



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

Citation: 2015 TMOB 181
Date of Decision: 2015-10-05

IN THE MATTER OF AN OPPOSITION

Vina San Pedro Tarapaca S.A.	Opponent
and	
Magnotta Winery Estates Limited	Applicant
1,569,681 for EPIC	Application

The Record

[1] On March 14, 2012, the Applicant applied to register the trade-mark EPIC (the Mark), based on proposed use in Canada in association with wines. The application was advertised for opposition purposes in the *Trade-marks Journal* dated November 14, 2012, and on January 11, 2013, the Opponent filed a statement of opposition to oppose it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). The opposition is based on the following grounds of opposition: section 30(i), section 16(3)(b) and section 2 (distinctiveness) of the Act. The determinative issue in this proceeding is whether there is a reasonable likelihood of confusion between this Mark and the Opponent's trade-mark EPICA which was previously adopted in Canada in association with wines and sparkling wines, and was subject of a previously filed Canadian trade-mark application.

[2] The Applicant filed a counter statement on February 14, 2013, denying each of the grounds of opposition.

[3] In support of its opposition, the Opponent filed the affidavits of Florinda Lages, Translator with the Toronto office of All Languages Ltd., and Sazia Aftab, Legal Assistant with the Opponent's agent. Neither of the Opponent's affiants was cross-examined.

[4] As its evidence, the Applicant filed the affidavit of Karen Lynne Durell, associate lawyer with the Applicant's agent, as well as a certified copy of the file history of the Opponent's trademark EPICA under number 1,528,048. Ms. Durell was not cross-examined.

[5] As evidence in reply, the Opponent filed a certified copy of the statement of opposition by the present Applicant to the Opponent's application No. 1,592,128 for EPICA & Design dated May 30, 2013, and covering letter dated June 18, 2013 that was forwarded to the present Opponent by the Registrar.

[6] Both parties filed a written argument and attended an oral hearing.

[7] At the oral hearing, the Opponent withdrew the section 30(i) ground.

Onus and Material Dates

[8] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

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

- Section 38(2)(c)/Section 16(3)(b) – the Applicant's date of filing;
- Section 38(2)(d)/non-distinctiveness - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Preliminary Issue – Admissibility of the Opponent’s Reply Evidence

[10] The Applicant submits that the Opponent’s reply evidence comprising a certified copy of a statement of opposition filed by the Applicant to the Opponent’s trade-mark EPICA & Design under application No. 1,592,128, (and covering letter), is inadmissible as reply evidence, or if admissible, should be given no weight, because it is not confined to evidence in reply. In this regard the Applicant submits that the reply evidence is not evidence of anything, since the mark being opposed in that opposition is a different mark than the Mark set out herein, and the legal rationale for the opposition is not set out in the statement of opposition. The Applicant submits that it is simply a pleading from which no relevant admission on the part of the Applicant herein can be inferred.

[11] The test for whether or not evidence is proper reply evidence is whether the evidence introduced by the Opponent is in reply to the Applicant's evidence and is responsive to unanticipated matters [see *Kerr Controls Ltd v Mike Witherall Mechanical Ltd* (2013), 116 CPR (4th) 357 (TMOB)].

[12] I agree with the Applicant that the certified copy of a statement of opposition by the Applicant in the subject matter against the Opponent’s application No. 1,592,128 for the trade-mark EPICA & Design (and covering letter) is not proper evidence in reply. It does not respond to the allegations contained in the Durrell affidavit in any way, and the Opponent has not explained how it replies to the Applicant’s evidence of the file wrapper for application No. 1,528,048 for the mark EPICA. This evidence is therefore inadmissible.

Summary of the Parties’ Evidence

[13] The evidence filed by the parties was very straight forward and primarily concerned the meaning of the marks at issue. In this regard, Ms. Lage’s evidence is that the English translation of the Spanish word “epica” is “epic”. Ms. Aftab’s evidence includes results from various Internet searches, as well as an excerpt from a pocket Spanish dictionary, that also shows that the English translation of the Spanish word “epica” is “epic”. The evidence of Ms. Durell is that there is no word “epica” in the French language which translates into “epic”.

Grounds of Opposition

Non-distinctiveness – Section 2

[14] The Opponent has claimed that the Mark is not adapted to distinguish nor does distinguish the Applicant's wine from the wines of the Opponent.

[15] In order to meet its initial burden with respect to this ground of opposition, the Opponent had to show that its trade-mark had become known sufficiently as of January 11, 2013 to negate the distinctiveness of the Mark [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC); *Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC and Bojangles Restaurants Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

[16] In support of this ground, the Opponent relied upon its certified copy of a statement of opposition by the Applicant in the subject matter against the Opponent's application No. 1,592,128 for the trade-mark EPICA & Design, wherein the Applicant claims that the Opponent's EPICA & Design trade-mark does not distinguish its wine from the Applicant's wine in association with the Mark EPIC. Although the opposition against the Opponent's EPICA & Design application was initiated approximately 4-5 months after the subject trade-mark opposition (i.e. May 30, 2013), the Opponent submits that the sole non-distinctiveness ground against application No. 1,592,128, appears to support the Opponent's non-distinctiveness ground in the present opposition and contradicts the Applicant's denial of this allegation in its counter statement.

[17] As noted above, I have found this evidence inadmissible as it is not proper reply evidence. Even if it was admissible, while this evidence may have raised some questions regarding the validity of the Applicant's denial of the allegation that its Mark is not distinctive in its counter statement, I would not have found it sufficient to meet the Opponent's evidential burden under this ground. In addition to being dated after the material date for this ground, this evidence does not show that the Opponent's trade-mark has been used or made known sufficiently to negate the distinctiveness of the Mark. This ground of opposition is therefore dismissed.

Non-entitlement – Section 16(3)(b)

[18] Under this ground, the Opponent pleads that the Applicant is not the person entitled to registration of the trade-mark EPIC having regard to section 16(3)(b) of the Act since, at the date of filing the application, the trade-mark EPIC was confusing with the Opponent's trade-mark EPICA which had previously been filed in Canada on May 16, 2011, based on proposed use in association with wines and sparkling wines.

[19] An opponent relying upon a trade mark application in challenging an applicant's entitlement to registration under section 16(3)(b) of the Act need only establish that the trade mark application being relied upon had been previously filed in Canada and that the application was pending at the date of advertisement of the applicant's application (see section 16(4) of the Act). In the present case, the Opponent's application No. 1,528,048 for the trade-mark EPICA was filed May 16, 2011 and was pending at the date of advertisement of the Applicant's application. The Opponent has therefore discharged the initial burden upon it.

[20] The legal onus is on the Applicant to show that there would be no reasonable likelihood of confusion between the marks, within the meaning of section 6(2) of the Act. Section 6(2) 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 there would be confusion of the Applicant's goods provided under the Mark as emanating from or sponsored by or approved by the Opponent [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at 12].

test for confusion

[21] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[22] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC) , the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[23] Both marks possess some degree of inherent distinctiveness as neither is suggestive of the goods they are used in association with. However, in view that the Mark comprises the ordinary dictionary word EPIC while there is no meaning in English or French for the Opponent’s mark EPICA, I find that the Opponent’s mark is inherently stronger than the Mark.

[24] As neither party has shown any use or promotion of their mark, I cannot conclude that either party’s mark has become known to any extent in Canada. I therefore find that, overall, this factor favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[25] As both parties’ marks are based on proposed use, and as neither has shown use of their mark, this factor does not favour either party.

sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade

[26] The parties’ goods are the same.

[27] While the Applicant’s agent acknowledges that the parties’ channels of trade would basically be the same as well, the Applicant’s agent submits that in liquor stores the parties’ wines would likely appear on different shelves. In this regard, the Applicant’s agent submits that I can take judicial notice of the fact that wines are normally stocked in liquor stores by country of origin.

[28] The Opponent's agent argued that I can't take judicial notice of this fact because whether or not wines are stocked in liquor stores by country of origin depends on the size and location of the store. The Opponent's agent also noted that there are vintages sections in liquor stores where not all wines are organized by country of origin. I agree with the Opponent's submissions. The alleged fact that wine is stocked by country is not the kind of easily verifiable information I can take judicial notice of (i.e. a question on which easily accessible information of undisputed reliability can be found [*Canada (Citizenship and Immigration) v Rahman*, 2013 FC 1274 (CanLII)]. In any case, regardless of whether the parties' wines appear in different sections in liquor stores, the fact remains that the parties' channels of trade would likely overlap.

section 6(5)(e) - the degree of resemblance between the marks in appearance, sound and ideas suggested

[29] When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trade-mark.

[30] In the present case, the word EPIC is almost identical to the coined word EPICA. The Applicant submits that the small difference between the marks (i.e. the letter A at the end of the Opponent's mark) should be enough to distinguish them. However, as I do not consider the marks at issue to be weak marks, I do not find that the small difference between them to be sufficient to distinguish them from one another [see for example *GSW Ltd v Great West Steel Industries Ltd et al* (1975), 22 CPR (2d) 154 (FCTD); *Associated Brands Inc v Scott Paper Ltd* (2004), 43 CPR (4th) 361 (TMOB)]. I therefore consider there to be a high degree of resemblance between the marks in appearance and sound.

[31] With respect to the ideas suggested by the marks, the Opponent's evidence shows that EPICA is Spanish for the word EPIC. While this may be the case, the Opponent has not shown how many Canadian consumers would be aware of this meaning [see *Krazy Glue, Inc v Grupo Cyanomex, SA de CV* (1992), 45 CPR (3d) 161 (FCTD)].

[32] As noted by the Applicant's agent, the average Canadian consumer is considered being either English or French speaking, or bilingual in both of these languages. I therefore agree with

the Applicant's agent that while the average Canadian consumer may be aware of the common dictionary definition for the word EPIC, they would not be aware that the word EPICA is Spanish for the word EPIC. I therefore do not find there to be as high a degree of resemblance between the words in ideas suggested.

Conclusion

[33] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden. In addition to there being a high degree of resemblance between the marks in appearance and sound, the Applicant has not established any reputation in association with its Mark and proposes to use it in association with goods identical to those of the Opponent. The issue is whether a consumer who has a general and not precise recollection of the Opponent's mark, will, upon seeing the Applicant's Mark, be likely to think that the goods share a common source. I find that it is reasonably likely that they would. This ground of opposition is therefore successful.

Disposition

[34] In view of the above, and 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.

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

Hearing Date: 2015-08-26

Appearances

Christine DeLint

For the Opponent

Stephen Georgas

For the Applicant

Agents of Record

Norton Rose Fulbright Canada

For the Opponent

Miller Thompson

For the Applicant