

**IN THE MATTER OF AN OPPOSITION
by Canadian Wine Institute to application no.
738,917 for the mark FRENCH PARAD'OX
filed by Laboratoires Arkopharma S.A.**

On October 12, 1993, the applicant, Laboratoires Arkopharma S.A., filed an application to register the mark FRENCH PARAD'OX for use in association with

produits diététiques sous forme de gélules pour la
prévention des maladies cardiovasculaires.

The subject application is based on proposed use in Canada and claims a priority filing date (June 2, 1993) under Section 34 of the *Trade-marks Act*, in view of a corresponding trade-mark application filed by the applicant in France. The subject Canadian application disclaims the right to the exclusive use of the word FRENCH apart from the mark as a whole. The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated July 12, 1995 and was opposed by Canadian Wine Institute on December 5, 1995. A copy of the statement of opposition was forwarded to the applicant on January 25, 1996. The applicant responded by filing and serving a counter statement.

The grounds of opposition are fairly summarised at pages 1-2 of the opponent's written argument:

The opponent's evidence consists of the affidavit of Roger Randolph, President of the opponent association. The applicant's evidence consists of the affidavit of Isabelle Deshaies, which affidavit merely serves to introduce into the record a copy of the applicant's United States of America trade-mark registration for the mark FRENCH PARAD'OX registered on October 3, 1995. I agree with the opponent that the U.S.A. registration, by itself, is not relevant to the issues in this proceeding. Both parties filed a written argument and both parties were represented at an oral hearing.

Mr. Randolph's evidence may be summarized as follows. The Canadian Wine Institute is an association of 18 members operating 25 wineries in Canada and represents about 90% of Canadian wine production. The association's mandate is to facilitate the sale of more wine domestically and for export. Mr. Randolph has been familiar with the phrase THE FRENCH PARADOX since about 1992. In this regard, *The French Paradox and Beyond* is the title of a book written by Lewis Perdue with introduction chapters by Dr. Keith Marton and Dr. Wells Shoemaker. The thesis of the book is that alcohol consumption in moderation is effective in preventing heart attacks and in lowering cholesterol. The book itself would be perceived as having the title *French Paradox* as those words are in larger font than the other words of the title on the book cover. As noted in paragraph 4 of Mr. Randolph's affidavit:

The above statement appears in a booklet entitled *Wine and a Healthy Lifestyle* produced by the opponent. In 1995 the opponent sent about 50,000 such booklets to various provincial liquor

control boards across Canada to be distributed free of charge to consumers. Mr. Randolph states that it is his belief that the phrase THE FRENCH PARADOX is well known to many Canadian consumers of alcoholic beverages, and that the use of the trade-mark FRENCH PARAD'OX will lead consumers to believe that the applicant's capsules have the same constitute elements and beneficial effects as wine.

The first ground of opposition is based on Section 9(1)(k) of the *Trade-marks Act*:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,

...

(k) any matter that may falsely suggest a connection with any living individual.

In my view, the opponent's evidence, even without discounting some hearsay aspects, is insufficient to establish that the phrase THE FRENCH PARADOX is known to a significant number of Canadians. Even if I am wrong in this, then I would find that the evidence is entirely lacking to show that a significant number of Canadians would associate Mr. Perdue or Drs. Marton or Shoemaker with the phrase THE FRENCH PARADOX: see, for example, the type of evidence used to establish a connection between a trade-mark and a living individual in *Carson v. Reynolds* (1980), 49 C.P.R.(2d) 57 (F.C.T.D.). Consequently, I find that the first ground of opposition alleging that the applied for mark FRENCH PARAD'OX would suggest a connection to any of the above named individuals is rejected.

The second ground of opposition alleges that the applied for mark is clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares. That issue is to be determined from the point of view of an everyday user of the wares. Furthermore, the trade-mark in question must not be carefully analysed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R.(2d) 25 at 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R.(3d) 183 at 186. In other words, Section 12(1)(b) only prevents the registration of trade-marks that are clearly descriptive or deceptively misdescriptive; suggestive, descriptive and misdescriptive marks are not precluded. In the instant case, the

second ground of opposition is related to the first ground in that, in order for the opponent to succeed at all, the opponent must establish that the general public is well acquainted with the phrase FRENCH PARADOX. As I have stated earlier, I do not view the opponent's evidence as sufficient to show that the term is well known in Canada, let alone known for its meaning. However, if I am wrong in this, and the evidence does establish that the Canadian public is familiar with the meaning of the term FRENCH PARADOX, then I am inclined to view the applied for mark FRENCH PARAD'OX as a descriptive or laudatory mark which is merely suggestive of a beneficial effect of the applicant's wares, but not clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares. In other words, the applicant is free to intimate that the beneficial effects of its product are equal to the beneficial effects of wine. Thus, the second ground of opposition is rejected.

The third ground of opposition alleges that the applicant is not entitled to register the applied for mark. Again, the opponent has failed to provide support for this ground in that firstly, the terms FRENCH PARADOX and THE FRENCH PARADOX AND BEYOND were not used as trade-marks by Mr. Perdue or Drs. Marton or Wells, but were used as a title of a book. Secondly, even if the terms were used as trade-marks in Canada, they were not so used by the opponent. By operation of Sections 16 and 17(1) of the *Act*, the opponent cannot rely on the use of marks by third parties to allege non-entitlement: see *Professional Pharmaceutical v. Laboratoires Ed. Fromont, S.A.* (1996), 69 C.P.R.(3d) 501 at 508-509 (TMOB). Thus, the third ground of opposition is rejected. The final ground of opposition, as pleaded in the statement of

opposition, merely reiterates the previous grounds of opposition and therefore it too is rejected.

Accordingly, the opponent's opposition is rejected.

DATED AT HULL, QUEBEC, THIS 18th DAY OF MAY, 1999.

Myer Herzig,
Member,
Trade-marks Opposition Board