



WHISKY TRADE-MARK “ON THE ROCKS”

ALEXANDRA STEELE^{*}
LEGER ROBIC RICHARD, LLP
LAWYERS, PATENT & TRADEMARK AGENTS

In a case opposing the Scotch Whisky Association and a Canadian distiller of whiskey, the Federal Court of Canada reversed the Registrar’s decision allowing the trade-mark GLEN BRETON to be registered in association with single malt whisky. The Court found that through commercial usage, the word “glen” had become recognized in Canada as designating the place of origin of the whisky, namely Scotland, and so the trade-mark GLEN BRETON could not be registered in association with Canadian made whisky. [*Scotch Whisky Association v. Glenora Distillers International Ltd.*, 2008 FC 429, Harrington J., April 3, 2008]

The Facts

Glenora Distillers International Ltd., (“Glenora”), distills its single malt whisky in Cape Breton, Nova Scotia. It applied for the registration of the trade-mark GLEN BRETON for its single malt whisky.

The Scotch Whisky Association (the “Association”) opposed the registration on the basis that the word “glen” was clearly descriptive or deceptively misdescriptive of the place of origin of the wares, that the word “glen” was recognized in Canada as designating whiskies originating from Scotland, thus that the use of GLEN BRETON as a trade-mark would likely mislead the consuming public, and finally, that the trade-mark was not distinctive of Glenora.

In light of the evidence adduced before the Trade-Marks Opposition Board, the Registrar concluded that the Canadian consumers of whiskies would not associate the word “glen” solely with “scotch whisky”, or whisky originating from Scotland. The Registrar found that the average Canadian consumer, upon seeing the trade-mark, could be under several impressions, such as that GLEN BRETON is the name of a person, or that the whisky is distilled in a “glen”, i.e. valley, somewhere in Cape Breton, or that the mark is merely suggestive of Scotland for those with knowledge of

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^{*} Lawyer, Alexandra Steele is a member of LEGER ROBIC RICHARD, L.L.P., a multidisciplinary firm of lawyers, and patent and trademark agents. Published in the June 2008 issue of the *World Intellectual Property Report*. Publication 142.214.

LEGER ROBIC RICHARD, L.L.P.
1001 Square-Victoria - Bloc E - 8th floor
Montreal (Quebec) Canada H2Z 2B7
Tel.: (514) 987-6242 Fax: (514) 845-7874
www.robic.ca info@robic.ca

whisky. Moreover, the Registrar concluded that the word “glen” was not distinctive, as it forms part of many other registered trade-marks.

The Registrar therefore dismissed the opposition and the the Association appealed the Registrar’s decision to the Federal Court of Canada.

The Federal Court Judgement

On appeal, the parties adduced additional evidence. The Court concluded that, had the Registrar had before it this additional evidence, it would have allowed the opposition.

In this judgement, Justice Harrington first proceeded to describe and identify the various known types of whiskies, such as Scotch whisky, which originates solely from Scotland, and malt whisky, which is either single or a blend, and which can originate from various countries, including Canada. He also proceeded to define the meaning of the word “glen” a it is generally understood and more particularly in association with whisky.

The Court concluded that the word “glen” was not strongly descriptive, as it forms part of the common English language to describe a valley. It can also serve as a given name or as a surname. He further concluded that in the year 2000, when Glenora applied for its trade-mark GLEN BRETON, the word “glen” was used principally in association with Scotch whisky, i.e. whisky that originates solely from Scotland. In light of the evidence, the Court was satisfied that GLEN BRETON was not registrable, as by its ordinary and *bona fide* commercial usage in Canada, it had become recognized as designating the place of origin of the wares.

The Court also discussed the Association’s argument that the trade-mark GLEN BRETON was deceptively misdescriptive of the place of origin of the wares, and of the character or quality of same. Justice Harrington dismissed this argument. The Court also dismissed Glenora’s argument that the word “glen”, as a prefix or a stand alone word, was not exclusively associated with the sale of Scotch whisky in Canada. Justice Harrington writes that the ultimate question comes down to assessing confusion in the marketplace: the test to be applied is that of first impression in the mind of a casual consumer somewhat in a hurry, purchasing a bottle of whisky at a liquor store, or a glass at a bar. The Court found that there was sufficient evidence in the marketplace of actual confusion between Glenora’s Canadian made whisky sold under the trade-mark GLEN BRETON and the various Scotch whiskies also bearing the word “glen” products. Justice Harrington concluded that that the ultimate consumer who thought that he or she was ordering Scotch single malt whisky would never know it was being served a Canadian made GLEN BRETON single malt whisky.

The Court therefore found in favour of the Association since the evidence showed that the word “glen” had long been used in Canada for whiskies originating solely from Scotland, to the exclusion of all others. The Court therefore directed the Registrar to refuse Glenora’s trade-mark application.

Conclusion

The use over time of a common word can lead this word to acquire a distinctive character when used in a particular context. Although the word “glen” is a word of the English language, in Canada specifically, it has been come recognized as indicating Scotch whiskies, thus preventing Canadian distillers from using this word in association with identical products. This case therefore serves to remind trade-mark owners that caution and care should always be exercised in all circumstances of use of a trade-mark, as such use will inevitably delineate the scope of protection afforded to the trade-mark.



