

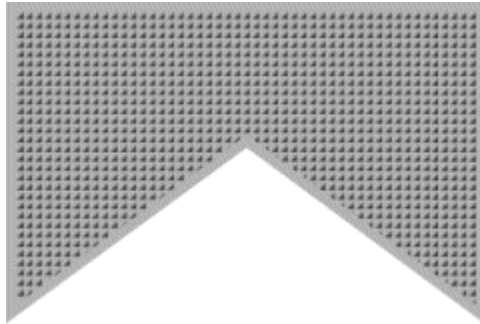


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 225
Date of Decision: 2012-11-21

**IN THE MATTER OF OPPOSITIONS by
Imperial Tobacco Canada Limited and
Marlboro Canada Limited to application
Nos. 1,298,547 and 1,299,494 for the trade-
marks ROOF Design in the name of Philip
Morris Products S.A.**

[1] On April 20, 2006, Philip Morris Products S.A. (the Applicant) filed an application to register the trade-mark ROOF Design (shown below) based on proposed use of the mark in Canada in association with the following wares, as revised:



(1) Tobacco, raw or manufactured, including cigars, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, tobacco substitutes (not for medical purposes); smokers' articles, namely, cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays not of precious metals, their alloys or coated therewith; pipes, pocket apparatus for rolling cigarettes, lighters; matches. (the Wares)

[2] The application is also based on use and registration of the mark in Switzerland and claims priority of a Swiss application filed on April 19, 2006 under No. 53533/2006.

[3] On April 27, 2006, the Applicant filed another application to register the trade-mark ROOF Design (shown below) based on proposed use of the mark in Canada in association with the same Wares, as well as use and registration of the mark in Switzerland. This second application also claims priority of a Swiss application, namely application No. 2005 59322 filed on November 14, 2005:



[4] Unless indicated otherwise, the ROOF Design mark covered by application No. 1,298,547 filed on April 20, and the ROOF Design mark covered by application No. 1,299,494 filed on April 27 will be collectively referred to as the Marks.

[5] The applications were advertised for opposition purposes in the *Trade-marks Journal* of June 20, 2007 (with respect to application No. 1,298,547), and July 18, 2007 (with respect to application No. 1,299,494).

[6] Imperial Tobacco Canada Limited and Marlboro Canada Limited (collectively referred to as the Opponent), filed a statement of opposition against each application on November 11, 2007 (with respect to application No. 1,298,547), and December 17, 2007 (with respect to application No. 1,299,494), which statements of opposition were later on amended by the Opponent with leave of the Registrar granted on November 25, 2008. The Applicant filed and served a counter statement in each case in which it denied the Opponent's allegations.

[7] As its evidence under section 41(1) of the *Trade-marks Regulations*, SOR/96-195 (the Regulations), the Opponent filed, in both files, the following:

- the affidavit of Ed Ricard, the Division Head, Marketing Research & Information of the Marketing Division of the opponent Imperial Tobacco Canada Limited, sworn on October 27, 2008;
- the affidavit of Dr. Chuck Chakrapani, Research Mentor and Industry Liaison Advisor at Ted Rogers School of Management and a Senior Research Fellow at the Centre for the Study of Commercial Activity at Ryerson University in Toronto, as well as the Chief Knowledge Officer of BehaviorWorx in Toronto and of the Blackstone Group in Chicago, sworn October 24, 2008;
- the affidavit of Corinne Matte, an assistant employed by the firm representing the Opponent, sworn August 25, 2008;
- a certified copy of registration No. TMDA55,988 for the trade-mark MARLBORO;
- a certified copy of the decision rendered on November 1st, 1985 by Mr. Justice Rouleau of the Federal Court of Canada, Trial Division in Federal Court file No. T-3387-81; and
- a certified copy of the decision rendered on September 29, 1987 by Mr. Justice MacGuigan of the Federal Court of Appeal of Canada in Federal Court of Appeal file No. A-906-85.

[8] Mr. Ricard and Dr. Chakrapani were cross-examined on their affidavits and the transcripts of the cross-examinations and the responses to undertakings form part of the Registrar' records. The Opponent further filed under section 44 of the Regulations, the following:

- a certified copy of the pleading named Second Fresh Amended Statement of Defence and Counterclaim dated March 10, 2010, filed in Federal Court file No. T-1784-06; and
- certified copies of the judgment and reasons for judgment rendered on June 29, 2012 by Mrs. Justice Gauthier of the Federal Court of Appeal of Canada in file No. A-463-10.

[9] As its evidence under section 42(1) of the Regulations, the Applicant filed in each file an affidavit of Anna DiDomenico, a Senior Law Clerk employed by the firm representing the Applicant, sworn January 7, 2010 (with respect to application No. 1,298,547), and February 1, 2010 (with respect to application No. 1,299,494). I will use the singular form to refer to these two affidavits, which are identical except for their execution date. The Applicant further filed under section 44 of the Regulations, a copy of the Notice of Application for Leave to Appeal to the Supreme Court of Canada (Docket – 35001) filed on September 28, 2012 from the judgment rendered by the Federal Court of Appeal on June 29, 2012 in file No. A-463-10.

[10] Both parties filed written arguments in each case and were represented by counsel at an oral hearing during which the Opponent withdrew some of the grounds of opposition pleaded in its amended statements of opposition, namely:

With respect to application No. 1,298,547:

- ground of opposition alleged in paragraph 19. a) (i) (1) and (2) of the amended statement of opposition alleging that the Applicant had no intention of using the applied-for trade-mark in Canada contrary to section 30(e) of the Act; and
- ground of opposition alleged in paragraph 19. a) (ii) (2) of the amended statement of opposition alleging that the Applicant could not have been satisfied that it was entitled to use the applied-for trade-mark in Canada in association with the Wares contrary to section 30(i) of the Act in view of the Applicant depreciating the value of the goodwill attaching to the Opponent's registered trade-mark MARLBORO contrary to section 22 of the Act.

With respect to application No. 1,299,494:

- ground of opposition alleged in paragraph 20. a) (i) of the amended statement of opposition alleging that the application is null and void as it does not meet the requirements of section 30 of the Act as the Applicant is requesting registration, *inter alia*, on the basis of proposed use whereas the applied-for trade-mark has already been

used in Canada in association with the tobacco product “cigarettes” contrary to section 30(b) of the Act; and

- ground of opposition alleged in paragraph 20. a) (ii) (2) of the amended statement of opposition alleging that the Applicant could not have been satisfied that it was entitled to use the applied-for trade-mark in Canada in association with the Wares contrary to section 30(i) of the Act in view of the Applicant depreciating the value of the goodwill attaching to the Opponent’s registered trade-mark MARLBORO contrary to section 22 of the Act.

[11] The remaining grounds of opposition in both files can be summarized as follows:

- the Applicant could not have been satisfied that it was entitled to use the Marks in Canada in association with the Wares contrary to section 30(i) of the Act in view of the Applicant unfairly competing with the Opponent by expressly and intentionally creating confusion with the trade-mark MARLBORO of the Opponent, as more fully described in the introductory paragraphs of the amended statements of opposition, the whole contrary to section 7(b) of the Act and section 1457 of the Civil Code of Quebec;
- the Marks are not registrable pursuant to section 12(1)(d) of the Act as they are confusing with the Opponent’s trade-mark MARLBORO registered under No. TMDA55,988;
- the Applicant is not the person entitled to registration of the Marks pursuant to section 16(2)(a) and (c) and section 16(3)(a) and (c) of the Act as the trade-mark MARLBORO and the trade-name MARLBORO CANADA have been used by the Opponent since well before the priority dates of filing of the instant applications, and the Marks are confusing therewith as more fully described in the introductory paragraphs of the amended statements of opposition; and
- the Marks are non-distinctive of the Applicant in that they neither distinguish nor are adapted to distinguish the Wares as the Marks create confusion with the Opponent’s trade-mark MARLBORO and its trade-name, the whole as more fully described in the introductory paragraphs of the amended statements of opposition.

Onus

[12] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. However, there is an initial evidentiary burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

[13] Before assessing each of the remaining grounds of opposition in the instant cases, I wish to do a brief summary of the history and the facts of these cases.

Overview of the history and the facts of the instant cases

[14] The parties to the instant proceedings are not strangers. They have a long history with respect to the use of the trade-mark MARLBORO in Canada and have been involved in this regard in a few legal disputes, including the ones referred to above, before the Federal Court in *Philip Morris Incorporated v Imperial Tobacco Ltd* (1985), 7 CPR (3d) 254 (FCTD) (Rouleau J.) (hereinafter *Philip Morris 1985*), upheld by the Federal Court of Appeal in *Philip Morris Inc v Imperial Tobacco Ltd (No 1)* (1987), 17 CPR (3d) 289 (FCA) (MacGuigan J.) (hereinafter *Philip Morris 1987*), and *Philip Morris Products SA and Rothmans, Benson & Hedges, Inc v Marlboro Canada Limited and Imperial Tobacco Canada Limited* (2010), 90 CPR (4th) 1 (FC) (de Montigny J.) (hereinafter *Philip Morris 2010*), overturned in part by the Federal Court of Appeal in *Marlboro Canada Limited and Imperial Tobacco Canada Limited v Philip Morris Products SA and Rothmans, Benson & Hedges Inc* (2012), 103 CPR (4th) 259 (FCA) (Gauthier J.) (hereinafter *Philip Morris 2012*).

[15] The history of the use of the trade-mark MARLBORO and how it became registered in the name of the Opponent in Canada is reflected in Mr. Ricard's evidence and was also reviewed and described in detail by Mr. Justice Rouleau in *Philip Morris 1985* and by Mr. Justice de Montigny in *Philip Morris 2010* and is not disputed by the parties in the instant proceedings.

[16] The history of the use of the "roof" geometric design (described below) by the Applicant

and its predecessors, as reflected in Mr. Ricard's evidence, was also reviewed and described in detail by Mr. Justice de Montigny in *Philip Morris 2010* and is not disputed by the parties.

[17] More particularly, both parties rely upon these judicial findings of fact, as well as the evidence of Mr. Ricard, disclosing the following:

- The Applicant's predecessors in title and former affiliated companies (hereinafter sometimes collectively referred to as Philip Morris) started marketing and selling cigarettes in association with the trade-mark MARLBORO in the United Kingdom in 1883 and expanded its market by distributing these products in Canada in or about 1905. [*Philip Morris 2010* at para 12]
- The trade-mark MARLBORO in Canada was sold by a predecessor in title of the Applicant to a predecessor in title of the Opponent some time in the 1920s and was then registered in Canada in 1932 under No. 55,988 in association with "tobacco in all its forms and particularly to be used in connection with the sale of cigarettes, cigarette papers, cigarette tubes, tobacco, snuff, and cigars". It has since then been continuously used in Canada by the Opponent and its predecessors in title in association with cigarettes. Philip Morris, on the other hand, owns the rights in the trade-mark MARLBORO throughout the world with the exception of Canada. [*Philip Morris 2010* at para 14; Ricard affidavit at paras 8-17]
- In the early 1950s, long after the Opponent's predecessor acquired an interest in the word mark MARLBORO in Canada, Philip Morris redesigned its cigarette packaging and image for the cigarettes it sold in international markets (i.e. outside Canada) in association with its MARLBORO trade-mark. The package design incorporated a striking red "roof" geometric design (hereinafter the "ROOFTOP design") that is substantially the same roof design that is the subject of the instant applications. A reproduction of Philip Morris' redesigned cigarette pack is shown below:

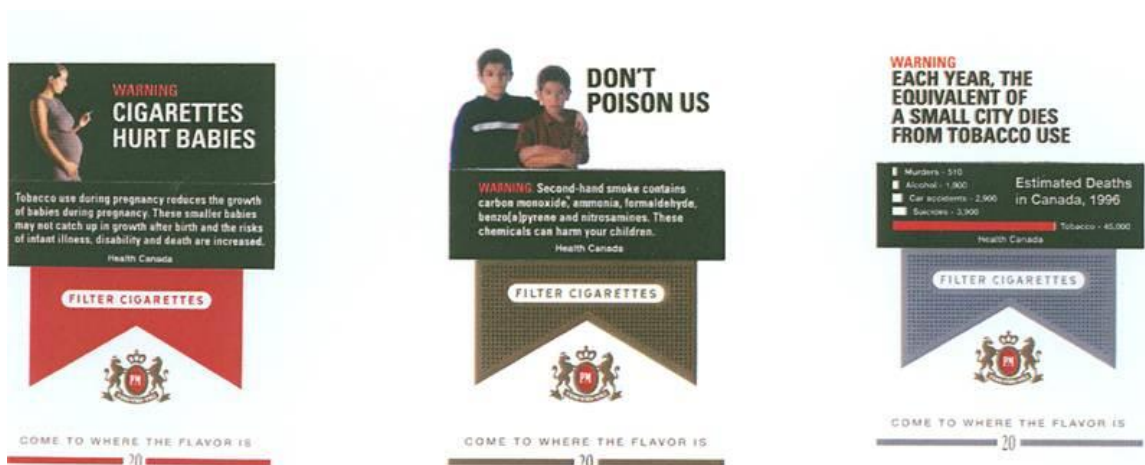


[*Philip Morris 2010* at paras 20-21; Ricard affidavit at para 18]

- Philip Morris also undertook advertising campaigns to market its newly-configured and redesigned product. The ads featured rugged cowboys working in “Marlboro country” and featured phrases including “Come to Where the Flavor Is”. The advertisements were widely disseminated outside Canada and became very well known in international markets. [*Philip Morris 2010* at para 24; Ricard affidavit at paras 18 and 24]
- The international Philip Morris MARLBORO cigarette product and package redesign and the advertising campaigns were highly successful, and are recognized today among the most successful ever. Philip Morris MARLBORO cigarettes became the number one selling cigarette in the world by 1972. Today, the Philip Morris MARLBORO cigarettes remain the best selling cigarettes in the world. [*Philip Morris 2010* at para 25; Ricard affidavit at paras 19-21]
- Two other products were sold in Canada using the ROOFTOP design. In 1958, the Applicant’s predecessor began selling the MATADOR brand of cigarettes in Canada. The product was sold in packages using substantially all of the elements of the Philip Morris MARLBORO products sold elsewhere in the world by the Applicant, except that the word MATADOR appeared on the packages instead of the word MARLBORO. Also sold by the Applicant’s predecessors starting in approximately 1970 was the MAVERICK brand of cigarettes, which was discontinued in approximately 1978. The sales of MATADOR and/or MAVERICK brand cigarettes sold in such packages,

however, were never significant and the distribution thereof was fairly limited. [*Philip Morris 2010* at paras 26-30; Ricard affidavit at para 26]

- The Applicant and/or its predecessors have, throughout the years, registered several of the various elements of the redesigned Philip Morris MARLBORO brand depicted hereinabove, as set out in the attached Annex “A”. [*Philip Morris 2010* at para 6; Ricard affidavit at para 23; DiDomenico affidavit attaching certified copies of the six registrations listed in Annex “A” as well as of registration No. TMA111,226 for the MATADOR & DESIGN trade-mark]
- Between 1958 (date of the first registration of a ROOFTOP design mark by the Applicant and/or its predecessors) and 2006 (date of the latest version of the ROOFTOP design mark registered by the Applicant), the various elements of the Philip Morris MARLBORO brand packaging, whether used and/or subject of any of the trade-mark registrations listed in Annex “A”, were always used in association with either the MATADOR or MAVERICK brand names. However, in 2006, the Applicant, through its Canadian licensee, began selling cigarettes with the Philip Morris package get-up with no brand name (which the Applicant refers as the “Rooftop”). Copies of photographs of these cigarette packages, which were offered in a red, silver and gold version (allegedly different strength of tobacco), are reproduced below:



[*Philip Morris 2012* at para 10; Ricard affidavit at paras 26 and 30]

- The get-up or label of the no-name product is unique in that, for the very first time in the world, cigarettes were offered for sale in a package with no brand name (or no word mark). [*Philip Morris 2012* at para 10; Ricard affidavit, Exhibit ER-13]
- The Opponent objected to the launch of the no-name brand cigarettes and alleged that they infringed the registered trade-mark MARLBORO. An action was then commenced in Federal Court, by which the Applicant sought a declaration that the sale of its “Rooftop” cigarettes (that is the no-name brand cigarettes) in Canada does not infringe any rights of the Opponent, and specifically, that the sale of the “Rooftop” cigarettes in packaging that bears the ROOFTOP design mark, is not confusing with the word mark MARLBORO. The Opponent responded with a counterclaim alleging precisely that infringement, which dispute ultimately led to the decisions in *Philip Morris 2010* and *Philip Morris 2012*.

[18] The most relevant passages of these two latter decisions will be reviewed in the course of my analysis.

[19] I will now analyze the grounds of opposition in regard to the evidence of record, without necessarily respecting the order in which they were raised in the statements of opposition.

Grounds of opposition

Non-registrability of the Marks pursuant to section 12(1)(d) of the Act

[20] The Opponent has pleaded that the Marks are not registrable having regard to the provisions of section 12(1)(d) of the Act in that they are confusing with the Opponent’s registered trade-mark MARLBORO identified above. I have exercised the Registrar’s discretion to confirm that this registration is in good standing as of today’s date, which date is the material date to assess a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[21] As the Opponent’s evidentiary burden has been satisfied, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between each of the Marks and the Opponent’s trade-mark MARLBORO.

[22] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[23] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 wares, 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. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[24] Each of the Marks and the Opponent's MARLBORO trade-mark are inherently distinctive.

[25] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. As indicated above, there is no dispute between the parties that the trade-mark MARLBORO has been continuously used in Canada by the Opponent and its predecessors in title in association with cigarettes since it was sold by a predecessor in title of the Applicant to a predecessor in title of the Opponent in the 1920s. From 2000 until mid October 2008, Canadian sales of MARLBORO brand cigarettes exceeded 12 million dollars, which amount represents over 76 million sticks of MARLBORO brand cigarettes sold in Canada [Ricard affidavit at para 12]. The MARLBORO trade-mark is used by the Opponent only on tailor-made cigarettes [Ricard examination, Q. 129].

[26] By comparison, there is no evidence that the Applicant has commenced use of either one of its proposed use Marks in Canada in association with any of the Wares or that the Marks have become known to any extent whatsoever in Canada in association with such wares. The extent to which the ROOFTOP design displayed on the Applicant's cigarettes packages reproduced above has become known in Canada will be considered later on in my analysis under the section 6(5)(e) factor. However, it is not relevant to the consideration of the acquired distinctiveness of the Applicant's proposed use Marks *per se*.

[27] The overall consideration of the section 6(5)(a) factor thus favours the Opponent.

b) the length of time the trade-marks have been in use

[28] For the reasons indicated above, this factor favours the Opponent.

c) the nature of the wares, services or business; and d) the nature of the trade

[29] As for the nature of the wares and services and the nature of the trade, I must compare the Applicant's statements of Wares with the statement of wares in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[30] There is a clear overlap between the Wares and those covered by the Opponent's registration. The Applicant and the Opponent being direct competitors on the Canadian cigarette market, the nature of their trade and their respective channels of trade are identical.

[31] The overall consideration of the section 6(5)(c) and (d) factors thus favours the Opponent.

e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[32] There is absolutely no degree of resemblance in appearance or sound between the parties' respective marks. The contentious issue is in respect of the ideas suggested by the marks.

[33] The Opponent submits that the idea conveyed by each of the Marks to the Canadian consumer is MARLBORO, the registered mark of the Opponent. More particularly, the Opponent submits that the evidence demonstrates that the Applicant's predecessors and their related companies, up to and including the Applicant, had historically always been using various elements of the Philip Morris MARLBORO brand in Canada with either the MATADOR or MAVERICK brand names. The Opponent submits that by launching the no-name brand, the Applicant, companies related thereto, their predecessors and/or licensees have deliberately attempted to create a "brand name void" on the packaging of the no-name cigarettes thereby compelling Canadian retailers and consumers to fill such void using the brand name MARLBORO [Ricard affidavit at paras 30-33]. The Opponent further submits that this brand name void is critical to the strategy implemented by the Applicant given the strict regulation of the tobacco industry which makes it virtually impossible to purchase a pack of cigarettes without either the Canadian cigarette consumer or retailer stating the brand name of the cigarettes the consumer wishes to purchase.

[34] Indeed, the Canadian market is now what is called a "dark market". As explained by Mr. Justice de Montigny in *Philip Morris 2010*, the sale of tobacco products has been increasingly regulated in Canada. Not only are cigarette packages now covered with a health warning that must occupy 50% of the display surface, but all provinces have now enacted legislation banning the display of tobacco products in retail shops. Similarly, the promotion and advertisement of tobacco products is severely restricted, making it virtually impossible for tobacco manufacturers to communicate directly with consumers except in very limited circumstances [*Philip Morris 2010* at para 53; *Philip Morris 2012* at paras 78-80].

[35] The Opponent submits that the above-described compulsion to fill the brand name void has been fuelled by the notoriety and recognition in Canada of the Philip Morris MARLBORO brand and brand name, including the ROOFTOP design, the predominant graphical component of which does not differ substantially from the Marks, and reinforced by the Applicant's distribution of point of sale material to Canadian retailers displaying the Marks or a trade-mark not differing substantially therefrom as depicted below:

July 25th, 2006

Important Notice to Retailers:

In conjunction with the launch of the new ROOFTOP brand by Rothmans, Benson & Hedges Inc. (RBH), you are being provided with a Presentation Box that contains copies of the packaging and ordering information for this new product. Please note that this introduction kit is being provided for trade information purposes only. It is not to be shown to consumers or used as a display that is visible to consumers and it is not for resale to consumers.

You will note that this new product is unique in that no brand name appears on the product packaging. Instead of a name, the product is identified by its distinctive ROOFTOP package design. The ROOFTOP package design is owned by Philip Morris Products S.A., with RBH being the exclusive licensee in Canada. You will recognize the ROOFTOP package design as that which is used internationally by Philip Morris Products S.A. and its affiliated companies.

It is important for you, as the retailer, to know that for historical reasons the trademark registration for the word MARLBORO in Canada is not owned by Philip Morris Products S.A., RBH or their affiliated companies.

Accordingly, the MARLBORO trademark cannot be used in connection with RBH's new ROOFTOP brand.

A brand of cigarettes is sold in Canada under the name "MARLBORO Canadian/Canadien". That product is not, however, in any way associated with Philip Morris Products, S.A., RBH or their affiliated companies and the packaging design for that product is dramatically different from RBH's new ROOFTOP brand.

July 25th, 2006

Important Notice to Retailers:

Rothmans, Benson & Hedges Inc. is pleased to announce the introduction of the cigarette brand famous for its ROOFTOP design that has adorned cigarette packages around the world since 1954.

Unlike any other trademark, it has become recognized for its high quality and rich tobacco flavor. The pack with the ROOFTOP design doesn't need a name because after all...it's what's inside the pack that counts – high quality American blend cigarettes made possible by the famous Richmond recipe!

The ROOFTOP product is offered in three sku's; ROOFTOP Red, ROOFTOP Gold, and ROOFTOP Silver and is being produced in a 20's flip top hard pack. The product will be available starting July 25, 2006 in the Ontario market.

<u>ROOFTOP Product Description</u>	<u>Code</u>
ROOFTOP Red	00310
ROOFTOP Gold	00311
ROOFTOP Silver	00312

[Ricard affidavit, Exhibit ER-11]

[36] The Opponent submits that the Applicant's strategy has clearly succeeded as evidenced by third party publications making the association between the no-name brand packaging and the Philip Morris MARLBORO brand and brand name [Ricard affidavit at paras 34-35, and Exhibits ER-12 and ER-13].

[37] The Opponent submits that the success of the Applicant's strategy is further demonstrated by the survey of Canadian cigarette consumers and retailers conducted by the Opponent shortly after the launch of the no-name brand [Dr. Chakrapani affidavit attaching as Exhibit E a complete report of the two studies]. I will revert to that survey below.

[38] As such, the Opponent submits that not only does the evidence demonstrate that Canadian cigarette smokers and Canadian retailers link the no-name brand, the predominant ROOFTOP design of which does not differ substantially from the Marks, to the Philip Morris MARLBORO brand and brand name, the evidence demonstrates that the association between the no-name brand and therefore the Marks and the trade-mark MARLBORO is inevitable at the time of transfer of possession or property of the no-name brand cigarettes bearing the Marks, thereby constituting use thereof.

[39] The Applicant submits to the contrary that there is no connection between the ROOFTOP design taken up in the Marks and the Opponent's cigarettes. It submits that such design looks like the roof of a house. The Opponent's mark is a word mark while the Marks are design marks. To the extent that the ROOFTOP design is said to suggest the idea of the word MARLBORO, it is to the Applicant's own international product. This is not source confusion, or even misidentification, but confirmation that the consumer clearly understands the source of the product.

[40] The Applicant further submits that the Opponent's survey evidence is not relevant to the issues in the instant oppositions and that the inherent methodological and technical problems with the survey render it inadmissible or worthy of little to no weight.

[41] More importantly, the Applicant submits that the *Philip Morris 2010* and *Philip Morris 2012* decisions are dispositive of the Opponent's allegations of confusion between each of the Marks and the Opponent's MARLBORO word mark.

[42] I am in general agreement with the Applicant's submissions for the following reasons.

The Opponent's survey evidence

[43] Addressing first the Opponent's survey evidence, I find that little weight if any ought to be afforded to it in the instant proceedings. As explained by the Applicant, the survey filed in these proceedings is the same that was filed in the litigation before the Federal Court in *Philip Morris 2010*. The one and only objective of that survey was "to assess the possible misidentification by consumers and retailers of a new brand of cigarettes in Canada [ROOFTOP], with the brand 'MARLBORO' that is marketed outside of Canada" [Dr. Chakrapani affidavit at para 14]. The survey took place before the implementation of the dark market, between January and April 2007, in Vancouver, Edmonton, Toronto, and Montreal.

[44] As summarized by Mr. Justice de Montigny in *Philip Morris 2010*, for the Consumer Study, interviewers showed smokers de-branded ROTHMAN, de-branded DUNHILL and ROOFTOP packages. They were first asked for each brand: "Can you tell me the brand name of this cigarette or not?" They were then asked: "Why do you say that?" Anything else?" The

reason why DUNHILL and ROTHMAN brands were also shown was to correct for random guessing, since they shared common elements of the international Philip Morris brand. The three brands were presented on a clipboard and their order was rotated to minimize possible order bias. On average, one out of four smokers interviewed “misidentified” the ROOFTOP brand as “MARLBORO”. The main reasons given by smokers were the colour scheme, the graphic design on the package and the familiarity with the brand [*Philip Morris 2010* at paras 140-141].

[45] As further summarized by Mr. Justice de Montigny, in the second study, retailers drawn from the same cities were visited, on two separate occasions, by interviewers who identified themselves as consumers. During the first visit, the interviewer pointed to the ROOFTOP package and asked: “What’s that brand?”, followed by “What can you tell me about it?” During the first visit, almost one third of all retailers “misidentified” the ROOFTOP brand as “MARLBORO”. Only one in five identified it as “ROOFTOP”. In response to the second question during the first visit, 49% of those who misidentified the product as “MARLBORO” could not or would not say anything further. The remaining 51% gave various responses, including the following: it is a new brand, it is Canadian or American, it is a popular brand, it is a type of MARLBORO or made by Marlboro, etc. During the second visit, when asked if they carried “MARLBORO”, retailers pointed to or handed over the ROOFTOP brand in 38% of the cases [*Philip Morris 2010* at para 142].

[46] As revealed by Dr. Chakrapani’s mandate, both of his studies were directed at consumer perceptions related to “cigarettes”, not the Wares covered by the instant applications, which cover smokers’ articles and other tobacco wares, but not cigarettes. Furthermore, Dr. Chakrapani’s studies were not designed to test consumer reactions to the instant Marks (i.e. the ROOFTOP design mark in isolation) but to a ROOFTOP cigarette package made of a particular combination of various elements, which included the ROOFTOP design element. As a result, I find that the survey evidence is of no assistance to the Opponent in the instant proceedings and find it is unnecessary to address the Applicant’s submissions with respect to the inherent methodological and technical problems with the survey in light of the findings made by Mr. Justice de Montigny in *Philip Morris 2010*.

The *Philip Morris 2010* and *Philip Morris 2012* decisions

[47] As indicated by Mrs. Justice Gauthier in *Philip Morris 2012*, the trial judge had to address various issues relating to the Opponent's and the Applicant's trade-marks, as well as a claim of copyright infringement. Both parties appealed from various portions of Mr. Justice de Montigny's decision granting in part only the relief sought by the Applicant, and dismissing the claim of the Opponent for infringement of its registered Canadian trade-mark MARLBORO, as well as its request to strike out the registration of six of the Applicant's trade-marks relating to its ROOFTOP design marks, namely the ones listed in the attached Annex "A".

[48] More particularly, the Opponent appealed from the dismissal of its trade-mark infringement counterclaim and from the trial judge's refusal to strike out the Applicant's registered trade-mark TMA670,898. The Applicant for its part appealed from the trial judge's dismissal of its copyright infringement claim, the trial judge's ruling that the Opponent's registration of MARLBORO is still valid, and the trial judge's ruling that the Opponent was not estopped from challenging the registration of the Applicant's various ROOFTOP design marks, particularly TMA670,898.

[49] The Court of Appeal granted the Opponent's appeal from the dismissal of its trade-mark infringement counterclaim in respect of the unregistered label (front and side) of the Applicant's no-name cigarette package. It otherwise dismissed the Opponent's appeal from the trial judge's refusal to strike out the Applicant's registered trade-mark TMA670,898, and further dismissed the Applicant's appeal in its entirety.

[50] As stressed by both Mr. Justice de Montigny and Mrs. Justice Gauthier, that case is unique in that it raised an issue that had never been previously addressed. In essence, the Applicant was asserting that it did not infringe the Opponent's trade-mark. Rather, it claimed to be merely using a packaging design whose elements were created for and are owned by the Applicant, and which are the subject of trade-mark registrations in Canada. Furthermore, it argued that there was no source confusion, nor had there been any confusion as to what product the ROOFTOP packages contain. According to its argument, preventing the Applicant from identifying and selling its ROOFTOP products in Canada would be tantamount to abuse and overextension of whatever trade-mark rights the Opponent may have in the word mark

MARLBORO. The Opponent, on the other hand, submitted that the Applicant had deliberately invited consumers to associate its products with the internationally-known MARLBORO brand by using the same package dressing and by declining to label them with any particular brand name. In doing so, the Applicant would be implicitly usurping the Opponent's rights in the word mark MARLBORO [*Philip Morris 2010* at paras 3-4].

[51] I do not wish to review in detail the various findings made by the Federal Court, but only the most relevant passages that find application to the instant proceedings.

[52] As stressed by the Applicant, Mr. Justice de Montigny and Mrs. Justice Gauthier have both found that the individual ROOFTOP design marks that are listed in the attached Annex "A" are not confusing with the word mark MARLBORO. However, in the circumstances of that case, which, as already mentioned, were quite unique, the registrations invoked by the Applicant did not constitute an absolute defence to the Opponent's claim that the current *combination* (my emphasis) of elements used on the no-name package (front and side) constituted infringement [*Philip Morris 2012* at paras 111-112].

[53] In overturning Mr. Justice de Montigny's dismissal of the Opponent's trade-mark infringement counterclaim in respect of the unregistered label (front and side) of the Applicant's no-name cigarette package, Mrs. Justice Gauthier commented on the trial judge errors in the interpretation and application of the test for confusion. As indicated by Mrs. Justice Gauthier at para 62 of her decision, one of these errors is that it was not clear if the trial judge analysed each design mark individually (that is the six ROOFTOP design marks listed in Annex "A") or as a composite in his subsection 6(5) analysis. The problem was compounded by the fact that the trial judge accepted the Applicant's argument that the presence of the many elements that do not appear in each registered versions of these design marks did not have a material effect on the dominant features and the distinctiveness of the registered ROOFTOP design marks. Thus, he considered the get-up of the no-name package as a whole as an illustration of the use of the registered ROOFTOP design marks.

[54] Mrs. Justice Gauthier therefore proceeded to compare the Opponent's registered word mark MARLBORO with each version (red, gold and silver) of the Applicant's no-name get-up as proposed by the Applicant. I am reproducing below the most relevant parts of her analysis:

[68] As mentioned, [the Applicant] takes the position that its no-name package is simply one illustration of the many ways in which it can use its registered marks particularly its ROOFTOP design marks. I will address this question later where it will be of more importance, that is, in assessing [the Applicant]'s defences based on its registrations and on *estoppel*.

[69] Starting with paragraph 6(5)(a), like the trial judge, I find that these marks have inherent distinctiveness. The trial judge also stated that they were both well known, but did not explain on what basis he had come to that conclusion, other than stating that there was no evidence to the contrary. At the hearing, [the Applicant] did not direct this Court to any specific evidence in response to [the Opponent]'s comment that there was no evidentiary basis for such finding in respect of the Canadian market, especially in respect of its own MARLBORO.

[70] Even though in this case this will ultimately be of no moment, I prefer to regard these marks as known rather than well-known marks. Although [the Opponent]'s product has only a small fraction of the Canadian cigarette market ([the Applicant]'s MATADOR had even a smaller fraction), [the Opponent] has been using its registered MARLBORO mark for more than 80 years. [The Applicant] has used most of the elements of the get-up of the no-name package in Canada for a long time (some, like the red version of the ROOFTOP design, since 1958) with the word mark (brand name) MATADOR. However, the particular package label under review, which adds unregistered elements and includes no brand name, has only been on the market since July 2006 (a few months before the institution of the present proceedings). The silver version of the ROOFTOP design was also not used prior to 2006 (paragraph 6(5)(b)).

[71] The marks are used with the same wares (cigarettes) and in the same trade (paragraphs 6(5)(c) & (d)).

[72] Turning to paragraph 6(5)(e), there is no resemblance in appearance between those marks. As mentioned, the trial judge did not consider under that paragraph the fact that a number of consumers did refer to the no-name packages as Marlboro because, in his view, to consider such idea would be an unwarranted extension of the breadth of paragraph 6(5)(e). He stated that the expression "ideas suggested" should be restricted to those ideas that are inherent to the nature of the trade-marks in question (for example, the design of a penguin giving the idea of a penguin) (Reasons, at paragraph 290).

[73] If the examples used by the trial judge in paragraph 290 and in paragraph 249 of his Reasons (the word Panda evoking the same idea as a design mark depicting that animal) were meant to restrict the ambit of paragraph 6(5)(e) to ideas suggested by the literal and common meaning of a word or design, I cannot agree with this interpretation.

[...]

[76] Keeping in mind the need to adopt a purposive and contextual interpretation of paragraph 6(5)(e), I cannot see how such resemblance could be ignored. That being said,

obviously when one invokes a resemblance based on something out of the ordinary, evidence will be required to satisfy the Court that the particular association or suggestion does indeed exist as a matter of fact before it is considered in the analysis under paragraph 6(5)(e).

[77] Even if I am in error and paragraph 6(5)(e) calls for a more restrictive construction, resemblance in unusual ideas suggested by any one of the marks once established would have to be considered as part of the surrounding circumstances (opening words of subsection 6(5)). Either way, it cannot be ignored.

[78] Be that as it may, in the special circumstances of this case, I prefer to consider the confusion as to the name of the product sold in the no-name package as part of the surrounding circumstances (opening words of subsection 6(5)) because of the particularities of the cigarette retail market in Canada which are dictated by Government regulations.

[79] In Canada, except for a limited number of specialty shops that require a special permit, the cigarettes market is a “dark market”. This means that the products cannot legally be exposed to the public’s view. A consumer must specifically ask for a product at the counter.

[80] One can understand how in such context a label that includes no brand name, or the sole use of design marks on a cigarette package to identify its source, will prompt consumers to ask for the product by using a word or words that is (are) not necessarily displayed on the product.

[81] That explains why the trial judge said that there was a significant degree of confusion among consumers (and to a lesser extent retailers) “as to how they should refer to the no-name package” (Reasons, paragraphs 282 and 291). That is also what prompted him to refer to the need for interpretation and interaction with the retailers.

[82] It is clear from the evidence accepted by the trial judge that this association was intentionally conveyed by the compilation of the various elements used by [the Applicant] around the world in respect of its famous Marlboro brand and the reference to the “world famous imported blend”. Here, I am not considering whether [the Applicant] intended to infringe, as intention is irrelevant to infringement. Rather, I am considering this evidence as supporting the fact that this combination of elements on no-name package suggests to some extent (a significant number of consumers) an association with Marlboro.

[83] I also note that the evidence is to the effect, and this was admitted at the hearing by both sides, that the use of a brand name on a [Philip Morris] package bearing most of the other elements of the no-name package (like the MATADOR get-up) would likely be sufficient to sever the mental link or association with Marlboro.

[84] The result is that, as the trial judge found, a number of consumers refer to the [Applicant]’s no-name product as Marlboro. This means that, in a dark market where the

trade-marks are not in view, consumers will use the same name to refer to two different products offered by two different manufacturers. This must necessarily result in confusion as to source since consumers expect that products of the same kind, which they can refer to by the same name and buy through the same channels, will come from the same source. It matters little whether this situation is characterized as confusion or reverse confusion, the result is the same. [Underlining mine]

[55] I am also reproducing below, the most relevant parts of Mrs. Justice Gauthier's assessment of the Applicant's defences based on its registrations and on *estoppel*:

[87] At trial, [the Applicant] relied on the registration of its ROOFTOP design marks as a full and complete answer to the allegation of infringement made by [the Opponent] (*Remo* defence).

[...]

[90] However, in the case at bar, the label of the no-name package has not been registered. Also, [the Opponent] is adamant that none of the individual ROOFTOP design marks as registered by [the Applicant] is confusing with its word-mark MARLBORO. In fact, as mentioned, although these marks (except for the one registered in 2006), have been used in Canada in various combinations for very many years, none appear to have created confusion among Canadian consumers.

[91] Before the trial judge, the *Remo* defence only came into play because [the Applicant] argued that [the Opponent]'s attack on the no-name package was in fact an attack on a legitimate use of [the Applicant]'s registered ROOFTOP design marks (six different ones). In response, [the Opponent] argued, among other things, that if the combination on the no-name package is confusing, then the individual marks that are part of this combination must also be confusing and their registration should be struck (Reasons, paragraph 216).

[92] Although he noted that this argument by [the Opponent] could not be easily disposed of (Reasons, paragraph 221), the trial judge never discussed it further as he concluded that there was no likelihood of confusion.

[93] I have already found that the combination on the no-name package is confusing. Thus, I have to address the argument. In doing so, it becomes evident that the following two aspects are intimately linked: i) whether a combination of various registered and unregistered elements is regarded as a simple use of a registered mark and ii) whether, when such a combination is found to be confusing, it necessarily means that the registered marks included in it are confusing.

[...]

[96] Here, it is not disputed that one can use a registered mark in combination with other registered or unregistered elements or marks without that mark losing its distinctiveness. It all depends on the circumstances. Hence, the real question before us is whether this necessarily means that the protection of the registration of each ROOFTOP design marks can be extended to the whole of the combination in which they are used on the no-name package under review.

[...]

[99] In this case, the Registrar never considered whether the marks used in this particular combination on the no-name package met the test for registration. When the ROOFTOP design marks were individually registered, the Registrar did not have, in my view, to consider the likelihood of confusion of a composite of all [the Applicant]’s registered marks. Nor was he required to speculate as to the effect of the addition of unregistered elements on a particular label, which would include the proposed design mark.

[...]

[101] [The Applicant] correctly submits that it should not be forced to register its labels or every combination of its marks. Again, this is not the issue. If one registers a combination, one will have the benefit accruing from the said registration. If one chooses to use a combination without going through the process of registration, one will still have rights but not necessarily the same rights as those accruing from registration. This is true for every trade-mark one uses to distinguish one’s wares.

[...]

[103] To answer the real question before us, I must determine whether it is the unregistered combination alone or the individual marks, used essentially as registered, that are confusing. If the combination alone is confusing, in my view, it must necessarily be conveying a different message to the consumers than the individual registered marks. In such circumstances, the unregistered combination cannot claim the benefit of the *Remo* defence since it is not *simply* a use of the marks essentially as registered.

[104] Based on their registration, I have to assume that these marks were not confusing at the time of their registration. Is there any evidence that the situation had changed at the time the relevant proceedings were instituted? Having completed a subsection 6(5) analysis in respect of each individual mark, in my view, the answer is no.

[105] In that respect, I do not need to add to the comments I already made in paragraphs 69-71 above in respect of paragraphs 6(5)(a), (b), (c) and (d).

[106] There is no resemblance in appearance and sound (paragraph 6(5)(e)).

[107] Turning to the opening words of subsection 6(5), when the trial judge at paragraph 282 finds that there is confusion as to how to refer to the no-name package, he simply says that this was so for a “variety of reasons”. In other words, he did not find that consumers associated the word Marlboro to the no-name package because of the presence of one individual registered mark included on the said package.

[108] In any event, the surveys filed in evidence were not specifically designed to test whether consumers associated the name Marlboro to cigarette packages bearing only each individual ROOFTOP design mark essentially as registered. What was presented to the participants in the survey by both parties’ experts was the no-name package as a whole.

[109] As mentioned, what is clear is that [the Applicant] used its registered design marks, except for the silver version registered in 2006, in other combinations for many years without apparent problems. What appears to be different here is the fact that the combination at issue characterizes the source of the product further than any of the trade-marks previously registered or used by [the Applicant] by associating or identifying it expressly to Marlboro.

[110] Indeed, according to the evidence, [the Applicant]’s marketing department rejected the idea of using its registered word-mark ROOFTOP as part of the combination on the no-name package because it thought that such use would lead the consumer to conclude that the product was a fake, meaning that the no-name package was not from the source of its Marlboro.

[111] Based on the foregoing analysis, I conclude that the individual ROOFTOP design marks including the latest silver ROOFTOP design (TMA 670,898) are not confusing with the word-mark MARLBORO.

[112] This conclusion means that, in the particular circumstances of the case, which, as already mentioned, are quite unique, the registrations invoked by [the Applicant] do not constitute an absolute defence to [the Opponent]’s claim that the current combination of elements used on the no-name package (front and side) constitutes an infringement.
[Underlining mine]

[56] As indicated above, the instant applications are based on proposed use of the Marks in Canada in association with smokers’ articles and other tobacco wares, but not cigarettes. Whether or not each of the Marks will be used in combination with other elements in an overall arrangement and display resembling that of or identical to the Applicant’s no-name cigarette package is pure speculation, especially in view of the fact that as the decision in *Philip Morris 2012* presently stands, the Applicant is restrained by a permanent injunction from directly or indirectly selling, distributing, and/or advertising in Canada, cigarettes or other tobacco products in, or in association with, the no-name packaging reproduced above.

[57] It is worth reminding in this regard that as noted by Mrs. Justice Gauthier at para 83 of her decision reproduced above, and as further reiterated by both sides at the oral hearing in the instant cases, the use of a brand name on a Philip Morris package bearing most of the other elements of the no-name package (like the MATADOR get-up covered by registration No. TMA111,226 mentioned above) would likely be sufficient to sever the mental link or association with Marlboro. This explains why the Opponent did not object to or oppose the applications that eventually matured to become the Canadian trade-mark registrations listed in Annex “A” as, when such trade-mark applications were originally published for opposition purposes, the trade-marks subject thereof were used with either the MATADOR or MAVERICK brand name.

[58] Under these circumstances, and being guided by the Federal Court reasons for judgment in *Philip Morris 2010* and *Philip Morris 2012*, I am not prepared to conclude as the Opponent wishes me to, that the idea suggested by each of the individual applied-for Marks taken in isolation is that of MARLBORO.

[59] Thus, I find that the overall consideration of the section 6(5)(e) factor favours the Applicant.

Conclusion regarding the likelihood of confusion

[60] As indicated above, the issue is whether a consumer, who has a general and not precise recollection of the Opponent’s trade-mark MARLBORO, will, upon seeing each of the Marks be likely to believe that their associated wares share a common source.

[61] Having regard to my comments above, and particularly the ones under the section 6(5)(e) factor, I find that there is not a reasonable likelihood of confusion between the parties’ marks. Accordingly, the section 12(1)(d) ground of opposition is dismissed in each case.

Non-entitlement grounds of opposition

[62] As indicated above, the Opponent has pleaded that the Applicant is not the person entitled to registration of the Marks pursuant to section 16(2)(a) and (c) and section 16(3)(a) and (c) of the Act as the trade-mark MARLBORO and the trade-name MARLBORO CANADA have been

used by the Opponent since well before the priority dates of filing of the instant applications, and the Marks are confusing therewith as more fully described in the introductory paragraphs of the amended statements of opposition.

[63] The Opponent has to show that as of the priority date of filing of each of the Applicant's applications, the trade-mark MARLBORO and the trade-name MARLBORO CANADA had been previously used in Canada and had not been abandoned as of the date of advertisement of each of the Applicant's applications [section 16(5) of the Act]. The Opponent has met its burden with respect to the trade-mark MARLBORO as far as the wares "cigarettes" are concerned. However, it has not with respect to the trade-name MARLBORO CANADA. Indeed, except for Mr. Ricard's statements as to the relationship existing between the opponent Marlboro Canada Limited (referred to by Mr. Ricard as "Marlboro Canada") and its licensee, Imperial Tobacco Canada Limited, the Opponent's evidence fails to establish use of the trade-name MARLBORO CANADA, not to mention that the Opponent did not make any representation on such alleged trade-name use in its written argument or at the oral hearing. The sections 16(2)(c) and 3(c) grounds of opposition are accordingly dismissed in each case.

[64] As for the sections 16(2)(a) and (3)(a) grounds of opposition, the difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition. As a result, I find that the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between each of the Marks and the Opponent's trade-mark MARLBORO. The sections 16(2)(a) and 3(a) grounds of opposition are accordingly dismissed in each case.

Non-distinctiveness grounds of opposition

[65] As indicated above, the Opponent has pleaded that Marks are non-distinctive of the Applicant in that they neither distinguish nor are adapted to distinguish the Wares as the Marks create confusion with the Opponent's trade-mark MARLBORO and its trade-name, the whole as more fully described in the introductory paragraphs of the amended statements of opposition.

[66] The Opponent has met its burden to show that as of the filing date of each of the instant oppositions, the trade-mark MARLBORO had become known to some extent at least to negate

the distinctiveness of the Marks as far as the Opponent's cigarettes are concerned. For the reasons explained above under the non-entitlement grounds of opposition, it has not with respect to the trade-name MARLBORO CANADA.

[67] The difference in relevant dates does not substantially affect my analysis above under the section 12(1)(d) ground of opposition. As a result, my finding made above concerning the likelihood of confusion between each of the Marks and the trade-mark MARLBORO remains applicable. Accordingly, I find that the Applicant has satisfied its burden to show that there is not a reasonable likelihood of confusion between each of the Marks and the Opponent's trade-mark MARLBORO.

[68] In view of the above, the non-distinctiveness grounds of opposition are dismissed in each case.

Section 30(i) ground of opposition

[69] As indicated above, the Opponent has pleaded that the Applicant could not have been satisfied that it was entitled to use the Marks in Canada in association with the Wares contrary to section 30(i) of the Act in view of the Applicant unfairly competing with the Opponent by expressly and intentionally creating confusion with the trade-mark MARLBORO of the Opponent, as more fully described in the introductory paragraphs of the amended statements of opposition, the whole contrary to section 7(b) of the Act and section 1457 of the Civil Code of Quebec.

[70] The ground of opposition as pleaded revolves around the likelihood of confusion between each of the Marks and the trade-mark MARLBORO. I find it is unnecessary to determine whether or not the Opponent's section 30(i) ground, as pleaded, raises a proper ground of opposition or, if the Opponent has satisfied its initial evidentiary burden with respect thereto. Indeed, even if it is found that the ground of opposition is properly pleaded and that the Opponent has satisfied its evidentiary burden, such ground ought to be dismissed since my finding made above concerning the absence of likelihood of confusion remains applicable as of the filing date of each application.

[71] In view of the above, each of the section 30(i) grounds of opposition is dismissed in each case.

Disposition

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

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Annex "A"



Registration No.: TMA252,082
Registration Date: November 4, 1980
Filing Date: December 21, 1975
Wares: (1) Cigarettes

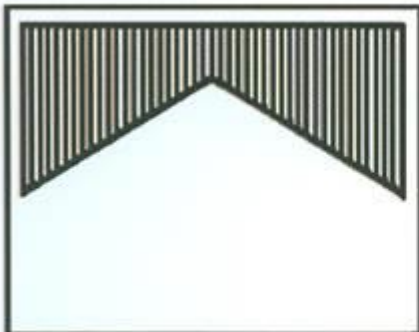
Based on use in Canada since August 8, 1958.



Registration No.: TMA252,083
Registration Date: November 4, 1980
Filing Date: December 21, 1979
Wares: (1) Cigarettes

Based on use in Canada since August 8, 1958.

The drawing is lined for the colour red.



Registration No.: TMA254,670
Registration Date: January 9, 1981
Filing Date: December 21, 1979
Wares: (1) Cigarettes

Based on use in Canada since August 8, 1958

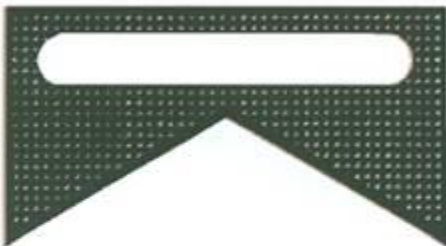
The drawing is lined for the colour red.



Registration No.: TMA274,442
Registration Date: December 3, 1982
Filing Date: October 1, 1981
Wares: (1) Cigarettes

Based on use in Canada since at least as early as 1971.

The drawing is lined for the colour gold.



Registration No.: TMA465,532
Registration Date: November 1, 1996
Filing Date: September 13, 1995
Wares: (1) Cigarettes

Based on use in Canada since April 12, 1995

The background of the design is in gold with black triangular designs thereon, no colour is claimed for the blank oval portion.



Registration No.: TMA670,898
Registration Date: August 23, 2006
Filing Date: May 25, 2005
Wares: (1) Cigarettes.

Declaration of use filed on July 28, 2006

Colour is claimed as a feature of the trade-mark. The background of the design is in silver with black triangular designs thereon, no colour is claimed for the blank oval portion. The design of the crest is in gold, the letters PM are in white on a black background and VENI VIDI VICI are in white.