



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

Citation: 2016 TMOB 131
Date of Decision: 2016-07-25

IN THE MATTER OF AN OPPOSITION

**Compagnie Champenoise PH-CH. Piper
Heidsieck Ancienne Maison Heidsieck
Fondée en 1785
and**

Opponent

Marina Díaz Jiménez

Applicant

1,594,064 for PIPER & Design

Application

Introduction

[1] Compagnie Champenoise PH-CH. Piper Heidsieck Ancienne Maison Heidsieck Fondée en 1785 (the Opponent) opposes registration of the trade-mark PIPER & Design as illustrated below:



PIPER (the Mark).

[2] The application was filed by Marina Díaz Jiménez (the Applicant) on September 13, 2012 on the basis of use and registration in Spain. Subsequent to the filing of a revised application on May 21, 2013, the application covers non-alcoholic fruit-based beverages (the Goods).

The Record

[3] The application was advertised in the *Trade-marks Journal* on March 19, 2014.

[4] The Opponent filed a statement of opposition on May 14, 2014 under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded are based on sections: 30(d), 12(1)(d), 16(2)(a), and 2 (distinctiveness).

[5] The Opponent filed as its evidence the statutory declarations of Mr. Alan Langley sworn on November 25, 2014 and Ms. Cécile Bonnefond sworn on November 24, 2014 as well as certified copies of registrations TMA434,154 for the trade-mark PIPER HEIDSIECK and TMA504,791 for the trade-mark PIPER HEIDSIECK & Design.

[6] The Applicant elected not to file any evidence.

[7] Both parties filed written arguments and no hearing was held.

[8] For the reasons explained below, I refuse the application.

Preliminary remarks

[9] I wish to point out that in reaching my decision I have considered all the evidence in the file but I will only refer in my reasons for this decision to the relevant portions of the evidence.

[10] The Applicant, in its written argument has referred to numerous facts not in evidence when it assessed the relevant criteria listed in section 6(5) of the Act. For illustration purposes only and without limiting the generality of the foregoing, they include: the selling price of the Goods, how promotional items are used in bars and restaurants, the Applicant's intention not to suggest to Canadian consumers to drink the Goods with champagne, and the difference in the channels of trade. I will obviously disregard any assertions made by the Applicant in its written argument that have not been made part of the evidence in the record.

The Opponent's evidence

Mr. Langley's statutory declaration

[11] Mr. Langley has been the Chief Financial Officer of Select Wine Merchants Ltd (Merchants) located in Surrey, British Columbia and has held such position since 2009. Merchants is a company founded in Vancouver in 1982. It is a privately owned import wine and spirit agency in Canada which expanded its operation over the years and became fully national in 2001.

[12] Mr. Langley alleges that Merchants has been selling since approximately 2008 in Canada the champagne under the trade-marks PIPER and PIPER HEIDSIECK (the PIPER marks). He explains that both trade-marks appear on the bottles: PIPER HEIDSIECK appears on the labels affixed at the bottom of the main surface of the bottles and PIPER appears on the neck of the champagne bottles as illustrated on the documentation annexed to his statutory declaration.

[13] Mr. Langley filed as Exhibit A a price list of Spring 2014 wherein bottles of champagne bearing the PIPER marks are illustrated. There is also a mention that such champagne has been selected the best 'champagne brut non millésimé' in the world by International Wine Challenge of London.

[14] Mr. Langley filed as Exhibit B a photograph showing the champagne displayed in a liquor store located in Montreal. The bottles appearing on the picture bear the PIPER marks, as described above.

[15] Mr. Langley states that, in order to promote and advertise the champagne under the PIPER marks, ads were placed in LCBO Food and Drink publication; BCLDB Taste Magazine; SAQ produced flyers and Alberta Retailer flyers. The PIPER marks also appear on promotional material such as cork stoppers and ice buckets. He filed samples of such advertising as Exhibit C to his statutory declaration. He filed as Exhibit D a bag on which appears the trade-mark PIPER HEIDSIECK and as Exhibit E a photograph showing a bottle cap bearing that trade-mark.

[16] Mr. Langley filed as Exhibits F-1 to F-10 various articles published in 2012 and 2013 in various magazines and newspapers in Canada, such as *Globe & Mail*, *Toronto Sun* and *LCBO Marketing Guide*, where the subject matter is champagne bearing the PIPER marks.

[17] Mr. Langley asserts that there was a promotion with the chain of hotels Fairmont entitled ‘Modern Classics’ featuring a one-page advertisement of the champagne sold in association with the trade-mark PIPER HEIDSIECK and he filed a copy of such advertisement as Exhibit G to his statutory declaration.

[18] Mr. Langley affirms that Merchants promotes champagne bearing the PIPER marks during tennis tournaments and he filed as Exhibits H-1 and H-2 photographs showing a display used on the site as well as an advertisement in connection with the Annual Tennis Invitational held in British Columbia in 2011.

[19] Mr. Langley filed as promotional and advertising material the following exhibits:

- Exhibit J: A sweater showing the trade-mark PIPER HEIDSIECK;
- Exhibit K: extracts from the LCBO website showing the trade-mark PIPER HEIDSIECK;
- Exhibit L: extracts of the Wine Align website showing the trade-mark PIPER HEIDSIECK.

[20] Mr. Langley also filed the following material found on the Internet where reference is made to the trade-mark PIPER HEIDSIECK:

- Exhibit M-1: screen extracts of the television program CH Morning Live broadcasted in December 2013;
- Exhibit M-2: extracts of the television program CBC The Lang and O’Leary Exchange;
- Exhibit M-3: extracts of a BNN Broadcast interview;
- Exhibit M-4: extracts from the Internet site of ‘BNN exclusive Tasting’.

[21] I shall afford very little probative value to the content of Exhibits M-1 to M-4 as we have no information on the number of viewers in Canada and, except for Exhibit M-1, the dates of these broadcasts.

[22] Mr. Langley asserts that Merchants spent on advertising and promotion of the PIPER marks in Canada over ‘these last years’ approximately \$150,000 per year.

[23] Finally, Mr. Langley alleges that The Cuvée brute bearing the PIPER marks is included in the Top 100 Wines of 2012 of the magazine Wine Spectator and is ranked the third champagne exporter worldwide.

Ms. Bonnefond's statutory declaration

[24] Ms. Bonnefond has been the Opponent's President since July 8, 2011. She asserts that the Opponent is the owner of the following marks:

- PIPER-HEIDSIECK & Design, registration TMA504,791
- PIPER-HEIDSIECK, registration TMA434,154
- PIPER, used in Canada since at least the years 1940's.

[25] Ms. Bonnefond states that the Opponent has been selling, in Canada, champagne in association with the PIPER marks for many years. As such, the trade-mark PIPER has been used on an individual basis, for many decades. The trade-mark PIPER alone is used in association with each bottle sold in Canada as it appears on specific places on the bottles to identify the champagne.

[26] Ms. Bonnefond provides the annual sales figures in volume and dollars of champagne bearing the PIPER marks in Canada between 2008 and 2014 and since 2003 in global volume per year. Those figures appear on Exhibit A to her statutory declaration.

[27] Ms. Bonnefond filed as Exhibit D various photographs illustrating the trimming on the bottles bearing the PIPER marks. Some of the pictures filed illustrate the use of the trade-mark PIPER alone. She adds that the Opponent's products are often referred to as 'PIPER champagne' or 'champagne PIPER'. Exhibit E to her statutory declaration are photographs of bottles bearing the PIPER marks presently used in Canada in association with the Opponent's products. The trade-mark PIPER alone appears often on the neck of the bottle as illustrated on the photographs filed.

[28] Ms. Bonnefond alleges that the Applicant's Goods bearing the Mark are offered for sale as products that could be mixed with alcoholic beverages, including champagne, for the preparation of cocktails. However, none of the exhibits filed shows the Goods and champagne in close proximity.

[29] Ms. Bonnefond asserts that she has been informed by an Opponent's employee that he saw during an evening in Monaco the distribution of beverages in association with the Mark in glasses and in a champagne bucket bearing the trade-mark PIPER HEIDSIECK. I am not giving any weight to such allegation as it constitutes inadmissible hearsay evidence.

[30] Ms. Bonnefond states that the Facebook page for the Goods bearing the Mark of the Applicant shows them in festive atmosphere where their mode of consumption is similar to alcoholic beverages and champagne. To substantiate such allegation, she filed photographs from various websites and the Applicant's Facebook pages as Exhibits F-1 to F-17 illustrating cans presented in an ice bucket, beverages available in night clubs and many pictures showing the Applicant's Goods bearing the Mark closely associated to alcoholic beverages.

[31] Finally, Ms. Bonnefond filed as Exhibit G various paper clips to illustrate the media coverage around the world of the Opponent's champagne bearing the PIPER marks.

[32] I wish to point out that nowhere in Mr. Langley's statutory declaration is there an allegation that Merchants imports the Opponent's champagne bearing the PIPER marks. Also, nowhere Ms. Bonnefond affirms that the Opponent sells its champagne bearing the PIPER marks to Merchants for resale in Canada. Even though one could assume that Merchants acts as an importer of the Opponent's champagne bearing the PIPER marks, in the absence of such an allegation, I cannot make this assumption. However, given the allegations contained in Ms. Bonnefond's statutory declaration, this flaw is not fatal to the Opponent. Ms. Bonnefond does allege that there have been sales of the Opponent's champagne in association with the PIPER marks in Canada since at least 2008.

The parties' respective burden of proof

[33] The legal onus is on the Applicant to show that its application does not contravene the provisions of the Act as alleged in the 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 291, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

Ground of opposition based on section 30(d) of the Act

[34] The relevant date to assess this ground of opposition is the filing date of the application (September 13, 2012) [see *Austin Nichols & Co, Inc v Cinnabon, Inc* 2000 CarswellNat 39, 5 CPR (4th) 565 (TMOB)].

[35] In its written argument the Opponent argues that it met its light evidential burden under this ground of opposition [see *United States Shoe Corp v Premiere Vision Inc* (1990), 33 CPR (3d) 353]. To substantiate its position, the Opponent refers to Exhibits F-1 to F-14 inclusive as well as Exhibits F-16 and F-17 to Ms. Bonnefond's statutory declaration.

[36] Most of those exhibits consist of photos taken from Facebook pages all referring to 'Piper Tribe'. They are all dated August 28, 2014 and therefore after the relevant date. Consequently, I will not consider them for the purpose of this ground of opposition.

[37] The Opponent also refers to an article found on the website *www.thenational.ae* and filed as Exhibit F-17 to Ms. Bonnefond's statutory declaration. The page was printed also on August 28, 2014. However, the article is dated May 23, 2011. Consequently, I am prepared to consider it for the purpose of this ground of opposition.

[38] The Opponent quotes the following extracts:

Mark Saunokonoko has just launched a new drink called Piper... A complex carbohydrate has been added to keep the muscles from feeling the effects. All ingredients come from New Zealand, where the drink is produced.

[39] However, being an article published on the Internet, it simply shows that such article was published on such date, but it cannot be relied upon as proof of the truth of its content. Moreover, we have no indication where this article was published, except that the name of the newspaper is *The National*. Finally, the letters 'ae' as part of the website address seems to indicate that the content originates from a foreign country.

[40] I am not satisfied, from the filing of this single article, that the Opponent has met its evidential burden, despite the fact that it is a light one.

[41] Therefore, this ground of opposition is dismissed.

Ground of opposition based on section 16 of the Act

[42] The ground of opposition based on section 16(2) of the Act must be assessed at the filing date of the application (September 13, 2012) [see section 16(2) of the Act]. The Opponent pleaded in its statement of opposition that the Mark was confusing with the Opponent's PIPER marks previously used and/or made known in Canada by the Opponent in association with Champagne wines. Consequently, the Opponent had the initial burden to prove that it had used or made known in Canada its PIPER marks, as alleged in its statement of opposition, prior to September 13, 2012 and that it had not abandoned such use at the advertisement date of the application (March 19, 2014) [see section 16(5) of the Act].

[43] From the above summary of the Langley and Bonnefond statutory declarations, I am satisfied that the Opponent has met its evidential burden to prove that its PIPER marks were used in Canada prior to the relevant date and that it had not abandoned such use on March 19, 2014.

[44] The Opponent has its best chances of success under this ground of opposition with its trade-mark PIPER. Should he not be successful with that mark, it would not achieve a better result with its other trade-marks.

[45] The test for confusion is outlined in section 6(2) of the Act. Some of the surrounding circumstances to be taken into consideration when assessing the likelihood of confusion between two trade-marks are described in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks or trade-names have been in use; the nature of the goods, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or any ideas suggested by them. Those criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Mattel Inc v 3894207 Canada Inc* 2006 SCC 22 (CanLII), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 623 (CanLII), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 SCC 27 (CanLII), 92 CPR (4th) 361 (SCC)].

Inherent distinctiveness of the trade-marks and the extent to which they have become known

[46] In its written argument, the Applicant has not addressed this issue. The Opponent takes the position that the parties' marks have an average degree of inherent distinctiveness. I agree. The word 'piper' is an English word but has no relationship with the parties' respective products sold in association with their marks.

[47] The degree of distinctiveness of a trade-mark may be enhanced through its use or promotion in Canada. The Applicant did not file any evidence of use of the Mark. The Opponent, through the statutory declaration of Ms. Bonnefond tried to illustrate how the Mark is being used by filing different photographs of the Goods in association with the Mark. These pictures do not, by themselves, constitute evidence of use of a trade-mark within the meaning of section 4(1) of the Act. There is no evidence of a transfer of property of the Goods in Canada. However, they may be relevant when assessing the channels of trade criteria.

[48] In so far as the use of the Opponent's trade-mark PIPER is concerned, as it appears from the summary of the Bonnefond statutory declaration there is evidence of extensive use of that mark in Canada since at least 2008. Ms. Bonnefond has provided the Canadian sales figures since 2008 of Champagne in association with the PIPER trade-marks, pictures of champagne bottles bearing the PIPER trade-marks, which include the trade-mark PIPER on the neck of the bottle.

[49] From this evidence, I conclude that the PIPER trade-mark was known in Canada at the relevant date and consequently, this factor favours the Opponent.

Length of time the marks have been in use

[50] From the evidence described above, this factor also favours the Opponent since there is no evidence of use of the Mark in Canada in the record, while there is evidence of use of the PIPER trade-mark since at least 2008 in Canada.

The nature of the goods and their channels of trade

[51] In its written argument, the Applicant argues that there is a difference in the nature of the parties' goods and their respective channels of trade as the application covers non-alcoholic beverages while the Opponent's product is champagne. It asserts that there is a difference between an alcoholic and non-alcoholic drinks.

[52] In *Moosehead Breweries Ltd v Stokely-Van Camp Inc* 2001 CarswellNat 3620, 20 CPR (4th) 181 (TMOB) the Registrar concluded in the following terms when facing a similar argument:

25 The applicant's lager beer and the opponent's non-alcoholic, non-carbonated fruit flavoured drinks belong to the same general class of wares, namely beverages. The applicant argues that the parties' wares should be considered as two different general classes of wares, namely alcoholic beverages and non-alcoholic beverages. In any event, it must be remembered that Subsection 6(2) of the Act states 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 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.*" [underlining added]

26 We have no information concerning the applicant's nature of business whereas the opponent's business is essentially that of a brewery that promotes its products and trade-marks through a variety of means such as promotional wares, lounge services and the sponsoring of sports events and teams.

27 The channels of trade overlap given that alcoholic and non-alcoholic beverages are sold through the same outlets in some parts of Canada, notably Alberta. It is noted that the applicant has not filed any evidence that would distinguish its channels of trade. In addition, I believe it reasonable to take judicial notice of the fact that restaurants and bars across Canada sell both alcoholic and non-alcoholic beverages (my underlined).

[53] On the channels of trade, the Applicant, in its written argument, tried to distinguish the parties' goods and their channels of trade by making allegations that have not been proven. For example:

- The sale of champagne in Canada is highly regulated;
- Champagne cannot be sold in grocery stores and convenient stores;
- The Goods are sold in supermarkets and convenient stores.

[54] The Opponent has shown, through the statutory declaration of Ms. Bonnefond, that the Goods are sold in bars and restaurants in close proximity with alcoholic beverages, or that the Goods can be mixed with alcoholic beverages. Even though the pictures illustrating such situation were taken from Facebook pages dated after the relevant date, they are a reasonable indication that the Applicant intended to sell the Goods in bars and restaurants when it filed its application.

[55] In all, I adopt the same reasoning adopted by the Registrar in *Moosehaed Breweries Ltd.* Consequently these factors also favour the Opponent.

Degree of resemblance

[56] As stated by the Supreme Court of Canada in *Masterpiece*, in the majority of cases, the degree of resemblance between the marks in issue is the most important factor. In this case, this factor favours the Opponent. The marks in issue are identical in sound. Even though no argument has been presented by the parties on the ideas suggested by their respective marks, since the word portion of the Mark is identical to the Opponent's trade-mark PIPER, it is reasonable to assume that the ideas suggested by these marks are the same. Furthermore, I do not believe that the design portion of the Mark, which is a stylized P is sufficient to negate the importance of the degree of resemblance in sound and ideas suggested by the word portion of the parties' marks.

[57] This factor also favours the Opponent.

Additional factors

Difference in retail selling prices

[58] The Applicant argues that the difference in the retail selling prices of the parties' goods constitute a factor that negates any likelihood of confusion between the parties' marks. Attached to Mr. Langley's statutory declaration, are price lists for the Opponent's champagne sold in association with the PIPER trade-mark in Canada. The price lists show a range between \$59.75 and \$256.25 per bottle of champagne. The Applicant argues that a bottle of non-alcoholic natural beverage is sold at approximately \$1. This is another assertion made by the Applicant on which there is no evidence in the record.

[59] Even if that would be the case, the Supreme Court in *Masterpiece, supra* at paragraphs 67 and ff., expressed some caution with respect to such argument, reminding us that the applicable test is the ‘first impression’ test.

Difference in the trade dress

[60] Another argument raised by the Applicant in its written argument is the difference in the trade dress used by the parties. It suggests that the Applicant’s Goods are sold in cans while the Opponent’s champagne is sold in glass bottles. Even though the photographs attached to Ms. Bonnefond’s statutory declaration show the Goods bearing the Mark in cans, there is no restriction in the Applicant’s description of the Goods on the containers to be used for the sale of the Goods. Nothing prevents the Applicant to sell the Goods in glass bottles as any other non-alcoholic beverages.

Conclusion on the likelihood of confusion

[61] In its written argument, the Applicant wrote:

...there is no chance that the average consumer will purchase the Opponent’s champagne in lieu of the Applicant’s product and vice-versa.

(...)

The Court is to put itself in the position of an average person who is familiar with the earlier mark but has an imperfect recollection of it: *Coca-Cola of Canada Ltd. v. Pepsi-Cola of Canada Ltd.* (1942) 2 D.L.R. 657 at 661, 1 C.P.R. 293 (P.C.). The question is whether the ordinary consumer will, on seeking the later mark, infer as a matter of first impression that the wares with which the later mark is to be used are in some way associated with the wares of the earlier.

[62] The test for confusion has been set out in the following terms by Mr. Justice Binnie in *Veuve Clicquot, supra*, at para. 20:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark], at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[63] The test under section 6(2) of the Act does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In

the instant case, the question posed by section 6(2) is whether a consumer, with an imperfect recollection of the Opponent's PIPER mark, who sees the Applicant's Goods in association with the Mark, would think they emanate from, or are sponsored by, or approved by the Opponent.

[64] From the evidence in the record, it is reasonable to conclude that a person with an imperfect recollection of the Opponent's trade-mark PIPER used in association with the Opponent's champagne, who sees the Goods in association with the Mark, would think, on a balance of probabilities, that the Goods originate from the Opponent or that it has sponsored or approved the Goods. To support such finding I refer to the fact that the word portion of the marks and the ideas suggested by them are identical; that the parties' products are in the same general class of goods namely, beverages and that they are sold through the same channels of trade, including bars and restaurants.

[65] Therefore, I maintain the ground of opposition based on section 16(2) of the Act.

Lack of distinctiveness ground of opposition

[66] It is generally accepted that this ground of opposition must be assessed as of the filing date of the statement of opposition (May 14, 2014) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317 (FC)].

[67] In *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427 the Federal Court determined that:

- A mark needs to be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada.

[68] The Opponent had therefore the initial burden to prove that its PIPER marks relied upon under this ground of opposition were known in Canada to some extent or they were well known in a specific area of Canada.

[69] The detailed summary of the Opponent's evidence described above leads me to conclude that the Opponent has met its initial burden to prove that its PIPER marks were known in Canada at the relevant date.

[70] Consequently, the burden shifted on the Applicant who had to show, despite the fact that the Opponent's trade-mark PIPER was known in Canada, that the Mark could serve to distinguish the Goods from the Opponent's products. The same factors listed in section 6(5) of the Act are used to determine such issue.

[71] The difference in the relevant dates does not have any influence on such analysis. The end result is the same namely, that there existed a likelihood of confusion at the relevant date, when the Mark is used in association with the Goods, such that it did not distinguish the Goods from the Opponent's products sold in association with its trade-mark PIPER.

[72] Consequently this ground of opposition is also maintained.

Ground of opposition based on Section 12(1)(d) of the Act

[73] The Opponent having been successful under two separate grounds of opposition, it is not necessary to rule on the registrability of the Mark under section 12(1)(d) of the Act.

Disposition

[74] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

No hearing held.

Agents of Record

Goudreau Gage Dubuc

FOR THE OPPONENT

Joli-Coeur Lacasse S.E.N.C.R.L.

FOR THE APPLICANT