



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

Citation: 2015 TMOB 184
Date of Decision: 2015-10-14

IN THE MATTER OF AN OPPOSITION

Constellation Brands Québec Inc.	Opponent
and	
Dallevigne S.P.A.	Applicant
1,561,950 for CANTINE LEONARDO DA VINCI & Design	Application

[1] On January 30, 2012, Dallevigne S.P.A. (the Applicant) filed application No. 1,561,950 to register the trade-mark CANTINE LEONARDO DA VINCI & Design (shown below) (the Mark). The application is based upon proposed use of the Mark in Canada in association with “wines; grappa; liqueurs” (the Goods) and includes the following colour claim:



Colour is claimed as a feature of the trade-mark. The wording CANTINE LEONARDO DA VINCI appears in black, and the mirror image of 'leonardo da vinci' in script appears in gold.

[2] Constellation Brands Québec Inc. (the Opponent) has opposed the application for the Mark under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), based upon the grounds that (i) the application does not conform with the requirements of sections 30(a), (e)

and (i) of the Act; (ii) the Mark is not registrable under section 12(1)(d) of the Act, because it is confusing with the Opponent's trade-mark DA VINCI registered under No. TMA303,667 in association with the goods "*boissons alcoolisées distillées, liqueurs*" (which goods have been translated by the Opponent as distilled alcoholic beverages and liquors); (iii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, because as of the filing date of the Applicant's application, the Mark was confusing with the Opponent's DA VINCI trade-mark, which has been continuously used in Canada since March 14, 1985, by the Opponent and its predecessors in title, in association with distilled alcoholic beverages, liquors and wines; and (iii) the Mark is not distinctive within the meaning of section 2 of the Act.

[3] For the reasons that follow below, I find the application ought to be refused.

The record

[4] The statement of opposition was filed by the Opponent on February 14, 2013. The Applicant filed and served a counter statement on June 20, 2013 denying each of the grounds of opposition set out in the statement of opposition.

[5] As its evidence, the Opponent filed the affidavits of Janick Masse, Marketing Director for the Opponent, sworn October 21, 2013 (the Masse affidavit), and Stéphanie La, an employee with the law firm representing the Opponent in the present proceeding, sworn October 18, 2013 (the La affidavit). Ms. Masse and Ms. La were not cross-examined on their affidavits. The Opponent also filed a certified copy of its registration for its trade-mark DA VINCI.

[6] The Applicant elected not to file evidence.

[7] Both parties filed written arguments and attended a hearing.

The parties' respective burden or onus

[8] The Opponent has the initial evidentiary burden to establish the facts alleged to support each ground of opposition. Once that burden is met, the legal burden or onus that the Mark is registrable remains on the Applicant, on a balance of probabilities [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)].

Analysis

Grounds of opposition summarily dismissed

[9] All of the section 30 grounds of opposition are dismissed. I do not wish to discuss in detail any of these grounds. Suffice it to say that, even if I were to assume that each of these grounds has been properly pleaded, the Opponent has not filed any evidence to put into question any of the claims made in the application, nor has it filed any evidence to support its contention that the goods are not defined in ordinary commercial terms.

Remaining grounds of opposition

Non-registrability of the Mark under section 12(1)(d) of the Act

[10] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent's registered trade-mark DA VINCI identified above.

[11] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which is the material date for assessing a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. I note that by decision dated April 28, 2015, the Registrar concluded that this registration ought to be expunged under section 45 of the Act [see *Smart & Biggar v Constellation Brands Québec, Inc.*, 2015 TMOB 82 (CanLII)]. However, this decision is presently under appeal to the Federal Court [Court File No. T-1104-15]. Consequently, the Opponent's registration is still in force.

[12] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's registered trade-mark.

The test for confusion

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

[14] Thus, this section does not concern the confusion of the trade-marks themselves, but of the goods or services from one source as being from another.

[15] 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 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. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [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].

Consideration of the section 6(5) factors

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

[16] I assess the inherent distinctiveness of the parties' marks as about the same, and relatively weak.

[17] Indeed, the Mark primarily consists of the name of the famous painter, sculptor, engineer and scientist Leonardo Da Vinci [see *Glaskoch B Koch Jr GmbH v Anglo Canadian Mercantile Co*, 2006 CanLII 80333 (TMOB), where a similar finding was made in respect of the word mark

LEONARDO DA VINCI]. I do not consider the design element which consists of the mirror-image of a signature to add much distinctiveness to the Mark. The same holds true for the French word “CANTINE” (in English “canteen”), in the context of the Goods. I shall note that I am not affording weight to the Opponent’s argument that the word “CANTINE” is derived from the Italian word for a cellar, winery, or vault. There is no evidence on this point, nor is there any evidence to suggest that the average consumer of the Goods would be aware of the meaning ascribed to the word “CANTINE” in Italian.

[18] The Opponent’s DA VINCI trade-mark is also relatively weak. The Opponent submits that its mark has no suggestive or descriptive connotation in the context of distilled alcoholic beverages and liquors. More particularly, it submits that the use of the trade-mark DA VINCI by itself is arbitrary and original to the Opponent and that there is no evidence as to what the perception of Canadian consumers might be in regards to the words “DA VINCI”. The Applicant submits that the Opponent’s trade-mark merely means “of Vinci” in Italian and would most likely be understood as describing that the Opponent’s goods are produced or originate from the town of Vinci in Italy. However, the Applicant’s argument is not supported by evidence. As for the Opponent’s position, I acknowledge that there is no evidence as to how the average Canadian consumer of the Opponent’s goods is likely to perceive its trade-mark. However, I may refer myself to dictionaries to determine the meaning of a word. In this regard, I note that the entry for “da Vinci” in the online *Canadian Oxford Dictionary* (2ed) reads: “see Leonardo da Vinci”. Thus, I find it unreasonable to conclude that there is no likelihood that consumers would react to DA VINCI by thinking of the well-known historical figure Leonardo da Vinci [see *Constellation Brands Québec, Inc v Casa Vinicola Botter Carlo & C (CVBC) SPA*, 2015 TMOB 160 where the same finding was made]. I will return to this point when considering the degree of resemblance between the parties’ marks in appearance or sound or in the ideas suggested by them.

[19] The strength of a trade-mark may be increased by means of it becoming known through promotion or use.

[20] The application for the Mark is based upon proposed use and there is no evidence that the Mark has been used in Canada pursuant to section 4 of the Act or that it has become known in Canada to any extent.

[21] By comparison, the Masse affidavit establishes the following facts, as per my review below of the salient points of her affidavit.

The Masse affidavit

[22] Ms. Masse states that the DA VINCI trade-mark has been used in Canada by the Opponent and its predecessors in title since at least as early as March 14, 1985, although she does not specify for which goods, and since at least as early as October 31, 2006 in association with wines [para 8 of the affidavit].

[23] In support of her statements of use of the DA VINCI trade-mark, Ms. Masse attaches the following exhibits to her affidavit:

- Exhibit JM-1: photographs of a bottle and specimens of labels, as well as order forms for the years 1998, 2003, 2004 and 2006 for the product “Amaretto DA VINCI”. I note that the specimens of labels identify the Opponent’s predecessor-in-title Dumont Vins & Spiritueux Inc. as the source of the product [para 6];
- Exhibit JM-2: copy of a notice issued by the *Société des alcools du Québec* (SAQ) on October 31, 2006, when the Opponent’s wines were introduced on the market through Dumont Vins & Spiritueux Inc. [para 9];
- Exhibit JM-3: copy of a printout from the *Registraire des entreprises du Québec* (CIDREQ report) showing that Dumont Vins & Spiritueux Inc. is a company that was struck off following a merger which resulted in the Opponent [para 10];
- Exhibit JM-4: copies of various order forms for the years 2006-2010 for wines associated with the trade-mark DA VINCI [para 11];
- Exhibit JM-5: photograph of the front of a bottle of wine displaying the DA VINCI trade-mark [para 14]; and
- Exhibit JM-6: copies of promotional materials for wines associated with the DA VINCI trade-mark [para 6].

[24] Ms. Masse states that the Opponent has sold more than 400 000 bottles of wine in association with the DA VINCI trade-mark in Canada since 2007 and that the said sales amount to \$3,500,000 [paras 15 and 16 of the affidavit].

[25] I shall note before concluding on this point, that I am not affording weight to any of the statements made by Ms. Masse that constitute personal opinion on the likelihood of confusion between the parties' marks. The likelihood of confusion is a question of fact and law to be determined by the Registrar based on the evidence of record in the present proceeding.

Conclusions to be drawn from the Masse affidavit

[26] The Masse affidavit evidences use of the DA VINCI trade-mark in association with amaretto and wine, whereas the Opponent's registration for the DA VINCI trade-mark is for the goods identified as "*boissons alcoolisées distillées; liqueurs*".

[27] While amaretto falls under the category of goods described as "*liqueurs*", the same does not hold true for wine.

[28] At the hearing I asked the Opponent to refer me to the relevant portions, if any, of the Masse affidavit, addressing the question of use of the DA VINCI trade-mark in association with the registered goods "*boissons alcoolisées distillées*". The Opponent declined to answer. Rather, it merely reiterated that the Masse affidavit evidences use of the DA VINCI trade-mark in association with amaretto and wine. The Opponent further declined to confirm that amaretto falls under the general category of goods "*liqueurs*". The Opponent also referred me to the La affidavit, which provides under Exhibit SL-1 a definition of "*vin de liqueur*" excerpted from the *Nouveau Larousse des vins 1979*. However, I fail to see how the definition of "*vin de liqueur*" ("liqueur wine") assists the Opponent in the present case.

[29] I acknowledge that wines and liqueurs both fall under the general category of alcoholic beverages. However, the Opponent's registration does not cover "alcoholic beverages" *per se* and I am not satisfied from the evidence before me that the French term "*liqueurs*" encompasses, generally speaking, wines. Moreover, I note that nowhere in the Masse affidavit is the DA VINCI wine described as a "*vin de liqueur*". Rather, the Opponent's wine consists of a table wine which is sold through grocery stores and convenience stores (the SAQ simply acts as an intermediary) [see Exhibits JM-2 and JM-6 to the Masse affidavit].

[30] In view of the foregoing, I find that the Masse affidavit does not establish use of the DA

VINCI trade-mark in association with “*boissons alcoolisées distillées*” at any time whatsoever.

[31] I acknowledge that the Masse affidavit establishes use of the DA VINCI trade-mark in association with “*liqueurs*”. However, the fact remains that there is strictly no evidence for concluding to sales of Amaretto DA VINCI in years subsequent to 2006. Furthermore, except for the four order forms provided under Exhibit JM-1, the Masse affidavit does not provide any information whatsoever as to the value of the Opponent’s sales associated with the product Amaretto DA VINCI, or marketing expenses related thereto. There are simply too many deficiencies in the Opponent’s evidence to draw any meaningful conclusion with respect to the extent to which the trade-mark DA VINCI has become known in Canada in association with the registered goods “*liqueurs*”.

[32] To sum up, I am not satisfied that the evidence introduced by the Opponent through the Masse affidavit establishes that the trade-mark DA VINCI has acquired a significant measure of reputation in Canada with the registered goods “*boissons alcoolisées distillées, liqueurs*”. Thus, I find that this factor, which is a combination of inherent distinctiveness and acquired distinctiveness, does not significantly favour either party.

The length of time the trade-marks have been in use

[33] As indicated above, the Applicant’s application is based on proposed use of the Mark and there is no evidence that any use of the Mark commenced subsequent to the filing of the application.

[34] The Opponent’s DA VINCI trade-mark proceeded to registration in association with distilled alcoholic beverages and liquors further to the filing of a declaration of use on March 14, 1985. However, the mere existence of a registration can establish no more than *de minimus* of the Opponent’s trade-mark and cannot give rise to an inference of significant or continuing use [see *Entre Computer Centers, Inc v Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

[35] As indicated above, the Opponent’s evidence does not establish any use of its DA VINCI trade-mark in association with “*boissons alcoolisées distillées*”. As for the goods “*liqueurs*”,

while the Opponent did sell Amaretto in association with its DA VINCI trade-mark, there is no evidence of any sales of it beyond the year 2006.

[36] In view of the foregoing, I find that this factor favours the Opponent, but only to a limited extent.

The nature of the goods, services or business; and the nature of the trade

[37] When considering the nature of the goods and the nature of the trade, I must compare the Applicant's statement of goods with the statement of goods in the registration relied upon by the Opponent [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)].

[38] The parties' goods all fall under the general category of alcoholic beverages, and there is no evidence from the Applicant to enable me to conclude that the parties' channels of trade would differ.

[39] In view of the foregoing, these factors favour the Opponent.

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

[40] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, "the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion".

[41] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, "[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it" [see *Pink Panther Beauty Corp v United Artists Corp* (1998), 1998,

CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trade-mark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trade-mark is particularly striking or unique [see *Masterpiece*, at paragraph 64].

[42] Finally, as reminded by the Supreme Court in *Masterpiece* at paragraph 59, “a subsequent use that is within the scope of a registration, and is the same or very similar to an existing mark will show how that registered mark may be used in a way that is confusing with an existing mark.”

[43] Applying those principles to the present case, I find there is a fair degree of resemblance between the parties’ marks.

[44] In terms of appearance, the design element made up of the mirror image of the signature of well-known historical figure Leonardo Da Vinci does not add much distinctiveness to the Mark. The same holds true for the color claims. Rather, it is the word portion of the Mark made up of the words CANTINE LEONARDO DA VINCI that gives full meaning to the Mark and constitutes the dominant element thereof. The Mark incorporates the whole of the Opponent’s DA VINCI trade-mark. As indicated above, nothing prevents the Opponent to use its trade-mark in any way within the scope of its registration, including in a way similar to that of the Applicant.

[45] In terms of sound, the parties’ marks both have an Italian sounding.

[46] In terms of ideas suggested, the Applicant rightly submitted at the hearing that the Opponent’s position that there is no connotation attaching to its DA VINCI trade-mark weakens the Opponent’s case. However, as indicated above, I disagree with the Opponent’s position and find it unreasonable to conclude that there is no likelihood that such consumer would react to DA VINCI by thinking of the well-known historical figure Leonardo da Vinci. To the contrary, I find that the ideas suggested by the parties’ marks resemble one another.

Conclusion regarding the likelihood of confusion

[47] As indicated above, the Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. The presence of a

legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the Applicant.

[48] Having considered all of the relevant circumstances, I find that at best for the Applicant, the balance of probabilities weighs equally for both parties.

[49] I am aware that comparatively small differences may suffice to distinguish between “weak” marks, that is, between marks of low inherent distinctiveness [see *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. However, in the present case, the main idea suggested by the Opponent’s DA VINCI trade-mark is that of well-known historical figure Leonardo Da Vinci, that is the very same idea as that conveyed by the Mark. There are also visual and phonetic similarities between the parties’ marks due to the fact that the Mark incorporates the whole of the Opponent’s mark. These resemblances coupled with the resemblance between the parties’ respective goods and channels of trade, mitigate in favour of the Opponent.

[50] Accordingly, the section 12(1)(d) ground of opposition succeeds.

Non-distinctiveness of the Mark under section 2 of the Act

[51] The Opponent has pleaded that the Mark is not distinctive, within the meaning of section 2 of the Act, in that it does not distinguish, nor is it adapted to distinguish the Goods of the Applicant from the distilled alcoholic beverages, liquors, and wines of the Opponent.

[52] An opponent meets its evidentiary burden with respect to a distinctiveness ground if it shows that as of the filing date of the opposition (in this case February 14, 2013) its trade-mark had a substantial, significant or sufficient reputation in Canada in association with its alleged goods so as to negate the distinctiveness of the applicant’s mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); and *Bojangles’ International, LLC and Bojangles Restaurants Inc v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427].

[53] As per my review above of the Masse affidavit, the Opponent has not met its burden with respect to its alleged use of the DA VINCI trade-mark in association with distilled alcoholic beverages at any time whatsoever.

[54] As for the Opponent's alleged use of the DA VINCI trade-mark in association with liquors, the Masse affidavit satisfactorily establishes use of the DA VINCI trade-mark in association with amaretto accruing to the benefit of the Opponent within the meaning of section 4 of the Act, between the years 1998 and 2006. However, the evidence falls short of establishing that the Opponent had a substantial, significant, or sufficient reputation in Canada in association with liquors at the relevant date of February 14, 2013. The absence of information concerning the value, volume, or extent of sales of liquors associated with the trade-mark DA VINCI at any time whatsoever is fatal to the Opponent's case [see by analogy *Constellation Brands Québec Inc v Casa Vinicola Botter Carlo & C, supra*].

[55] This leaves us with the Opponent's alleged use of the DA VINCI trade-mark in association with wine.

[56] The Masse affidavit satisfactorily establishes extensive and continuous use of the DA VINCI trade-mark in association with wine between 2006 and the date of signature of Ms. Masse's affidavit on October 21, 2013. However, the evidence does not satisfactorily establish that such use accrues to the benefit of the Opponent.

[57] Indeed, upon review of the promotional materials filed under Exhibit JM-6, I note that one of the specimen displays the following mention:



[58] The specimen of promotional material in question is attached to my decision under Schedule "A". The bottle of wine illustrated therein is the same as the one depicted under Exhibit JM-5.

[59] At the hearing, I asked the Opponent what the relationship was between "Vincor Canada" and the Opponent. The Opponent's response was that there was no entity by the name of "Vincor Canada". Rather, the Opponent took the position that the above shown use constitutes use of the

trade-mark and/or trade-name “VINCOR”, which is listed in the CIDREQ report filed under Exhibit JM-3 as another name under which the Opponent carries on business in the province of Québec. The Opponent argued that the mention “CANADA” merely serves to indicate the name of the country within which the “*compagnie mondiale*” (global company) “Constellation” carries on business.

[60] However, the relationship existing between the so-called global company “Constellation” and the Opponent is nowhere explained in the Masse affidavit. The display of the words VINCOR CANADA above the phrase UNE SOCIÉTÉ DE CONSTELLATION directly refers to an entity by the name of VINCOR CANADA. To say otherwise is to consider the word VINCOR out of context.

[61] The relationship existing between VINCOR CANADA and the Opponent is nowhere explained in the Masse affidavit. Is VINCOR CANADA a distinct entity merely distributing the Opponent’s wine? Is it rather a licensee of the Opponent? If so, has the necessary control as to the character and quality of the DA VINCI wine been exercised by the Opponent under section 50 of the Act?

[62] In addition, the Masse affidavit provides no evidence showing use of the DA VINCI trade-mark by the Opponent itself within the meaning of section 4 of the Act. None of the photographs of the bottle of wine and labels affixed thereto filed under Exhibits JM-5 and JM-6 display any name. Further, although the order forms filed under Exhibit JM-4 corroborate Ms. Masse’s testimony as to the sale of wine in association with the DA VINCI trade-mark, they do not show the name of the recipient for the orders. The order forms merely relate to orders from the SAQ.

[63] The fact that Ms. Masse was not cross-examined on her affidavit does not cure the above-described ambiguities as to the source of the DA VINCI wine. Indeed, the lack of cross-examination does not prevent me from assessing the value or weight to be given to her affidavit [see by analogy *Constellation Brands Québec Inc v Casa Vinicola Botter Carlo & C, supra*].

[64] In view of the foregoing, I find that the Opponent has failed to discharge the evidential burden resting upon it with respect to its alleged use of the DA VINCI trade-mark in association

with wine.

[65] Accordingly, the non-distinctiveness ground of opposition is dismissed for the Opponent having failed to meet its evidentiary burden in respect thereof.

Non-entitlement under section 16(3)(a) of the Act

[66] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, because, as of the date of filing of the application, the Mark was confusing with the Opponent's trade-mark DA VINCI that had been previously used in Canada by the Opponent in association with distilled alcoholic beverages, liquors, and wines.

[67] An opponent meets its evidentiary burden with respect to as section 16(3)(a) ground of opposition if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act].

[68] For the same reasons as those provided under the non-distinctiveness ground of opposition, I find that the Opponent has not met the evidentiary burden resting upon it with respect to its alleged use of the DA VINCI trade-mark in association with distilled alcoholic beverages and wines.

[69] This leaves us with the Opponent's alleged use of the DA VINCI trade-mark in association with liquors.

[70] As indicated above, I acknowledge that the Masse affidavit establishes use of the DA VINCI trade-mark in association with "*liqueurs*". However, the fact remains that there is strictly no evidence for concluding to sales of Amaretto DA VINCI in years subsequent to 2006. The question thus becomes whether the evidence establishes that the Opponent had not abandoned its DA VINCI trade-mark for liquors at the date of advertisement of the application for the Mark, that is September 26, 2012.

[71] As noted by the Federal Court of Appeal in *Iwasaki Electric Co Ltd v Hortilux Schreder B V*, 2012 FCA 321 (CanLII), at paragraph 21, "section 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. [...] 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. [...] 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.”

[72] In the present case, the Masse affidavit is totally silent as to the sale of Amaretto DA VINCI after 2006. Rather, all of the statements of use of the DA VINCI trade-mark for the years 2006 to the date of signature of Ms. Masse’s affidavit, and accompanying exhibits, relate strictly to the Opponent’s wine DA VINCI.

[73] Except for the photographs of a bottle and specimens of labels, and the four order forms for the years 1998, 2003, 2004 and 2006 for the product Amaretto DA VINCI filed under Exhibit JM-1, nowhere in her affidavit does Ms. Masse expressly refer to the Opponent’s “*liqueurs*”. As stressed before, except for these four order forms, the Masse affidavit provides no information whatsoever as to the value of the Opponent’s sales associated with the product Amaretto DA VINCI, or marketing expenses related thereto.

[74] At the hearing I asked the Opponent to confirm that the Masse affidavit provides no evidence of use of the product Amaretto DA VINCI for the years subsequent to 2006. The Opponent’s response was that this is true. However, the Opponent submitted that this is insufficient to enable me to conclude that the DA VINCI trade-mark had been abandoned as of the material date of September 26, 2012. I disagree.

[75] I find that the Opponent has not met its burden to show non-abandonment of its trade-mark DA VINCI in association with the Opponent’s liquors as of the material date. As per my review above of the Masse affidavit, except for the product Amaretto DA VINCI, there is no evidence of any other type of liquor having been sold in association with the trade-mark DA VINCI at any time whatsoever. With respect to the Opponent’s amaretto product, I find that an inference of intention to abandon the trade-mark DA VINCI in association with the Opponent’s liquors can be drawn from the Opponent’s failure to use the DA VINCI trade-mark for a period of six years. There are simply no indicia whatsoever enabling me to conclude that the Opponent

had not abandoned and had no intention to abandon the DA VINCI trade-mark in association with its liquors as of the date of advertisement of the Applicant's application.

[76] Accordingly, the non-entitlement ground of opposition is dismissed for the Opponent having failed to meet its evidentiary burden in respect thereof.

Disposition

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

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

Hearing Date: 20015-09-23

Appearances

Bruno Barrette

For the Opponent

Richard Whissell

For the Applicant

Agents of Record

Barrette Legal Inc.

For the Opponent

MACRAE & CO

For the Applicant

Schedule A



ITALIE

DAVINCI

DA VINCI

Italie, Vin rouge
Cépage : Montepulciano
Alcool : 13 %
Code produit : 10666041
Format : 750 ml

Description



DaVinci, un vin inspirant et envoûtant, est empreint de mystère dont vous prendrez plaisir à décoder les arômes nuancés. Épicé au nez, minéral en bouche, il met le jour sur des arômes bien équilibrés, affichant une fraîcheur intéressante, typique au vin de son origine.

Accords mets et vins



Il accompagne merveilleusement le veau, le bœuf, les pâtes sauce tomate et les fromages forts.

*Disponible dans le réseau des épiceries
et dépanneurs en format 750 ml.*

VINCOR
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