

**IN THE MATTER OF AN OPPOSITION by
Spirits International N.V. to application No. 1,033,359
for the trade-mark STALINSKAYA & Design
filed by SC Prodal 94 SRL**

On October 22, 1999, the applicant, SC Prodal 94 SRL, filed an application to register the trade-mark STALINSKAYA & Design. The mark is shown below:



The application is based upon proposed use of the trade-mark in Canada in association with alcoholic beverages, namely distilled grain, wheat and rye spirit except beer. The applicant has disclaimed the right to the exclusive use of all the reading matter except for the word STALINSKAYA. As well, the letter P superimposed upon the coat of arms is disclaimed apart from the trade-mark.

The application was advertised for opposition purposes in the Trade-marks Journal of March 28, 2001. On May 28, 2001, the opponent, Spirits International N.V., filed a statement of opposition against the application. The applicant filed and served a counter statement.

As rule 41 evidence, the opponent filed the affidavit of Stanislaw Brasiler. The applicant filed the affidavits of Ionna Claudia Marin and Allison Huff as rule 42 evidence.

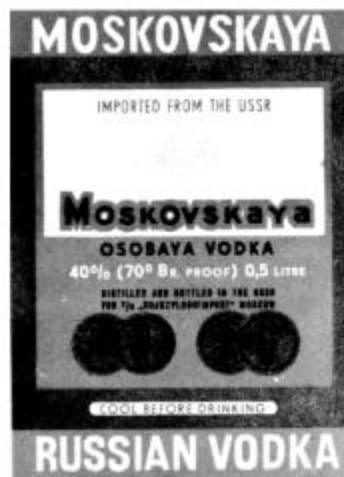
Written arguments were filed by both parties. An oral hearing was held at which both parties were represented.

Grounds of Opposition

The grounds of opposition are summarized below:

1. the application does not comply with the requirements of s. 30(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) because it does not contain a statement in ordinary commercial terms of the specific wares with which the trade-mark will be used;
2. the application does not comply with the requirements of s. 30(i) of the Act because at the date of filing such application, the applicant was well aware that it was not entitled to use the applied for mark in Canada in association with the wares specified in the application;
3. the applied for mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with a family of ten trade-marks owned by the opponent and registered under Nos. 208,808, 208,809, 283,218, 495,126, 495,127, 538,598, 540,828, 540,830, 544,670 and 479,418, each of which is shown below:

i) 208,808:



ii) 208,809:



iii) 283,218:



iv) 495,126:

MOSKOVSKAYA CRISTALL

v) 495,127:



vi) 538,598:



vii) 540,828:



viii) 540,830:



ix) 544,670:

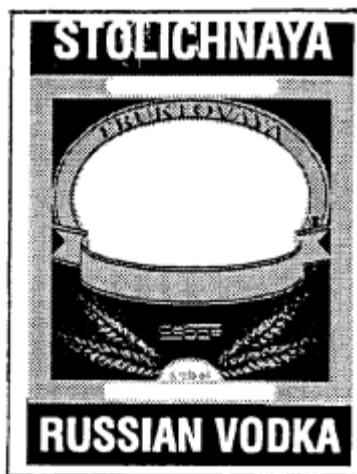


x) 479,418:

CRISTALL

4. the applicant is not the person entitled to register the mark because, at the date of filing of the application, was confusing with the aforementioned family of trade-marks, which had been previously used in Canada by the opponent, as well as with eight additional family members, namely the trade-marks shown below:

i) application no. 726,952:



ii) application no. 867,712:



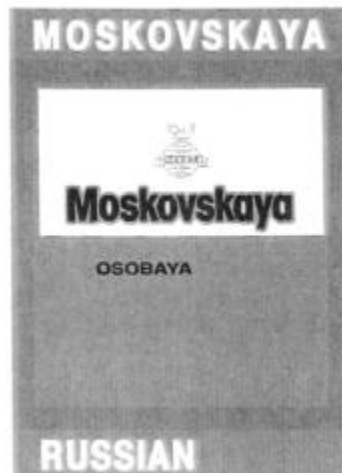
iii) application no. 867,715:



iv) application no. 1,064,642:



v) application no. 1,064,643:



vi) application no. 1,064,644: STOLICHNAYA

vii) application no. 1,064,645: MOSKOVSKAYA

5. the applied-for mark is not distinctive of the applicant because it will not distinguish as it is not adapted to distinguish the proposed use wares of the applicant from the wares of others, in

particular the wares in association with which the opponent has previously registered, applied for and used the opponent's family of trade-marks in Canada.

Onus

Although 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 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 Limited v. The Molson Companies Limited*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)]

Material Dates

The material dates with respect to the grounds of opposition are as follows: s. 30 - the date of filing of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at 475]; s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]; s. 16(3) - the date of filing of the application; non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324].

Opponent's Evidence

Brasiler Affidavit

Mr. Brasiler has been the opponent's Managing Director since March 2, 1999. Mr. Brasiler states that as a result of his normal duties with the opponent, he is familiar with the full line of products sold by the opponent in Canada. In addition, he indicates that he has access to his company's ordinary business records. The applicant has not raised any objections to Mr. Brasiler's evidence.

Mr. Brasiler provides certified copies of the trade-mark registrations and applications relied upon in the statement of opposition. He attests that the primary mark used by the opponent in Canada

is STOLICHNAYA and that it also uses MOSKOVSKAYA and STOLI in Canada. The wares are sold to provincial liquor control boards that in turn sell them to Canadian consumers.

Canadian sales of STOLICHNAYA product began in 1976 and Mr. Brasiler states that sales of STOLICHNAYA vodka have been extensive since that time. As Exhibit “B” he provides a chart showing the number of 9 litre cases sold in each province in 1996, which amounted to 20,000 cases nationally. Mr. Brasiler estimates that the Canadian retail value of STOLICHNAYA product sales in Canadian dollars exceeded the following amounts in the years indicated: 1999 – \$1,139,00; 2000 – \$609,000; 2001 – \$1,503,000.

Canadian sales of MOSKOVSKAYA and STOLI product began in 1976 and 1993, respectively.

Mr. Brasiler has provided a number of invoices from 1999 to 2001 relating to some of his company’s sales of STOLICHNAYA, MOSKOVSKAYA and STOLI product in Canada. He has also provided sample labels and photographs depicting some of his company’s products. All of the labels are for “vodka” and state “distilled and bottled in Russia for Vzao ‘Sojuzplodoimport’, Moscow”. The invoices list Zao Sojuzplodimport as the supplier but appear to have been issued by SPI Limited of Gibraltar or S.P.I. Spirits (Cyprus) Limited of Cyprus. I do not see the opponent’s name on any of these materials.

According to the certified copy of some of the opponent’s trade-mark registrations, Vzao Sojuzplodoimport was a trading style of the entity that owned the trade-marks between April 16, 1996 and April 3, 1998. The records show that the present opponent acquired the trade-mark rights from that entity’s successor-in-title on October 26, 1999. Mr. Brasiler’s affidavit, which is dated March 2002, offers no explanation concerning the various names that appear on the invoices and labels provided by him.

Applicant's Evidence

Marin Affidavit

Ms. Marin has been the applicant's Brand Manager since June 1, 2001. She started work with the applicant in or about August 1999, in an unspecified job. She states, "By virtue of my employment with [the applicant], I have personal knowledge of the matters deposed to in this my Affidavit except where stated to be on information or belief." She has not stated that she has reviewed the business records of the applicant.

In its written argument, the opponent submitted that Ms. Marin's affidavit should be disregarded because it contains hearsay. I agree that Ms. Marin has not justified the introduction of evidence that predates her association with the applicant. There is no explanation as to why someone who was employed with the applicant prior to 1999 could not have attested to events that took place prior to Ms. Marin's employment. Accordingly, in my summary of her evidence, I have omitted portions that are clearly inadmissible as unjustified hearsay.

Ms. Marin states that the applicant is a manufacturer and merchant of bottled alcoholic beverages and that it produces and bottles STALINSKAYA alcoholic beverages in Romania. "STALINSKAYA is a genuine type of vodka produced from 100% double distilled grain alcohol, blended and purified according to an original Russian recipe."

I reproduce below paragraphs 8-11 of Ms. Marin's affidavit:

8. In my experience, the suffix "AYA" in the Russian language is the feminine possessive ending that is used to conform with the feminine word "vodka".

9. In my experience, the suffix "AYA" and "SKAYA" in the Russian language have been commonly used, including in Canada, in association with the sale of vodka and related products.

10. In addition to the specific use of "AYA" and "SKAYA", in my experience it is very common for producers and vendors of vodka around the world, including those in Canada, to adopt and use in association with their wares, Russian and Russian-sounding or foreign-sounding words (foreign to the English language), whether actual or coined terms.

11. The brand STALINSKAYA was created in 1995 and used in the Romanian market. When creating the brand, SCP took into consideration two aspects which are true to this day:

- a) Consumers had to be aware that the product used a genuine Russian recipe. In my experience, “AYA” has become commonly used for vodka produced using a Russian recipe. This featured in SCP’s decision to use “AYA” at the end of STALINSKAYA; and,
- b) STALINSKAYA was created to have the connotation of a product with an image “AS STRONG AS STEEL”. The word “STAL” was chosen for its meaning in Russian language: STEEL. SCP chose “STALIN” over “STAL” because the combination “STALINSKAYA” in SCP’s view had a better sound than “STALSKAYA” and because of the well-known historical figure Joseph Stalin.

[I have included paragraph 11 of Ms. Marin’s affidavit in my summary because she has attested that these aspects are true to this day.]

Ms. Marin says that, to her knowledge, the word STOLICHNAYA has the connotation of “THE CAPITAL” or “OF THE METROPOLIS” while the word “MOSKOV” refers to the city of Moscow. She is not aware of any instances of confusion between the applicant’s STALINSKAYA mark and the opponent’s STOLICHNAYA, MOSKOVSKAYA or STOLI marks anywhere in the world. She provides a copy of a decision issued by the Intellectual Property Office of the Czech Republic, which found in favour of the present applicant when its STALINSKAYA & Design mark was opposed by the present opponent in that country.

Before proceeding, I will mention that the opponent also submitted that Ms. Marin is not qualified to make comments about the meaning of Russian words or practices in the vodka industry. Ms. Marin has certainly not been qualified as an expert but I do not think that precludes her from making the statements objected to by the opponent. Presumably, as Brand Manager of a vodka manufacturer, she would have some knowledge of the vodka industry and it was open to the opponent to cross-examine her or to introduce evidence to disprove any statements that it considers to be inaccurate.

Huff Affidavit

Ms. Huff is a legal assistant employed by the applicant’s law firm. She informs us that the applicant owns a Canadian trade-mark registration for the word mark STALINSKAYA for

vodka, No. 501,347, and that no one opposed the registration of that mark. According to the Trade-marks Office's records, STALINSKAYA and STALINSKAYA & Design are associated marks.

On or about March 19, 2002, Ms. Huff conducted searches of the Canadian Trade-marks Database at www.strategis.ic.gc.ca for marks that incorporate "AYA" or "SKAYA" in association with vodka and related alcoholic beverage products. She located five such registered word marks, namely POSOLSKAYA, RUSSKAYA, PETROVSKAYA, RYESKAYA and STOLBOVAYA, each of which is owned by a different party. In addition, she located six such registered design marks, which are shown below:

1.



2.

BOLS KAYA

3.



4.



5.



6.

Смирновская Водка No. 21

(translated as SMIRNOVSKAYA VODKA NO. 21)

The first three of the above design marks are owned by one party. I do not consider the sixth design mark to be pertinent as it only contains the suffix AYA in its translation.

Ms. Huff also searched “for marks which incorporate Russian, Russian-sounding or other Eastern European or foreign-sounding words and designs in association with vodka and related alcoholic beverage products.” She has provided registration pages for more than 60 of such marks.

In addition, Ms. Huff conducted Internet searches for the word “Stalin”. She also has provided copies of two articles that she retrieved from the Internet that discuss a dispute over the global ownership of the STOLICHNAYA brand.

Section 30(a) Ground

The opponent's position is that the present application does not contain a statement in ordinary commercial terms of the specific wares in association with which the mark is to be used and is therefore not in compliance with s. 30(a) of the Act. I agree for the following reasons.

The application's statement of wares reads, "alcoholic beverages, namely distilled grain, wheat and rye spirit except beer." Although the opponent raised concern about the inappropriateness of excluding beer from a category to which it does not belong, I do not think that makes the statement unacceptable. Rather, my concern stems from the fact that the applicant clearly intends to use its mark in association with vodka and yet chose not to refer to vodka in its statement of wares. It is noted that the registration for its word mark STALINSKAYA refers to vodka. Nevertheless, when asked by the examiner to further define its alcoholic beverages in the present application, the applicant replied as follows:

"The applicant has considered limiting the designation of the services to 'alcoholic beverages, namely vodka'. However, the word 'vodka' has, in common parlance, acquired a meaning distinctive of a peculiar alcoholic beverage, despite the fact that the dictionary meaning of vodka is the much broader 'colourless alcoholic liquor distilled from rye, wheat, etc.' The applicant respectfully submits that a limitation of the applied for wares to 'vodka' would be severely limiting and even excluding an alcoholic beverage such as a colourless brandy which is, by right, also a vodka."

I will not argue with the applicant's position that, pursuant to a technical interpretation, a colourless brandy could be a vodka. I think it is self-evident that in Canada brandy is not considered to be a type of vodka by the typical seller or buyer of such beverages. Cognizance must be given to the requirement that terms listed in a statement of wares must be the commercial term that is both ordinary and specific. I believe that I can take judicial notice that the average Canadian wishing to order the applicant's product would refer to it as a vodka, not as a "distilled grain, wheat and rye spirit". Throughout her evidence, Ms. Marin refers to "vodka" and the mark applied for itself identifies the wares as vodka. The term employed in the application is therefore not the ordinary commercial term. Nor is it specific, as demonstrated by the interpretation that the applicant itself proposed during examination.

An alternative way to look at it would be to say that distilled grain, wheat and rye spirit describes

a general class of wares, not a specific one. [see *Scotch Whisky Association v. Mark Anthony Group Inc.* (1990), 31 C.P.R. (3d) 55 (T.M.O.B.)]

For the foregoing reasons, the ground of opposition based on s. 30(a) succeeds.

Analysis re Likelihood of Confusion

The majority of the grounds of opposition are based on the likelihood of confusion between STALINSKAYA & Design and the members of the opponent's alleged family of trade-marks.

I will begin by addressing the opponent's claim to a family of marks. The opponent has referred in its pleadings to "the opponent's family of STOLICHNAYA, MOSKOVSKAYA and SIBIRSKAYA trade-marks". It is unclear to me what the common element of the opponent's family is, especially as it identifies its word mark CRISTALL as being part of this family (see third ground of opposition). If one were to give the opponent the most favourable benefit of the doubt, one would conclude that it is claiming a family of marks ending in AYA. However, in order to assert a family, one must prove use of each member of the family. [see *McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.)] Moreover, the presumption of the existence of a family is rebutted where there is evidence that the alleged family's common feature is registered and used by others. [see *Thomas J. Lipton Inc. v. Fletcher's Fine Foods Ltd.* (1992), 44 C.P.R. (3d) 279 (T.M.O.B.) at 286-7]

In my view, Mr. Brasiler's affidavit only evidences use of STOLICHNAYA and MOSKOVSKAYA, albeit possibly on various forms of labels. Also, at least some of the use shown is not by the opponent, its predecessor, or an entity whose use has been shown to enure to the benefit of the opponent pursuant to s. 50 of the Act. In addition, there is evidence that others have registered marks ending in AYA in the opponent's field. I therefore do not accept that the opponent has a family of trade-marks.

The opponent's strongest position with respect to the likelihood of confusion is based on its STOLICHNAYA trade-mark, since that mark is both the one that has been used the most in Canada and the one that arguably most resembles the applicant's mark. I will therefore focus this

discussion on the likelihood of confusion between the applicant's mark and STOLICHNAYA.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in s. 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act. Those factors specifically set out in s. 6(5) are: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

Both STALINSKAYA & Design and STOLICHNAYA are inherently distinctive marks. As there is no evidence that the applicant's mark has been used or promoted in Canada, it has not acquired any distinctiveness here. Although there has been use of the opponent's mark, I have difficulty concluding that it has acquired distinctiveness in the hands of the opponent since the evidence shows use by another party.

There has been lengthy use of the opponent's mark in Canada. However, I accord reduced weight to this factor since such use since 1999 does not appear to have been by the trade-mark owner.

Both parties' marks are associated with vodka. Both parties' wares are of the same general class and would be sold to the public through similar channels of trade.

Visually and aurally, the dominant word in the mark STALINSKAYA & Design bears some resemblance to STOLICHNAYA since both words start with ST, have LI in the middle and end with AYA. Although the applicant has introduced evidence concerning the meaning of the components of these words, I have no reason to assume that the average Canadian consumer would be aware of the English translations of these words. However, I believe that I can take

judicial notice that Joseph Stalin is a well-known Russian historical figure and some Canadian vodka consumers may relate the first part of STALINSKAYA to the surname STALIN and the most well known individual bearing that name. The first part of STOLICHNAYA does not appear to have any meaning in the English language. However, it is trite law that the trade-marks are to be considered as a whole and not broken down into their individual parts. Overall, each of the words STALINSKAYA and STOLICHNAYA suggests nothing more than a foreign-language mark, possibly in the Russian language.

There are of course other components to the applicant's STALINSKAYA & Design mark beyond the word STALINSKAYA but I am not convinced that they would serve to distinguish the applicant's mark from the opponent's mark.

The fact that the applicant owns a registration for the word mark STALINSKAYA does not give it the automatic right to obtain a further registration no matter how closely it may be related to its earlier registration [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.* (1984), 4 C.P.R. (3d) 108 (T.M.O.B.) at 115].

Another surrounding circumstance to be considered is the applicant's evidence of the state of the register. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.)]. Moreover, inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located. [*Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]

Ms. Huff's evidence has satisfied me that the Canadian public would be used to seeing trade-marks that incorporate what appear to be Russian words in association with vodka. Presumably, such marks are popular because of the reputation attributed to Russian vodka. I am therefore prepared to accept that Canadian vodka drinkers would not assume that two vodkas share the

same source simply because they are associated with trade-marks that might appear to be Russian. However, the two marks here bear more resemblance than just their ethnicity.

We do have evidence of at least 8 other companies registering marks ending in AYA for vodka or similar wares and that may be just enough to enable me to conclude that Canadians would be sufficiently astute at distinguishing one AYA suffix vodka mark from another based on their different beginnings. Nevertheless, it is not to be forgotten that there are more similarities between the marks at issue here than merely their common termination.

At the oral hearing, the opponent referred to two decisions rendered in the United Kingdom with respect to an opposition by the present opponent to the present applicant's application to register in the United Kingdom the mark that is at issue here. The decisions comprise the Registrar's decision in the opposition and the High Court's decision in an appeal from the Registrar's decision: *In the matter of Application 2207412 by SC Prodal 94 SRL to Register a trade mark in Class 33 and in the matter of Opposition thereto under No. 50901 by Spirits International N.V.*, April 25, 2003; and *SC Prodal 94 SRL v. Spirits International NV* [2003] EWHC 2756 (CH) (04 November 2003). Copies of these unreported decisions were provided to the Board and the applicant by the opponent prior to the oral hearing. In other circumstances, I might be reluctant to consider mere photocopies of unreported foreign decisions but I am prepared to consider them in the present case because the parties in the decisions are the same as in the present proceedings and the applicant has not raised any objection to the inclusion of these unreported decisions in the opponent's case law.

Foreign decisions are not binding on this Board, but that does not mean that they cannot be persuasive. [see *Neutrogena Corp. v. Guaber SRL* (1993), 49 C.P.R. (3d) 282 (T.M.O.B.); *Origins Natural Resources v. Warnaco U.S.* (2000), 9 C.P.R. (4th) 540 (T.M.O.B.) at 548] In the present case, no evidence has been presented concerning how closely the law of the United Kingdom coincides with Canadian trade-mark law. The opponent asks me to take judicial notice of the similarities. While I agree that every Canadian lawyer knows of the relationship between British and Canadian law, it cannot be said that they are the same. For example, the decision

being relied upon makes it clear that in the United Kingdom the likelihood of confusion “must be appreciated globally”. In addition, the evidence before the U.K. Trade Marks Registrar is not identical to that presented in the present proceedings. However, the following discussion by the U.K. Registrar concerning the resemblance between the marks at issue is not evidence-dependent and is quite on point:

“35. I now turn to a visual comparison of the respective marks. The dominant, distinctive element of the mark in suit is the word STALINSKAYA which, as the opponent points out, is of the same length as the opponent’s STOLICHNAYA mark (eleven letters), and both commence with the letters ST, share the same fourth and fifth letters and end with the letters AYA. The words differ in their third, sixth and seventh, and eighth letters and the marks also differ in that (as mentioned in paragraph 31 of this decision) the mark in suit comprises a label containing additional material, mainly product descriptors and product information. As mentioned earlier in this decision, similarity of marks must be considered in the light of overall impression. On this basis, given that the word STALINSKAYA is the dominant, distinctive element of the applicant’s mark and that the differing letters are in the middle of the respective words, where there [stet] visual impact is relatively less apparent than it is at the beginning and termination of the words, and after bearing in mind the potential for imperfect recollection, it seems to me that the respective marks as a whole possess obvious visual similarity and there is considerable scope for visual confusion, notwithstanding that the STALIN element of the word STALINSKAYA may remind some customers of the deceased Russian dictator.

36. In relation to oral use of the marks, it seems to me that the mark in suit is likely to be referred to in general use by the word element STALINSKAYA only. While the marks share similar beginnings and identical terminations and aural similarity exists, I believe the opponent’s case for aural similarity to be less strong than the visual one.

37. Next, I turn to a conceptual comparison of the marks. In the U.K. the marks would be perceived primarily as invented words. As Ms. Heal points out, the dominant part of the mark in suit, the word STALINSKAYA, contains the element STALIN which could remind customers of the deceased dictator. However, conceptual similarity exists in that the respective marks both have a Russian or East-European feel or impact. It seems to me that invented words sharing a Russian or East-European identity are not likely to be distinguished in the way dictionary words with similar appearances but different meanings would be and imperfect recollection may well be a factor.”

The U.K. Registrar concluded by finding that there was a likelihood of confusion between STALINSKAYA & Design and STOLICHNAYA. His decision was upheld on appeal. In doing so, Mr. Justice Laddie commented, in *obiter*, “In my view, had this been a case where I had been

deciding the matter at first instance, I am not sure that I would have said that the aural similarity is less strong than the visual one. In my view, it is as strong as the visual one and therefore, if anything, I would have come to the same conclusion as the Hearing Officer but perhaps I would have also done so on the basis of the aural similarity as well.” [paragraph 21]

I believe that the analysis of the resemblance between the marks STALINSKAYA & Design and STOLICHNAYA as set out by the U.K. Registrar and adjusted by Mr. Justice Laddie applies well in the present case. I am not saying that I am bound by this analysis, but simply that I find that it echoes, and perhaps reinforces, my own s. 6(5)(e) analysis.

On the other hand, I have not found the opposition decision in the Czech Republic to be of any assistance in analyzing the likelihood of confusion for several reasons. A review of the decision indicates that although the opposition there was based in part on the word mark STOLICHNAYA, that ground was rejected because it was found that the rights in STOLICHNAYA did not have priority over the applicant’s rights. As a result, the decision dealt only with the issue of whether the applicant’s STALINSKAYA & Design mark was “interchangeable” with the opponent’s STOLICHNAYA Label and the adjudicator relied in large part upon the differences between the various design features of each party’s label to find in favour of the applicant. It is therefore clear that both the law and the facts before the Czech adjudicator were not the same as in the present proceedings.

Conclusion re Likelihood of Confusion

Having considered all of the surrounding circumstances, I conclude that the applicant has not satisfied me that, on a balance of probabilities, there was not a reasonable likelihood of confusion between STALINSKAYA & Design and STOLICHNAYA as of May 28, 2001. Despite the evidence concerning the somewhat common adoption of the suffix AYA in the parties’ fields, the fact remains that the resemblance between the two marks exceeds that commonality. Given the “foreign” nature of the dominant words in each mark, and their considerable resemblance overall, combined with the lack of use or acquired reputation of the applicant’s mark in Canada, I conclude that the applicant’s mark does not serve to distinguish its wares from the wares of

others in Canada, in particular from vodka sold in association with the mark STOLICHNAYA. In reaching this conclusion, I have considered that it may be unclear to the Canadian consumer who in fact is the owner of the STOLICHNAYA mark but have concluded that this does not improve the ability of the applicant's mark to distinguish its source from the source of the STOLICHNAYA wares, regardless of who that source may be.

For the foregoing reasons, the distinctiveness ground of opposition succeeds.

As I have already found in favour of the opponent with respect to two of the grounds of opposition, I do not propose to address the remaining grounds.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I refuse application No. 1,033,359.

DATED AT TORONTO, ONTARIO, THIS 9th DAY OF NOVEMBER 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board