

**IN THE MATTER OF THE OPPOSITION
BY the Institut National des Appellations
D'Origine to the application for registration
No. 877,189 for the trade-mark SAVEUR
DE PROVENCE, property of Vincor
(Québec) Inc.**

On April 14, 1998, Dumont Vins & Spiritueux Inc, the successor in title to Vincor (Québec) Inc. (the “Applicant”), filed an application for registration of the trade-mark SAVEUR DE PROVENCE (the “mark”) in association with some wines from Provence, based on a proposed use. The applicant disclaimed the right to exclusive use of the word PROVENCE apart from the trade-mark. It was published in the Trade Marks Journal on September 1, 1999.

On October 15, 1999, the Institut National des Appellations D'Origine (the “OPPONENT”) filed a statement of opposition on the grounds that:

[Translation]

- (a) the mark is not registrable because, contrary to the provisions of section 12(1)(b) of the *Trade-marks Act*, R.S.C. 1985, c. T-13, (the “Act”), it is, whether depicted, written or sounded, 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 used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.
- (b) the mark is not registrable because, contrary to the provisions of sections 12(1)(e) and 10 of the Act, it so nearly resembles the French appellations of origin *Côtes de Provence*, *Coteaux d'Aix-en-Provence* and *Les Baux-de-Provence* as to be likely to be mistaken therefor, the said appellations of origin concerning wares of the same general class as those covered by the application for registration, and having become recognized in Canada as designating the kind, quality, value or place of origin of the wares in association with which these appellations are used.

- (c) the mark that is the subject matter of the application for registration No. 877,189 is not distinctive in that it is not adapted to distinguish the wares in association with which it is proposed to use it from the wares of other owners, and in particular for the reasons previously cited.

The applicant filed a counter statement of opposition in which it essentially denies the allegations contained in the statement of opposition, adding that the word PROVENCE is a component of ten (10) trade-marks appearing in the Canadian Trade Marks Register and therefore was not considered to be contrary to paragraphs 12(1)(b) and (e), section 10 and section 2 of the Act in relation to the said registrations. No certificate of registration was produced in the record to support this allegation.

It should be understood from the evidence presented more fully below that an appellation of origin [*appellation d'origine contrôlée*] of a wine is a designation that can be used, under French law, only in association with wines emanating from a region of France, the characteristics and conditions of production of which are defined by decree.

The opponent's evidence includes the affidavits of Marie-Claude Dupont to which are attached exhibits MCD-1 to MCD-29, of Karen Fiona MacDonald with exhibits KFM-1 to KFM-44, of Ziad J. Katul including exhibits A to N and of Jacques Janelle including exhibit JJ-1. None of these affiants was cross-examined. The applicant filed no evidence in the record. Only the opponent filed written submissions and none of the parties requested a hearing.

Mr. Jacques Janelle has held the position of analyst in the market research department of the Société des alcools du Québec (the "SAQ") for 24 years. At the request of the opponent's agents, he researched the sales in the SAQ's outlets of wines with the appellation of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*". His report, introduced as exhibit JJ-1, states that the Quebec sales of the wines bearing these appellations increased from more than two million dollars in 1995-1996 to more than four million dollars in 1999-2000.

Ms. Marie-Claude Dupont is a legal assistant in Montréal with the opponent's agents. Pursuant to the instructions she was given, she began by consulting the library of the faculty of arts and social sciences of the University of Montréal. She produced as exhibit MCD-1 some extracts from dictionaries in which the word PROVENCE is defined as a region in south-eastern France. She also visited one of the Renaud Bray bookstores, where she procured the "Michelin Guide" on France. It contains in the relevant pages introduced as exhibit MCD-2 a map of France on which the region of Provence is identified in the south-eastern part. She then visited the Maison de la France in Montréal and procured some documents on the Provence region. The relevant pages of these documents were introduced as exhibits MCD-3 to MCD-5 in support of her affidavit.

She also went to the City of Montréal Library to consult some magazines containing references to the Provence region. Extracts from three magazines are appended to her affidavit as exhibits MCD-6 to MCD-8. She visited a second outlet of the Renaud Bray bookstore to obtain a list of the publications dealing with Provence. This list, exhibit MCD-9, refers to 264 items, books, laser disks, calendars or photo albums. In the same place she procured two of these titles in which the appellations of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*" are mentioned for the purpose of designating wines produced in the Provence region. The relevant extracts were introduced as exhibits MCD-10 and MCD-11.

She visited the Indigo bookstore to procure a list (exhibit MCD-12) of all the products dealing with Provence. This list includes 195 items. She procured three titles in which the Provence region is discussed, including the reference *Côtes de Provence* as an *appellation contrôlée* and some references to *Coteaux d'Aix* and *Baux-de-Provence*. The relevant extracts from these works are appended as exhibits MCD-13 to MCD-16. She also did some research on the Internet using the Alta Vista search engine. The entry of the word Provence was used to identify more than 200 sites concerning that region. The exhibit MCD-17 constitutes some examples of relevant extracts from those sites.

She purchased the guide *Les Vins de France* (extracts introduced as exhibit MCD-19), which contains a section on the appellations of origin *Côtes de Provence* and *Coteaux d'Aix-en-Provence*. She also visited one of the outlets of the Société des alcools du Québec (SAQ) and noted the presence of a label bearing the word Provence on a display unit. In this section she found several wines with the appellation of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*" and some photographs of the bottles provided for sale were introduced as exhibit MCD-20. She went to the Bibliothèque Nationale du Québec to consult various Quebec publications and wine guides containing information on wines with the appellation of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*". More than twenty-five extracts from publications were appended to her affidavit as exhibits MCD-21 to MCD-28.

Finally, she was given, by a representative of the opponent, a copy of the French decrees defining the appellations of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*" and article L 641-3 of the French *Code rural* (introduced together as exhibit MCD-29), which provides that each appellation of origin is defined by a decree.

Karen Fiona MacDonald is a student employed in Vancouver by the firm of agents representing the opponent. She set out to find information concerning the use of the word PROVENCE to identify a region in France, known by Canadians, and likewise known by Canadians for its wines. She also did some research on the appellations of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*".

She visited the main branch of the Vancouver library to locate works containing extracts on Provence. Some such extracts are introduced as exhibits KFM-1 to KFM-5 to her affidavit. These extracts are taken from various works dealing with French cuisine, the wines of Europe and of France in which references are found to the region of Provence, and the appellations of origin "*Côtes de Provence*", "*Coteaux d'Aix-en-Provence*" and "*Les Baux-de-Provence*".

She went to an outlet of the British Columbia Liquor Store (“BCLS”) to consult the section set aside for French wines. She found some bottles of four different wines bearing the appellation of origin “*Côtes de Provence*”. A photograph illustrating these bottles was introduced as exhibit KFM-6. She visited a second outlet of the BCLS where she procured a wine guide containing a list of wines emanating from Provence and available in the BCLS outlets (exhibit KFM-7). She went to a Chapters bookstore and purchased six books dealing with the region of Provence. The relevant extracts describing this region and discussing wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*” make up exhibits KFM-9 to KFM-15.

She went back to the City of Vancouver Library to consult some travel guides on France. She introduced some relevant extracts from nine of these guides (exhibits KFM-16 to KFM-24) dealing with the region of Provence and its wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. She then asked an official of the library to supply her with a statement of the frequency of loans of these books to this library’s clients. Between May 1990 and November 2000, these books had been loaned out to users more than 1300 times in all. She also asked the official for the same information in relation to the books and videocassettes entitled “A Year in Provence” and “Toujours Provence” during the same period. These books and videos were borrowed on more than 7,000 occasions during this period. She traced two articles published in the daily *Vancouver Sun* concerning Provence and Aix-en-Provence (exhibits KFM-34 and 35).

She also went to the Marquis Wine Cellar and found two wines bearing the appellation of origin “*Côtes de Provence*”. Some photos of these bottles are appended to her affidavit as exhibit KFM-25.

She then conducted an Internet search for sites on the region of Provence. She introduced several relevant extracts from these sites (exhibits KFM-26 to KFM-32) in which the

word Provence identifies a region of France. The extracts produced also contain some references to wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. She also consulted the Web site of the BCLB, where she found an article entitled “About *Côtes de Provence*” (exhibit KFM-33).

She visited a second Chapters bookstore and found six magazines containing articles on the region of Provence and wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. The relevant extracts from these articles are appended to her affidavit as exhibits KFM-36 to KFM-42.

She obtained from the BCLB a computer log of the total sales, in units, of wines from the region of Provence for the years 1998, 1999 and 2000. These figures show sales during this period of more than 30,000 bottles of wine emanating from the region of Provence. She also introduced as exhibit KFM-44 a copy of the relevant extracts from the December 2000 edition of the BC Liquor Store Product Guide, which includes a FRANCE-PROVENCE section containing a description of eleven different wines from this region.

Mr. Ziad J. Katul is a student employed by the opponent’s firm of agents in Ottawa. He began with a visit to two outlets of the Liquor Control Board of Ontario (the “LCBO”) and procured four different wines with the appellation of origin “*Coteaux d’Aix-en-Provence*” and “*Côtes de Provence*”. The labels on these bottles were introduced as exhibit A to his affidavit. He consulted the City of Ottawa Library to find some works dealing with the region of Provence and “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. He found three books in the travel section and introduced the relevant extracts as exhibit C to his affidavit. He located a dozen books on wines (relevant extracts introduced as exhibit D) containing references to the Provence region or to wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. He also found nine works in the food and cooking section, nine titles in the encyclopaedia section and six dictionaries in the dictionaries section with references (exhibits E, F and G respectively,

in his affidavit) to the Provence region and wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”.

On a second visit to this library, he consulted some CD-ROM reference databases to find newspaper or magazine articles on the Provence region or the wines of that region. He accordingly introduced as exhibit J to his affidavit twenty extracts from various articles dealing with these topics that were taken from the Canadian Business and Current Affairs databank. He also found thirty-five articles (relevant extracts introduced as exhibit L) from the Canadian NewDisc database dealing with the region of Provence and/or wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. He produced five extracts of articles found through the Globe and Mail Plus 1991-1999 database (exhibit N to his affidavit) dealing with these topics.

Finally, he visited a Chapters bookstore to look for books on the region of Provence and/or wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”. He came up with a list of forty-four books dealing with one of these topics (paragraph 18 of his affidavit).

The relevant date for determining whether the mark is not registrable under the provisions of section 12(1)(b) of the Act is the date of the decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991)*, 37 C.P.R. (3d) 413 (FCA)], as it is in regard to the analysis of the prohibition in sections 10 and 12(1)(e) of the Act [see *Allied Corp. v. Canadian Olympic Association (1989)*, 28 C.P.R. (3d) 161 and *Canadian Olympic Association v. Olympus Optical Company Limited (1991)*, 38 C.P.R. (3d) 1].

In proceedings in relation to an opposition to the registration of a trade-mark, the opponent must present sufficient evidence concerning the grounds of opposition on which it is relying that it is apparent that there is a factual basis for that opposition. If it succeeds in doing so, the burden of proof then shifts to the applicant, who will have to

persuade the Registrar that the grounds of opposition should not prevent the registration of its trade-mark (*Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984)*, 3 C.P.R. (3d) 325).

Based on the totality of the opponent's voluminous evidence, summarized above and uncontradicted by the applicant, I find that the average Canadian consumer associates the word PROVENCE with a region of France, that he recognizes this region for its wines and that he is aware of wines with the appellation of origin "Côtes de Provence", "Coteaux d'Aix-en-Provence" and "Les Baux-de-Provence".

The applicant alleged in its counter statement that there are ten trade-marks in the Register containing the word PROVENCE. Of this list, only one was registered in association with wines, it says. There is no evidence that these marks are used in Canada, however. This number is clearly insufficient for me to infer that this word is widely used in the market in association with wines [see *Scott Paper Co. v. Wyant & Co. (1995)*, 61 C.P.R. (3d) 546, *Welch Foods Inc. v. Del Monte Corp. (1992)*, 44 C.P.R. (3d) 205 and *T. Eaton Co. v. Viking GmbH & Co. (1998)*, 86 C.P.R. (3d) 382] or that it is not considered contrary to paragraphs 12(1)(b) and 12(1)(e) and sections 10 and 2 of the Act, as the opponent would argue. Moreover, the applicant has filed no written submissions and did not request a hearing to support these contentions.

The first ground of opposition is based on section 12(1)(b) of the Act. The test for determining whether the mark gives a clear description of the place of origin of the wares is one of first impression. It is not necessary to conduct a critical analysis of each word in the mark [ref. *G.W.G. Ltd. v. Registrar of Trade Marks (1981)*, 55 C.P.R. (2d) 1 and *Oshawa Group Ltd. v. Registrar of Trade Marks (1980)*, 46 C.P.R. (2d) 145]. Applying this test, I conclude that the mark is descriptive of the place of origin of the wares, Provence. I therefore allow this ground of opposition but I will nevertheless proceed to the analysis of the other grounds of opposition.

The second ground is essentially based on section 10 of the Act. The opponent argues that the applicant cannot adopt the mark since it so nearly resembles wines with the appellation of origin “*Côtes de Provence*”, “*Coteaux d’Aix-en-Provence*” and “*Les Baux-de-Provence*”, which have become recognized in Canada as designating the kind, quality, value and place of origin of the wares in association with which these appellations are used, as to be likely to be mistaken therefor.

I adopt the remarks of Mr. Partington, then the chair of this Board, concerning the legal characterization of French appellations of origin in *Institut National des Appellations D’Origine des vins et eaux-de-vie v. T.G.Bright & Co. Ltd, (1986) 14 C.P.R. (3d) 197*:

Having regard to s. 25 of the *Trade Marks Act*, I am of the view that it is at least arguable that the appellation of origin Entre-Deux-Mers could be characterized as an unregistered certification mark descriptive of the place of origin of certain wines emanating from France. In any event, I do not consider that the words "Entre-Deux-Mers" need qualify as a trade mark in order to be relied upon by the opponent in challenging the distinctiveness of the applicant's trade mark ENTRE DEUX LACS.

It is important to note that Parliament, in section 10 of the Act, did not use the word “confusion” but instead used the words “so nearly resembling ... as to be likely to be mistaken therefor”. This is one of the circumstances referred to in section 6(5) of the Act and used to determine whether there is a risk of confusion between trade-marks or trade-names. Accordingly, since section 10 is cited as a ground of opposition, it must be determined whether there is such resemblance between the mark and these appellations of origin that the mark might be confused for the latter. The language of section 10 is similar to that of section 9 of the Act and I may therefore refer to the test devised in *The Queen v. Kruger (1978), 48 C.P.R. (2d) 135, at page 139*, and ask the following question by way of analogy: Could a person familiar with any or all of the opponent’s appellations of origin and having an imperfect recollection thereof confuse the mark with those appellations of origin? The applicant has failed to discharge its onus of proof by demonstrating to me, on the basis of a balance of probabilities [see *Christian Dior, S.A.*

v. Dion Neckwear Ltd [2002] 3 F.C. 405], that by applying this test the mark could not be confused with each of the opponent's appellations of origin. The second ground of opposition is therefore allowed as well.

The opponent cites as a third ground of opposition the lack of distinctiveness of the mark. Since I have already found that the mark is descriptive of the origin of the wares in regard to which it is proposed to be used and that it resembles each of the appellations of origin of the opponent listed above and recognized in Canada as designating the kind, quality and origin of the wines bearing these appellations, I can only conclude that the mark, as of the date of filing of the opposition (October 15, 1999)) [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (FCA)*], was not distinctive within the meaning of section 2 of the Act in that it was not adapted so to distinguish the applicant's wines from the other wines emanating from the region of Provence or from wines with the appellation of origin "Côtes de Provence", "Coteaux d'Aix-en-Provence" and "Les Baux-de-Provence".

Pursuant to the powers delegated to me by the Registrar of Trade-marks under section 63(3) of the Act, I uphold the opposition of the opponent and I therefore refuse the application for registration of the applicant for the mark SAVEUR DE PROVENCE, in accordance with the provisions of section 38(8) of the Act.

DATED AT MONTRÉAL, QUEBEC, THE 4th DAY OF SEPTEMBER 2003.

Jean Carrière
Objections board member