

**IN THE MATTER OF AN OPPOSITION  
by Vergina Foods Inc. to application No. 756,229  
for the trade-mark VERGINA & Design filed by  
Vergina Import and Export International Inc.**

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**On June 6, 1994, the applicant, Vergina Import and Export International Inc., filed an application to register the trade-mark VERGINA & Design, which is shown below.**

**The application is presently based upon proposed use of the trade-mark in Canada in association with food, namely olive oil, olives, canned fruit, cheese, spring water and wine.**

**The application was advertised for opposition purposes on October 11, 1995. The opponent, Vergina Foods Inc., filed a statement of opposition on October 30, 1995. The applicant filed and served a counter statement.**

**As its evidence, the opponent filed the affidavit of its president, Anastasios (Tasso) Trihas. Mr. Trihas was cross-examined on his affidavit and the transcript of the cross-examination and replies to undertakings form part of the record in these proceedings.**

**As its evidence, the applicant filed the affidavit of its president, Alex Kitosopanidi ("Kitts").**

**Both the applicant and the opponent filed a written argument. An oral hearing was held at which only the opponent was represented.**

**The opponent's five grounds of opposition are reproduced below:**

**I will first consider the Paragraph 38(2)(d) ground of opposition. The material date with respect to this ground of opposition is the date of filing of the opposition [*Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at p. 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at p. 424 (F.C.A.)]. While the legal burden is on the applicant to establish that its trade-mark is distinctive, there is an evidential burden upon the opponent to establish the facts being relied upon by it in support of this ground. In order for the distinctiveness ground of opposition to succeed, the**

opponent need only show that as of October 30, 1995, its trade-marks or trade-name had become known sufficiently to negate the distinctiveness of the applied for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. The weight to be given to each relevant factor may vary, depending on the circumstances [*Clorox Co. v. Sears Canada Inc.* 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.)].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [*John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

I will first focus on the surrounding circumstances relating to the likelihood of confusion between the applied for mark and the opponent's VERGINA mark.

#### Inherent Distinctiveness

The applicant's trade-mark and the opponent's trade-mark are each inherently distinctive with respect to their respective wares. Although the word Vergina apparently is a place in Greece where Alexander the Great's tomb is located, there is no evidence that this location has any reputation with respect to food or drink. Also, it is questionable if the average Canadian would be aware that this is a geographical reference as opposed to an invented or foreign word. The inclusion of the design features in the applicant's VERGINA & Design mark, as well as the words VERGINA IMPORT AND EXPORT, does increase the inherent distinctiveness of that mark.

#### **Extent to which Marks have Become Known**

There is no evidence that the applicant's VERGINA & Design mark had become known as of October 30, 1995. As of that date, the opponent's evidence shows that its VERGINA trade-mark had been advertised in the Greek Canadian Tribune and various charity programs and booklets. It had also appeared on invoices, letterhead and business cards. Sales had exceeded \$4000. Although the extent of use of the opponent's VERGINA trade-mark may have been limited, the opponent's trade-mark was better known as of October 30, 1995 than was the applicant's trade-mark.

#### **Length of Time the Marks Have Been in Use**

The opponent began using its VERGINA mark in December 1993. The applicant on the other hand appears to have not commenced use of its applied for mark as of August 1, 1997, the date of Mr. Kitts' affidavit. In fact, there is no information provided even as to the applicant's intentions with respect to commencing use of the applied for mark for any of the wares covered by this application.

#### **Nature of the Wares, Services, Business and Trade**

The opponent carries on business as an importer and distributor of food products. The opponent's evidence shows that it has sold sugar, coffee and tea in association with its VERGINA trade-mark prior to the filing of the applicant's application. Since prior to September 1998, it has also been selling jams, juices and low calorie sweeteners in association with its VERGINA trade-mark, but it is unclear when such sales began. The opponent's VERGINA wares are sold to restaurants, offices, food service distributors and coffee distributors, as well as directly to consumers.

The wares covered by the applicant's application are olive oil, olives, canned fruit, cheese, spring water and wine, but the applicant's evidence is that it carries on business as an importer, exporter and distributor of fine wines and spirits. The wines that it imports and distributes in Canada are sold to restaurants and through the LCBO and Société des alcools du Québec.

Clearly, the parties' wares are related and their channels of trade overlap.

#### **Degree of Resemblance Between the Marks**

Despite its design features, the applicant's VERGINA & Design mark highly resembles the applicant's VERGINA mark in appearance and sound. This is because the dominant feature of the applicant's mark is the word VERGINA.

#### Other Surrounding Circumstances

The opponent has related two instances where potential clients thought that it had begun to distribute wine because they mistook the applicant's activities to be those of the opponent.

The opponent has also pointed out that it was using its VERGINA trade-mark before the applicant was even incorporated.

#### Conclusion re Paragraph 38(2)(d) Ground

I conclude that the applicant has not met the onus on it to establish that its mark is capable of distinguishing the applied for wares from the wares sold by the opponent under the opponent's VERGINA trade-mark. The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks [*Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2D) 70]. In the present case, we have the added influential circumstances of the wares and channels of trade being similar and the lack of any use or acquired distinctiveness with respect to the applicant's trade-mark.

In view of my decision with respect to the non-distinctiveness ground of opposition, I do not propose to deal in detail with the remaining grounds of opposition. However, I must say that the Paragraph 38(2)(c) ground of opposition appears to have been insufficiently pleaded. The opponent states that the applicant is not the person entitled to register the mark because the mark is confusing with the opponent's mark but the opponent never alleges that the opponent's mark was used before the date of filing of the applicant's proposed use application. The statements made in support of this ground of opposition in the statement of opposition are in the present tense and use as of the date of the statement of opposition is insufficient to defeat an application on the basis of Paragraph 16(3)(a) of the *Act*. Furthermore, the opponent's reference to its trade-name is ambiguous as it nowhere identifies in the statement of opposition what its trade-name is.

Regarding the opponent's grounds of opposition based on Paragraph 38(2)(a) of the *Act*, there is an evidential burden on the opponent to prove those allegations of fact upon which it relies [*Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 at pp. 329-330]. These grounds would not succeed because there is no evidence that the applicant "knew or should have known" the facts alleged by the opponent.

**Disposition**

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to

Subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 24th DAY OF JULY, 2001.

Jill W. Bradbury  
Hearing Officer  
Trade-marks Opposition Board