office's Goods and Services Manual, namely: cigarettes, hemp, cordials, tinctures, capsules, patches, candy, and retail services. The search results are attached as Exhibit A. Mr. Penney was not cross-examined.

[6] Neither party filed a written argument or attended a hearing.

#### THE PARTIES' RESPECTIVE BURDEN OR ONUS

[7] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

ANALYSIS OF THE GROUNDS OF OPPOSITION

**Grounds of opposition under section 30 - summarily dismissed**

[8] The Opponent has not met its initial burden with respect to the grounds of opposition based on sections 30(a), 30(e), 30(g), and 30(i) of the Act.

[9] The material date for considering a ground of opposition under section 30 of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475].

[10] The Opponent has pleaded that contrary to section 30(a), a number of the goods and services are not “statements in ordinary commercial terms of the specific goods or services” in association with which the Mark was proposed to be used. However, no evidence or argument was filed by the Opponent in support of this ground of opposition.

[11] The Opponent has pleaded that contrary to section 30(e), as of the filing date of the Application, the Applicant did not, by itself or through a licensee, or by itself and through a licensee, intend to use the Mark in Canada. However, no evidence or argument was filed in support of this ground of opposition.

[12] The Opponent has pleaded that contrary to section 30(g), the address for the Applicant listed in the Application, namely 360 Madison Ave., New York, NY 10017, USA, is not the address of the Applicant’s principal office or place of business. However, no evidence or argument was filed in support of this ground of opposition.

[13] The Opponent has pleaded that contrary to section 30(i), the Applicant could not have been satisfied that it was entitled to use the Mark in association with the listed goods and services since:

- such use would contravene section 8(1) of the *Narcotic Control Regulations* since the Applicant is not, nor is eligible to become, a licensed dealer pursuant to section 8.2 thereof. Such use would also contravene section 18(1) of the *Access to Cannabis for*

*Medical Regulations*, which prevents marijuana being sold or provided with any additives or in any dosage form (such as in a roll or capsule);

- at the time of filing the Application, the Applicant knew, or should have known, that the Mark was confusing with one or more of the NATURAL MARLEY SPIRIT trademarks that the Opponent had registered and/or applied to register in other jurisdictions and in which the Opponent had developed a substantial goodwill and reputation;
- at the time of filing of the Application, the Applicant knew, or should have known, that the use of the Mark in association with the listed goods and services in Canada would constitute passing off contrary to paragraph 7(b) and/or (c) of the Act and/or at common law.

[14] Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to use the trademark in Canada, as has been done by the Applicant in this case. With respect to the third prong of opposition advanced under section 30(i), setting aside the question of which subsections of section 7 can be combined with section 30(i) to form a valid ground of opposition, the Opponent has not filed any evidence or argument to support this ground of opposition. With respect to the second prong advanced under section 30(i), I note that mere awareness of prior rights alleged by an opponent, which has not been established in this case, does not preclude an application from truthfully making the statement required by section 30(i) of the Act [*Woot, Inc v WootRestaurants Inc*, 2012 TMOB 197]. With respect to the first prong of opposition advanced under section 30(i), the Opponent has not filed any evidence or argument to support this ground of opposition.

[15] Accordingly, as the Opponent has not met its evidential burden, these grounds of opposition are summarily dismissed.

### **Ground of opposition under section 2 – summarily dismissed**

[16] The Opponent has pleaded that the Mark is not distinctive and does not actually distinguish nor is it adapted to distinguish the goods and/or services of the Applicant from the goods and/or services of the Opponent in view of the Opponent's goodwill and reputation in the

NATURAL MARLEY SPIRIT Trademarks (which include the trademark NATURAL MARLEY SPIRIT and other trademarks comprised of, or including, NATURAL MARLEY SPIRIT).

[17] The material date to assess this ground of opposition is the filing date of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

[18] There is an initial burden on the Opponent to establish that as of the filing of the opposition, the Opponent's trademarks were known to a sufficient extent that could negate the distinctiveness of the applied-for Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427]. To do so, the Opponent must establish that its trademarks are either known to some extent in Canada or are well known in a specific area of Canada [*Bojangles, supra* at paras 33-34]. In this case, the Opponent has filed no evidence demonstrating the extent to which the Opponent's trademarks have become known in Canada. As the Opponent has failed to meet its evidential burden, this ground of opposition is summarily dismissed.

#### DISPOSITION

[19] In view of the above, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Jennifer Galeano  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**Hearing Date:** No hearing held

**Agents of Record**

No Agent of Record

FOR THE OPPONENT

Bereskin & Parr LLP

FOR THE APPLICANT

## SCHEDULE A

Goods and services listed in the Application:

### Goods:

(1) Medical marijuana, pre-rolls, namely, medical marijuana cigarettes, hemp, medical cannabis; oils, namely, made from marijuana, hemp and cannabis for medicinal purposes, tinctures, capsules, and skin patches containing medical marijuana, hemp, and medical cannabis; cosmetic and beauty care preparations for skin, body and hair care, namely, face and body lotions and face creams, body wash, soaps, hair shampoo and body scrubs; chocolate; chocolate bars; confectionery, namely, bakers' confections, namely, sweet pastries, cakes, cookies and brownies, and candy confection, namely, chocolates, chewing gum, rock sugar, sweetmeats, sugar paste, and other confections that are made primarily of sugar, namely, fruit jelly candy, peppermint candy, toffee candies, chocolate candies; food flavorings; essences for nutritional purposes, except essential essences and oils, namely, essences extracted from plants and flowers, namely, non-alcoholic cordials for dilution; sauces, namely, marinades, hot sauce, grilling sauces, barbecue sauces, chocolate sauces, caramel sauces, strawberry sauces; granola-based snack bars; smoking accessories, namely, vaporizer pipes, smoking pipes, tobacco filters, electronic cigarette refill cartridges sold empty, grinders, tobacco pouches, ashtrays; health products containing marijuana, hemp, and cannabis, namely, non-medicated and medicated topical creams and preparations for use on the lips and skin for the treatment of anxiety, sleeplessness and aches and pains.

### Services:

(1) Retail store services in the field of confection, medical cannabis, smoking preparation tools, smoking accessories, beauty care products and body care products, medical marijuana and smoking accessories, namely, vaporizer pipes, smoking pipes, tobacco filters, electronic cigarette refill cartridges sold empty, grinders, tobacco pouches and storage, ashtrays, hemp lighters, and trays, metallic cones for the burning and consumption of medical marijuana, cosmetics, personal care products, namely, face and body lotions and face creams, after-shave lotions, hair shampoos, hair lotions, hair spray, salves, lip balm, sunscreen, after-sun care, hand sanitizer, bar soap, liquid soap, face wash, food; marijuana dispensary services for medical purposes.