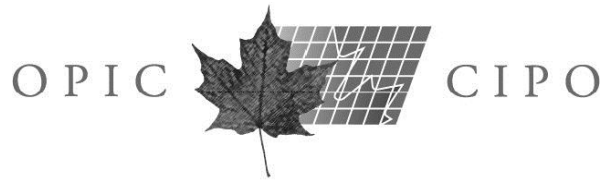


Translation



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

Reference: 2013 TMOB 45
Date of Decision: 20/03/2013

**IN THE MATTER OF THE
OPPOSITION submitted by
Constellation Brands Québec, Inc. and
Constellation Brands Canada, Inc.
against registration application
No. 1,434,577 for the JULIA CELLIER
trade-mark & Design in the name of Julia
Wine Inc.**

[1] On April 15, 2009, Julia Wine Inc. (the Requesting Party) submitted an application to register the JULIA CELLIER trade-mark & Design (the Mark), as illustrated below, in association with “wines” and based on the use of the Mark in Canada since October 13, 2008.



[2] The application was published for purposes of opposition in the *Trade-Marks Journal* on March 17, 2010.

[3] On April 12, 2010, Vincor (Québec) Inc. and Vincor International Inc. submitted a joint statement of opposition.

[4] At this time, I note that the opponents requested, on July 24, 2012, to have the file in the current procedure amended to reflect the change in their respective names, i.e. Vincor (Québec) Inc. to Constellation Brands Québec, Inc. and Vincor International Inc. to Constellation Brands Canada, Inc. In an official letter dated August 29, 2012, the registrar confirmed the registration of Constellation Brands Québec, Inc. as being the opponent. After examining the file, it seems clear to me that the registration of Constellation Brands Canada, Inc. was wrongly omitted from the official letter. Accordingly, I confirm that the file has been amended to reflect the name of Constellation Brands Canada, Inc. as opponent. Unless indicated otherwise, I will refer collectively to Constellation Brands Québec, Inc., formerly Vincor (Québec) Inc., and Constellation Brands Canada, Inc., formerly Vincor International Inc., as the Opponent.

[5] In the introductory paragraphs of the statement of opposition, the Opponent specifically claims ownership of a family of trade-marks comprising the terms “cellar”, “cellars” and “cellier” registered and used in Canada by the Opponent or by its designated predecessors in association with wines (collectively the CELLIER marks), namely:

| <u>Trade-mark</u> | <u>Registration number</u> |
|------------------------|----------------------------|
| VASEAUX CELLARS | TMC285,567 |
| CELLIER DES CHATELAINS | TMC286,471 |
| CELLAR SELECTION | TMC290,787 |
| BRIGHTS CELLAR | TMC292,585 |
| CELLIER DU MANOIR | TMC299,331 |
| CELLIER DU MONDE | TMC303,988 |
| ABBAY CELLAR | TMC307,213 |
| OLIVER CELLAR & Design | TMC502,125 |



TMC522,863

[6] Taking into account the introductory paragraphs of the statement of opposition, the grounds of opposition raised pursuant to the *Trade-marks Act*, RSC 1985, c T-13 (the Act) can be summarized as follows:

- The application does not meet the requirements of Sections 30(b) and 30(i) of the Act;
- The Mark is not registrable pursuant to Section 12(1)(d) of the Act because it causes confusion with the following registered trade-marks: (i) The Opponent's CELLIER marks; and (ii) the JULIA'S (No. TMC655,291) de Jackson Family Farms, LLC mark;
- The Requesting Party is not the person entitled to register the Mark pursuant to Section 16(1)(a) of the Act because on the date of the first use claimed in the application, the Mark caused confusion with the following marks: (i) the CELLIER marks previously used in Canada by the Opponent in association with wines; and (ii) the JULIA'S de Jackson Family Farms, LLC trade-mark registered on the basis of its use in Canada since at least as early as February 25, 2004 in association with wine;
- The Requesting Party is not the person entitled to register the Mark pursuant to Section 16(1)(c) of the Act because on the date of the first use claimed in the application, the Mark caused confusion with the CELLIERS DU MONDE INC. brand name previously used in Canada by Celliers du Monde Inc., the designated predecessor of Constellation Brands Québec, Inc.; and
- The Mark is not distinctive pursuant to Section 2 of the Act because it is not suitable for distinguishing the wares of the Requesting Party from the wares of the Opponent due to the use and advertising in Canada of the Opponent's CELLIER marks.

[7] The Requesting Party submitted a counter-statement denying all grounds of opposition.

[8] In support of its opposition, the Opponent submitted certificates of authenticity for the registrations claimed in the statement of opposition and an affidavit dated September 23, 2010 by Natasha Gangai, a para-legal employed by the firm Stikeman Elliott LLP, at the time trade-marks agent representing the Opponent.

[9] In support of its application, the Requesting Party submitted an affidavit dated February 24, 2011 by Alain Mounir, president of the Requesting Party, and a statement dated February 23, 2011 by Lisa Saltzman, manager of the trade-mark search Department at Groupe Onscope Inc.

[10] No cross-examination was conducted.

[11] Each of the parties produced a written argument and was represented at a hearing.

Burden of proof

[12] It is incumbent on the Requesting Party to show that its application complies with the requirements of the Act. However, it is incumbent on the Opponent to ensure that each of its grounds of opposition are duly argued and to meet its initial burden of proof by establishing the facts on which it bases its grounds of opposition. Once this initial burden of proof has been met, it is incumbent on the Requesting Party to establish, according to the preponderance of probabilities, that none of these grounds of opposition are an obstacle to registration of the Mark [*John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (CF 1st inst.); and *Dion Neckwear Ltd. v. Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (CAF)].

Relevant dates

[13] The relevant dates for assessment of the circumstances relating to each of the grounds of opposition in this case are as follows:

- Section 38(2)(a)/Section 30: the date of submission of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 CPR (3d) 469 (TMOB)];

- Section 38(2)(b)/Section 12(1)(d): the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413 (CAF)];
- Section 38(2)(c)/Sections 16(1)(a) and 16(1)(c): the date of the first use claimed in the application; and
- Section 38(2)(d)/absence of distinctive character: the date of submission of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 CPR (4th) 317 (CF 1st inst)].

Analysis of the grounds of opposition

[14] I will now conduct an analysis of the grounds of opposition in light of the evidence submitted in the file.

Grounds of opposition summarily rejected

[15] For the reasons discussed below, I reject the grounds of opposition raised pursuant to Sections 30(i), 16(1)(a) and 16(1)(c) of the Act and the absence of distinctive character of the Mark.

[16] Section 30(i) of the Act requires simply that a requesting party provide a statement declaring that it is convinced that it is entitled to use the trade-mark in Canada in association with the wares or services described in its application. The Requesting Party has strictly complied with the requirements of this provision. I would also add that it has been established in case law that a ground of opposition founded on non-compliance with Section 30(i) of the Act should only be retained in precise cases, specifically when bad faith on the part of the requesting is claimed or established or when specific legislative provisions are an obstacle to registration of the mark covered by the application [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 CPR (2d) 152 (TMOB); and *Canada Post Corporation v. Registrar of Trade-marks* (1991), 40 CPR (3d) 221 (CF 1st inst)]. This is not the case here.

[17] The Opponent has not met its initial burden of proof relating to the ground of opposition pursuant to Section 16(1)(a) of the Act and based on prior use in Canada of its CELLIER marks.

Contrary to the Opponent's claims, the certificates of authenticity for registration of the CELLIER marks do not enable it to meet its burden of showing that one or other of these marks had been used prior to the relevant date and had not been abandoned at the date of the publication of the application [see Section 16(5) of the Act]. The simple existence of a registration establishes at most a minimal use of the registered trade-mark [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 CPR (3d) 427 (TMOB)].

[18] The ground of opposition pursuant to Section 16(1)(a) of the Act and based on the JULIA'S de Jackson Family Farms, LLC mark is invalid since the claimed mark is not the property of the Opponent. Section 17(1) of the Act stipulates that no application for registration of a trade-mark may be refused for the fact that a person other than the author of the application for registration or its designated predecessor has previously used or displayed a trade-mark creating confusion, *except at the request of this other person* or its designated successor [see *Professional Pharmaceutical Corp. v. Laboratoires Ed Fromont SA* (1996), 69 CPR (3d) 501 (TMOB) for an analysis of the operation of Sections 16 and 17(1) of the Act].

[19] The Opponent has not met its initial burden of proof relating to the ground of opposition pursuant to Section 16(1)(c) of the Act and based on prior use of the CELLIERS DU MONDE INC. brand name by the designated predecessor of Constellation Brands Québec, Inc. Contrary to the claims of the Opponent, the display on the website of the Registraire des entreprises du Québec regarding Constellation Brands Québec, Inc. [exhibit A of Ms. Gangai's affidavit] does not enable it to meet its burden of showing that the brand name claimed to have been used by Constellation Brands Québec, Inc. or its designated predecessor prior to the relevant date and had not been abandoned at the date of the publication of the application [see Section 16(5) of the Act].

[20] Lastly, the Opponent has not met its initial burden of proof of showing that one or other of the CELLIER marks had become sufficiently known on the relevant date to deny the distinctive character of the Mark [see *Motel 6, Inc. v. No 6 Motel Ltd.* (1981), 56 CPR (2d) 44 (CF 1st inst); and *Bojangles' International, LLC and Bojangles Restaurants, Inc. v. Bojangles Café Ltd.* (2006), 48 CPR (4th) 427 (CF)]. Here again, and contrary to the claims of the Opponent, the simple existence of registrations for the CELLIER marks does not enable it to

meet its burden of proof relating to the ground of opposition based on the absence of distinctive character of the Mark.

[21] I will now conduct an analysis of the remaining grounds of opposition and based on Sections 30(b) and 12(1)(d) of the Act.

Non-compliance with Section 30(b) of the Act

[22] Insofar as a requesting party has easier access to the facts, the initial burden of proof incumbent on an opponent regarding the ground of opposition based on non-compliance with Section 30(b) of the Act is less onerous [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 CPR (3d) 84 (TMOB)]. An opponent can use the evidence of the requesting party to meet this burden, but it must show that this evidence is clearly incompatible with the claimed use of the mark covered by the application [see *Ivy Lea Shirt Co. v. Muskoka Fine Watercraft & Supply Co.* (1999), 2 CPR (4th) 562 (TMOB) pp. 565-566; conf (2001), 11 CPR (4th) 489 (CF 1st inst)]. In this regard, Section 30(b) of the Act requires the mark covered by the application to have been in continuous use in the normal course of business since the claimed date [see *Labatt Brewing Co. v. Benson & Hedges (Canada) Ltd.* (1996), 67 CPR (3d) 258 (CF 1st inst.) p. 262].

[23] In the current case, the Opponent has presented no evidence in support of its ground of opposition. Rather, the Opponent relies on the evidence of the Requesting Party to meet its burden of proof. To summarize the Opponent's position, it is suffice to say that it submits in its written argument that Mr. Mounir's affidavit does not show the sale of wine in association with the Mark on or before October 13, 2008 for the following reason:

29. The only evidence furnished by the Applicant regarding its use of the subject trade-mark in Canada is through invoices which do not list the Applicant's name Julia Wine Inc.

The Mounir Affidavit, paras 6 to 14, Exhibits AM-1, AM-3 and AM-5

[24] To better understand the Opponent's representations, I first note that Mr. Mounir states in paragraph 5 of his affidavit that the normal business practice of the Requesting Party as an

international wine trader consisted specifically in purchasing large quantities of wine, then reselling this wine in bottles bearing the Requesting Party's marks, including the Mark, to distributors of alcoholic drinks.

[25] The invoices appended to Mr. Mounir's affidavit as exhibits AM-1, AM-3 and AM-5 are submitted in support of his statements to the effect that the Requesting Party had sold cases of bottles of wine to a distributor in the United States on October 13, 2008 and June 15, 2009, and to a distributor in Chile on December 20, 2010. According to Mr. Mounir's statements, these cases were exported from a vineyard supplier of the Requesting Party located in the city of Niagara-on-the-Lake, Canada, location where the labels were affixed to the bottles. I note that under the terms of Section 4(3) of the Act, a trade-mark that is marked in Canada on wares is deemed, when these wares are exported from Canada, to be used in Canada in association with the wares.

[26] Given the Opponent's representations, during the hearing, I stressed to him that he wrongly submitted that the invoices did not show the name of the Requesting Party. To this end, I noted the following mention in the lower left corner of each invoice:

ÉTABLIR VOTRE PAIEMENT À L'ORDRE DE JULIA WINE INC.
PLEASE MAKE YOUR PAYMENT TO JULIA WINE INC.

[27] In addition, Mr. Mounir submitted with his affidavit photographs of bottles of wine [Exhibits AM-2, AM-4 and AM-6] bearing a label identical to that affixed to the bottles sent to distributors as part of the sales covered by the invoices. The Opponent is therefore wrong in submitting that the evidence of use of the Mark is limited to invoices.

[28] On completion of the analysis, I conclude that the evidence of the Requesting Party is not clearly incompatible with the claimed use of the Mark since October 13, 2008. Accordingly, I reject the ground of opposition based on non-compliance with Section 30(b) of the Act because the Opponent has not met its burden of proof.

Enregistrability pursuant to Section 12(1)(d) of the Act

[29] I exercised the registrar's discretion to confirm that each registration claimed by the Opponent is in order. Given that the Opponent had met its initial burden of proof, it is incumbent on the Requesting Party to show, according to the preponderance of probabilities, that there is no confusion between the Mark and one or other of the registered marks claimed by the Opponent.

[30] The test in terms of confusion is that of first impression and imperfect memory. According to Section 6(2) of the Act, the use of a trade-mark creates confusion with another trade-mark when the use of both trade-marks in the same region would be likely to give the impression that the wares related to these trade-marks are manufactured, sold, leased or rented or that the services related to these trade-marks are leased or executed, by the same person, whether these wares or these services are or are not of the same general category.

[31] In deciding whether these trade-marks create confusion, the registrar must take into account all circumstances in the case, specifically those listed in Section 6(5) of the Act, i.e. a) the inherent distinctive nature of the trade-marks and the extent to which they have become known; b) the period during which the trade-marks have been in use; c) the type of wares, services or enterprises; d) the type of business; e) 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 different weight can be given to each of these circumstances according to the situation [see *Mattel, Inc. v. 3894207 Canada Inc* (2006), 49 CPR. (4th) 321 (CSC); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltd. et al* (2006), 49 CPR (4th) 401 (CSC); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR (4th) 361 (CSC) for an in-depth analysis of the general principles applicable to the confusion test].

[32] I will consider the ground of opposition by starting with an analysis of the probability of confusion between the Mark and the CELLIER marks

Probability of confusion between the Mark and the CELLIER marks

[33] I note first of all that contrary to the Opponent's claims, the evidence submitted in the file does not enable it to claim the existence of a family of marks comprising the terms “cellar”, “cellars” and “cellier” in association with wine. Aside from the fact that the registrations of the CELLIER marks are held in part by Constellation Brands Québec, Inc. (Nos. TMA286,471, TMA299,331, TMA303,988 and TMA307,213) and in part by Constellation Brands Canada, Inc. (Nos. TMA285,567, TMA290,787, TMA292,585, TMA502,125 and TMA522,863), the Opponent has presented no evidence of use of each of the CELLIER marks comprising the claimed family [see *MacDonald’s Corporation v. Yogi Yogurt Ltd.* (1982), 66 CPR (2d) 101 (CF 1st inst.)].

[34] Since the Supreme Court of Canada repeated in the *Masterpiece* ruling, *supra*, the degree of similarity in the presentation or the sound or in the ideas suggested is generally the most important factor in assessing confusion. In the reasons for his judgment, Judge Rothstein stated as follows:

49. [...] the degree of resemblance, although the last factor listed in s. 6(5), 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. The other factors become significant only once the marks are found to be identical or very similar [...] As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[35] The law clearly establishes that in assessing confusion, the trade-marks should not be dissected into their constituent elements. Rather, the trade-marks must be examined as a whole. In discussing the approach to adopt in testing for resemblance between trade-marks, Judge Rothstein said the following in paragraph 64 of *Masterpiece*: “While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique”.

[36] The Opponent claims that there is no difference between the Mark and the CELLIER marks in the presentation, the sound and the ideas they suggest because the term “cellier” is

contained in the Mark. I do not agree. Insofar as the term “cellier” describes a place laid out for keeping wine, I consider that it cannot be considered as a distinctive element in this case. The descriptive connotation attached to the term ”cellier” is all the more apparent in the Mark, since this term is followed by the element “No”. Since the other graphic and normal elements that make up the Mark, including “Julia” and the compass, I consider that there are significant differences between the Mark and each of the CELLIER marks in the sound, presentation and ideas suggested. I would add that the Opponent seems to want to claim a monopoly in the term “cellier” in association with wine, which I find unreasonable in this case.

[37] I believe it is not necessary to examine the evidence regarding the list on the register of trade-marks comprising the word “cellier” or “cellar” presented by Ms. Saltzman to decide in favour of the Requesting Party. In effect, I am convinced that the differences between the Mark and each of the CELLIER marks, when considered as a whole, suffice to distinguish them. Accordingly, I conclude that the Requesting Party has met its burden of showing that there is no probability of confusion between the Mark and the CELLIER marks.

[38] Given the above, I reject the ground of opposition based on Section 12(1)(d) of the Act in regard to each of the registrations of the CELLIER marks of Constellation Brands Québec, Inc. (Nos. TMA286,471, TMA299,331, TMA303,988 and TMA307,213) and of Constellation Brands Canada, Inc. (Nos. TMA285,567, TMA290,787, TMA292,585, TMA502,125 and TMA522,863). Accordingly, I will now analyze the probability of confusion between the Mark and the JULIA’S mark.

Probability of confusion between the Mark and the JULIA’S mark

[39] I agree with the Requesting Party that the JULIA’S mark has little inherent distinctive character since it primarily comprises the forename Julia (see by analogy the comment of Judge Binnie in *Mattel, Inc., supra*, para. 3, to the effect that the forename Barbie, in fact a regular diminutive of the forename Barbara, does not have as such an inherent distinctive character). I would add that the Opponent’s representations during the hearing did not persuade me that the JULIA’S mark cannot be perceived as a forename. Moreover, although it is possible to enhance the impact of a trade-mark by making it known through promotion and use, there is no evidence to suggest that the JULIA’S mark has become known in Canada. I recall that the simple

existence of registration No. TMA655,291 establishes at most a minimal use of the JULIA'S mark. Accordingly, contrary to the Opponent's representations, I conclude that it is not favoured by the circumstances stated in Section 6(5)(a) of the Act.

[40] The registration TMA655,291 claims use of the JULIA'S mark in Canada since as early as February 25, 2004 whereas the Requesting Party is claiming use of the Mark since October 13, 2008. However, in the absence of evidence showing continuous use of the JULIA'S mark since the claimed date, I consider that the period during which the trade-marks have been in use is not a significant circumstance in this case.

[41] With regard to the degree of similarity between the Mark and the JULIA'S mark, I consider that the Requesting Party fairly submits that the latter is not as significant as the Opponent claims. Since the Mark must be considered as a whole, the other elements in its make-up, including the compass representing the cardinal points, cannot be ignored. It is well-established that when trade-marks have little or no inherent distinctive character, slight differences are used to distinguish them [see *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 CPR (3d) 349 (CAF)]. In this case, I consider that any resemblance between the marks attributable to the presence of the forename of Julia cannot outweigh the visual and phonetic differences between the marks when taken as a whole.

[42] After considering the circumstances in this case, including the weakness of the JULIA'S mark, I conclude that the Requesting Party has met its burden of showing that there is no probability of confusion between the Mark and the JULIA'S mark.

[43] Given the above, I reject the ground of opposition based on Section 12(1)(d) of the Act in regard to registration No. TMA655,291 for the JULIA'S mark.

Decision

[44] In exercising the authority delegated to me pursuant to the provisions of Section 63(3) of the Act, I reject the opposition according to the provisions of Section 38(8) of the Act.

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Traduction certifiée conforme
Alan Vickers