



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2022 TMOB 215

**Date of Decision:** 2022-11-07

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Taylor Fladgate & Yeatman (Malta) Limited

**Applicant:** Sazerac North America, Inc.

**Application:** 1,675,063 for OLD TAYLOR

### **INTRODUCTION**

[1] The Opponent Taylor Fladgate & Yeatman (Malta) Limited opposes the registration of the Applicant Sazerac North America, Inc.'s trademark OLD TAYLOR, for use in association with whiskey. The Opponent asserts several grounds of opposition including that the applied for trademark is confusing with the registered trademark TAYLOR FLADGATE, registered for use in association with port wine.

[2] For the following reasons, the opposition is rejected. On the evidence of record, I find on a balance of probabilities that the applied for trademark is not confusing with the registered trademark TAYLOR FLADGATE. As for the other grounds of opposition, the Opponent has failed to meet the initial evidential burden required to support these grounds.

## **FILE RECORD**

[3] The application was filed on April 30, 2014 and is based on use in Canada since at least as early as 1887 in association with whiskey.

[4] The application was advertised for opposition on August 9, 2017 and was opposed on January 24, 2018. In accordance with section 70 of the *Trademarks Act*, R.S.C. 1985 c. T-13 (the Act), the grounds of opposition will be dealt with in accordance with the provisions of the Act as they read immediately before June 17, 2019.

[5] The grounds of opposition are:

- the application does not comply with the requirements of section 30(b) of the Act because the applied for trademark was not used in Canada by the Applicant since the claimed date of first use (the “Prior Use Claim Ground”);
- the application does not comply with the requirements of section 30(i) of the Act because the Applicant could not have been satisfied it was entitled to use the applied for trademark. In particular, the use of the trademark is contrary to section 22 of the Act and is likely to have the effect of depreciating the value of the goodwill attached to the registered trademark TAYLOR FLADGATE (TMA354,399) (the “Section 30(i) Ground”);
- the applied for trademark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the registered trademark TAYLOR FLADGATE (TMA354,399) (the “Registrability Ground”); and
- the applied for trademark is not distinctive of the Applicant having regard to section 2 of the Act because it does not, and is not adapted to, distinguish the Applicant’s whiskey from the goods and services of others, particularly the port wine of the Opponent sold in association with the trademark TAYLOR FLADGATE (the “Distinctiveness Ground”).

[6] While the Opponent did submit three affidavits and a statutory declaration in support of its opposition, it failed to produce the affiants and the declarant for cross-

examination, pursuant to the Opposition Board's order for cross-examination. Accordingly, the Opponent's affidavits and statutory declaration are not in evidence.

[7] The Applicant submitted the affidavit of Nathan Simpson, a law clerk with the Applicant's trademark agents. Mr. Simpson's affidavit provides the following:

- copies of the particulars of four trademark registrations, for trademarks containing the word "Taylor";
- copies of web pages depicting various alcoholic beverages that appear to be associated with names containing the word "Taylor" at liquor stores, including provincially owned liquor stores, in Canada; and
- printouts from Wikipedia, 411.ca, canada411.ca and the Government Electronic Directory Service showing lists of people having the given name or surname "Taylor".

[8] Both parties submitted written arguments with only the Applicant attending the oral hearing.

### **GROUND OF OPPOSITION SUMMARILY REJECTED**

[9] Most of the Opponent's grounds of opposition can be summarily rejected because they are not supported by evidence. There is an initial evidential burden on an opponent to provide sufficient evidence that the facts alleged in support of the opposition are true [*John Labatt Ltd v Molson Cos* (1993), 30 CPR (3d) 293 at 298 (FCTD)]. An applicant need not respond to grounds of opposition for which an opponent's initial burden has not been met.

[10] With regard to the Prior Use Claim Ground, the Section 30(i) Ground and the Distinctiveness Ground, it is clear that the initial evidential burdens for these grounds have not been met because the Opponent has no evidence on which to rely. Further, there is nothing in the Applicant's evidence which puts the Applicant's use claim, statement that it was satisfied it was entitled to use the applied for trademark, or the applied for trademark's distinctiveness in issue. The Applicant need not respond to

these grounds of opposition, since the Opponent's initial evidential burden has not been met. Accordingly, these grounds are rejected.

### **SECTION 12(1)(D) GROUND OF OPPOSITION**

[11] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[12] With regard to the Registrability Ground, the Opponent's initial evidential burden is met if the registration upon which it relies is extant at the date of this decision. I have exercised my discretion to check the register to confirm that the registration of TAYLOR FLADGATE (TMA354,399) for use in association with port wine remains extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial evidential burden for the section 12(1)(d) ground of opposition.

[13] The Applicant must now satisfy the Registrar, on a balance of probabilities, that the Registrability Ground should not prevent registration of the trademark at issue [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD)]. The question is whether, on a balance of probabilities, there is a reasonable likelihood of confusion between the applied for trademark OLD TAYLOR and the registered trademark TAYLOR FLADGATE. For the following reasons, I find there is not.

### ***Test for Confusion***

[14] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods ... associated with those trademarks are manufactured ... by the same person...

[15] Thus, the issue is confusion of goods from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether the average consumer of whiskey, sold in association with the trademark OLD TAYLOR, would believe that this whiskey was produced or authorized or licensed by the makers of TAYLOR FLADGATE port wine.

[16] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two trademarks are confusing, are “all the surrounding circumstances” including those specifically mentioned in section 6(5) of the *Act*: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

***Inherent Distinctiveness and Extent to which the Trademarks have Become Known***

[17] The Opponent’s trademark TAYLOR FLADGATE appears to consist solely of a person’s name or the surnames of two people. I accept that TAYLOR is a fairly common given name and surname in Canada, based on the Wikipedia entry and directory search results provided by Mr. Simpson (Exhibits 93,95,97). As for FLADGATE, while there is no evidence of record as to the meaning of this word, its use in conjunction with the name TAYLOR may suggest to the average consumer it is a person’s surname.

[18] In the absence of evidence of the contrary, since the trademark TAYLOR FLADGATE appears to consist solely of names, it has a low degree of inherent distinctiveness [*Glaskoch B. Koch Jr GmbH & Co KG v Anglo Canadian Mercantile Co* 2006 Carswell Nat 5362 (TMOB)].

[19] The applied for trademark also consists of a name along with the adjective “OLD”. While the applied for trademark is not *solely* a name, I do not find that the adjective “OLD” contributes substantially to the inherent distinctiveness of the trademark.

[20] As for the extent to which the trademarks have become known in Canada, neither party has submitted any evidence of use or promotion of their respective trademarks, or other evidence suggesting that their trademarks have become known in Canada to any extent.

[21] Therefore, the inherent distinctiveness and extent to which the trademarks have become known favours neither party.

### ***Degree of Resemblance Between the Trademarks***

[22] I find the degree of resemblance between the trademarks to be fairly low. Considering the trademarks as a whole, they are fairly different in both appearance and sound. The single common element appears at different places within the trademark (as the first word in the Opponent’s registered trademark, and as the second word in the applied for trademark). Furthermore, the additional elements of each trademark (OLD vs FLADGATE) cause the trademarks as a whole to be substantially different in both appearance and sound.

[23] Further, both trademarks suggest dissimilar ideas. While the Opponent’s trademark suggests either an individual named “Taylor Fladgate” or a partnership of two people with the surnames “Taylor” and “Fladgate”, the applied for trademark is suggestive of an “old” person having either a given name or a surname “Taylor”.

[24] The Opponent asserts that both trademarks suggest individuals having the *given* name “Taylor”, and argues that this distinguishes these trademarks from other “Taylor” trademarks on the register, which suggest the *surname* “Taylor”. However, there is no evidence of record to establish that either of the trademarks suggest *only* the given name “Taylor” and not the surname “Taylor”. And even if there was such evidence, it

would not assist the Opponent, since the evidence also establishes that the given name “Taylor” is common in Canada, and is not entitled to a wide ambit of protection.

[25] In view of the foregoing, I find that the low degree of resemblance between the trademarks favours the Applicant.

### ***Length of Time in Use***

[26] Neither party has provided evidence of any use of their respective trademarks in Canada. In the absence of evidence of continuous use of either trademark, the length of time the trademarks have been in use in Canada is not a material circumstance even though use is claimed in the application and the registration [*Advance Magazine Publishers Inc v Brunswick Corporation*, 2022 TMOB 42 at para 21; *Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951; and *Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

### ***Nature of the Goods, and the Trade***

[27] The parties’ goods are related in that both are types of alcoholic beverages. Furthermore, the Simpson Affidavit shows that different types of alcoholic beverages are sold at provincially owned liquor stores across Canada. This suggests that port wines and whiskey could both be found in the same stores. In view of the related nature of the goods and the fact that the channels of trade in which they move likely overlap, I find that these factors favour the Opponent.

### ***Surrounding Circumstance: State of the Register and Marketplace***

[28] The state of the Register or marketplace evidence in the Simpson Affidavit does not favour the Applicant.

[29] Mr. Simpson attaches four registrations for trademarks containing the name “Taylor” for use in association with different types of alcoholic beverages. Mr. Simpson also attaches nearly ninety exhibits constituting web pages purporting to show various alcoholic beverages available for purchase from liquor stores across Canada. These alcoholic beverages are each offered in association with a trademark containing the name “Taylor”. The Applicant argues that this evidence shows nine trademarks

containing the name “Taylor” co-existing on the market for alcoholic beverages in Canada (Applicant’s Written Submissions, para 27).

[30] I find that four registrations are not sufficient to draw inferences as to the commonality of the name “Taylor” in trademarks for alcoholic beverages in Canada. Since a significant number of pertinent registrations have not been located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 1992 CanLII 14792 (FCA), 43 CPR (3d) 349 (FCA)], the state of the register does not favour the Applicant. With respect to the state of the marketplace evidence, I do not find that this evidence significantly assists the Applicant since the web pages do not establish the extent to which Canadian consumers were aware of the Taylor products identified in Mr. Simpson’s searches. Therefore, I am unable to conclude that there is common use of the component TAYLOR such that I can infer that consumers are accustomed to distinguishing between trademarks including this component by paying more attention to the differences between them [*Advance Magazine Publishers Inc. v Farleyco Marketing Inc. Eyeglasses* 2009 FC 153 at para 78].

### ***Jurisprudence Concerning Weak Trademarks***

[31] The jurisprudence concerning weak trademarks favours the Applicant. Comparatively small differences will suffice to distinguish between weak trademarks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 2001 FCT 1024, 15 CPR (4th) 345 (FCTD) at para 66]. In *Provigo Distribution Inc v Max Mara Fashion Group SRL* (2005), 2005 FC 1550, 46 CPR (4th) 112 at para 31 (FCTD), de Montigny J. explained:

The two trademarks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...



[32] Further, a party adopting a weak trademark has been held to accept some risk of confusion [*General Motors v Bellows* (1949), 1949 CanLII 47 (SCC), 10 CPR 101 at 115-116 (SCC)]. While the scope of protection afforded a mark increases it has acquired distinctiveness, there is no such evidence here with respect to the Opponent's trademark TAYLOR FLADGATE.

### ***Conclusion Regarding Confusion***

[33] In assessing all of the surrounding circumstances of this case, including those listed in section 6(5) of the Act, I find that on a balance of probabilities that there is no reasonable likelihood of confusion between the trademarks. While the nature of the goods and trade overlaps, the common occurrence of the name "Taylor" as a given name and surname in Canada and the fairly low degree of similarity between the trademarks makes it unlikely that consumers will infer that the parties' products emanate from the same source.

### **DISPOSITION**

[34] 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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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2022-10-18

## **APPEARANCES**

**For the Opponent:** No one appearing

**For the Applicant:** Mark Evans

## **AGENTS OF RECORD**

**For the Opponent:** Riches, McKenzie & Herbert LLP

**For the Applicant:** Smart & Biggar LP