



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

**Citation: 2015 TMOB 182**  
**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**

**1,592,128 for EPICA & Design** **Application**

[1] The Applicant has applied for the trade-mark EPICA & Design (the Mark), shown below. The Opponent opposes this application on one ground – 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 August 29, 2012. The application was advertised for opposition purposes in the *Trade-marks Journal* dated May 15, 2013. On May 30, 2013, the Opponent filed a statement of opposition wherein the only ground pleaded was that the Mark is not distinctive pursuant to sections 38(2)(d) and 2 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The Applicant filed a counter statement on August 19, 2013, denying the allegation 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. The Applicant's evidence comprises the affidavit of Mandy Wright, Legal Assistant in the IP group with the Applicant's agent. Neither affiant was cross examined.

[5] Both parties submitted written arguments and both attended an oral hearing wherein the opposition to the Applicant's trade-mark EPICA, application No. 1,528,048 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] Her affidavit comprises 7 paragraphs and 1 exhibit in total. The most pertinent parts of her affidavit, paragraphs 4-6, 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 3200 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.

### Applicant's Evidence

[8] Mandy Wright was asked to conduct an Internet search of "G. Marquis The Silver Line Epic" or "G Marquis Epic" to locate release date or public availability date information in Canada concerning the "G Marquis The Silver Line Epic" branded wine. Attached as Exhibit A to her affidavit is a copy of the printed results generated from her search. The results from these links consist of pages from the Liquor Board of Ontario website and two wine information and review websites located at ontariowinereview.com and www.winealign.com, all of which appear to be advertising a wine referred to as "G. Marquis The Silver Line Epic 2010" and show bottles bearing the same label as Ms. Magnotta's Exhibit A." Further, each of the results consistently indicates that the wine's availability and release date was November 9, 2013.

### Grounds of Opposition

#### Non-distinctiveness – Section 2

[9] 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.

[10] 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 May 30, 2013, its EPIC trade-mark was known to an extent that could negate the distinctiveness of the Mark. The trade-

mark's reputation should be substantial, significant or sufficient [see *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[11] 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.

[12] First, the Applicant's agent has pointed 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" but 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 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 3200 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, nor did she produce any copies of invoices or sales revenue information concerning the EPIC branded wine to corroborate her claims.

[13] Also on this point, the Applicant's agent submits that the evidence of Ms. Wright directly contradicts the evidence of Ms. Magnotta. In this regard, the Applicant's agent notes that each of the Internet search results of Ms. Wright indicate that the Opponent's wine's availability and release date was November 9, 2013 (and not April 2012 as alleged by the Opponent).

[14] The second issue the Applicant's agent submits 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.

[15] 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's agent states that it has sold its EPIC wine, namely duty free

stores and restaurants. The Opponent's agent maintains that regardless, this evidence should not be given any weight because it is hearsay.

[16] 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.

[17] 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 clear whether the use allegedly shown is use by the Opponent.

[18] 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 Purepharm 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.

[19] With respect to the evidence of Ms. Wright, 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.

[20] Even if I were to give full weight to the Magnotta affidavit, and accept that the Opponent began selling wine 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 3200 bottles of wine in Ontario in association with the mark EPIC from April 2012 until the date of Ms. Magnotta's affidavit (i.e. Oct. 9, 2013), and we do not know how much of this wine was sold before May 30, 2013, the material date for this ground. The Opponent has not shown

that the Mark has been otherwise made known in Canada through promotion or advertising. In my view, the Opponent has not shown that its trade-mark has become known sufficiently in Canada to negate the distinctiveness of the Applicant's Mark [*Bojangles, supra*].

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

Disposition

[22] 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.

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

Hearing Date: 2016-08-26

Appearances

Stephen Georgas

For the Opponent

Christine deLint

For the Applicant

Agents of Record

Miller Thomson

For the Opponent

Norton Rose Fulbright Canada

For the Applicant