



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2024 TMOB 152

Date of Decision: 2024-08-21

IN THE MATTER OF AN OPPOSITION

Opponent: Chatam International Incorporated

Applicant: Beam Suntory UK Limited

Application: 1938142 for BARTENDER'S MALT

INTRODUCTION

[1] This is an opposition brought by Chatam International Incorporated (the Opponent) in respect of application number 1,938,142 for the trademark BARTENDER'S MALT (the Mark) filed by Beam Suntory UK Limited (the Applicant).

[2] The Mark is applied for in association with the following goods:

CI 33 (1) Alcoholic beverages, except beer, namely, whiskey

[3] For the reasons set out below, I reject the opposition.

THE RECORD

[4] The application for the Mark was filed on December 27, 2018 and was advertised for opposition in the *Trademarks Journal* of April 6, 2022.

[5] On October 6, 2022, the Opponent filed its statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T 13 as amended June 17, 2019 (the Act). The Opponent bases the opposition on the following sections of the Act: 38(2)(b) (confusion with registered trademarks), 38(2)(c) (non-entitlement to registration), 38(2)(d) (non-distinctiveness), 38(2)(e) (no use or proposed use), 38(2)(f) (non-entitlement to use) and two grounds based on section 39(2)(a.1) (bad faith).

[6] The Applicant filed a counterstatement denying the grounds of opposition.

[7] In support of its opposition, the Opponent filed the affidavit of Deborah Lecourt, an assistant for the Opponent's agent, sworn June 1, 2023 (the Lecourt Affidavit).

[8] The Applicant submitted a notice advising that it would not be filing evidence in the proceeding.

[9] No cross-examination was conducted.

[10] Neither party filed written representations and no hearing was held.

OVERVIEW OF THE EVIDENCE

[11] The Lecourt Affidavit contains a description of two searches conducted by Ms. Lecourt in the Canadian Intellectual Property trademark database and attaches as exhibits the full particulars of the application for the Mark and full details of registration no.TMA589,435 for the trademark ORIGINAL BARTENDERS COCKTAILS owned by the Opponent (the Opponent's Mark).

EVIDENTIAL BURDEN AND LEGAL ONUS

[12] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded

in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FC)]. 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 admissible evidence from which it could reasonably be concluded that the facts alleged to support that the issue exists [*John Labatt* at 298].

[13] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

ASSESSMENT OF THE GROUNDS OF OPPOSITION

Dismissed Grounds of Opposition

[14] As noted above, there is an initial evidential burden on the Opponent for each ground of opposition that must be met in order for the analysis to shift to the legal onus on the Applicant.

[15] For each of the two grounds of bad faith (section 38(2)(a.1), and each of the grounds raised under sections 38(2)(c) (non-entitlement to registration), 38(2)(d) (non-distinctiveness), and 38(2)(e) (no use or proposed use), the Opponent has failed to file any evidence that would enable it to meet its evidential burden for these grounds. Accordingly, these grounds of opposition are dismissed.

Section 38(2)(b) and 12(1)(d) Ground of Opposition

[16] The Opponent pleads that the Mark is not registrable as it is confusing with the Opponent's Mark which was previously registered in Canada. The

Opponent's Mark was registered on September 10, 2003 in association with "Prepared alcoholic cocktails".

[17] The relevant date for this ground of opposition is the date of my decision [*Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd*, (1991), 37 CPR (3d) 413 (FCA)].

[18] An opponent's initial burden is met with respect to a section 12(1)(d) ground of opposition if the registration relied upon remains in good standing as of the date of the opposition decision. I have exercised my discretion to check the register and confirm that the registration for the Opponent's Mark remains extant [see *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has satisfied its evidential burden for this ground. I must now assess whether the Applicant has met its legal burden.

[19] In determining whether two trademarks are confusing, all the surrounding circumstances should be considered, including those listed 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 the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks, 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 at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the degree of resemblance between the marks, will often have the greatest effect on the confusion analysis.

[20] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the applicant's mark, at a time when they have no more than an imperfect recollection of the opponent's trademark, and do not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot*, para 20].

Inherent Distinctiveness and Extent Known

[21] In my view, both the Mark and the Opponent's Mark are at least highly suggestive of the associated goods as both trademarks describe an alcoholic beverage provided by or associated with a bartender. Therefore, the trademarks of both parties have low inherent distinctiveness.

[22] Neither party has filed evidence of the extent their respective trademarks are known in Canada.

[23] Accordingly, neither party is favoured by this factor.

Length of Time in Use

[24] Neither party filed evidence of use of their respective trademarks in Canada.

[25] While the Opponent's Mark is registered in Canada and claims a date of first use of since at least as early as August 1998 in the registration, the mere existence of a registration only gives rise to an inference of *de minimus* use. This *de minimus* use alone is insufficient to give rise to an inference of significant and continuous use in Canada [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB), *Tokai of Canada Ltd v Kingsford Products Company, LLC*, 2018 FC 951 at para 36].

[26] Accordingly, neither party is favoured by this factor.

Nature of the Goods or Business/Nature of the Trade

[27] As the Mark is associated with “Alcoholic beverages, except beer, namely, whiskey” and the Opponent’s Mark with “Prepared alcoholic cocktails”, there is obviously the potential for overlap in the nature of the parties’ goods.

[28] Noting the absence of evidence regarding the parties’ businesses or trades, given the potential overlap in the nature of the parties’ goods, there is also at least potential for overlap in the nature of the parties’ businesses or trades.

[29] Accordingly, this factor favours the Opponent.

Degree of Resemblance

[30] When considering the degree of resemblance, the trademarks at issue must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece*, para 64].

[31] Given that both trademarks are comprised of common English words and are at least suggestive of the associated goods, I find that neither trademark has an element that is particularly striking or unique – it is each of the trademarks as a whole that is what is unique to each.

[32] While the trademarks share the element BARTENDERS/BARTENDER’S (sounded the same whether in possessive or plural form), the MALT element is not present in the Opponent’s Mark, and neither the first element of the Opponent’s Mark, ORIGINAL, nor the COCKTAILS element are present in the

Mark. In my view, this causes the trademarks to be more different than alike in all of appearance, sound, and idea suggested.

[33] Overall, I find this factor favours the Applicant, but only slightly.

Additional Circumstances – Suggestive and Descriptive Trademarks

[34] As noted under the Inherent Distinctiveness factor above, both the Mark and the Opponent's Mark are at least highly suggestive, if not descriptive, of the associated goods.

[35] It has been consistently held that trademarks comprising descriptive or suggestive words are only entitled to a narrow ambit of protection. The reason for this is that a greater degree of discrimination may fairly be expected from the public where a trademark consists wholly or partly of words describing the associated goods, such that relatively minor differences may suffice to avert confusion [*General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL)].

[36] Accordingly, I am of the view that the Opponent's Mark should be afforded a very narrow scope of protection given that it is at least highly suggestive of the associated goods. I also consider, despite the fact that the trademarks at issue share the common word BARTENDERS/BARTENDER'S, that the overall differences between the trademarks constitute more than "minor" differences which would allow the public to readily distinguish the trademarks on first impression and imperfect recollection.

[37] This is therefore an additional circumstance that favours the Applicant.

Conclusion in Respect of Confusion

[38] Having considered all of the surrounding circumstances, I find that the Applicant has met its legal onus with respect to the likelihood of confusion

between the parties' trademarks. I reach this conclusion due to the degree of resemblance factor favouring the Applicant as well as the inherent weakness of the Opponent's Mark warranting only a narrow scope of protection, and notwithstanding the overlap in the general nature of the parties' goods and potential overlap in the nature of the parties' businesses and trades.

[39] This ground of opposition is therefore rejected.

Section 38(2)(f) Ground of Opposition

[40] The Opponent has pleaded that the Applicant is not entitled to use the Mark in Canada with the goods set out in the application for the Mark as such use is likely to cause confusion in Canada with the Opponent's Mark.

[41] The material date for this ground of opposition is the date of filing of the application.

[42] I note that section 38(2)(f) does not address an applicant's entitlement to register the mark relative to another person's trademark. Instead, this section addresses an applicant's lawful entitlement to use the trademark, for example, in compliance with relevant federal legislation and other legal obligations prohibiting "use" of the trademark within the meaning of section 4 of the Act [see *Methanex Corporation v Suez International, société par actions simplifiée*, 2022 TMOB 155]. Accordingly, this ground is not properly pleaded and can be dismissed on this basis.

[43] In any event, even if I were to consider this a properly pleaded ground, as with the section 12(1)(d) ground above, the basis for this ground as pleaded rests on the allegation of confusion between the trademarks of the parties. Given that the earlier material date for this ground does not affect my conclusion in respect of confusion set out above, I find this ground of opposition unsuccessful.

DISPOSITION

[44] 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.

Leigh Walters
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Riches, Mckenzie & Herbert LLP

For the Applicant: Gowling WLG (Canada) LLP