

IN THE MATTER OF AN OPPOSITION by Giorgio Barbero & Figli  
S.p.A. to application No. 617,957 for the trade-mark BARBERRIAN  
filed by Ridout Wines Limited/ Les Vins Ridout Limitée

On October 26, 1988, the applicant, Ridout Wines Limited/ Les Vins Ridout Limitée, filed an application to register the trade-mark BARBERRIAN based upon proposed use of the trade-mark in Canada in association with "wine coolers".

The opponent, Giorgio Barbero & Figli S.p.A., filed a statement of opposition on May 5, 1989 in which it alleged, as its first ground of opposition, that the applicant's application does not comply with the requirements of Section 30 of the Trade-marks Act. The remaining grounds of opposition are that the applicant's trade-mark BARBERRIAN is not registrable and not distinctive, and that the applicant is not the person entitled to its registration, in that the applicant's trade-mark BARBERRIAN is confusing with the opponent's trade-mark BARBERO, registration No. 280,766, covering "vins et liqueurs", as registered and previously used in Canada.

The applicant filed a counter statement in which it effectively denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavits of Peter G. Chubb and Pierre Larretche while the applicant elected not to file any evidence.

Neither party filed a written argument while both parties were represented at an oral hearing.

Subsequent to the oral hearing, the applicant advised the Opposition Board that Ridout Wines Limited/ Les Vins Ridout Limitée had changed its name to Cartier Wines & Beverages Corp. and that Cartier Wines & Beverages Corp. subsequently changed its name to Cartier & Inniskillin Vintners Inc. A notarially certified copy of a Certificate of Amendment showing the latter change of name was filed with the Trade-marks Office on August 20, 1992.

At the oral hearing, the applicant's agent made a number of submissions relating to the perception of the average Canadian consumer as to the possible derivation of the applicant's trade-mark. However, no evidence was submitted by the applicant which might have supported these submissions which I have therefore disregarded. Likewise, I have disregarded the applicant's submissions concerning the state of the register. Had the applicant wished to rely upon state of the

register evidence, it should have submitted such evidence at the Rule 44 stage of this proceeding.

No evidence has been submitted by the opponent in relation to its Section 30 grounds of opposition. As a result, the opponent has failed to meet the evidential burden on it in respect of these grounds which I have therefore dismissed.

The determination of the issue of confusion between the applicant's trade-mark BARBERRIAN as applied to wine coolers and the opponent's registered trade-mark BARBERO for wines and liquors will effectively decide the remaining issues in this opposition. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue as of either the applicant's filing date (the material date in respect of the non-entitlement grounds of opposition) or as of the date of decision (the material date in relation to the Section 12(1)(d) ground), the Registrar must have regard to all the surrounding circumstances, including those specifically referred to in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant in respect of the issue of confusion.

The applicant's trade-mark BARBERRIAN as applied to "wine coolers" is inherently distinctive. However, no evidence has been furnished by the applicant that its trade-mark has become known to any extent in Canada. While the opponent's evidence establishes that its trade-mark BARBERO possesses a surname significance, thus minimizing its inherent distinctiveness, I have my doubts as to whether the average Canadian consumer would recognize Barbero as being an Italian surname. Further, the opponent's evidence establishes that its trade-mark BARBERO has become known in Canada, particularly in association with liqueurs. As a result, the extent to which the trade-marks at issue have become known, as well as the length of time that the marks have been in use, both favour the opponent in this opposition.

The applicant's wine coolers differ from the opponent's wines and liquors although the wares of both parties can be categorized generally as alcoholic beverages. In this regard, Mr. Justice Denault in his yet unreported reasons for judgment in Molson Breweries v. Pernod Ricard, (F.Ct. File No. T-1478-90, dated August 11, 1992) commented as follows at page 9 with respect to the nature of the wares at issue in that case, namely, "brewed alcoholic beverages" and "apératifs, alcools et eaux-de vie, liqueurs et spiritueux":

"Having regard to the nature of the wares, the Registrar found that, although "brewed alcoholic beverages" differ from the wares covered in the respondent's registration, "the wares of both parties could be categorized generally as alcoholic beverages".

and at page 10, the learned trial judge stated the following:

"I believe that Mr. Perkins' statement does address the proper test to be applied under this heading, that is, whether there is a real likelihood that the average consumer of alcoholic beverages would believe that the wares associated with these trade marks are manufactured and sold by the same person. In my opinion, such a likelihood exists since the wares of both parties are products of the same industry. Consequently, I see no reason to disagree with the Registrar's finding on this point."

With respect to the channels of trade associated with the wares of the parties, I would refer to the decisions of the Federal Court, Trial Division in Carling Breweries Ltd. v. Registrar of Trade Marks, 8 C.P.R. (2d) 247 and John Haig & Co. Ltd. v. Haig Breweries Ltd., 24 C.P.R. (2d) 66. In the Carling Breweries case, Carling Breweries Ltd. applied to register the trade-mark WHITE CAP as applied to alcoholic brewery beverages, namely, beer, ale, lager, porter and stout. The Registrar refused the application pursuant to Section 36(1) (now section 37(1)) of the Trade-marks Act, the Registrar being of the opinion that the proposed trade-mark was confusing within the meaning of Section 12(1)(d) of the Act with two registered trade-marks for the words "White Cap", one covering wines and the other covering rum. At page 251 of the published decision, Mr. Justice Gibson commented as follows in relation to the criteria of Section 6(5) of the Trade-marks Act as applied to the trade-marks before him:

From the above quotation, it is apparent that Gibson, J. had before him no evidence of use of the trade-marks at issue from which he could conclude that the registered trade-marks were known to any extent in Canada. Further, the learned trial judge also pointed out at page 250 of the published reasons for judgment that "...it is not essential that the wares of the appellant and the owners of the two registered trade marks be of the same general class (s. 6(2) of the Act)". Nevertheless, Mr. Justice Gibson concluded that there would be a likelihood of confusion between the applicant's trade-mark and the two registered marks, the learned trial judge giving considerable weight to the fact that

the alcoholic beverage industry is one industry and, therefore, that beer, wines and spirits are all products of the one industry, such that it was probable that the public would be more likely to confuse the source of origin of any of these products.

In the John Haig & Co. Ltd. case, the court considered the issue of the likelihood of confusion between the trade-marks HAIG & HAIG as applied to whisky and the trade-mark HAIG covering alcoholic beverages, namely, beer. At page 70 of the published reasons for judgment, Addy, J. commented as follows:

The comments in the above decisions are equally applicable to the channels of trade associated with the wares of the parties in this opposition. As a result, I have concluded that the channels of trade associated with the applicant's wine coolers and the opponent's wines and liquors are closely related.

As for the degree of resemblance between the trade-marks at issue, the marks BARBERRIAN and BARBERO bear a fair degree of similarity in appearance and a somewhat lesser degree of resemblance in sounding when considered as a matter of immediate impression and imperfect recollection. However, there appears to be no resemblance in the ideas suggested by the trade-marks at issue.

In view of the fact that the wares of the parties are alcoholic beverages generally travelling through the same channels of trade, and that the trade-marks at issue possess a fair degree of similarity, particularly in appearance, I have concluded that the applicant has failed to meet the legal burden upon it in respect of the issue of confusion. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30<sup>th</sup> DAY OF NOVEMBER 1992.

G.W. Partington,  
Chairman,  
Trade Marks Opposition Board.