



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2015 TMOB 180**  
**Date of Decision: 2015-10-05**

**IN THE MATTER OF AN OPPOSITION**

**Magnotta Winery Estates Limited** **Opponent**

**and**

**Vina San Pedro Tarapaca S.A.** **Applicant**

**1,528,048 for EPICA** **Application**

[1] The Applicant has applied for the trade-mark EPICA (the Mark). The Opponent opposes this application on two grounds – that the Applicant did not intend to use the Mark as applied for in Canada and that the Mark is not distinctive because it does not distinguish nor is it adapted to distinguish the Applicant’s wine from the wine of the Opponent provided in association with its trade-mark EPIC.

[2] For the reasons that follow, this opposition is rejected.

File Record

[3] The Applicant filed its application on May 16, 2011. The application was advertised for opposition purposes in the *Trade-marks Journal* dated July 31, 2013, and on November 4, 2013, the Opponent filed a statement of opposition to oppose it under section 38 of the *Trade-marks*

*Act*, RSC 1985, c T-13 (the Act) based on sections 30(e) and 2 of the Act. The Applicant filed a counter statement on January 20, 2014, denying the allegations made by the Opponent in its statement of opposition.

[4] The Opponent filed as its evidence the affidavit of Rossana Magnotta, Founder, President and Chief Executive Officer of the Opponent and Karen Lynne Durell, associate lawyer with the Opponent's agent. The Applicant's evidence comprises the affidavits of Jose Jerez, Marketing Manager of the Applicant and Lorraine Sham, Legal Assistant in the Intellectual Property group with the Applicant's agent. None of the affiants were cross examined.

[5] Both parties submitted written arguments and both attended an oral hearing wherein the opposition to the Applicant's trade-mark EPICA & Design, application No. 1,592,128, was heard at the same time.

### Summary of the Evidence

#### Opponent's Evidence

[6] As noted above, Ms Magnotta is the Founder, President and Chief Executive Officer of the Opponent. She has been personally involved in various aspects of the business operations of the Opponent since the company was founded in 1990. She explains that the Opponent is a winery with a principal place of business in Vaughan, Ontario.

[7] The affidavit of Ms. Magnotta is quite short, and is only 7 paragraphs in length and has 1 exhibit. The most pertinent parts of Ms. Magnotta's affidavit are paragraphs 4-6, which are reproduced below:

4. Magnotta Winery has used, and uses, the trade-mark EPIC continuously since April, 2012 to the present day by displaying the trade-mark on labels attached to wine bottles. Now produced and shown to me and marked Exhibit A to this my affidavit is the label that appears on EPIC wine bottles. Magnotta Winery sells its EPIC wine through the provincial liquor control board, duty free stores and restaurants. The trade-mark EPIC is visible to the consumer at the time that the consumer purchases EPIC wine, through the various liquor control board outlets, duty free stores and restaurants.

5. Since the time that Magnotta Winery started selling EPIC wine, it has sold approximately 4200 bottles of wine throughout Ontario under the EPIC label.

6. Magnotta Winery has used the trade-mark EPIC continuously since it first started selling EPIC wine in Canada as described in paragraph 4 and up to the present time and in no way has interrupted or abandoned its use.

[8] The evidence in the Durell affidavit describes how the EPICA mark is depicted on a label on the Applicant's wine which she procured from the LCBO location at First Canadian Place in Toronto, Ontario, on March 10, 2014 (Durell, Exhibit B). Exhibits C through E to her affidavit show how the Mark is depicted in search results from online liquor control board websites across Canada.

### Applicant's Evidence

[9] Mr. Jerez describes the Applicant as a large producer of Chilean wines. He also provides details of the extent of wine allegedly sold in association with the Mark in Canada since April 2013, how the EPICA mark is depicted on the wine bottle labels, and the manner in which the wine is presented on store shelves in the various liquor control board outlets across the country. According to Mr. Jerez, between April 2013 and the date of his affidavit (i.e. August 27, 2014), total sales of the Applicant's wine in Canada were \$729,314.64. Mr. Jerez further states that since the Applicant began selling its wine in Canada, the Applicant has spent approximately \$120,000 on in store direct to consumer "point of sale" advertising in the provincial government controlled liquor stores throughout Canada. This figure did not include money spend on advertising for events or via magazines, online or social media in Canada.

[10] Ms. Sham was asked to conduct an Internet search of "G. Marquis The Silver Line Epic" or "G Marquis Epic" to locate release date or publicly available date information in Canada concerning the "G Marquis The Silver Line Epic" branded wine. Two of the links were from wine information and review websites (grapeguy.ca and winealign.com), and the pages from these websites both show a wine referred to as "G. Marquis The Silver Line Epic 2010" which is similar to what appears on the label attached as Exhibit A to the Magnotta affidavit. Further, both of the results indicate that the wine's availability and release date was November 9, 2013.

### Grounds of Opposition

Non-compliance – section 30(e)

[11] The Opponent pleads that the application does not comply with the provisions of section 30(e) in that the Applicant did not intend to use the Mark as applied for in Canada. On the contrary, the Opponent pleads that if the Applicant intended to use any trade-mark in Canada, it intended to use the mark as shown in application No. 1,592,128, which to the average Canadian consumer is either the mark EPIC \_ A (the hyphen highlighting the space between the word EPIC and the letter A) or the trade-mark EPIC, followed by the series number A.

[12] The material date for determining whether the application complies with the provisions of section 30(e) is the filing date of the application. Since the application contains a statement that the Applicant by itself and/or through a licensee intends to use the trade-mark in Canada, it formally complies with section 30(e). The issue therefore becomes whether or not the Applicant substantially complied with section 30(e), i.e. was the Applicant's statement that it intended to use the Mark true? [see *Home Quarters Warehouse, Inc v Home Depot, USA, Inc* (1997), 76 CPR (3d) 219 (TMOB); *Jacobs Suchard Ltd v Trebor Bassett Ltd* (1996), 69 CPR (3d) 569 (TMOB).]

[13] In view that the facts regarding an applicant's intentions are particularly within the knowledge of the applicant, the initial burden on the opponent is lighter than usual regarding section 30(e). However, the opponent may only successfully rely upon the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's application [see *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paragraphs 30-38 (CanLII)]

[14] The Opponent submits that the Applicant's evidence shows that the Applicant did not intend to use the Mark as applied for, but rather the EPICA & Design mark shown in the Applicant's co-pending application 1,592,128 (filed August 29, 2012). In this regard, the Opponent submits that the predominant manner in which the Mark appears on the labels attached to the Applicant's wine bottles shows the letters "epic" disposed horizontally and the letter "a" being disposed vertically (see Durell, Exhibit B and Jerez, Exhibit A). The Opponent submits that this evidence shows the design mark from the Applicant's co-pending application which is

not merely a depiction of the word mark EPICA but rather is either EPIC\_ A or EPIC followed by the series letter A.

[15] I will begin by noting that none of the evidence relied upon by the Opponent under this ground is dated prior to the material date for this ground of opposition (i.e. May 16, 2011). This by itself, however, does not preclude the consideration of evidence arising subsequently insofar as it indicates a situation existing at the material date [*Bacardi & Co Ltd v Jack Spratt Mfg Inc.*, 1 CPR (3d) 122 at 125-126].

[16] The test for determining if the use shown is also use of the Mark is a question of fact based on the public's first impression [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)]. The jurisprudence emphasizes the maintenance of identity and recognition as well as the preservation of dominant features as the criteria for trade-mark use [see *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[17] In *Kraft General Foods Inc v Fraser Valley Milk Producers Cooperative* (1994), 56 CPR (3d) 560 (TMOB) at 562, former Hearing Officer Savard made the following comments regarding whether the use shown in that case was use of the registered mark:

In the present case, the registered trade mark is the word "shape" in block letters. The trade-mark as used is as follows... the letter "A" has been replaced by the design of a stick human figure whose legs form the left and right arm of the letter "A". In my opinion, the purchaser of the wares would still perceive and identify the trade mark as SHAPE. The entire word mark is being used albeit in a stylized form. In applying the principles set out in *Munsingwear* and *Nightingale*, *supra*, and the principles set out in *Honey Dew Ltd. v. Rudd and Flora Dew Co.*, [1929] 1 DLR 449 at p 453, [1929] Ex CR 83. I am of the view that this minor variation is not apt to deceive the consuming public in any way.

[18] Applying the above reasoning to the present case, I am of the view that the public would perceive and identify the trade-mark used as the trade-mark EPICA. While the manner in which it has been used on the front of the wine labels shows the letters EPIC displayed horizontally and the letter A displayed vertically directly under the word EPIC, the letters are all in the same size and type of font. I therefore find that the entire word mark was being used, albeit in a stylized form. The design feature that was added (i.e. the letter A being depicted vertically instead of horizontally) was only a minor element of the mark as a whole and did not result in the Mark EPICA being unidentifiable.

[19] As I am satisfied that the public would have perceived the trade-mark that was used as the applied for Mark, the Opponent has not met its evidential burden to support its argument that the Applicant did not intend to use the applied for Mark. The section 30(e) ground is therefore not successful.

Non-distinctive – section 2

[20] The Opponent pleads that the Mark is not distinctive in that it does not distinguish nor is adapted to distinguish the Applicant's goods from the goods of the Opponent provided in association with its trade-mark EPIC.

[21] The material date for assessing the issue of distinctiveness is the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. There is an initial burden on the Opponent to establish that, as of November 4, 2013, its EPIC trade-mark was known to an extent that could negate the distinctiveness of the Mark. The Opponent's trade-mark's reputation should be substantial, significant or sufficient [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[22] The pertinent points of Ms. Magnotta's evidence have been summarized above. The Applicant's agent submits that there are at least two substantive issues with Ms. Magnotta's evidence.

[23] First, the Applicant's agent points out that Ms. Magnotta simply indicates that the EPIC trade-mark has been used since April 2012 "by displaying the trade-mark on labels attached to wine bottles". She does not state whether that use as she defines it occurred during the public display of any EPIC branded wine since April 2012 when the trade-mark was allegedly first displayed on a label. The Applicant's agent notes that Ms. Magnotta does not specify which liquor control boards, duty free stores or restaurants the EPIC wine is sold or was sold in. Further, although Ms. Magnotta states that 4200 bottles of wine were sold under the EPIC label since the time that the Opponent started selling EPIC wine, Ms. Magnotta did not state when the first sale of EPIC wine actually was. She also did not produce any copies of invoices or sales revenue information concerning the EPIC branded wine to corroborate her claims.

[24] Also on this point, the Applicant's agent submits that the evidence of Ms. Sham directly contradicts the evidence of Ms. Magnotta. In this regard, the Applicant's agent notes that both of the Internet search results of Ms. Sham indicate that the Opponent's wine's availability and release date was November 9, 2013 (which is after the material date for this ground and contradicts the April 2012 date provided by Ms. Magnotta).

[25] Another issue identified by the Applicant's agent is that on the EPIC wine label attached as Exhibit A to Ms. Magnotta's affidavit, nowhere on the label is reference to the Opponent. Instead, the label refers to "G. Marquis Vineyards" in Beamsville, Ontario. Ms. Magnotta does not explain anywhere in her affidavit what, if any, connection G Marquis or G. Marquis Vineyards has to the Opponent whose principal business is in Vaughan Ontario.

[26] In response, the Opponent's agent submits that the November 9, 2013, release date only relates to release in the Ontario Liquor Control Board stores and does not address the other channels where the Opponent states that it has sold its EPIC wine, namely duty free stores and restaurants. The Opponent's agent submits that regardless, this evidence should not be given any weight because it is hearsay.

[27] The Opponent's agent further submits that the Applicant's agent had the opportunity to cross-examine Ms. Magnotta on her affidavit but it chose not to do so. Finally, the Opponent's agent asserts that it is not necessary that the name of the trade-mark owner appear in association with the trade-mark when used on the packaging.

[28] I find that the Opponent's evidence is open to attack in several respects. While I agree with the Opponent that it is not necessary that the name of the trade-mark owner appear on the packaging, Ms. Magnotta does not explain anywhere in her affidavit what, if any, connection G Marquis or G. Marquis Vineyards has to the Opponent. It is therefore not possible to know whether or not this company is licensed to use the Mark.

[29] Next, while I acknowledge that Ms. Magnotta was not cross-examined, the absence of cross-examination does not prevent me from assessing the value or weight of her evidence [see *London Drugs Ltd v Purpharm Inc* (2006), 54 CPR (4th) 87 at 92-93 (TMOB)]. I agree with the Applicant's agent that the statements contained in the operative paragraphs of the Magnotta

affidavit are not as clear as they could be. I am therefore not prepared to give full weight to this evidence.

[30] With respect to the evidence of Ms. Sham, in view that I consider it necessary and there is no indication that it is not reliable, I am prepared to give some weight to it. I therefore agree with the Applicant that it is indeed curious that the release date of the Opponent's wine in Ontario was 19 months after Ms. Magnotta claims the Opponent began selling its wine in Ontario.

[31] Even if I were to give full weight to the Magnotta affidavit and accept that the Opponent began selling wine in Canada in association with the EPIC mark in April 2012, I still would not find that the Opponent had met its burden under this ground. At best, the Opponent has shown that it has sold 4200 bottles of wine in Ontario in association with the mark EPIC from April 2012 until April 3, 2014 (the date of Ms. Magnotta's affidavit), and we do not know how much of this wine was sold before November 4, 2013, the material date for this ground. Further, the Opponent has not shown that the Mark has been otherwise made known in Canada through promotion or advertising. I therefore conclude that the Opponent has not shown that its trade-mark has become known in Canada to a sufficient extent to negate the distinctiveness of the applied for Mark [*Bojangles, supra*].

[32] This ground of opposition is therefore not successful.



Disposition

[33] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

---

Cindy R. Folz  
Member,  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Hearing Date: 2015-08-26

Appearances

Stephen Georgas

For the Opponent

Christine de Lint

For the Applicant

Agents of Record

Miller Thomson

For the Opponent

Norton Rose Fulbright Canada

For the Applicant