

Federal Court



Cour fédérale

**Date: 20140708**

**Docket: T-1678-12**

**Citation: 2014 FC 664**

**Ottawa, Ontario, July 8, 2014**

**PRESENT: The Honourable Mr. Justice Roy**

**BETWEEN:**

**JACK BLACK L.L.C.**

**Applicant**

**and**

**THE ATTORNEY GENERAL OF CANADA**

**Respondent**

**JUDGMENT AND REASONS**

[1] This is an appeal of a Registrar of Trade-marks' decision dated July 9, 2012, rejecting Trade-mark application No 1,459,921 to register the trade-mark JACK BLACK [the Trade-mark]. The appeal is pursuant to section 56 of the *Trade-marks Act*, RSC, 1985, c T-13 [the Act].

[2] The applicant seeks an order setting aside the Registrar's decision and directing that the registration of the Trade-mark be approved.

[3] For the reasons that follow, the Court concludes that the applicant is entitled to the remedy sought.

I. Facts

[4] The facts of this case are not disputed by the parties. Indeed, the respondent did not take issue with the new evidence adduced by the applicant on this appeal. The Court did not have the benefit of arguments about evidence, its admissibility or sufficiency to support the conclusion reached by the Registrar, or the materiality and weight that carried the new evidence adduced by the applicant on this appeal.

[5] The trade-mark application that gave rise to the negative decision of July 9, 2012 was made on November 20, 2009. The application concerns the following wares:

1. Sun block preparation, sun screen preparation, skin emollient, skin lotions, hand creams, skin moisturizer and non-medicated lip balm; after-shave lotions; shaving balms; bath gels; shaving gels; shower gels; facial lotions; face and body and wrinkle removing skin care preparations; antiperspirants, personal deodorants, hair styling preparations, body lotions, hair pomades, skin soaps, perfumes; skin cleansing lotions; colognes; eye creams; shaving creams; skin creams; facial scrubs; shaving lotions; body powder; body scrubs; shampoo; hair conditioner; non-medicated acne treatment preparations; non-medicated bath preparations; non-medicated bath salts.

2. Sun block preparation, sun screen preparation, skin emollient, skin lotion, hand creams, skin moisturizer and non-medicated lip balm.
3. After-shave lotions; shaving balms; bath gels; skin cleansing lotions; colognes; eye creams; shaving creams; skin creams; facial scrubs; bath gels; shaving gels; shower gels; skin lotions; facial lotions; shaving lotions; skin cleansing lotions; face and body and wrinkle removing skin care preparations.

[6] An application to register the trade-mark JACK BLACK AUTHENTIC AND ORIGINAL DESIGN was made in 2004. It seems that this application was permitted to become abandoned by the applicant.

[7] However, the Trade-mark has been used in Canada for much longer than the date of application for registration. The respondent does not dispute for the purpose of this case that the JACK BLACK mark has been used in Canada since January 2002. The trade-mark JACK BLACK appears to have been used in the United States [US] since some time in 1999 and an application to register that trade-mark in the US was made on June 17, 1999. The applicant claims in new evidence before this Court that the name was coined without any knowledge of anyone having the name Jack Black.

[8] The Trade-mark has been registered in a number of countries around the world. The applicant claims in that new evidence that there has not been any complaint or challenge in connection with its registration of the Trade-mark, including from anyone whose name would be “Jack Black”, and including the actor by that name. It would appear that the only resistance to

the registration came from the Registrar of Trade-marks and that the objection was raised *proprio motu*.

[9] Finally, the new evidence shows that the skin care products have been sold and advertised in large-circulation magazines in North America. The products are also available for sale online from well known, and high end, retailers. To put it another way, the evidence before this Court is to the effect that the products are not new and that they benefit from a fairly large circulation.

## II. Decision

[10] Following the application for registration, there were numerous exchanges between the applicant and the Registrar (through an examiner). The initial reaction came on March 9, 2010: the objection to registration was then based on paragraphs 9(1)(k) and 12(1)(a) of the Act. These paragraphs read as follow:

### **Prohibited marks**

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

...

(k) any matter that may falsely suggest a connection with any living individual;

...

### **When trade-mark**

### **Marques interdites**

9. (1) Nul ne peut adopter à l'égard d'une entreprise, comme marque de commerce ou autrement, une marque composée de ce qui suit, ou dont la ressemblance est telle qu'on pourrait vraisemblablement la confondre avec ce qui suit :

...

k) toute matière qui peut faussement suggérer un rapport avec un particulier vivant;

...

### **Marque de commerce**

**registrable**

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

...

**enregistrable**

12. (1) Sous réserve de l'article 13, une marque de commerce est enregistrable sauf dans l'un ou l'autre des cas suivants :

a) elle est constituée d'un mot n'étant principalement que le nom ou le nom de famille d'un particulier vivant ou qui est décédé dans les trente années précédentes;

...

[11] With respect to the application of paragraph 9(1)(k), the examiner suggested that the mark was not “registrable since JACK BLACK is an internationally renowned actor, comedian and musician.” That would remain the objection the Registrar had for the registration. A mark that cannot be adopted pursuant to section 9 cannot be registered (para 12(1)(e)). Similarly, the mark could not be registered, in the view of the examiner, under paragraph 12(1)(a) because “this application is considered to be primarily the name of a famous living individual.”

[12] The applicant made submissions with respect to those objections on August 23, 2010. Indeed, there were further submissions on January 13, 2011, November 21, 2011 and January 27, 2012. Following the August 23, 2010 submissions, the Registrar's objection based on paragraph 12(1)(a) was withdrawn. The applicant claims that it is because of the recognition on the part of the Registrar that the Trade-mark JACK BLACK does not satisfy the test of being primarily merely the name of an individual who is living, the actor Jack Black. That left the objection made pursuant to paragraph 9(1)(k), which was the subject of the numerous submissions that followed.

[13] The applicant argued that the assessment to be made under paragraph 9(1)(k) of the Act must be made at the time the trade-mark was adopted. In this case, the trade-mark was adopted in 1999, in the US and, in the applicant's contention, the actor did not have a significant prominence or public reputation in 1999, at the time the applicant made its US application for registration. There would therefore be no likelihood that the mark would be mistaken with any living individual at the time of adoption.

[14] The examiner continued to disagree. Ultimately, a decision was rendered on July 9, 2012. The decision made the following determinations:

- a) the relevant date for the paragraph 9(1)(k) assessment is the date of the adoption of the trade-mark which, by operation of section 3 of the Act, would be January 2002, the date when products were first sold in Canada, and not the date when the mark was submitted in the US for registration (June 17, 1999);
- b) materials, gleaned from the internet, showed that "Jack Black has a significant reputation in Canada at the applicant's date of adoption"; that "evidence" suggests to a not insignificant segment of the Canadian public a connection with Jack Black, the "internationally renowned actor, comedian and musician";
- c) paragraph 9(1)(k) implies that all that is required is the attempted registration of a mark by any applicant who is not the living individual referred to in paragraph 9(1)(k), and therefore, as the applicant is not Jack Black, there is a false connection in this case.

As a result, the mark is unregistrable by operation of paragraph 37(1)(b) of the Act. It reads:

<b>When applications to be refused</b>	<b>Demandes rejetées</b>
37. (1) The Registrar shall refuse an application for the registration of a trade-mark if he is satisfied that	37. (1) Le registraire rejette une demande d'enregistrement d'une marque de commerce s'il est convaincu que, selon le cas :
...	...
(b) the trade-mark is not registrable, or	b) la marque de commerce n'est pas enregistrable;
...	...

### III. Arguments

[15] The respondent in these proceedings, the Attorney General [AG], took the view that he “has no interest in whether the Applicant receives or does not receive a registration for a trade-mark for JACK BLACK” (Memorandum of Fact and Law of the Respondent, para 6). The AG limits his arguments to two issues:

- a) the word “adopt” in section 9 cannot include adoption outside of Canada in view of section 3 of the Act;
- b) the relevant date for assessing registrability in accordance with paragraph 12(1)(e) is not the date of adoption of the mark in Canada, as found by the Registrar, but rather the date of the decision.

[16] As for the interpretation of section 3 of the Act, the AG relies on the text of the section and the view that relying on the adoption of a mark outside Canada would undermine the goal of the Act to reward adoption, use and registration of trade-marks in Canada. Section 3 reads:

**When deemed to be adopted**

3. A trade-mark is deemed to have been adopted by a person when that person or his predecessor in title commenced to use it in Canada or to make it known in Canada or, if that person or his predecessor had not previously so used it or made it known, when that person or his predecessor filed an application for its registration in Canada.

**Quand une marque de commerce est réputée adoptée**

3. Une marque de commerce est réputée avoir été adoptée par une personne, lorsque cette personne ou son prédécesseur en titre a commencé à l'employer au Canada ou à l'y faire connaître, ou, si la personne ou le prédécesseur en question ne l'avait pas antérieurement ainsi employée ou fait connaître, lorsque l'un d'eux a produit une demande d'enregistrement de cette marque au Canada.

[17] Finding support on a decision of the Trade-marks Opposition Board [TMOB] (*Villeneuve et al v Mazsport Garment Manufacturing Inc*, 50 CPR (4th) 127) the AG asserts that the date of the decision is the date on which the assessment with respect to the test of paragraph 9(1)(k) must be made. Be that as it may, the AG argues that on the facts of this case it does not really matter what date is chosen (2002 or 2012) because the evidence is such that the decision is owed “some deference” (para 21, Memorandum of Fact and Law of the Respondent). Quoting from *McDonald's Corp v Silcorp Ltd* (1989), 24 CPR (3d) 207 (FCTD), the AG suggests that, on appeal, the Court must consider the special expertise of the Registrar.

[18] For its part, the applicant makes a number of arguments. Relying on *Rogers Communications Inc v Society of Composers, Authors and Music Publishers of Canada*, 2012 SCC 35, [2012] 2 SCR 283, the applicant argues that the standard of review on the interpretation to be given to sections 3 and 9 of the Act has to be correctness. It then goes on to argue that the date of adoption is the relevant date, which would be in its view the adoption date in the US



(1999). Section 3 being a deeming provision, the word “adopt” has not been exhaustively defined, which opens the door to the date of adoption being the relevant date.

[19] Switching gears, the applicant submits that the actor Jack Black did not establish a substantial reputation in Canada such that it cannot be said that the Trade-mark is so nearly resembling as to be likely to be mistaken for any matter that may falsely suggest a connection with any living individual.

[20] Finally, the applicant submits that the construction put on section 3 of the Act was new when it appeared in the final refusal letter. As such, that was contrary to subsection 37(2) of the Act which requires the Registrar to notify applicants of objections and provide applicants an adequate opportunity to answer those objections.

#### IV. Analysis

[21] This case was not fully argued on its merits, given the position taken by the AG to argue, in effect, two legal issues: whether the adoption of a trade-mark for the purposes of the Act can take place outside Canada, and whether the relevant date for the purpose of determining if a trade-mark is registrable, pursuant to paragraph 12(1)(e), is the date of the adoption in Canada, the date of adoption outside of Canada or the date of the decision.

[22] However, those issues do not arise if, on the evidence in this record, the test of paragraph 9(1)(k) can be satisfied. Here, the information considered by the Registrar consists, for all intents

and purposes, of printouts from the internet which do not establish how prominent the living individual is in this country.

[23] On the other side of the ledger, new evidence, in the form of an affidavit of the co-founder of Jack Black, LLC, proffered in accordance with subsection 56(5), establishes that

- i) the trade-mark JACK BLACK was adopted originally without any knowledge of the actor by that name and that its use has never been challenged, in Canada or elsewhere, by the actor or anyone else;
- ii) the trade-mark has been registered in many other countries and no issues have ever been raised;
- iii) there is not a single instance of the personal care and grooming products being sold on the mistaken belief that the JACK BLACK products would be in any way connected to the actor JACK BLACK.

[24] When one compares the information used by the Registrar in this case to reach a conclusion to that made available in other cases involving section 9 of the Act, one is struck by how thin the information is in this case. Actually, with much stronger evidence, cases fell short of the standard required in order to meet the test of paragraph 9(1)(k) of the Act and thus prohibit the mark.

[25] In the case of *Waltrip v Boogiddy Boogiddy Racing Inc*, 2007 CanLII 80867 (CA TMOB) [*Waltrip*], extensive evidence was presented of how widely circulating was the use by Darrell

Lee Waltrip, a sports announcer for NASCAR races broadcast in Canada with an estimated following of 5.8 million NASCAR fans in this country, of his expression Boogity Boogity Boogity used at the start of every NASCAR race. That same expression was prominently featured on merchandise sold in this country. Waltrip opposed an application to register the trade-mark Boogity Boogity Boogity and failed. With respect to the argument that paragraph 9(1)(k) found application, the TMOB found the evidence lacking:

In the present case, the evidence shows that NASCAR races are widely viewed in Canada, and are enjoying a growing popularity in Canada. While it can be assumed that many fans have heard the signature phrase “BOOGITY BOOGITY BOOGITY” at the start of a race, it has not been shown that a significant number of Canadians would associate this phrase with Darrell Waltrip, or would even know who Darrell Waltrip is by name. In this regard, although Mr. Colley attached copies of webpages featuring articles, interviews and fan commentary demonstrating the popularity of Darrell Waltrip and his signature phrase, the Opponent provided no evidence regarding the number of Canadians who may have accessed these websites or read these articles. While Mr. Waltrip states that he has been nicknamed “Mr. Boogity” by various sport news and article writers who interviewed him for magazines and sports news including Sports Illustrated and Fox Sports, copies of such articles have not been provided. Finally, while the Opponent has marketed and sold merchandise in Canada through its on-line store since as early as March, 2004, sales figures for the amount of items sold in Canada bearing the mark BOOGITY BOOGITY BOOGITY were not provided, nor was any information provided regarding the number of Canadians who have visited the website. [My emphasis]

[26] Another case where the connection with a living individual was found not to be robust enough is *Aykroyd v Brews Brothers Coffee Corp*, 1997 CanLII 15866 (CA TMOB) [*Aykroyd*]. The TMOB found that “A significant number of Canadians must be aware of the name ‘Blues Brothers’ which would suggest to these Canadians a connection with a particular living individual, namely Daniel E. Aykroyd.” The conclusion reached on that particular record reads:

The opponent has not met the evidentiary burden placed on them to establish evidence of a significant public reputation for Daniel E. Aykroyd in Canada. I do not consider that the evidence is sufficient that I can conclude, on a balance of probabilities, that the average person who would purchase coffee or tea bearing the BREWS BROTHERS trade-mark would be misled by the use of the trade-mark BREWS BROTHERS in association with the applicant's wares, into assuming that a living individual, Daniel E. Aykroyd, who has used the name 'Blues Brothers', has sponsored/approved or licensed the wares or that these wares are a spin-off from Daniel Aykroyd's activities. [My emphasis]

[27] The TMOB compares the evidence to that offered in *Carson v Reynolds*, (1980) 49 CPR (2d) 57 [*Carson*], a decision of Mahoney J of this Court. The TMOB said:

In one of the cases on point cited by the opponent, **Carson v. Reynolds** (1980), 49 C.P.R. (2d) 57 (F.C.T.D.), Mahoney J. had extensive survey evidence before him to the extent of the Canadian public's awareness of the Tonight Show and Johnny Carson's personal notoriety in Canada. By contrast, I do not have sufficient evidence to conclude that Daniel E. Aykroyd is famous and that he is associated in the public's mind with the trade-mark **BLUES BROTHERS**. As a result, I have dismissed this second ground of opposition. [My emphasis]

[28] There is nothing of the sort before this Court in this case. The un-contradicted evidence in this case is that no connection with the actor Jack Black was ever intended, there has not been any complaint ever since the use of the Trade-mark started in the US in 1999, in Canada since 2002 and elsewhere where the Trade-mark is already registered. Internet printouts constitute the basis for the decision in this case, without any evidence commensurate with what was available in *Waltrip*, *Aykroyd*, or *Carson*. To put it simply, it has not been established that there is a Canadian public's awareness of a person named Jack Black, let alone that that awareness reaches a level of significant public reputation.

[29] In my view, the finding of Cullen J in *Bousquet aka Jean Cacharel SA et al v Barmish Inc*, (1991) 37 CPR (3d) 516, imposes itself on the record before this Court. On the connection with a living individual, in the context of the examination under paragraph 9(1)(k), Cullen J concluded:

However, in my opinion, the applicants have not met the evidentiary burden upon them to establish evidence of a significant public reputation for Jean Cacharel in Canada at either the date of adoption of the trade-mark or the date of registration. In the *Carson* case, Mahoney J. had extensive survey evidence before him as to the extent of the applicant's personal notoriety in Canada. While in my opinion survey evidence is not the only method to establish the existence of a substantial public reputation under paragraph 9(1)(k), I cannot conclude that Jean Cacharel was sufficiently famous in Canada from the evidence submitted by the applicants. Letters from four retailers seeking to distribute CACHAREL clothing written to Jean Cacharel between 1969 and 1973 were submitted by the applicants, but this does not satisfy me that there was a significant public reputation for Jean Cacharel personally. The applicants also refer to foreign newspapers and periodicals in which Jean Cacharel is mentioned between 1972 and 1974, but there was no evidence submitted as to the circulation level of these publications in Canada. In my opinion, the applicants have failed to establish that Jean Cacharel had a public reputation sufficiently significant for me to conclude that use of the word CACHAREL would suggest a connection with the individual Jean Cacharel.

[30] I come to the same conclusion in the case at bar in view of this record. The applicant had demonstrated, on this record, that the Trade-mark is not primarily merely the name of an individual. Indeed, the objection from the examiner has been withdrawn. There is no indication that it had acquired distinctiveness in Canada or that the name has a significant public reputation in this country. David Vaver summarized the issue in *Intellectual Property Law: Copyright, Patents, Trade-marks*, 2<sup>nd</sup> ed (Toronto: Irwin Law Inc., 2011) at page 485:

Anything falsely suggesting a connection with any living person (including a portrait or signature) cannot be used or registered

without his or her consent. ... The Individual must, however, have a significant public reputation which, on current practice, must be Canada-wide.

[31] As put succinctly in *Hughes on Trade-marks* (Roger T. Hughes et al, *Hughes on Trade-marks*, 2<sup>nd</sup> ed (Markham, On: Butterworths, 2005) (loose-leaf updated 2014, release 38)), at §44:

Where new evidence is filed on appeal, the Court must first determine whether such evidence would have had a material impact on the Registrar's decision. If the answer is yes, then the Court must proceed to make its own determination of the matter.

To the same effect is the Judgment of the majority of the Federal Court of Appeal in *Molson Breweries v John Labatt Ltd*, [2000] 3 FC 145 at paragraphs 46 to 51.

[32] Not only is there an absence of such proof but the evidence presented on appeal, which has been tendered by the applicant without objection, would tend to confirm that there is no false suggestion of a connection with a living individual after more than 10 years of use of this Trade-mark in Canada and elsewhere.

[33] The combination of lack of probative evidence of significant public reputation in Canada, to support the Registrar's conclusion with respect to the application of paragraph 9(1)(k) and new evidence, which tends to show that there is no such connection in Canada, carries that the appeal must succeed. The new evidence would have had a material impact on the Registrar's decision in showing even more clearly that the Trade-mark may not falsely suggest the connection with an individual that the examiner suspected on the basis of internet printouts.

[34] As a result, the appeal is granted. The application No 1,459,921 is to be approved and advertised in the Canadian Trade-marks Journal. There is no order as to costs.

**JUDGMENT**

**THIS COURT'S JUDGMENT is that** the appeal is granted. The application No 1,459,921 is to be approved and advertised in the Canadian Trade-marks Journal. There is no order as to costs.

"Yvan Roy"

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Judge



**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-1678-12

**STYLE OF CAUSE:** JACK BLACK L.L.C. v THE ATTORNEY GENERAL  
OF CANADA

**PLACE OF HEARING:** TORONTO, ONTARIO

**DATE OF HEARING:** OCTOBER 17, 2013

**JUDGMENT AND REASONS:** ROY J.

**DATED:** JULY 8, 2014

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