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LESSONS TO BE LEARNED FROM OTHER BREWERS' TRADEMARK FIGHTS

As a craft brewer, you know the importance of choosing a unique name for your brewery and your beer. Those names are how your customers find you, talk about you, and help you develop a customer base that sustains your business and your passion. However, coming up with a name is no easy task, and it is getting more and more difficult as the brewing industry booms.

There are now estimated 130 craft brewers in British Columbia^[1] and over 600 in Canada^[2]. That means thousands of trademarks for beer and related goods and services are in the marketplace. To help you understand more about trademarks, a vital part of your business, here is a quick recap of two trademark decisions from 2016 involving large beer producers.

1. No registration for Coors Brewing's mark STONES because of Anheuser-Busch^[3]

Coors Brewing Company applied to register the mark STONES for beer and was opposed by Anheuser-Busch, LLC on several grounds including that STONES was confusing with Anheuser-Busch's registered STONE'S marks for wines and ROLLING ROCK marks for alcoholic brewery beverages.

Despite that STONES and ROLLING ROCK are used for identical or nearly identical products, the Trademarks Opposition Board (the "Board") did not think that the public would confuse one with the other mainly because the marks have little resemblance when viewed as a whole.

On the other hand, the Board found that the following factors favored a finding of a likelihood of confusion between STONES for beer and STONE'S for wines:

- there is a potential overlap in the goods because wine producers can also produce beers;
- the marks STONES and STONE'S are similar in appearance and sound; and
- there are other registered marks containing STONES, which means that Coors Brewing does not have monopoly over the use of STONES in the alcoholic beverage sectors.

Takeaway: Do **not** pick a name that appears or sounds too similar to an existing mark for brewery, beer or even wine. In fact, there have been other cases in Canada where marks for alcoholic beverages were considered confusingly similar to marks for non-alcoholic beverages as well as restaurant services.^[4] So if



your proposed mark is similar to another mark already used in association any food/beverage related goods or services, you may need to consider a different mark altogether.

2. Registration of Banks DIH's mark BANKS partially cancelled^[5]

Banks DIH Ltd. is the owner of the mark BANKS for "beer, ale and larger", registered in Canada on November 15, 1991. On July 17, 2014, at the request of a party, the Trademarks Registrar issued a Section 45 notice to Banks asking Banks to show use of the mark in Canada with association with each of the goods listed, i.e. beer, ale and larger, between July 17, 2011 and July 16, 2014.

In the trademark world, "use" with respect to goods generally means that the trademark is marked on the goods or on their packaging at the time the goods are sold in a commercial setting.^[6]

In order to establish use, Banks provided product labels with the mark BANKS, product flyers and advertisements showing products bearing the mark BANKS, photographs of actual BANKS products sold at stores, invoices evidencing sales of BANKS products, etc. However, the Board found that the evidence only demonstrated the sale of larger in Canada. As evidence with respect to one good cannot be used to maintain other registered goods, the Board canceled the registration for "beer" and "ale".

Takeaway: If you registered your mark for A, B, C, D and E, then you need to continue using the mark for A, B, C, D and E in order to maintain your rights in the mark for all of the products.

^[1] One The Coast, *B.C. Craft Beer Scene Set to Grow in 2016, Says Beer Columnist* (posted Jan 5, 2016), <http://www.cbc.ca/news/canada/british-columbia/bc-craft-beer-2016-1.3390711>.

^[2] OBN Staff, *How Many Breweries in Canada? New Stats Out* (published Jun 25, 2015) <http://www.momandhops.ca/how-many-breweries-are-in-canada-new-stats-released/>.

^[3] *Anheuser-Busch, LLC v Coors Brewing Company*, 2016 TMOB 85.

^[4] *Aykroyd v. Brew Brothers Coffee Corp.*, (1997) 83, C.P.R. (3d) 230 (TMOB), *Prime Restaurants Inc. v. Pacific Vision Proprietary Ltd.*, 2014 TMOB 9

^[5] *Gowling Lafleur Henderson LLP v Banks DIH Ltd.*, 2016 TMOB 128.



RICHARDS
BUELL
SUTTON^{LLP}
Established in 1871

^[6] *Trade-marks Act, R.S.C., 1985, c. T-13, s. 4(1).*



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