

2) *No Postponement of Scheduled Hearings*

The TMOB will no longer grant postponements of scheduled hearings, even on the basis of consent between the parties and/or on the basis of settlement negotiations. After the hearing has been scheduled and if the parties agree that they no longer wish to be heard, the TMOB will proceed to issue a final decision for the proceeding. Notwithstanding the foregoing, the TMOB may discontinue the proceedings upon receipt of a request signed by or on behalf of both parties.

Notably, however, the foregoing does not prevent the party or parties that requested a hearing to cancel the hearing (if both parties requested the hearing, it will only be cancelled if both parties consent to the cancellation). If a hearing is cancelled, the TMOB will proceed to issue a decision, except in cases where the Section 45 Proceeding has been discontinued on consent or the Registrant has abandoned the subject registration.

The TMOB had initially proposed amendments that would (1) allow the TMOB to issue a final decision to maintain, amend, or expunge the registration without the benefit of the parties' written representations or oral submissions where the TMOB was satisfied that the evidence filed by a registrant "clear on its face"; and (2) allow the TMOB to issue a decision to maintain, amend, or expunge the registration even if the ultimate hearing was cancelled by the requesting party and registrant on consent. However, after consideration was given to the submissions made by the public and practitioners during the consultation period, the TMOB did not include these proposals in the final Practice Notice that was placed into effect on 14 September 2009.

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Does use of the word 'Glen' imply a whisky is Scotch?

Glenora Distillers International Ltd. filed an application to register the trade mark GLEN BRETON in association with "single malt whisky" in 2000. Since the term "Scotch whisky" is a protected geographical designation in Canada pursuant to Section 11.12 of the Trade-marks Act,¹ Glenora is not permitted to call its brand of whisky "Scotch". However, Glenora markets its product as having the taste, character, and aroma of a Scotch whisky.

Hafeez Rupani reports.



Hafeez Rupani

The Scotch Whisky Association opposed Glenora's application for the trade mark GLEN BRETON. The Association contended that the trade mark GLEN BRETON is deceptively misdescriptive because Glenora's whisky is not made in Scotland, unlike all other whiskies whose corresponding registered trade mark contains the GLEN prefix. The Association also argued that the adoption and use of the trade mark GLEN BRETON is prohibited under Section 10 of the Act since the term "glen" has, by ordinary and bona fide commercial usage, become recognized in Canada as designating the place of origin of "Scotch whisky".

The Trade-marks Opposition Board² rejected the Association's opposition and found that although there was evidence of "glen"-prefixed marks used by Scotch whisky distillers, such use was not widespread enough to have created an association in the

minds of consumers in Canada between the word "glen" and Scotch whiskies. Accordingly, the TMOB found that the term "glen" had not become recognized through "ordinary and bona fide commercial usage" as designating the geographical origin of whisky, and was not a prohibited mark pursuant to Section 10 of the Act.

On appeal to the Federal Court³, the Association filed new evidence showing that in the year 2000, some 896,607 cases of Scotch whisky were imported into Canada, of which the "Glen" single malts amounted to close to 59% of all single malts imported into Canada. Justice Harrington for the Federal Court also considered that a "glen"-prefixed mark had not been used in Canada in association with a whisky that was not a Scotch whisky. Moreover, Justice Harrington found that there was (1) actual confusion in the marketplace in that some consumers were not aware that Glenora's product was not a Scotch distilled in Scotland; and (2) that such confusion was due to the use of a "glen"-prefixed mark and that the word "glen" had, by ordinary and bona fide commercial usage, become recognized in Canada as designating Scotch whisky, and was therefore a prohibited mark pursuant to Section 10 of the Act. On this basis, the Federal Court directed the Registrar of Trade-marks to refuse Glenora's application to register the trade mark GLEN BRETON.

On appeal to the Federal Court of

Appeal⁴, Justice Sexton for the Court found that the Federal Court made an error of law by failing to consider whether the word “glen”, having only previously been used as part of various registered trade marks, is in fact a “mark” within the meaning of Section 10 of the Act. In this regard, Justice Sexton was of the view that there was no evidence that would justify a finding that the term “glen” alone was a mark. Moreover, Justice Sexton was of the view that the word “glen”, standing alone, had never been used as a trade mark in Canada for any product, although “glen” has been used as a prefix for many trade-marks associated with Scotch whisky, such as Glenfiddich, Glenmorangie, and Glenlivet.

While the Federal Court of Appeal found that the term “mark”, as it appears in Section 10 of the Act, is broader than the term “trade mark”, the Federal Court of Appeal was of the view that a segment of a trade mark could not stand alone as a mark, particularly given the principle that trade marks should generally not be dissected and analyzed syllable by

syllable. Accordingly, Justice Sexton held that the word “glen” had not been shown to constitute a “mark” within the meaning of Section 10 of the Act, and therefore could not be prohibited. Alternatively, Justice Sexton held that even if “glen” could be considered a mark and was prohibited, “glen” did not dominate the trade mark GLEN BRETON when the mark is considered as a whole.

In view of the above, while conceding that this case was an unusual case under Section 10 of the Act, Justice Sexton stated that success in the appeal by the Association would jeopardize the trade marks of many of the Association’s own members by the Association seeking to establish a monopoly over the word “glen”, which Justice Sexton found not to be “inherently descriptive” [inherently distinctive] for a group of traders, particularly since it is not clear that any of the Association’s members incorporated the word “glen” into their respective trade marks for the purpose of designating their whiskies as being from Scotland. Accordingly, the Federal Court of Appeal allowed

Glenora’s appeal and directed the Registrar of Trade-marks to allow Glenora’s application to register the trade mark GLEN BRETON.

While the Association filed an application for leave to appeal the decision of the Federal Court of Appeal to the Supreme Court of Canada, the Association’s leave application was dismissed with costs by the Supreme Court on 11 June 2009.

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- ¹ R.S.C. 1985, c. T-13, as am.
- ² Scotch Whisky Association v. Glenora Distillers International Ltd. (2007), 2007 CarswellNat 1037, 2007 CarswellNat 1485 (T.M.O.B.).
- ³ Scotch Whisky Association v. Glenora Distillers International Ltd. (2008), 2008 FC 425, 65 C.P.R. (4th) 441 (F.C.).
- ⁴ Scotch Whisky Association v. Glenora Distillers International Ltd. (2009), 2009 FCA 16, 385 N.R. 159 (F.C.A.).

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