

The Record

[4] The application was filed by Casa Vinicola Botter Carlo & C. (C.V.B.C.) S.P.A. (the Applicant) on April 4, 2011. It is based upon proposed use of the trade-mark DIVICI (the Mark) in association with “wines and sparkling wines”.

[5] The application was advertised in the March 28, 2012 issue of the *Trade-marks Journal*.

[6] Constellation Brands Québec, Inc. (the Opponent), then known as Vincor (Québec) Inc., filed a statement of opposition on May 22, 2012 that was forwarded to the Applicant by the Registrar on June 7, 2012. According to the record, the Opponent’s change of name from Vincor (Québec) Inc. to Constellation Brands Québec, Inc. occurred on June 1, 2012 and was reflected in this proceeding on August 29, 2012.

[7] On August 3, 2012, the Applicant filed a counter statement denying all of the allegations contained in the statement of opposition.

[8] On March 6, 2013, the Opponent was granted leave to file an amended statement of opposition dated December 3, 2012. Below is a summary of the grounds of opposition raised under section 38 of the *Trade-marks Act*, RCS 1985, c T-13 (the Act).

- a. The application does not conform to the requirements of section 30 of the Act, and more particularly to the requirements of:
 - section 30(a) since the goods “wines and sparkling wines” have not been defined specifically in ordinary commercial terms;
 - section 30(e) since the Applicant did not intend to use the Mark in Canada; and
 - section 30(i) since the Applicant could not have been satisfied that it was entitled to use the Mark in Canada in association with the goods.
- b. The Mark is not registrable because:
 - it is either clearly descriptive or deceptively misdescriptive of the place of origin of its associated goods contrary to section 12(1)(b) of the Act; and

- it is confusing with the trade-mark DA VINCI of registration No. TMA303,667 for distilled alcoholic beverages and liquors contrary to section 12(1)(d) of the Act.
- c. The Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act in view of confusion with the Opponent's trade-mark DA VINCI previously used in Canada in association with distilled alcoholic beverages, liquors and wines.
- d. The Mark is not distinctive under section 2 of the Act as it not adapted to distinguish the Applicant's goods from the goods associated with the Opponent's trade-mark DA VINCI.

[9] The Opponent's evidence consists of a certified copy of registration No. TMA303,667 as well as the affidavits of Lyne Milord and Janik Masse.

[10] The Applicant's evidence consists of the affidavit of Christine Fréchette.

[11] None of the affiants was cross-examined.

[12] Each party filed a written argument and was represented at the hearing.

[13] To conclude, I should note that printouts from online dictionaries were filed by the Applicant along with copies of cases it provided for the purposes of the hearing. At the hearing, the Opponent asked that these dictionary definitions be disregarded because they had not been properly filed as evidence in this proceeding. The Applicant submitted that it was acceptable for it to refer to dictionary definitions in the course of its oral submissions. In my view, this debate between the parties is a moot point because in the exercise of the Registrar's discretion, I may refer myself to dictionaries to determine the meaning of words [see *Insurance Co of Prince Edward Island v Prince Edward Island Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)].

Material Dates

[14] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30 of the Act - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)];
- sections 38(2)(b)/12(1)(b) of the Act – the filing date of the application [see *Fiesta Barbeques Limited v General Housewares Corporation*, 2003 FC 1021, 28 CPR (4th) 60];
- sections 38(2)(b)/12(1)(d) of the Act – the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- sections 38(2)(c)/16(3)(a) of the Act – the filing date of the application; and
- sections 38(2)(d)/2 of the Act– the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185, 34 CPR (4th) 317].

Legal Onus and Evidential Burden

[15] The legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the amended statement of opposition. This means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant. However, there is also an evidential burden on the Opponent to prove the facts inherent to its pleadings. The presence of an evidential burden on the Opponent means that in order for a ground of opposition to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

The Evidence

[16] I provide below an overview of the evidence filed by each party, I will discuss some of it further when analyzing the grounds of opposition, where appropriate.

Opponent's Evidence

Certified copy of registration No. TMA303,667 for the trade-mark DA VINCI

[17] At the hearing, both parties brought up the fact that registration No. TMA303,667 has been the subject of a section 45 proceeding. They were also both aware of the Registrar's decision of April 28, 2015 concluding that registration No. TMA303,667 ought to be expunged [see *Smart & Biggar v Constellation Brands Québec, Inc.*, 2015 TMOB 82 (CanLII)]. The decision, which I rendered on behalf of the Registrar, is currently under appeal before the Federal Court [Court File No. T-1104-15]. Thus, as of today registration No. TMA303,667 is extant in the Opponent's name and the trade-mark DA VINCI is registered for "*boissons alcoolisées distillées; liqueurs*".

[18] I note in passing that registration No. TMA303,667 issued on June 14, 1985 in the name of Les Distilleries Dumont Ltée. According to the footnotes to the registration page, the successor in title of the registrant was Dumont Vins & Spiritueux Inc. / Dumont Wine & Spirits Inc.; the Opponent, then known as Vincor (Québec) Inc., was recorded as owner of the registration further to a merger of April 1, 1999.

Affidavit of Lyne Milord, dated November 30, 2012

[19] Ms. Milord, an administrative assistant employed by Opponent's trade-marks agent, provides printouts from the websites located at *www.maplandia.com* and *www.tripmondo.com* further to her search for the term "divici" [paras 2-3 and Exhibit LM-1].

[20] Ms. Milord also provides excerpts from the *Nouveau Larousse des vins* of 1979 further to her search for the term "*vin de liqueur*" [paras 4-5 and Exhibit LM-2]. I note in passing that the Opponent did not make any submissions concerning these dictionary excerpts.

Affidavit of Janik Masse, dated December 3, 2012

[21] Ms. Masse, the Marketing Director for the Opponent, provides evidence with respect to the use and advertisement of the trade-mark DA VINCI.

[22] Ms. Masse affirms that the trade-mark has been used in Canada by the Opponent and its predecessors in title since at least as early as March 14, 1985, although she does not specify for which goods, and since at least as early as October 31, 2006 in association with wines [para 8 of the affidavit].

[23] According to Ms. Masse's testimony, over 400,000 bottles of wines bearing the trade-mark DA VINCI have been sold in Canada by the Opponent since 2007. Since that same year, sales of wines associated with the trade-mark have amounted to over \$3,500,000. The Opponent distributes promotional and advertising material to publicize the wines associated with the trade-mark [paras 15-17 of the affidavit].

[24] Ms. Masse attaches the following as exhibits to her affidavit:

- a photograph of a bottle, specimen labels and copies of order forms for the product "Amaretto DA VINCI" [Exhibit JM-1; para 6 of the affidavit];
- a notice issued by the Société des alcools du Québec (SAQ) on October 31, 2006, entitled *Info SAQ*, when the Opponent's DA VINCI wines were introduced on the market [Exhibit JM-2; para 9 of the affidavit];
- a printout from the Registraire des entreprises du Québec (the CIDREQ report) to show that Dumont Vins & Spiritueux Inc. is a company that was struck off following a merger which resulted in the Opponent [Exhibit JM-3; para 10 of the affidavit]. I note that an highlighted part of the CIDREQ report shows a merger of April 1, 1999 for Dumont Vins & Spiritueux Inc.;
- copies of order forms for wines associated with the trade-mark [Exhibit JM-4, para 11 of the affidavit];
- copy of a photograph of the front of a bottle of wine displaying the trade-mark [Exhibit JM-5; para 14 of the affidavit]; and
- copies of promotional materials for wines associated with the trade-mark [Exhibit JM-6, para 7 of the affidavit].

[25] Ms. Masse concludes her affidavit by opining on questions of fact and law to be determined by the Registrar in the present proceeding [paras 18-20 of the affidavit].

[26] As I will return to the evidence introduced by Ms. Masse, at this time I note that I made a few observations to the Opponent at the hearing about what I considered to be deficiencies in the evidence provided by Ms. Masse. Ultimately, the Opponent argued that because Ms. Masse was not cross-examined, her statements must be taken at face value. I disagree. In my view, the lack of cross-examination does not prevent me from assessing the value or weight of the evidence introduced by the affiant [see *H-D Michigan Inc v MPH Group Inc*, 2004 CanLII 71788, 40 CPR (4th) 245, and *GA Modefine SA v Di Gio' SRL*, 2006 CanLII 80390, 51 CPR (4th) 102, where analogous arguments have been addressed by the Registrar].

Applicant's Evidence

Affidavit of Christine Fréchette

[27] Ms. Fréchette is the Vice-President and General Manager of Selections Fréchette Vins D'Exception, which is a company acting as a wine agent in the province of Quebec. More particularly, it represents wine producers to the SAQ [para 1 of the affidavit].

[28] Ms. Fréchette affirms that the SAQ maintains a database of sales of its products; her company purchases this data, which is updated weekly [para 3 of the affidavit]. Ms. Fréchette goes on to state:

4. I reviewed the sales of DA VINCI wine and DA VINCI amaretto sold in Quebec by Vincor or Constellation Brands provided by Dumont Vins & Spiritueux. Both products are delisted. The amaretto has been delisted since at least as early as 2010. The wine has been delisted since at least as early as 2013.

[29] Ms. Fréchette concludes her affidavit by filing website pages to show examples of DA VINCI wines sold in Canada “by companies other than Vincor and Constellation Brands” [para 5 and Exhibit “1” of the affidavit].

Grounds of Opposition Summarily Dismissed

[30] For the reasons that follow, the grounds of opposition alleging that the application does not conform to the requirements of sections 30(a), (e) and (i) of the Act can be summarily dismissed for the Opponent's failure to meet its evidential burden.

[31] First, an opponent's evidential burden under section 30(a) of the Act is a light one; it may be met simply through sufficient argument [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 (TMOB) at 104].

[32] In this case, the Opponent argues that the application fails to comply with the requirements of section 30(a) of the Act because the statement of goods does not mention the origin of the "wines and sparkling wines". This argument is insufficient for the Opponent to meet its initial evidential burden. Indeed, having referred myself to the *Goods and Services Manual* of the Canadian Intellectual Property Office, I am satisfied that the terms "wines" and "sparkling wines" are acceptable without further specification. [See *Semperviva Natural Health and Body Care Products Limited v Hexameron Corporation*, 2014 TMOB 41 (CanLII) as an example of cases where the Registrar has referred to this manual to consider a section 30(a) ground of opposition.]

[33] Second, the Opponent did not file any evidence to establish that the Applicant falsely made the statement required by section 30(e) of the Act. In fact, the Opponent did not make submissions with respect to the section 30(e) ground of opposition.

[34] Finally, section 30(i) of the Act requires an applicant to include a statement in the application that the applicant is satisfied that it is entitled to use the trade-mark in Canada. Where an applicant has provided the required statement, the jurisprudence suggests that non-compliance with section 30(i) of the Act can be found only where there are exceptional circumstances that render the applicant's statement untrue such as evidence of bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. There is no such evidence here.

Analysis of the Remaining Grounds of Opposition

[35] The issues arising from the remaining grounds of opposition are:

1. Was the Mark either clearly descriptive or deceptively misdescriptive of the place of origin of its associated goods as of April 4, 2011?
2. Is the Mark registrable as of today's date?
3. Was the Applicant the person entitled to registration of the Mark in Canada as of April 4, 2011?
4. Was the Mark distinctive of the Applicant's goods as of May 22, 2012?

[36] I will analyze these issues in turn.

Was the Mark either clearly descriptive or deceptively misdescriptive of the place of origin of its associated goods as of April 4, 2011?

[37] This issue arises from the ground of opposition alleging that the Mark is not registrable pursuant to the provisions of section 12(1)(b) of the Act because whether depicted, written or sounded, it is either clearly descriptive or deceptively misdescriptive of the place of origin of its associated wines and sparkling wines.

[38] The purpose of the prohibition under section 12(1)(b) of the Act is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [*Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD)]. The purpose of denying the registration of a deceptively misdescriptive trade-mark is to prevent the public from being misled [see *Atlantic Promotions Inc v Registrar of Trade-marks* (1984), 2 CPR (3d) 183 (FCTD)]. To be misdescriptive, a trade-mark must first be found to be descriptive [see *Oshawa Group Ltd v Canada (Registrar of Trade Marks)* (1980), 46 CPR (2d) 145 at 148 (FCTD)].

[39] In deciding whether the registration of the Mark is prohibited by section 12(1)(b) of the Act, the Mark must be considered as to the immediate impression created and from the point of view of the average purchaser [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD); and *Atlantic Promotions Inc, supra*]. The word “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34].

[40] The Opponent submits that its evidence must lead me to conclude on a balance of probabilities that the average Canadian consumer as a matter of first impression would recognize the Mark as a city of Romania and assume that the goods associated with the Mark originates from Romania. More particularly, the Opponent submits that Exhibit LM-1 to the affidavit of Ms. Milord shows that “Divici” is a known place situated in Caras-Severin, Romania. Because the origin of the Applicant’s goods is neither mentioned in the application nor has been evidenced by the Applicant, “it can validly be assumed” that the goods originate from Romania and thus the Mark is clearly descriptive of their place of origin.

[41] The Applicant does not dispute that the term “Divici” appears to be the name of a geographical location in Romania. In fact, the Applicant in its written argument noted that according to the printouts filed under Exhibit LM-1, the term “Divici” appears to be also the name of geographical locations in Bosnia and Herzegovina, and in Croatia. However, the Applicant submits that there is no indication that any of these regions has an established reputation or is widely recognized as a source of production or sales of wines and/or sparkling wines. The Applicant further submits that there is no evidence to suggest that these places are known by anyone in Canada in any context.

[42] In *Sociedad Agricola Santa Teresa Ltd v Vina Leyda Limitada*, 2007 FC 1301 (*Leyda*), Justice Harrington held that “section 12(1)(b), at least as far as ‘place of origin’ is concerned, is not dependent on the knowledge, or lack thereof, of the average Canadian consumer” [see *Leyda*, *supra*, at para 9]. Rather, once a determination has been made that a trade-mark is the name of a place of origin for the goods, the ground of opposition must be successful.

[43] The findings of Justice Harrington as to the irrelevance of the perception of the ordinary consumer were discussed in *MC Imports Ltd v Afod Ltd*, 2014 FC 1161, where Justice Rennie also reviewed the line of authorities supporting the relevance of the perception of ordinary consumers. Justice Rennie stated that he did “not think the jurisprudential divide, if it exists at all, does so to the extent urged by counsel”. He went on to say: “In any event, it is not necessary, in this case, to resolve the tension between what is said to be two divergent schools of thought. Regardless of how broadly the consumer is scoped, the mark in question fails.” [*MC Imports*, *supra*, at para 25]

[44] I also do not view the case before me as one where there is a need to discuss the issue of the relevance of the perception of an ordinary consumer. Indeed, even though the evidence is that “Divici” is a geographical location, there is no evidence that the Applicant’s wines and sparkling wines originate from a geographical location known as “Divici”. Furthermore, there is no evidence that “Divici” in Romania, or for that matter any of the other “Divici” locations shown in Exhibit LM-1, is a place of origin for wines and/or sparkling wines. Also, because there is no evidence that Romania is recognized as a country producer of wines, including sparkling wines, I can see no basis for the Opponent’s argument that it can be validly assumed that the Applicant’s goods originate from Romania.

[45] In the end, I conclude that the Opponent’s evidence does not support a finding that the Mark is either clearly descriptive or deceptively misdescriptive of the place of origin of its associated wines and sparkling wines.

[46] Accordingly, the ground of opposition raised under section 12(1)(b) of the Act is dismissed for the Opponent’s failure to meet its initial evidential burden.

Is the Mark registrable as of today’s date?

[47] This issue arises from the ground of opposition alleging that the Mark is not registrable pursuant to the provisions of section 12(1)(d) of the Act because it is confusing with the Opponent’s trade-mark DA VINCI of registration No. TMA303,667.

[48] The Opponent has met its evidential burden since registration No. TMA303,667 is extant as of today. Thus, the question becomes whether the Applicant has met its legal onus to show, on a balance of probabilities, that the Mark is not likely to cause confusion with the trade-mark DA VINCI registered in association with “*boissons alcoolisées distillées; liqueurs*”.

[49] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[50] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time the trade-marks have been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 49 CPR (4th) 321; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361 for a thorough discussion of the general principles that govern the test for confusion.]

[51] In *Masterpiece, supra*, the Supreme Court of Canada stated that the degree of resemblance between marks, although the last factor listed in section 6(5) of the Act, is often likely to have the greatest effect on the confusion analysis; the Court chose to begin its analysis by considering that factor. Thus, I turn to the assessment of the section 6(5) factors starting with the degree of resemblance between the marks.

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[52] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trade-marks. The first portion of a trade-mark is usually considered more important for assessing the likelihood of confusion [see *Conde Nast Publications Inc v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD)]. At paragraph 64 of the *Masterpiece* decision, the Court writes that to measure the degree of resemblance, a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique.

[53] The Applicant submits that the visual and phonetic differences between the trade-marks are very clear. In terms of visual differences, the Applicant submits that the Opponent's trade-mark is comprised of two words whereas the Mark is one word. It also submits that the first

portion of the Opponent's mark, i.e. "DA", is not similar to the prefix "DI" in the Mark because the letters "I" and "A" look very different.

[54] In terms of sound, the Applicant submitted in its written argument that the Mark is "an alliteration of the sound ē (or, "ee"), where the sound ē is markedly repeated three times". At the hearing, the Applicant argued that French or English speaking Canadian consumers may not know the pronunciation of "DIVICI" in a foreign language, but they would know how to pronounce "DA VINCI" by association with the "famous Italian artist, scientist and philosopher" Leonardo da Vinci.

[55] In fact, the Applicant argues that the idea suggested by the Opponent's trade-mark is that of Leonardo da Vinci, whereas the Mark does not suggest any ideas other than possibly representing a foreign term. Thus, the ideas suggested by the trade-marks are entirely different and distinguishable.

[56] By comparison, the Opponent submits that the trade-marks are visually "very similar". Not only do they both start with "D" and end with "CI", but they are comprised with "almost the same letter count, six and seven respectively". In terms of sound, the Opponent submits in its written argument that the phonetic similarity between the trade-marks is "indisputable". However, the Opponent did not expand on this point either in its written argument or at the hearing.

[57] The Opponent did not address the issue of the ideas suggested by the trade-marks in its written argument, but it did so at the hearing. The Opponent disputed the Applicant's contention that the trade-mark DA VINCI is suggestive of Leonardo da Vinci. The Opponent essentially argued that its trade-mark is DA VINCI; not Leonardo da Vinci.

[58] In my view, to argue differences in appearance because the Opponent's trade-mark is comprised of two words whereas the Mark is one word, as did the Applicant, involve a side-by-side comparison of the type warned against by the courts. In the end, I consider that there is a fair degree of resemblance between the trade-marks in appearance. That being said, I disagree with the Opponent that the phonetic similarity between the trade-marks is "indisputable", if only because neither in French nor in English does the prefix "DA" sound like the prefix "DI".

[59] Finally, I find that the ideas suggested by the trade-marks are entirely different. In that regard, I find that the Mark does not suggest any particular idea, except maybe that of a word in a foreign language. Further, I agree with the Applicant that an average Canadian consumer is likely to react to the trade-mark DA VINCI by thinking of Leonardo da Vinci, the Italian painter, scientist and engineer [see the online *Canadian Oxford Dictionary* (2 ed)]. With due respect for the Opponent, I consider it is unreasonable to contend that there is no likelihood that an average Canadian consumer would react to DA VINCI by thinking of Leonardo da Vinci. I would add that the entry for “da Vinci” in the online *Canadian Oxford Dictionary* (2 ed) reads: “see Leonardo da Vinci”.

[60] In the end, I agree with the Applicant that any resemblance between the trade-marks is significantly mitigated by the fact that an average Canadian consumer, as a matter of first impression, would likely react to the Opponent’s trade-mark DA VINCI by thinking of the famous historical figure, Leonardo da Vinci.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[61] Given my finding under the section 12(1)(b) ground of opposition, I do not subscribe to the Opponent’s view that the Mark lacks inherent distinctiveness because it is clearly descriptive of the place of origin of the Applicant’s goods. Furthermore, not only does the term “DIVICI” have no meaning in the French and English languages, but it does not have a suggestive or descriptive connotation in the context of the goods. Thus, I agree with the Applicant that the Mark is inherently strong.

[62] As for the Opponent’s trade-mark “DA VINCI”, it has also no suggestive or descriptive connotation in the context of distilled alcoholic beverages and liquors. Still, the degree of inherent distinctiveness of the Opponent’s trade-mark is lessened by the fact that it is evocative of Leonardo da Vinci.

[63] A trade-mark may acquire distinctiveness through promotion or use in Canada. There is no evidence of use or promotion of the Mark in Canada subsequently to the filing of the application.

[64] I now turn to the Opponent's evidence with respect to the registered goods, i.e. distilled alcoholic beverages and liquors.

[65] I note from the outset the lack of evidence concerning the promotion of distilled alcoholic beverages and liquors in association with the Opponent's trade-mark.

[66] In terms of use, Ms. Masse affirms that the trade-mark DA VINCI has been used in Canada by the Opponent and its predecessors in title since March 14, 1985. However, Ms. Masse does not provide documentary evidence showing use of the trade-mark in association with distilled alcoholic beverages, nor any information as to sales of distilled alcoholic beverages in association with the trade-mark in Canada.

[67] I am satisfied that the Opponent has provided documentary evidence showing use of its trade-mark in association with liquors [Exhibit JM-1 to the affidavit]. Still, I find the Opponent's evidence insufficient to establish either continuous or significant use of its trade-mark since March 14, 1985 up to the date of the affidavit, as claimed by the Opponent. For one thing, only four order forms for the product "Amaretto DA VINCI" have been provided under Exhibit JM-1. The earliest order form relates to sales in 1998 whereas the three others are dated September 27, 2003, April 13, 2004 and April 7, 2006. Furthermore, except for these four order forms, there is no information as to sales of liquors, such as value of sales, associated with the trade-mark at any time whatsoever. In other words, there is no evidence for concluding to sales of Amaretto DA VINCI in years subsequent to 2006.

[68] Finally, the mere existence of the Opponent's registration can establish no more than minimal use and cannot give rise to an inference of significant and continuous use of the trade-mark DA VINCI in association with distilled alcoholic beverages and liquors [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)].

[69] To summarize, I find that the Mark is inherently stronger than the Opponent's trade-mark DA VINCI. I find that the Mark does not benefit from acquired distinctiveness. Still, I also find that the Opponent's trade-mark DA VINCI does not benefit from acquired distinctiveness in association with the registered goods "*boissons alcoolisées distillées*". Finally, in my view, there

are too many deficiencies in the Opponent's evidence to draw any conclusion on the extent to which the trade-mark DA VINCI has become known in Canada in association with "*liqueurs*".

[70] In the end, I disagree with the Opponent that the evidence it has introduced through the affidavit of Ms. Masse establishes that the trade-mark DA VINCI has acquired a significant measure of reputation in Canada in association with the registered goods. Thus, because the Mark is inherently stronger than the Opponent's trade-mark, I find that the overall consideration of section 6(5)(a) factor favours the Applicant.

Section 6(5)(b) – the length of time the trade-marks have been in use

[71] The application filed on April 4, 2011 is based upon proposed use of the Mark and there is no evidence that the Mark has been used in Canada subsequently to the filing of the application.

[72] The trade-mark DA VINCI proceeded to registration in association with distilled alcoholic beverages and liquors further to the filing of a Declaration of Use on March 14, 1985. As previously mentioned, the mere existence of the registration cannot give rise to an inference of continuous use of the trade-mark in association with the registered goods.

[73] The Opponent's evidence does not establish use of the trade-mark DA VINCI in association with distilled alcoholic beverages at any time whatsoever. I acknowledge that the evidence shows use of the trade-mark DA VINCI in association with liquors. However, it remains that there is no evidence for concluding to sales of Amaretto DA VINCI in years subsequent to 2006.

[74] Accordingly, even though the section 6(5)(b) factor favours the Opponent, in my view it does not do so to the extent urged by the Opponent. In any event, it would only favour the Opponent to the extent that the registered goods "*liqueurs*" are concerned.

Sections 6(5)(c) and (d) – the nature of the goods; the nature of the trade

[75] It is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registration that must be taken into consideration when assessing the

section 6(5)(c) and (d) factors under the section 12(1)(d) ground of opposition [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe, Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)].

[76] I agree with the Opponent that it is favoured by the consideration of the sections 6(5)(c) and (d) factors.

[77] Indeed, although distilled alcoholic beverages and liquors differ from wines and sparkling wines, all of these goods could be categorized generally as alcoholic beverages. Further, it has been held that “beer, wines and spirits, are all products of one industry” [see *Carling Breweries Ltd v Registrar of Trade-marks* (1972), 8 CPR (2d) 247 (FCTD) at 251]. There is no evidence from the Applicant to conclude that the parties’ channel of trade would differ.

Additional surrounding circumstance: third-party DA VINCI marks

[78] The Applicant contends that its evidence shows third-party use of the trade-mark DA VINCI in association with wines. It submits that the fact that the Opponent has allowed third-party use of DA VINCI in association with wines supports a finding that there is no reasonable likelihood of confusion between the trade-marks because the Opponent’s trade-mark has lost any distinctiveness it may have had.

[79] The evidence relied upon by the Applicant is found at paragraph 5 of the affidavit of Ms. Fréchette reading as follows:

5. Third parties, in other words, companies other than Vincor and Constellation Brands, have been selling their own DA VINCI wine in Canada. As a small sample, now shown to me and marked as Exhibit “1”, are printouts from websites across Canada showing sales of third party DA VINCI wine currently for sale across Canada.

[80] The Applicant submits that Exhibit 1 to the affidavit shows that “DA VINCI CHIANTI” is sold in British Columbia, Alberta, Ontario, New Brunswick and Nova Scotia, and that “DAVINCI PINOT GRIGIO” is sold in Alberta and New Brunswick. The Applicant contends that this evidence “clearly shows that third parties are using the trade-mark DA VINCI in association with wines in Canada to a significant extent”.

[81] While I am satisfied that the websites existed at the time they were accessed by Ms. Fréchette, which is seemingly on May 1, 2013, the evidence is not admissible for the truth of its contents since very little information, if any, was provided to establish that these may be “official websites” or that the evidence is reliable [see *ITV Technologies, Inc v WIC Television Ltd*, 2003 FC 1056, 29 CPR (4th) 182]. In any event, even if afforded weight, the evidence falls short of establishing that DA VINCI CHIANTI or DAVINCI PINOT GRIGIO wines would have been available for sales, or sold, in Canada at any time before or after May 1, 2013.

[82] In the end, I am not affording any significance to the evidence relied upon by the Applicant.

Conclusion on the likelihood of confusion

[83] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. In weighing all of the factors enumerated at section 6(5) of the Act and their relative importance, I am satisfied that the Applicant has discharged its legal onus of establishing that there is no reasonable likelihood of confusion between the Mark in association with wines and sparkling wines and the Opponent’s trade-mark DA VINCI, registered under No. TMA303,667, in association with “*boissons alcoolisées distillées; liqueurs*”.

[84] Indeed, I consider that the inherent distinctiveness of the Mark at least counter balances the length of time the trade-mark DA VINCI would have been used in Canada in association with the registered goods “*liqueurs*” up until 2006, the extent of which remains unclear. Further, while the nature of the goods and the nature of the trade favour the Opponent, in my view the overall consideration of the degree of resemblance between the trade-marks tips the balance of probabilities in favour of the applicant. As previously indicated, I am of the view that any resemblance between the trade-marks in appearance or sound is significantly mitigated by the fact that an average Canadian consumer, as a matter of first impression, would likely react to the Opponent’s trade-mark DA VINCI by thinking of the famous historical figure, Leonardo da Vinci, whereas the Mark does not suggest any ideas other than possibly representing a foreign term.

[85] Accordingly, the section 12(1)(d) ground of opposition is dismissed.

Was the Applicant the person entitled to registration of the Mark in Canada as of April 4, 2011?

[86] This issue arises from the ground of opposition alleging that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act in view of confusion with the Opponent's trade-mark DA VINCI alleged to have been previously used in Canada by the Opponent in association with distilled alcoholic beverages, liquors and wines.

[87] In order to meet its evidential burden under the pleaded ground of opposition, the Opponent must show that it had used the trade-mark DA VINCI in Canada in association with distilled alcoholic beverages, liquors, and wines prior to April 4, 2011 [section 16(3)(a) of the Act]. Further, the Opponent must show that it had not abandoned the trade-mark DA VINCI at the date of advertisement of the application for the Mark, namely March 28, 2012 [section 16(5) of the Act].

[88] For the reasons that follow, I find that the Opponent has not discharged the evidential burden resting upon it with respect to its alleged use of the trade-mark DA VINCI in association with distilled alcoholic beverages and wines. However, I find that the Opponent has discharged the evidential burden resting upon it with respect to its alleged use of the trade-mark DA VINCI in association with liquors.

- *Distilled alcoholic beverages*

[89] I find that the Opponent has not discharged the evidential burden resting upon it to show prior use of the trade-mark DA VINCI in association with distilled alcoholic beverages. Suffice it to say that evidence introduced through the affidavit of Ms. Masse does not establish use of the trade-mark in association with these goods, within the meaning of section 4(1) of the Act, at any time whatsoever.

- *Wines*

[90] Citing the decision *Constellation Brands Quebec, Inc v A Lassonde Inc*, 2015 TMOB 26 at paras 21-22 (CanLII), the Opponent submits that the notice *Info SAQ* issued on

October 31, 2006 may serve as evidence establishing use of the trade-mark DA VINCI in Canada in association with wines since at least as early as October 31, 2006 [Exhibit JM-2 to the affidavit].

[91] It is of note that the *Info SAQ* notice issued on October 31, 2006 references “Da Vinci, Rouge” under the name of “Dumont Vins et Spiritueux Inc.”. Since I previously noted that CIDREQ report shows a merger of April 1, 1999 for the company Dumont Vins & Spiritueux Inc., I now note that this report references the name Dumont Vins & Spiritueux Inc. among the listing of other names used in Quebec (“*Autres noms utilisés au Québec*”) by Vincor (Québec) Inc. from April 1, 1999 to July 7, 2007.

[92] In any event, the present case does not turn on the value of the *Info SAQ* notice as evidence of use of the trade-mark DA VINCI in association with wines since October 31, 2016 because I am satisfied that the Opponent has provided sufficient evidence to show use of the trade-mark DA VINCI in Canada in association with wines prior to April 4, 2011. In that regard, I note that the Ms. Masse provides with her affidavit five order forms for wines associated with the trade-mark (one order form for each of the years 2006 to 2010) [Exhibit JM-4]; a photograph of a bottle of wine with the front label bearing the trade-mark [Exhibit JM-5]; and the volume and value of sales of DA VINCI wines since 2007, although not broken down on a yearly basis [para 8].

[93] Furthermore, Ms. Masse provides specimens of promotional material that display the trade-mark DA VINCI in association with wines [Exhibit JM-6]. It is trite law that use of a trade-mark cannot be established in relation to goods by the mere distribution of promotional materials. For the display of a trade-mark in promotional materials to be sufficiently associated with goods to constitute use under section 4(1) of the Act, the promotional materials must be visible at the time of transfer of property [see *BMW Canada Inc v Nissan Canada Inc*, 2007 FCA 255, 60 CPR (4th) 181]. In the present case, Ms. Masse does specifically affirms that the promotional materials have been handed out to distributors or were visible to consumers at the time of transfer of the wines at point of sales [para 17 of the affidavit]. Accordingly, I am satisfied that the promotional material may serve as evidence of use of the trade-mark DA VINCI in Canada in association with wines.

[94] The next issue becomes whether the evidence establishes that the trade-mark DA VINCI has been previously used in Canada *by the Opponent* in association with wines, as required by section 16(3)(a) of the Act. This issue arises from one of the specimens of promotional materials that displays the following mention



The specimen of promotional material in question is reproduced in Schedule A to my decision. I note that bottle of wine it illustrates is the same as the bottle of wine shown by the photograph filed as Exhibit JM-5 to the affidavit.

[95] At the hearing, the Applicant argued that the above mention on the promotional material establishes that it is a third party, i.e. Vincor Canada, who has been using the trade-mark in association with wines; not the Opponent. Furthermore, the Applicant submitted that there is no evidence of record with respect to the relationship existing between “Vincor Canada” and the Opponent, much less evidence to establish that the Opponent controls, either directly or indirectly, the character or quality of the wines associated with the trade-mark DA VINCI in order to benefit from the use of the trade-mark by “Vincor Canada” pursuant to section 50(1) of the Act. The Applicant also noted the absence of a public notice that would allow the Opponent to benefit from the presumption created by section 50(2) of the Act. I agree.

[96] The Applicant also argued, and rightly so, that an application may not be refused on the basis of prior use of a confusing trade-mark except at the instance of the user of that confusing trade-mark [section 17(1) of the Act].

[97] Obviously, at the hearing I invited the Opponent’s submissions in reply to those of the Applicant. The Opponent initially contended that since Ms. Masse was not cross-examined, I had no choice but to take at face value her sworn statement that the Opponent has used the trade-mark in association with wines. Once I indicated my disagreement with this contention, if only because the promotional material specimen seemingly contradicts the statement, the Opponent

then turned to the CIDREQ report to argue that “Vincor Canada” was one of its trade-name. When it became apparent that the Opponent was unable to find a satisfactory reference to “Vincor Canada” on the CIDREQ report, the Opponent ultimately acknowledged that “Vincor Canada” was a distinct entity. Nonetheless, the Opponent went on to argue that it was corporately link to “Vincor Canada” through “Vincor International Inc.” who is listed on the CIDREQ report as the first shareholder of the Opponent.

[98] While it seems to me that the CIDREQ report does not establish the existence of a corporate relationship between “Vincor Canada” and the Opponent, whether it does is a moot point. Indeed, a corporate relationship alone is insufficient to establish the existence of a license within the meaning of section 50(1) of the Act [see *MCI Multinet Communications Corp v MCI Multinet Communications Inc* (1995), 61 CPR (3d) 245 (TMOB); and *Loblaws Inc v Tritap Food Broker* (1999), 3 CPR (4th) 108 (TMOB)]. There must also be evidence that the owner controls the use of its trade-mark and take steps to ensure the character and quality of the goods and services provided.

[99] In view of the Opponent’s evidence, I conclude that a third party, “Vincor Canada” has been using the trade-mark DA VINCI in Canada in association with wines since 2007. Furthermore, there is no evidence for me to conclude that the Opponent controlled, either directly or indirectly, the character or quality of the wines associated with the trade-mark DA VINCI in order to benefit from the use of the trade-mark by “Vincor Canada” pursuant to section 50(1) of the Act. As a matter of fact, the affiant does not provide any information about the relationship between the Opponent and Vincor Canada. For instance, if Vincor Canada solely distributes the wines, I could have considered its use of the trade-mark DA VINCI as being that of the Opponent because any trade-mark use by a distributor is that of the owner of the trade-mark.

[100] In addition, there is no evidence showing use of trade-mark DA VINCI by the Opponent itself within the meaning of section 4(1) of the Act. For instance, the front label of the bottle of wine does not display any name. Further, although the order forms filed under Exhibit JM-4 corroborate the testimony of Ms. Masse as to the sales of wines in association with the trade-

mark, these forms do not show the name of the recipient of the orders. All that I may conclude from these forms is that they relate to orders from the SAQ.

[101] Accordingly, the Opponent has failed to discharge the evidential burden resting upon it to show its use of the trade-mark DA VINCI in association with wines in Canada prior to April 4, 2011, as required by section 16(3)(a) of the Act.

- *Liquors*

[102] I am satisfied that the photograph of a bottle, specimen labels and copies of order forms for the product “Amaretto DA VINCI” provided as Exhibit JM-1 to the affidavit of Ms. Masse satisfactorily establishes use of the trade-mark DA VINCI in Canada, within the meaning of section 4(1) of the Act, in association with liquors prior to April 4, 2011.

[103] The next issue becomes whether the evidence establishes that the Opponent had not abandoned the trade-mark DA VINCI for liquors at the date of advertisement of the application for the Mark, i.e. March 28, 2012. This issue arises from the Applicant’s submission that its evidence suggests that the Opponent “has ceased, or at least substantially ceased, its commercial activity in relation with the trade-mark DA VINCI”.

[104] In that regard, to the extent that liquors are concerned, the Applicant relies on the testimony of Ms. Fréchette that “the DA VINCI amaretto sold in Quebec by Vincor or Constellation Brands provided by Dumont Vins & Spiritueux” has been delisted from the SAQ database since at least as early as 2010 [paras 3-4 of the affidavit].

[105] The Opponent submits that Ms. Fréchette’s testimony should not be afforded any weight in this proceeding. In its written argument, the Opponent essentially argues that Ms. Fréchette did not search under the full and exact name of the Opponent at the time. At the hearing, the Opponent further argued that Ms. Fréchette’s testimony is restricted to the province of Quebec; it does not cover sales in the other Canadian provinces.

[106] Despite acknowledging the merit of the Opponent’s submissions, at the hearing the Applicant maintained that it would be reasonable for me to infer that the trade-mark DA VINCI had been abandoned for liquors as of March 28, 2012. I disagree. Not only is the evidence

introduced by Ms. Fréchette restricted to the province of Quebec, but Ms. Frechette affirming that the DA VINCI amaretto has been delisted from the SAQ database since at least as early as 2010 is surely not sufficient for me to infer that the Opponent had abandoned the trade-mark DA VINCI in association with liquors as of March 28, 2012. [See *Isawaki Electric Co Ltd v Hortilux BV*, 2012 FCA 321 at para 21 for a discussion of section 16(5) of the Act.] In any event, my finding that the Opponent had not abandoned its trade-mark DA VINCI for liquors at the date of advertisement of the application for the Mark does not affect the ultimate outcome of the non-entitlement ground of opposition.

[107] In the end, I am satisfied that the Opponent has met the evidential burden resting upon it. Thus, the question becomes whether the Applicant has met its legal onus to show, on a balance of probabilities, that the Mark as of April 4, 2011 was not likely to cause confusion with the trade-mark DA VINCI previously used by the Opponent in association with liquors.

[108] Because the differences in material dates do not have a significant impact on the determination of the issue of confusion, my findings that there is no likelihood of confusion between the Mark and the Opponent's trade-mark DA VINCI registered for "*liqueurs*" likewise apply to the non-entitlement ground of opposition. Accordingly, I am satisfied that the Applicant has discharged its legal onus of establishing that, as of April 4, 2011, there was no reasonable likelihood of confusion between the Mark in association with wines and sparkling wines and the Opponent's trade-mark DA VINCI previously used in association with liquors.

[109] Accordingly, the non-entitlement ground of opposition is dismissed in its entirety.

Was the Mark distinctive of the Applicant's Goods as of May 22, 2012?

[110] This issue arises from the ground of opposition alleging that the Mark is not distinctive of the Applicant's wines and sparkling wines under section 2 of the Act because of the previous continuous use and advertisement in Canada by the Opponent of the trade-mark DA VINCI.

[111] In order to meet its evidential burden under the pleaded ground of opposition, the Opponent must show that its trade-mark DA VINCI had a substantial, significant or sufficient reputation in Canada in association with distilled alcoholic beverages, liquors and wines so as to

negate the distinctiveness of the Mark as of May 22, 2012 [see *Motel 6, Inc v No 6 Motel Ltd*, (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles' International, LLC and Bojangles Restaurants, Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[112] For the reasons that follow, I find that the Opponent did not discharge the evidential burden resting upon it.

[113] For one thing, the Opponent did not provide any evidence concerning the promotion of distilled alcoholic beverages and liquors associated with the trade-mark DA VINCI.

[114] Furthermore, the Opponent did not provide any evidence to show use of the trade-mark DA VINCI in association with distilled alcoholic beverages within the meaning of section 4(1) of the Act. While the Opponent has provided documentary evidence showing use of the trade-mark DA VINCI in association with liquors, this evidence does not by itself establish that the trade-mark DA VINCI had a substantial, significant or sufficient reputation in Canada in association with liquors at the relevant date. In other words, the absence of information concerning the value, volume, or extent of sales of liquors associated with the trade-mark DA VINCI at any time whatsoever is fatal to the Opponent's case.

[115] Finally, for the same reasons than those discussed under the non-entitlement ground of opposition, I find that the evidence does not establish use of the trade-mark DA VINCI in association with wines by the Opponent itself or use that has accrued to its benefit. Rather, the evidence establishes that the trade-mark DA VINCI has been used in association with wines by an unlicensed third party, i.e. Vincor Canada. It follows that there has been non-distinctive use of the trade-mark DA VINCI in association with wines as of the material date. In other words, despite significant sales of wines in association with the trade-mark DA VINCI, the Opponent's evidence does not support a finding that as of May 22, 2012 the trade-mark DA VINCI for wines had acquired a reputation in the hands of the Opponent, as pleaded.

[116] Accordingly, the non-distinctiveness ground of opposition is dismissed.

Disposition

[117] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition under section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-05-13

Appearances

Bruno Barrette For the Opponent

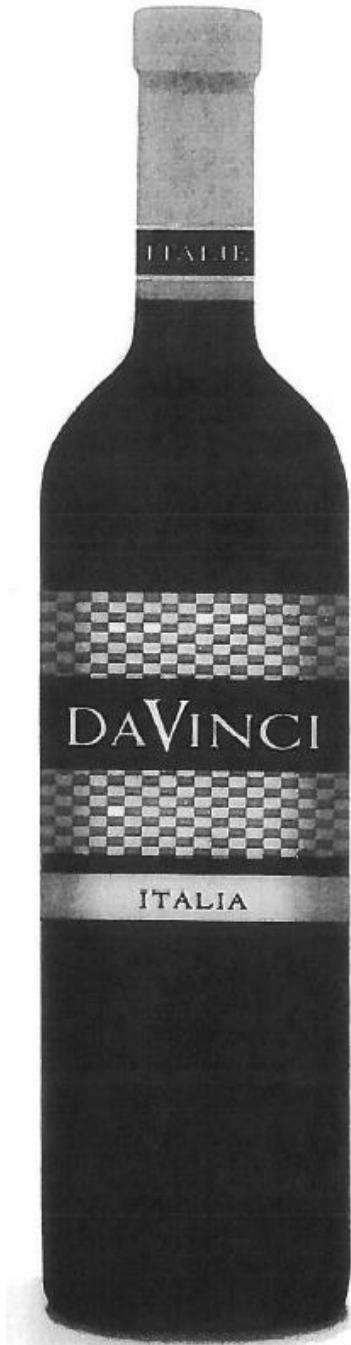
Philip Lapin For the Applicant

Agents of Record

Barette Legal Inc. For the Opponent

Smart & Biggar For the Applicant

Schedule A



ITALIE

DAVINCI

DA VINCI

Italie, Vin rouge
Cépage : Montepulciano
Alcool : 13 %
Code produit : 10666041
Format : 750 ml

Description



DaVinci, un vin inspirant et envoûtant, est empreint de mystère dont vous prendrez plaisir à décoder les arômes nuancés. Épicé au nez, minéral en bouche, il met le jour sur des arômes bien balancés, affichant une fraîcheur intéressante, typique au vin de son origine.

Accords mets et vins



Il accompagne merveilleusement le veau, le bœuf, les pâtes sauce tomate et les fromages forts.

*Disponible dans le réseau des épiceries
et dépanneurs en format 750 ml.*

VINCOR
CANADA
UNE SOCIÉTÉ DE CONSTELLATION

www.vincoralimentation.com