



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

Citation: 2015 TMOB 26
Date of Decision: 2015-01-30

TRANSLATION

**IN THE MATTER OF AN OPPOSITION
by Constellation Brands Quebec Inc.
against application No. 1,510,439 for
registration of the trade-mark FIESTA
DEL SOL in the name of A. Lassonde Inc.**

Introduction

[1] A. Lassonde Inc. (the Applicant) filed an application on January 7, 2011 for registration of the FIESTA DEL SOL trade-mark (the Mark) on the basis of a projected use in association with:

Wine-based alcoholic beverages; fruit-based alcoholic beverages (the Goods).

[2] This application was published on August 10, 2011 in the *Trade-Marks Journal* for the purposes of opposition.

[3] Vincor (Quebec) Inc. filed a statement of opposition on August 29, 2011. The grounds of opposition raised are based on sections 30(i), 30(e), 16(3)(a), 16(3)(b) and 2 of the *Trade-marks Act*, RSC (1985), c T-13 (the Act). They are described in greater detail in Appendix A of this decision. The Applicant filed a counter-statement denying each and every ground of opposition.

[4] The Opponent (as defined hereinafter) filed the affidavit of Janick Masse. The Applicant filed the affidavits of Ms. Lisa Saltzman, Mr. David Masiala Mavungu and Mr. Mathieu Houle. Ms. Masse and Mr. Houle were cross-examined and the transcripts are part of the record. The Opponent filed Ms. Lyne Milord's affidavit as rebuttal evidence.

[5] Each of the parties filed a written argument and was represented at the hearing.

[6] During the proceedings, Vincor (Quebec) Inc. changed its name to Constellation Brands Quebec, Inc. I will use the term 'Opponent' to refer both to Vincor (Quebec) Inc. and to Constellation Brands Quebec, Inc.

[7] I will first have to determine whether the Opponent has filed sufficient evidence to support its grounds of opposition. If this is the case, I will have to rule on the validity of each of these grounds.

[8] For the reasons more fully described hereinafter, I find the Applicant has not discharged its ultimate onus of proving, according to the balance of probabilities, that there was no risk of confusion between the Mark and the Opponent's trade-mark, TIERRA DEL SOL.

Preliminary comments

[9] Such as it will appear from the summary of evidence and the Applicant's arguments, the deciding factor in the case is to know whether the Opponent proved the previous use of its TIERRA DEL SOL mark and, if this is the case, whether it abandoned the use of this mark. More specifically, can it be concluded this mark was abandoned, due to the absence of evidence of its use during a long period of time? In our case, the Applicant argues there was an absence of any documentary evidence of use of the TIERRA DEL SOL mark from 1996 to 2011, namely during a period of nearly 15 years.

[10] Since this question of absence of evidence of use of the TIERRA DEL SOL mark was raised in the Applicant's written argument, I expected the parties to refer to the relevant jurisprudence on this point to support their claims. To my great surprise, when I asked the agents during the hearing to submit jurisprudence on this point, neither of them could cite the relevant jurisprudence. I therefore granted the parties an extension to submit the jurisprudence they considered relevant after the hearing, and they complied.

Evidential burden

[11] In trade-mark opposition proceedings, the ultimate onus rests with the Applicant to prove the application for registration does not contravene the provisions of the Act. 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, the Opponent must discharge the initial burden of proving the facts on which it bases its allegations. The fact that an initial evidential burden is imposed on the Opponent means that a ground of opposition will be taken into consideration only if sufficient evidence exists to allow a reasonable conclusion of the existence of the facts alleged in support of this ground of opposition [see *John Labatt Ltd. v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA); and *Wrangler Apparel Corp v The Timberland Company* (2005), 41 CPR (4th) 223 (FC)].

Grounds of opposition rejected for lack of evidence

[12] The Opponent filed no evidence able to support the ground of opposition based on section 30(e) of the Act. Accordingly, this ground of opposition is rejected, as the Opponent has not met its initial burden of proof.

[13] In regard to the ground of opposition based on section 30(i), the Act requires only that the Applicant declares it is convinced it has the right to use the Mark. The statement is included in the application. The presumed knowledge of the Opponent's mark due to its use over the years is insufficient in itself to support a ground of opposition based on section 30(i) of the Act. This section of the Act could be raised in very specific cases, including, *inter alia*, when the Applicant's statement had been made in bad faith [see *Sapodilla Co Ltd v Bristol Myers Co* (1974) 15 CPR (2d) 152 (TMOB)]. This has neither been claimed nor proven in this case. Accordingly, this ground of opposition is also rejected.

Ground of opposition based on section 16(3)(a) of the Act

[14] The relevant date to analyze this ground of opposition is the date the application for registration was filed, namely January 7, 2011 [see section 16(3) of the Act]. For the purposes of the next discussion, it is appropriate to reproduce the text of section 16(5) of the Act:

(5) The right of an applicant to secure registration of a registrable trade-mark is not affected by the previous use or making known of a confusing trade-mark or trade-name by another person, if the confusing trade-mark or trade-name was abandoned at the date of advertisement of the applicant's application in accordance with section 37. [my underlining]

[15] The onus therefore rests with the Opponent to prove not only the previous use of its trade-mark, but also to prove that it had not abandoned the use of its mark. I reproduce hereinafter the following passages from the Federal Court of Appeal decision in *Iwasaki Electric Co Ltd v Hortilux Schreder B V* 2012 FCA 321:

[21] Subsection 16(5) of the Act is not based on a person ceasing to use (as defined in the Act) a trade-mark but rather on a person abandoning a particular trade-mark. As noted above, abandonment of a trade-mark is not determined based solely on a person ceasing to use that trade-mark. The person must also have intended to abandon the trade-mark. I would agree that in determining whether a person has an intention to abandon a trade-mark, an inference of such intention could, in the absence of any other evidence, be drawn as a result of a failure to use the trade-mark for a long period of time.

[22] However, there was other evidence in this case as noted by the judge in paragraphs 94 to 97 of his reasons and in the affidavit of Marco Brok (Appeal Book pages 75 to 79). Even though these examples are not examples of the use (as defined in the Act) of the Mark in association with the wares, these examples support a finding that Hortilux Schreder did not intend to abandon the Mark at January 9, 2002. In my opinion, the judge has not made a palpable and overriding error in finding that Hortilux Schreder had not abandoned the Mark at the date of publication.

(my underlining)

Proof of use of the TERRA DEL SOL mark by the Opponent

[16] The Opponent argues that it has used the TIERRA DEL SOL mark in association with wines since 1995 or 1996. It refers to the affidavit of Ms. Masse, the Director of Marketing at the Opponent, and more specifically, to Exhibit JM-2, a notice issued by Société des alcools du Québec (SAQ) entitled INFO-SAQ, dated May 31, 1995, and to page 39 of the cross-examination of Mr. Houle, General Manager of one of the Applicant's divisions. The Opponent also relies on the allegations contained in Ms. Masse's affidavit, to the effect that the Opponent or its predecessors in

title used the Mark in association with wine since at least October 7, 1996 (paragraph 9 of her affidavit).

[17] Mr. Houle explained in his cross-examination that the SAQ does not purchase wine directly from producers. The importers, such as the Applicant and the Opponent, import the wines they wish to sell and proceed to bottle them under SAQ supervision. The finished product is then sold and shipped to the SAQ, which resells it to the authorized distributors, who in turn resell it directly to the retailers (Q 151, page 39, line 14 and following).

[18] This portion of Mr. Houle's cross-examination was covered by an objection 'under advisement', because the Applicant claims the original question pertained to the wines distributed by the Applicant, although they are in no way covered by this opposition. Following this objection, the Opponent instead questioned Mr. Houle about the importing and bottling process, and finally the presentation of wines and the Goods on the retailers' shelves [see Q 150 and following].

[19] I judge that this series of questions was relevant, because it concerns both the sale of the Goods and of wines by an importer to the SAQ. I therefore dismiss the objection raised by the Applicant on the questions dealing with this subject.

[20] I must mention that, apart from the INFO-SAQ communiqué of March 31, 1995, there is no documentary evidence establishing a transfer of ownership of wines bearing the Opponent's TIERRA DEL SOL mark to the SAQ or any other third part for the period from May 31, 1995 to January 7, 2001, the relevant date under this ground of opposition. There is indeed a purchase order filed as Exhibit JM-4 to Ms. Masse's affidavit, but this is dated November 1, 2011, after the relevant date.

[21] The Opponent argues this evidence is sufficient to prove the previous use of its TIERRA DEL SOL mark in association with wines, since May 31, 1995, or at least since October 7, 1996. It claims that Mr. Houle's testimony during his cross-examination proves that, once the SAQ announces the arrival of a new product in an edition of INFO-SAQ, this product is therefore available for distribution. Consequently, this product necessarily would have sold by the importer to the SAQ no later than the publication date of INFO-SAQ. In this case, according to the Opponent's

claim, wines bearing the TIERRA DEL SOL mark would have been sold to the SAQ as early as May 31, 1995.

[22] Two comments are necessary at this stage. First of all, I do not consider there is an admission by Mr. Houle that the wines bearing the TIERRA DEL SOL Mark have been sold since May 31, 1995 in Canada. However, the description of the sequence of events made by Mr. Houle, from importing a wine until it is on a retailer's shelves, leads me to infer that, on or about May 31, 1995, there was indeed a transfer of ownership of wines bearing the TIERRA DEL SOL Mark from the Opponent to the SAQ. Thus, in that period, the TIERRA DEL SOL mark was used within the meaning of section 4(1) of the Act.

[23] Secondly, the mere assertion by Ms. Masse that there would have been sales of wines bearing the TIERRA DEL SOL mark, by the Opponent or its predecessors in title since October 7, 1996, is not, in itself, sufficient evidence of use of this mark in Canada within the meaning of section 4(1) of the Act [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980) 53 CPR (4th) 62]. The filing of an application for registration of this mark (Exhibit JM-1 in Ms. Masse's affidavit), based on use since October 7, 1996, cannot serve as proof of use of the TIERRA DEL SOL mark since the date alleged in this application for registration.

Other evidence concerning the TIERRA DEL SOL mark

[24] Ms. Masse filed labels (Exhibit JM-5) bearing the TIERRA DEL SOL mark.

[25] Ms. Masse filed different promotional documents under Exhibit JM-7, bearing the TIERRA DEL SOL mark. Some of the documents filed bear dates prior to the date of publication of this application for registration (August 10, 2011).

[26] In his affidavit, Mr Houle refers to an advertisement published in the May 2011 edition of *L'Alimentation* magazine (thus, before the date of publication of this application for registration) in which, under the 'Quoi de neuf' (What's new) heading, the wines bearing the TIERRA DEL SOL mark are advertised.

[27] Mr. Mavungu is employed by the Applicant's agents. On June 19, 2012, he ordered from the Canadian Intellectual Property Office (CIPO) a copy of the record concerning the proceedings

initiated under section 45 of the Act against registration No. TMA466,284 for the TIERRA DEL SOL trade-mark, property of the Opponent. This evidence proves this registration was struck from the Register on November 9, 2010, due to the Opponent's default in filing the evidence required under section 45 of the Act.

Conclusion on the Opponent's evidential burden

[28] Applying the foregoing principles stated in the *Horitlux Schreder* decision, I conclude that the Opponent has discharged its initial evidential burden to prove it used the TIERRA DEL SOL mark, before the filing of this application for registration and that it had not abandoned the use of this mark at the date of publication of this application for registration. On this last point, I must emphasize that the facts produced in evidence and described above (Exhibit JM-7 and the excerpt from the May 2011 edition of *l'Alimentation* magazine) prove that, at August 10, 2011, the Opponent had no intention of abandoning its mark.

[29] Regarding the fact that the registration for the TIERRA DEL SOL trade-mark had been struck from the register, I do not consider this to be proof of abandonment of that mark by the Opponent. I recall that the Registrar's decision was not based on inconclusive proof of use of the trade-mark during the relevant period associated with these proceedings but instead resulted from the Opponent's default in responding to the notice under section 45 of the Act. Moreover, in these opposition proceedings, the abandonment of the TIERRA DEL SOL mark must be determined at the date of publication of this application, and this date is subsequent to the relevant period associated with the procedure under section 45 of the Act (December 1, 2006 to December 1, 2009). As indicated previously, certain facts exist that tend to prove that, at August 10, 2011, the Opponent had no intention of abandoning the use of its mark.

Analysis of the different criteria under section 6(5) of the Act

[30] It is incumbent on the Applicant to prove, according to the balance of probabilities, that use of the Mark in association with the Wares was not confusing with the Opponent's TIERRA DEL SOL mark at January 7, 2011. The test to be applied to rule on this issue is stated in section 6(2) of the Act. This test does not address confusion between the marks themselves, but rather confusion regarding the source of the Goods. Thus, I must determine whether a casual consumer somewhat in a

hurry, who saw the Goods in association with the Mark, with no more than an imperfect recollection of the TIERRA DEL SOL mark, believed the Opponent was their source or that their sale was authorized by the Opponent [see *Masterpiece Inc v Alavida Lifestyles Inc et al* 2011 CSC 27].

[31] I must take into account all relevant circumstances, including those listed in section 6(5) of the Act, i.e. the inherent distinctiveness of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the type of goods, services or enterprises; the type of business; the degree of similarity between the trade-marks in their presentation or sound, or in the ideas they suggest. This list is not exhaustive, and it is not necessary to grant the same weight to each of these factors.

[32] In its *Masterpiece* ruling cited above, the Supreme Court of Canada interpreted section 6(2) of the Act and enlightened us as to the scope of the various criteria listed in section 6(5) of the Act.

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

[33] I agree with the Opponent when it claims that its TIERRA DEL SOL trademark has a distinctiveness superior to that of the Mark, because this Mark contains the word ‘fiesta’, which is defined as follows in *Nouveau Petit Le Robert*: [TRANSLATION] ‘Pleasure party, celebration’. As for the word ‘tierra’, it seems to be an invented word, or at least I have no evidence that this is a foreign-language word known to Canadians. Finally, I have no evidence of the meaning of the words ‘del sol’, which appear in each of the marks involved.

[34] The distinctiveness of a mark can be enhanced by its use and the extent to which it has become known in Canada due to its use and promotion. Yet at the relevant date (filing date of the application for registration), the Applicant had not begun to use the Mark, because this application for registration is based on a projected use and there is no evidence in the record of the promotion of the Mark in Canada at that date.

[35] Regarding the use of the TIERRA DEL SOL mark, Ms. Masse alleges that the Opponent sold more than 1 million bottles of wine in Canada, bearing the TIERRA DEL SOL mark. She mentions that these bottles sold in Quebec are distributed through the SAQ in the grocery store network. However, she did not break down the number of bottles sold since the date of execution of her

affidavit. It is therefore possible these sales took place subsequent to the relevant date. Another plausible scenario, in view of the evidence described above, would be that the vast majority of these sales took place in 1995 or 1996 and that there were very few sales subsequently.

[36] Ms. Masse alleges that the Opponent invests tens of thousands of dollars each year in marketing for the promotion of its marks, including the TIERRA DEL SOL mark. However, she refrains from disclosing the amounts invested for the promotion of the wines bearing the TIERRA DEL SOL mark.

[37] In the circumstances, I am not disposed to grant the Opponent a marked advantage concerning the extent to which the parties' marks have become known in Canada. However, taken overall, this first criterion favours the Opponent, in view of the inherently superior distinctiveness of its mark relative to the Mark.

The period during which the trade-marks have been in use

[38] There is a certain evidence of use of the TIERRA DEL SOL trade-mark dating back to May 31, 1995, whereas there is no evidence in the record of the use of the Mark in Canada.

[39] Although this factor seems to favour the Opponent, I do not consider, in the absence of evidence of continuous use of the TIERRA DEL SOL mark since May 31, 1995, that this will be a determining factor in the overall analysis of the factors enumerated in section 6(5) of the Act. I find that the most material factors in this case are the nature of the goods, their distribution channels and the degree of resemblance between the parties' marks.

The type of goods and the nature of the trade

[40] Considering the type of goods and the nature of the trade, I must compare the statement of goods covered by the application under opposition with the Opponent's goods (wines) sold by the Opponent in association with its TIERRA DEL SOL mark.

[41] The Applicant, through Mr. Houle, attempted to prove that a difference exists between the wines and the Goods in terms of their composition and the different distribution channels used, as well as the target clientele for such products.

[42] Thus, Mr. Houle alleges that wine-based alcoholic beverages are constituted from a wine base (approximately 40%), to which are mainly added fruit juices and fruit beverages, with natural/artificial flavours. Alcoholic fruit beverages are constituted from different types of alcoholic beverages, such as wine, cider and spirits, to which are mainly added fruit juice, natural/artificial flavours, etc.

[43] The percentage of alcohol for these beverages is generally lower than 7%. They are cold and are commonly called 'coolers'. They have a sweet taste. However, wine is a grape-based fermented beverage with an alcohol rate ranging between 10% and 14%. The taste is less sweet, and even dry. Wine does not contain added products, such as fruit juices and fruit beverages.

[44] According to Mr. Houle, the Goods are sold in grocery stores in sections other than the wine section, near the beers and on shelves or display cases containing different types of 'coolers'. The selling price is different, approximately \$8 per litre for the Goods, whereas a 750 ml bottle of wine generally sells from \$9 to over \$1000.

[45] Regarding the difference in price of parties' goods, I cite the remarks of the Honourable Justice Rothstein in the *Masterpiece* decision, cited above:

The focus of this question is the attitude of a consumer in the marketplace. Properly framed, consideration of the nature of the wares, services or business should take into account that there may be a lesser likelihood of trade-mark confusion where consumers are in the market for expensive or important wares or services. The reduced likelihood of confusion is still premised on the first impression of consumers when they encounter the marks in question. Where they are shopping for expensive wares or services, a consumer, while still having an imperfect recollection of a prior trade-mark, is likely to be somewhat more alert and aware of the trade-mark associated with the wares or services they are examining and its similarity or difference with that of the prior trade-mark. A trade-mark, as Binnie J. observed in *Mattel*, is a shortcut for consumers. That observation applies whether they are shopping for more or less expensive wares or services.

[46] Mr. Houle also claims the clientele varies. As for the Goods, the majority of the target clientele is composed of women between ages 18 and 35 years, whereas the target market for wine is men and women age 25 and over.

[47] Mr. Houle affirms that the Goods have a festive connotation inspiring vacations and are mainly consumed on summer afternoons and at parties. He also alleges that the Product line sold under the Mark is available seasonally.

[48] Finally, according to Mr. Houle, wine has a more formal connotation and targets people wishing to procure a more refined beverage to mark a special occasion, offer a gift, enjoy during a good meal or simply add to a collection of good bottles. He argues that wine is a sophisticated product, the potential buyer of which inquires about different characteristics that distinguish it before buying it, such as place of origin, bottling year, cepage, brand, colour, vinosity, etc. Thus, according to Mr. Houle, the purchase of a bottle of wine generally is not taken lightly by consumers.

[49] In his affidavit, Mr. Houle illustrates a display case of Goods bearing the Mark in a grocery store. The Opponent's wine, according to Mr. Houle, is sold conservatively in grocery store sections and well stored in the way that wine is usually presented.

[50] However, during his cross-examination, Mr. Houle admitted that:

- in small-surface grocery stores, the 'coolers' will be displayed next to the wines (page 52);
- in all cases, the 'coolers' will be in the same location as beer and wine. They are in the alcoholic beverages section (page 54);
- in grocery stores, the price range for wine sales varies between \$9 and \$18 (page 73).

[51] In its decision in *Giorgio Barbero & Figli SpA v Ridout Wines Limited* (1992), 46 CPR (3d) 284 (TMOB), the Registrar concluded that, although differences exist between wine and 'coolers', these two products nonetheless are part of the same general product category, alcoholic beverages.

[52] Also, the evidence proves that the parties' goods are sold, inter alia, in grocery stores, and in the same section. According to the 'planograms' produced by Mr. Houle, even though they are displayed on separate shelves, the parties' products may be located side by side. To this effect, I refer to the photos filed in support of the affidavit of Ms. Milord, Administrative Assistant employed by the Opponent's agents. She alleges that on November 9, 2012, she visited an IGA banner to take photos and noted that the wines and wine-based alcoholic beverages/alcoholic fruit beverages were side by side on the shelves. She filed photos to this effect. On November 11, 2012 she visited a

MAXI banner this time, for the same reasons, and took photos proving the proximity of the shelves containing wines and alcoholic beverages.

[53] I therefore find that these two material factors favour the Opponent.

The degree of resemblance between the trade-marks

[54] I recall that the Supreme Court of Canada, in its *Masterpiece* ruling, supra, clearly indicated that the degree of resemblance between the marks is the factor that is often likely to have the greatest effect among those listed in section 6(5) of the Act.

[55] The Applicant argues, and rightly, that the first word of a mark is often the most important part when determining whether the consumer can distinguish between the marks involved [see *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359]. Thus, it claims that the difference between FIESTA and TIERRA is sufficient to distinguish between the parties' marks.

[56] I consider that when we take these marks as a whole, resemblances exist: they both contain the words 'DEL SOL', and phonetically, although the words TIERRA and FIESTA have differences, it nonetheless remains that there are similarities between these words (~IE and ~A).

[57] In my opinion, the visual and phonetic similarities of these marks outweigh their visual and phonetic distinctions. This key factor therefore favours the Opponent.

Other factors to consider

[58] Mr. Houle affirms that before an alcoholic beverage can be sold in a grocery store, the SAQ validates the mark to ensure there is no conflict with the marks of the goods already offered on the market. Thus, Mr. Houle filed a document entitled 'Déclaration de marque exclusive' (Declaration of exclusive mark) issued by the SAQ for the Mark. This document is prepared and submitted by the Applicant to the SAQ for its approval. It contains a claim by the Applicant to the effect that the Mark is not confusing with any other alcoholic beverage mark marketed in Quebec.

[59] There is no evidence on record of the criteria used by the SAQ to draw such a conclusion. In any event, the Registrar is not bound by the SAQ's decision. It is the Registrar's duty to determine

whether the Mark is confusing with the Opponent's TIERRA DEL SOL mark, by applying the test stated in section 6(2) of the Act and the criteria set out for this purpose in section 6(5) of the Act.

[60] The Applicant also filed proof of the state of the Register since July 1995, through the affidavit of Ms. Saltzman, Director of the Research Department at Onscope Group Inc. She mentions that her duties include consulting and searching the CIPO database.

[61] Thus, on June 11, 2012, Ms. Saltzman received a mandate from the Applicant's agents to conduct a search of the Register of Trade-marks including the terms *IESTA*, *del* with *sol* and finally sol* or *sol in association with international classes 32 and 33. She explains that the symbol '*' is used to broaden the search to include marks that contain the term searched as a prefix or suffix or within a word. She conducted the requested search, filtering the results to eliminate marks that include the prefix SOL when this prefix forms any of the following words: Solution or Solutions or Soluble or Solstice or Soldier or Solomon.

[62] She filed the results of this search, in which over 255 marks are cited, but no analysis of these citations is included in her report or the Applicant's written arguments.

[63] I pointed out this deficiency to the Applicant's agent during the hearing and asked him to identify the citations from the Register contained in Ms. Saltzman's affidavit to which he was relying. Out of 255 citations, he identified only twelve (citations 80, 84, 85, 86, 92, 97, 98, 99, 100, 103, 107, 108 and 109 in Ms. Saltzman's report). For the purposes of the discussion, I do not have to reproduce the details of these citations. Indeed, one of them is in opposition (98) and 8 others (80, 84, 85, 92, 97, 103, 108 and 109) do not contain the expression 'DEL SOL'. I do not consider that this evidence proves that the expression 'DEL SOL' is diluted in the Register, and thus in common use on the market [see *Maximum Nutrition Ltd v. Kellogg Salada Canada Inc.* (1992), 43 CPR (3d) 349 (FCA)].

[64] The Applicant also bases its position on the results of the search conducted by Mr. Mavungu of the different websites of the various provincial liquor boards to identify different goods sold under a trade-mark containing the expression 'Del Sol'. This search was conducted on June 14, 2012, after the relevant date under this ground of opposition. Even if I presumed that wines bearing a date prior to 2011 were available before the relevant date, evidence that I do not have on record, there are only

5 wines containing the expression 'Del Sol' as a component of their trade-mark that bear a date prior to 2011. This number is clearly insufficient to conclude common use of this expression on the market in association with alcoholic beverages.

Conclusion on the likelihood of confusion

[65] The Registrar must put himself in the position of an ordinary consumer having an imperfect recollection of the Opponent's TIERRA DEL SOL mark, used in association with wine, and who sees the FIESTA DEL SOL mark on a later date in association with the Goods. He must determine, on the basis of a first impression whether the consumer, on January 7, 2011, risked believing that the Goods associated with the Mark came from the same source or were otherwise related to or associated with the wines sold in association with the TIERRA DEL SOL mark.

[66] In light of my analysis of the factors set out in subsection 6(5) of the Act, I conclude that the Applicant has not discharged its onus of proving, according to the balance of probabilities, that there was no probability of confusion between the Mark in association with the Goods and the Opponent's TIERRA DEL SOL mark. Indeed, the distinctiveness of the TIERRA DEL SOL mark, the similarity in the nature of the respective goods of the parties, their distribution channels, and the degree of phonetic and visual resemblance between the parties work in the Opponent's favour.

[67] In the event that I had to attach greater importance to the phonetic and visual differences between the marks involved, at most this would cancel out the advantages granted to the Opponent regarding the degree of phonetic and visual resemblance between the marks. Thus, this factor would not favour either party. What would remain is the advantage granted to the Opponent due to the inherent distinctiveness of its mark, the nature of the products and their distribution niches. This slight advantage in the Opponent's favour would be sufficient to conclude that the Applicant has not discharged its ultimate evidential burden.

[68] At most, for the benefit of the Applicant, I would arrive at a situation where the analysis of all the relevant factors would favour neither of the parties. Since the ultimate onus rests with the Applicant, I therefore should rule in favour of the Opponent, given such a scenario.

[69] The ground of opposition based on Section 16(3)(a) of the Act is therefore maintained.

Ground of opposition based on section 16(3)(b) of the Act

[70] Under this ground opposition, the Opponent has the initial onus of proving that it had filed an application for registration prior to the present application for registration (January 7, 2011) and that its application for registration was still pending at the time of publication of the present application for registration (August 10, 2011).

[71] Ms. Masse submitted a copy of registration application No. 1,463,034 for the TIERRA DEL SOL trade-mark, filed the Opponent on December 16, 2009 in association with wines. I checked the Register and, even though this application for registration was rejected by the Registrar on July 14, 2014 and this decision was appealed to the Federal Court and no judgment has been rendered yet, it nonetheless remains that this application for registration was still pending at the time of publication of the present application for registration [see section 16(4) of the Act].

[72] During the hearing, the Applicant invited me to stay my decision until the Federal Court has ruled on this appeal. No jurisprudence has been created to support the claim that I could exercise some discretion in the circumstances and thus postpone my decision to a date subsequent to the Federal Court judgment. Moreover, it was decided in *Anheuser-Busch Inc v Carling O'Keefe Breweries of Canada Ltd* (1982), 69 (2d) 136 (FCA) that the Registrar did not have the power to stay opposition proceedings. In any event, the Registrar's decision to reject this application for registration is subsequent to the date of publication of the present application for registration.

[73] Considering that the Opponent met its initial evidential burden, I must therefore determine whether the Applicant discharged its ultimate onus of proving that the use of the Mark, at January 7, 2011, was not confusing with the TIERRA DEL SOL trade-mark, which is covered by the Opponent's registration application No. 1,463,034.

[74] My analysis of the criteria to determine the fate of this question would be analogous to the analysis performed under the previous ground of opposition (section 16(3)(a) of the Act). Therefore, for the same reasons as those described under the previous ground of opposition, I conclude that the Applicant has not discharged its ultimate onus to prove, according to the balance of probabilities, that the use of the Mark in association with the Goods would not be confusing with the Opponent's TIERRA DEL SOL mark, which is covered by registration application No. 1,463,034.

Ground of opposition based on non-distinctiveness of the Mark

[75] Since the Opponent has prevailed based on two different grounds of opposition, I find it unnecessary to rule on this ground of opposition.

Disposal

[76] In exercising the authority delegated to me by the Registrar of Trade-marks pursuant to section 63(3) of the Act, I reject registration application No. 1,510,439 registration of the Mark in association with the Goods.

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

Certified true translation
Arnold Bennett

Appendix A

The grounds of opposition can be summarized as follows:

1. The application for registration is not in compliance with the provisions of section 30(e) of the Act, in that the Applicant, whether on its own or through a licensee, never had the intention of using the Mark in Canada in association with the Goods.
2. The application for registration is not in compliance with the provisions of section 30(i) of the Act, in that the Applicant could not be satisfied it was entitled to use the Mark in Canada in association with the Goods, because on the date the application was filed, the Opponent was the owner of the TIERRA DEL SOL mark, which is covered by registration application No. 1,463,034 filed on December 16, 2009, based on a use in Canada since October 7, 1996 in association with wines, and since the Opponent used this mark continuously in Canada in association with wines prior to the filing of this application for registration. The expressions FIESTA DEL SOL and TIERRA DEL SOL are essentially identical, the only difference being that the first word of each expression is different. However, FIESTA and TIERRA are 6-letter words ending in A;
3. The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act, because on the date the application was filed, the Mark was confusing with the TIERRA DEL SOL mark used in Canada by the Opponent in association with wines;
4. The Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(b) of the Act, because at the date of filing of the application, the Mark was confusing with the Opponent's TIERRA DEL SOL trade-mark, which was covered by registration application No. 1,463,034 filed prior to this application for registration;
5. The Mark does not distinguish the Goods from those of the Opponent, nor is it adapted to distinguish them within the meaning of section 2 of the Act, from the Opponent's goods in association with the TIERRA DEL SOL trade-mark previously used and published by the Opponent.