

**IN THE MATTER OF AN OPPOSITION by
Rothmans Benson & Hedges Inc. to application
No. 1122416 for the trade-mark du MAURIER
RUBY filed by Du Maurier Company Inc.**

[1]. On November 19, 2001, Du Maurier Company Inc. (the Applicant) filed an application to register the trade-mark du MAURIER RUBY (the Mark) based upon proposed use of the Mark in Canada in association with “manufactured tobacco products” (the Wares).

[2]. The application was advertised for opposition purposes in the Trade-marks Journal of December 18, 2002.

[3]. On May 20, 2003, Rothmans Benson & Hedges Inc. (the Opponent) filed a statement of opposition against the application. The grounds of opposition, as amended, can be summarized as follows:

- a. The application does not conform to the requirements of s. 30(e) of the *Trade-marks Act*, R.S.C.1985, c. T-13, as amended (the Act) in that the Applicant does not intend to use the phrase “du MAURIER RUBY”, as a trade-mark;
- b. The Mark is not registrable, contrary to s. 12(1)(b) of the Act, since the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which it is proposed to be used; and
- c. The Mark is not distinctive of the Applicant.

[4]. The Applicant filed and served a counter statement in which it denied all grounds of opposition.

[5]. As its evidence, the Opponent submitted an affidavit of Perry J. Lao. The Applicant filed a single set of affidavits of Edmond Ricard, Chantal Dorais, Adamo Santoianni, Timothy Owen Stevenson, Eric Weaver, Iva Morina and Gay Owens in respect of the present opposition as well as five oppositions to other applications involving the same Applicant and Opponent. Only the aspects of evidence relevant to the present opposition will be discussed herein.

[6]. Each party filed a written argument. Only the Applicant was represented at an oral hearing.

Summary of the Opponent's Evidence

Affidavit of Perry J. Lao

[7]. Perry J. Lao identifies himself as a lawyer employed in the law firm representing the Opponent in the present opposition proceeding.

[8]. Mr. Lao states that he obtained various cigarette packages of the Applicant on February 9, 2004, from a convenience store located in Toronto. He attaches as Exhibits "A" to "F" to his affidavit, scanned images of the front display panels featuring the design and text appearing on the "du MAURIER" and "du MAURIER Light/Extra Light/Ultra Light/Edition/ or Special Mild" cigarette packages of the Applicant. I am reproducing below the main features of the front display panels of the Applicant's "du MAURIER Edition" and "du MAURIER Ultra Light" cigarette packages that are being referred to in the present opposition proceeding:



[9]. Mr. Lao makes various observations regarding the indicia appearing on the said packaging. He further states that based on the Applicant's commercially available products that are included as Exhibits "A" to "F" as well as a printout from the Canadian Intellectual Property Office's on-line trade-mark database attached to his affidavit as Exhibit "G" and pertaining to a trade-mark application of the Applicant for the mark "du MAURIER EDITION" that was, at the time of Mr. Lao's affidavit, also opposed by the Opponent, it is reasonable to conclude that the

applied for Mark would appear on packaging in a similar fashion to that of the commercially available products of the Applicant shown in Exhibits “A” to “G”, whereby the words “du MAURIER” would appear separate from the word “RUBY”. I am not prepared to accord any weight to this latter portion of Mr. Lao’s affidavit that constitutes pure speculation on his part.

[10]. Mr. Lao further includes in his affidavit, extracts from various paper and web-based dictionaries available in Canada defining the word “RUBY”.

Summary of the Applicant’s Evidence

Affidavit of Edmond Ricard

[11]. Edmond Ricard identifies himself as the Division Head, Marketing Futures and Development of the Marketing Division of Imperial Tobacco Canada Limited/Imperial Tobacco Canada Limitée (“ITCan”). He states that in his position, he is responsible for, among other things, maintaining trade-marks owned by ITCan and its subsidiaries (including Imperial Tobacco Company Limited (“ITCo”), Imperial Brands Limited/Les Marques Imperial Ltée (“Imperial Brands”) and the Applicant) and monitoring the use of these trade-marks.

[12]. Mr. Ricard states that pursuant to a licence agreement between the Applicant and Imperial Brands, Imperial Brands is licensed to use all of the Applicant’s trade-marks in association with the manufacture and sale of tobacco products. The license also grants Imperial Brands the right to sub-license its rights to others and Imperial Brands has sub-licensed its rights to ITCan under the same terms as the license between the Applicant and Imperial Brands.

[13]. Mr. Ricard states that ITCan has manufactured, marketed and sold du MAURIER EDITION cigarettes in Canada since at least as early as May 6, 2002.

[14]. Mr. Ricard explains the manner in which the du MAURIER EDITION cigarettes are being sold in Canada. He further attaches to his affidavit, representative samples of packaging, order forms and invoices for same.

Affidavit of Chantal Dorais

[15]. Chantal Dorais identifies herself as the Consumer Relations Team Leader for ITCan. Ms. Dorais states that her department handles customer communications, including questions, compliments, comments and complaints, concerning the products manufactured by ITCan, including ITCan's du MAURIER EDITION cigarette product.

[16]. Ms. Dorais states that communications concerning ITCan's products are most often received by telephone, via a phone number printed on the outside of packages for ITCan's products. She further states that employees within the department, including her, take these calls and enter the subject of the discussion directly in an electronic database. At the conclusion of these calls, the department asks the customer to provide details of the communication in writing via a comment form, which is mailed to the customer by the department. These forms are then returned to the department.

[17]. Ms. Dorais states that in the majority of cases customers refer to the product in issue by its full name. Thus, if a customer is contacting the department concerning ITCan's du MAURIER EDITION product, the customers have, in the majority of cases, referred to the product as "du MAURIER EDITION". Ms. Dorais further states that ITCan has received over 700 communications concerning ITCan's du MAURIER EDITION cigarettes and she attaches as Exhibit "A" to her affidavit, representative samples of communications received from Canadian consumers concerning same.

Affidavit of Adamo Santoianni

[18]. Adamo Santoianni identifies himself as a Sales Representative employed by ITCo. He has held his position with ITCo and its predecessors for 23 years.

[19]. He states that his role is to work with retailers in the Montreal area in the merchandising of products manufactured by ITCan, for whom ITCo distributes cigarettes. Mr. Santoianni

explains that he speaks with retailers regularly and also visits them in their stores to hand over informational documents, to maintain their stock of cigarette displays, etc. He further states that he often has the opportunity to speak with or overhear customers who enter retail stores while he is visiting the retailers. He states that over the past 23 years, he has spoken to, or overheard thousands of customers discussing or purchasing their cigarettes and that in the vast majority of cases (in his estimation, about 95% of the time), these customers refer to the cigarette brand in issue using its full name. He states that this is true of ITCan's du MAURIER EDITION cigarettes, which are referred to by such customers as "du MAURIER EDITION".

[20]. Mr. Santoianni further continues his affidavit by stating that this is not surprising as in his experience it has been and continues to be commonplace for a given tobacco manufacturer to offer a number of brands whose names use a common first element. He states as examples without further supporting facts, PLAYER'S FILTER, PLAYER'S LIGHT SMOOTH, PLAYER'S SILVER and PLAYER'S SPECIAL BLEND; and EXPORT A EXTRA LIGHT, EXPORT A LIGHT, EXPORT A MEDIUM, EXPORT A MEDIUM FLAVOUR and EXPORT A MILD.

[21]. While the Opponent has not objected to the admissibility as evidence of Mr. Santoianni's statements, I will discuss same later on in my decision.

Affidavits of Iva Morina, Timothy Owen Stevenson and Eric Weaver

[22]. Iva Morina, Timothy Owen Stevenson and Eric Weaver identify themselves as respectively paralegal, summer student and student-at-law employed by the law firm representing the Applicant in the present opposition proceeding.

[23]. Iva Morina and Timothy Owen Stevenson have each attended one or more convenience stores in November 2004 and verbally ordered a pack of du MAURIER EDITION cigarettes. Photocopies of the du MAURIER EDITION pack of cigarettes received as well as receipt for same are attached to each of their affidavits.

[24]. Eric Weaver viewed and printed excerpts from the web page www.whistlergrocery.com on November 23, 2004. On the same date, he purchased a single pack of du MAURIER EDITION cigarettes from this website. These excerpts as well as a confirmation of purchase page printed following his purchase are attached to his affidavit.

Affidavit of Gay Owens

[25]. Gay Owens identifies herself as a trade-mark searcher with the law firm representing the Applicant in the present opposition proceeding. She has attached to her affidavit, the results of a computer-assisted state of the register search that was conducted to locate active trade-mark registrations and applications that include the word “RUBY” in relation to various wares. I will discuss the results of this search later on in my decision.

Onus and relevant dates

[26]. 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, however, 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[27]. The relevant dates for assessing the circumstances in regard to each of the grounds of opposition in the present case are the following:

- Ground based on s. 30 of the Act: the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- Ground based on s. 12(1)(b) of the Act: the filing date of the application [see *General Housewares Corp. v. Fiesta Barbeques Limited* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]
- Ground based on non-distinctiveness of the Mark: generally accepted as being the

filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

[28]. I will now analyze the grounds of opposition in regard to the evidence filed in the record.

Section 30(e) ground of opposition

[29]. The Opponent's first ground of opposition is that the application does not conform to the requirements of s. 30(e) of the Act, in that the Applicant does not intend to use the Mark, as a trade-mark pursuant to s. 2 of the Act, in association with the general class of wares described in the application. More particularly, the Opponent has pleaded that the Applicant will use the du MAURIER RUBY trade-mark in a manner such that the public, as a matter of first impression, will not perceive the alleged mark as being used as a single or unitary trade-mark. The Opponent contends that the words "du MAURIER" and the word "RUBY" will use different lettering or sizing and the word "RUBY" will be perceived as being purely descriptive of the colouring of the packaging, such that the public will not perceive this element as forming part of the trade-mark as a whole, and will only perceive the words "du MAURIER" as functioning as a trade-mark.

[30]. As further set forth in the Lao affidavit and the Opponent's written argument, the Opponent relies on the Applicant's commercially available products that are included as Exhibits "A" to "F" to the Lao affidavit, to argue that the Mark would appear on packaging in a similar fashion to that of the du MAURIER EDITION packaging (i.e. the words "du MAURIER" would appear separate from the word "RUBY") and that such use of du MAURIER RUBY trade-mark would therefore not constitute use as a unitary trade-mark.

[31]. Conversely, the Applicant contends that at most, this evidence demonstrates the manner in which the Applicant sold its unrelated du MAURIER EDITION brand of cigarettes in 2004 and cannot possibly be taken as evidence of what the Applicant's intention may have been some three years earlier, as to how it would sell its du MAURIER RUBY brand of cigarettes. As such, the Applicant contends that it is not possible to conclude from the evidence filed in the record

that the Applicant's intention in 2001 was not to use the du MAURIER RUBY Mark, particularly in view of the Applicant's unequivocal and contemporaneous statement in its application that it would use the Mark as a trade-mark. I agree.

[32]. Assuming that there would be evidence supporting the Opponent's contentions, I further agree with the Applicant's contention that such manner of use would qualify as use as a trade-mark.

[33]. Indeed, if the Applicant were to use the Mark in the same format as its du MAURIER EDITION cigarette product, I believe that such manner of use would qualify as use as a trade-mark since the fact that the words "du MAURIER" and "EDITION" ["RUBY"] appear [would appear] in different fonts, sizes and colours on the front, side and top panels of the cigarette packages does not in itself prevent the words from being considered use of the word mark du MAURIER EDITION [du MAURIER RUBY] as a whole. The words "du MAURIER" and "EDITION" ["RUBY"] always appear [would always appear] in close proximity with each other, and with either no other indicia (side panel) or no other wording (top panel) surrounding them. They are the only words of significant size appearing on the front panel.

[34]. The said use of du MAURIER RUBY as a trade-mark on cigarette packages is further supported by the use made of du MAURIER EDITION on the invoices and order forms attached to the Ricard affidavit. "du MAURIER EDITION" appears in the body of the invoices and the invoices accompany the wares or are shipped to the purchasers. "du MAURIER EDITION" appears on order forms used by retailers and wholesalers to order cigarettes from ITCo. "du MAURIER EDITION" further appears on consumer sales receipts as evidenced by the Morina and Stevenson affidavits.

[35]. Furthermore, the samples of communications attached to the Dorais affidavit evidence that du MAURIER EDITION cigarettes are referred to by customers as "du MAURIER EDITION".

[36]. I do not need to determine the admissibility of the statements made by Mr. Santoianni as

I consider the above outlined evidence sufficient to conclude in the circumstances that if the Applicant were to use the applied for Mark in the same format as its du MAURIER EDITION cigarette product, such use would qualify as use of the proposed trade-mark.

[37]. Based on the foregoing analysis, I find that the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Applicant does not intend to use the Mark, as a trade-mark, in association with the Wares. The s. 30(e) ground of opposition is accordingly dismissed.

Section 12(1)(b) ground of opposition

[38]. The Opponent contends that the Mark is not registrable, contrary to s. 12(1)(b) of the Act, since the Mark, whether depicted, written or sounded, is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares in association with which it is proposed to be used.

[39]. While I have doubts as to the sufficiency of this pleading, I understand from the Lao affidavit and the statement of opposition as a whole that the Opponent contends that the word “RUBY” will be perceived as being purely descriptive of the colour of the packaging of the Wares.

[40]. The test under s. 12(1)(b) of the Act considers whether the trade-mark as a whole is clearly descriptive or deceptively misdescriptive of the character or quality of the wares or services in association with which it is used or proposed to be used. The trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.), at 27-28 and *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.), at 186]. As a corollary, if only part of a proposed trade-mark is objectionable, the trade-mark as a whole may still be registrable provided that the objectionable part does not so dominate the applied for trade-mark as a whole such that the trade-mark would thereby be precluded from

registration [see *Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 35 C.P.R. (4th) 507]. “Character” means a feature, trait or characteristic of the product and “clearly” means self-evident, plain, easy to understand [see *Drakett Co. of Canada v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Ex. Ct.), at 34].

[41]. Applying these principles to the present case, I agree with the Applicant that the s. 12(1)(b) ground of opposition ought to be dismissed, for the reasons set out below.

[42]. The Opponent has acknowledged in its written argument that the Mark is made up of two components, namely “*the well-known house mark du MAURIER*”, and the ordinary dictionary word “RUBY”. The Opponent has not alleged that the words “du MAURIER” are in a way descriptive or misdescriptive of the character or quality of the Wares. Accordingly, the Mark as a whole cannot be clearly descriptive or deceptively misdescriptive of the character or quality of the Wares. The component “du MAURIER” dominates the Mark and renders the entirety of the Mark non-descriptive.

[43]. Furthermore, the dictionary definitions for the word “RUBY”, filed by the Opponent suggest that when used in association with tobacco products, the Mark may suggest any of the following, in addition to potentially suggesting that the packaging of the tobacco product is ruby in colour:

- that the tobacco product itself is ruby in colour
- that the tobacco product itself, much like the precious stone, is something of great worth
- that the tobacco product is part of a collection of products each designated using the name of a gem (e.g. emerald, diamond, ruby)

[44]. The variety and number of trade-marks comprising the word “RUBY” presently on the register as evidenced by the Owens affidavit further supports the finding that the word “RUBY” by itself does not necessarily render the entirety of the Mark clearly descriptive or deceptively misdescriptive. As of the date of the search, there were over 30 trade-mark registrations or

allowed applications for trade-marks containing the word “RUBY”. I agree with the Applicant that the fact that many of these registrations and applications do contain a disclaimer of the right to the exclusive use of the word “RUBY” apart from the trade-mark by no means implies that the present application should be refused on the basis that “RUBY” on its own is clearly descriptive and should therefore have been disclaimed. While not pleaded by the Opponent in the present case, the absence of a disclaimer is not, in any event, a valid ground of opposition [see *Canadian Schenley Distilleries Ltd. v. Registrar of Trade-marks and Bodegas Rioja Santiago, S.A.* (1974), 15 C.P.R. (2d) 1 at 10 (F.C.T.D.)].

[45]. Having regard to the foregoing analysis, I find that the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the Wares. Accordingly, the s. 12(1)(b) ground of opposition is dismissed.

Non-distinctiveness ground of opposition

[46]. The Opponent contends that the Mark is not distinctive of the Applicant as it does not distinguish the Wares of the Applicant nor is it adapted so as to distinguish them. The Opponent has detailed further that ground of opposition as follows:

“Distinctive, in relation to a trade-mark means a trade-mark that actually distinguishes the wares in association with which it is being used by its owner from the wares of others or is so adapted so to distinguish them. The alleged trade-mark du MAURIER RUBY is not distinctive as it is not, nor will it be perceived as being, a trade-mark, for the reasons described in paragraph 3(a) [that is ground a)] above.”

[47]. As the findings made above with respect to the s. 30(e) ground of opposition are equally applicable to the non-distinctiveness ground of opposition as pleaded by the Opponent, this latter ground of opposition also fails at the very least for the same reasons that the s. 30(e) ground of opposition failed.

Disposition

[48]. Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition to the registration of the Mark pursuant to s. 38(8) of the Act.

DATED AT Montréal, Québec, THIS 16th DAY OF July 2009.

Annie Robitaille
Member
Trade-marks Opposition Board