



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

Citation: 2015 TMOB 230
Date of Decision: 2015-12-23

IN THE MATTER OF AN OPPOSITION

S.A. DAMM

Opponent

and

HIJOS DE RIVERA, S.A.

Applicant

**1,568,398 for ESTRELLA GALICIA (&
DESIGN)**

Application

Background

[1] The Applicant has filed an application to register the trade-mark ESTRELLA GALICIA (& DESIGN) (the Mark), as shown below. The application is based upon proposed use of the Mark in Canada, in association with “beer”.



[2] The Opponent is the owner of the trade-mark ESTRELLA DAMM which it has registered under registration No. TMA818,413 and used in Canada, in association with “beer”.

[3] The Opponent is of the view that there is a likelihood of confusion between its trade-mark and the Mark and it has therefore opposed the Applicant’s application.

[4] For the reasons which follow, the opposition is successful.

File Record

[5] The application for the Mark was filed on March 13, 2012.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 15, 2013 and on September 6, 2013, the Opponent opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) by way of filing a statement of opposition.

[7] The grounds of opposition were originally based upon sections 30(e), 30(i), 12(1)(d), 16(3)(a) and 2 (distinctiveness) of the Act. However, the section 30(e) ground of opposition is no longer being pursued by the Opponent and I will therefore not be addressing it in my decision.

[8] A counterstatement denying the allegations set out in the statement of opposition was filed by the Applicant on November 6, 2013. At the time that it filed its counterstatement, the Applicant also requested an interlocutory ruling on the sufficiency of the pleading based upon section 2 (distinctiveness) of the Act. A portion of that particular pleading was consequently struck out, as will be discussed later on in my decision.

[9] As evidence in support of its opposition, the Opponent filed the affidavit of Floris van Neerijnen, sworn February 27, 2014 (the first Neerijnen affidavit) and the affidavit of Jeannine Summers, sworn March 4, 2014 (the Summers affidavit). Neither of the affiants was cross-examined.

[10] As evidence in support of its application, the Applicant filed the affidavit of Thelma Thibodeau, sworn June 18, 2014 (the Thibodeau affidavit). Ms. Thibodeau was not cross-examined.

[11] As evidence in reply, the Opponent filed the affidavit of Floris van Neerrijnen, sworn July 9, 2014 (the second van Neerrijnen affidavit).

[12] Both parties filed written arguments and attended a hearing.

Onus

[13] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Grounds of Opposition Summarily Dismissed

Non-compliance - Section 30(i)

[14] The Opponent has pleaded that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada, having regard to the Opponent's prior use and registration of its trade-mark ESTRELLA DAMM. Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trade-marks does not in and of itself support an allegation that the applicant could not have been satisfied of its entitlement to use a mark [*Woot, Inc v WootRestaruant Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)]. The Applicant has provided the necessary statement and the Opponent has not demonstrated that this is an exceptional case. Accordingly, this ground of opposition is dismissed.

Analysis of Remaining Grounds of Opposition

Non-registrability - Section 12(1)(d)

[15] The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-mark ESTRELLA DAMM, which is the subject of registration No. TMA818,413.

[16] The material date to assess a section 12(1)(d) ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[17] The Opponent has filed a certified copy of its registration as evidence [first van Neerijnen affidavit, para 5; Exhibit A] and I have exercised my discretion to check the register to confirm that it is still extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden with respect to this ground.

[18] As the Opponent's evidentiary burden has been satisfied, the Applicant must establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark.

[19] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[20] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – the inherent distinctiveness and the extent to which the marks have become known

[21] Both of the parties' trade-marks possess a fair degree of inherent distinctiveness due to the fact that they both consist of or contain words which have no meaning in English or French. Arguably, the Mark possesses slightly more inherent distinctiveness due to the inclusion of the design element.

[22] The distinctiveness of a trade-mark may be further increased through promotion or use.

[23] In this case, the application for the Mark is based upon proposed use and the Applicant has not evidenced any use of the Mark. By contrast, the Opponent has filed evidence pertaining to the promotion and use of its trade-mark. Such evidence can be found in the first van Neerijnen affidavit and in the Summers affidavit. I will discuss each of those affidavits in turn below.

The van Neerijnen Affidavit

[24] Mr. van Neerijnen is a Brand Specialist with the Opponent [para 1]. According to Mr. van Neerijnen, the Opponent began selling beer in Canada in association with its trade-mark at least as early as 1999 and its beer has been continuously sold in Canada in association with its trade-mark since at least 2008 [paras 6 and 7].

[25] In paragraph 8, Mr. van Neerijnen explains that the ESTRELLA DAMM brand of beer has included: ESTRELLA DAMM BARCELONA (since 2008); ESTRELLA DAMM INEDIT (since 2009); and ESTRELLA DAMM DAURA (since 2009). Mr. van Neerijnen refers to these products collectively as the "ESTRELLA DAMM Beers". As the Applicant has pointed out, the Opponent has not filed any evidence of use of its ESTRELLA DAMM trade-mark in Canada prior to 2008.

[26] According to Mr. van Neerijnen, the ESTRELLA DAMM Beers have been sold in various channels of trade including through licensed establishments such as bars, pubs, restaurants, and retail outlets including provincially regulated beer and liquor stores [para 9].

Attached as Exhibit B is are excerpts of a beer menu from a restaurant in Ontario which lists ESTRELLA DAMM lager.

[27] Mr. van Neerijnen states that the Opponent has prominently displayed the ESTRELLA DAMM trade-mark on bottles and/or cans of ESTRELLA DAMM Beers which have been distributed for sale within Canada. He explains that bottles and cans sold through retail outlets are typically packaged in cartons and that the cans, bottles and cartons have been displayed in retail stores in at least Ontario, British Columbia, Alberta, Nova Scotia and Manitoba [para 10].

[28] Attached as Exhibits C-G are copies of photos of cans, bottles and/or cartons in retail stores in these provinces that Mr. van Neerijnen states are representative of cans, bottles and/or cartons of ESTRELLA DAMM Beers sold by the Opponent between 2008 and the present [para 10]. I note that on the cans shown in Exhibit C, the word ESTRELLA appears in large letters on top of DAMM, which appears in smaller letters. The word BARCELONA appears in very small letters underneath both ESTRELLA and DAMM. On the carton shown in Exhibit C, ESTRELLA and DAMM appear side by side in the same size and style of font and “Barcelona” appears underneath in a different, smaller sized font. Despite the presence of the word “Barcelona” in close proximity to the words ESTRELLA DAMM, I am satisfied that the manner in which the trade-mark is used constitutes use of the Opponent’s trade-mark as registered [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)].

[29] According to Mr. van Neerijnen, sales volumes of the Opponent’s ESTRELLA DAMM Beers in Canada by the Opponent were approximately 27 million liters over the years 2009-2013 [para 11]. Mr. van Neerijnen states that since 2008, the Opponent has spent at least \$500,000 marketing its ESTRELLA DAMM Beers in Canada [para 12].

[30] In paragraph 13, Mr van Neerijnen states that advertising of the Opponent’s ESTRELLA DAMM Beers since 2008 has taken many forms including branded merchandise, private tastings, trade shows, merchandising materials and on premise posters. Attached as Exhibit H are examples of such advertising. Attached as Exhibit I is a copy of excerpts of a document from the Opponent’s Canadian distributor showing how it marketed the Opponent’s ESTRELLA DAMM Beers in Canada in 2011. Mr. van Neerijnen also provides details pertaining to a contest that

was held by the Opponent in 2011 in which the grand prize was a trip to Barcelona for one resident of Ontario and one resident of British Columbia. The contest was advertised online via Canadian websites, digital media, at trade shows, on beer cartons and through Facebook® [paras 15 and 16; Exhibits K and L]. He states that advertising for the contest (not including through Facebook®) made over 8.5 million “impressions” and that through Facebook® over 2.5 million more impressions were made [para 16]. Attached as Exhibit L are copies of the statistics for the impressions and click-through rates for the 2011 online contest campaign.

[31] In paragraph 14, Mr. van Neerijnen states that some of the Opponent’s ESTRELLA DAMM Beers have been featured in advertisements of the Liquor Control Board of Ontario (LCBO) as well. Examples of such advertisements are attached as Exhibit J.

[32] In paragraph 17, Mr. van Neerijnen states that the Opponent also receives international exposure through the sponsorship of the Barcelona Football Club, as the Opponent is the exclusive beer sponsor for it and has been working with it for more than 20 years. According to Mr. van Neerijnen, banner advertisements for ESTRELLA DAMM border the stands at the FC Barcelona stadium in Spain and matches of the Club are broadcast worldwide and viewable in Canada. Attached as Exhibit M, are copies of two Canadian advertisements for an ESTRELLA DAMM branded soccer ball featuring the Barcelona Football Club and the ESTRELLA DAMM brand.

The Summers Affidavit

[33] Ms. Summers is a paralegal with the agent for the Opponent [para 1]. Her affidavit appears to have been filed to support the statements made by Mr. van Neerijnen’s affidavit regarding use of the Opponent’s trade-mark.

[34] In paragraph 3, she states that she accessed a number of websites, including for: the Liquor Mart (Manitoba); Newfoundland Labrador Liquor Corporation; Nova Scotia Liquor Corporation; LCBO; Société des Alcools du Québec; and Saskatchewan Liquor and Gaming Authority. According to Ms. Summers these websites provide particulars and photographs of ESTRELLA DAMM CELIAC, ESTRELLA DAMM INEDIT and/or ESTRELLA DAMM LAGER products that are shown to be available for purchase in Canada. Attached as Exhibits

A1-A8 are printouts from these web pages. Attached as Exhibit B to her affidavit, is a print copy of a price list from the Yukon Liquor Corporation website which refers to ESTRELLA DAMM INEDIT.

[35] In paragraph 5, Ms. Summers states that she accessed the website of the Barcelona Football Club and that many of the pages on it display the Opponent's ESTRELLA DAMM trade-mark. Attached as Exhibit C to her affidavit are printouts and screen shots from the website.

[36] In paragraph 6 of her affidavit, Ms. Summers provides the results of an internet search which she conducted for the words "estrella damm" and "sponsor" together. Printouts from some of the websites that came up in her search are attached as Exhibit D. Attached as Exhibit E are printouts and screen shots from the Opponent's website which make reference to ESTRELLA DAMM.

[37] Attached as Exhibit F to Ms. Summers affidavit is a certified copy of the Opponent's registration for its trade-mark ESTRELLA DAMM (No. TMA818,413).

[38] I am satisfied that the Opponent has used its trade-mark ESTRELLA DAMM in Canada since at least 2008 and that it has become known to some extent. Overall, I find that this factor, which is a combination of the inherent distinctiveness of the marks and the extent to which they have become known, favours the Opponent.

Section 6(5)(b) – the length of time each has been in use

[39] This factor also favours the Opponent, as it has shown use of its ESTRELLA DAMM trade-mark since at least 2008, whereas the application for the Mark is based upon proposed use and the Applicant has not filed any evidence to show that use of the Mark has commenced in Canada.

Sections 6(5)(c) and (d) – the nature of wares, services or business and trade

[40] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent's registration that governs

the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA) and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)].

[41] The Opponent's registration and the Applicant's application for the Mark both cover "beer". In view of the fact that the parties' goods are identical and in the absence of any evidence to the contrary, I find it reasonable to conclude that their channels of trade would be similar, if not identical.

Section 6(5)(e) – the degree of resemblance between the trade-marks

[42] In *Masterpiece Inc v Alavida Lifestyles Inc et al* [supra], the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. If the parties' trade-marks do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion.

[43] In *Masterpiece*, the Supreme Court observed that even though the first word of a trade-mark may be the most important, for the purpose of distinctiveness [*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[44] The Applicant acknowledges that both of the parties' trade-marks contain the element ESTRELLA, but it submits that aside from this commonality, the parties' trade-marks are completely different from one another visually and phonetically because the Opponent's trade-mark contains the word DAMM and the Mark contains the word GALICIA, which are visually and phonetically different. The Applicant points out that the Mark also contains additional reading matter (albeit in very small print) and a design feature (including a star in a circle) in the form of stylistic writing, and an oval shape with a dark background and a bright contour. The

Applicant submits that the design features create a striking visual impression that makes the Mark completely different from the Opponent's trade-mark.

[45] I acknowledge that there are differences between the parties' trade-marks. However, when the trade-marks are viewed in their totality, I still consider there to be some degree of resemblance between them due to the presence of the word ESTRELLA. It is quite distinctive in nature, it appears in the dominant first position of the Opponent's trade-mark and in my view, it is the first word that would likely be taken in by consumers when they have regard to, read or sound out the Mark. I therefore find that its inclusion in the parties' marks results in a somewhat similar overall impression, despite the existence of the other elements which are also featured in the parties' marks.

Surrounding Circumstances

State of the Register

[46] As an additional surrounding circumstance, the Applicant relies on state of the register evidence which was filed by way of the Thibodeau affidavit. Ms. Thibodeau accessed the Canadian trade-marks database and printed out the particulars for 21 trade-mark applications and registrations [paras 2-3; Exhibit TT-1]. The trade-marks which are the subject of the applications and registrations are identified in paragraph 3 of her affidavit.

[47] It is unclear how she selected these particular trade-marks. Of the marks that were identified by Ms. Thibodeau, three contain the word ESTRELLA'S (or a phonetic equivalent thereof). Many, but not all, of the remaining marks appear to have the word STAR or an image of a star in them. Based upon the submissions of the parties, I gather that these "star" marks have been included because "estrella" means "star" in Spanish. However, there is no evidence of record to suggest that the average Canadian consumer would be aware of this meaning. In view of this, I do not consider these marks to be particularly relevant.

[48] While state of the register evidence can be useful to assess the commonality or distinctiveness of a trade-mark or portion of a trade-mark in relation to the register as a whole, it has been held that such evidence is only relevant insofar as inferences may be made with respect

to the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[49] Given that Ms. Thibodeau only identified three trade-marks containing the word ESTRELLA'S (or a phonetic equivalent thereof), I do not consider this evidence to be of much assistance to the Applicant and I am not prepared to draw any inferences from it regarding the state of the marketplace.

Co-existence/ Proceedings between the Parties in other Jurisdictions

[50] As part of her evidence, Ms. Thibodeau also provided print-outs from foreign trade-mark registers to show that the same or similar trade-marks of the parties co-exist on the register in other jurisdictions [paras 5-13; Exhibits TT-2 – TT-4]. As evidence in reply, the Opponent filed the second van Neerijnen affidavit, in order to refute any argument that the parties' marks are co-existing peacefully in other jurisdictions. In his second affidavit, Mr. van Neerijnen points out that the Applicant has actually opposed the Opponent's ESTRELLA DAMM trade-mark in 20 countries and filed cancellation proceedings against it in various countries [paras 4-6; Exhibits A-D].

[51] The mere coexistence of marks on foreign registers is not relevant to the issue of the likelihood of confusion in Canada [*Vivat Holdings Ltd v Levi Strauss & Co* (2005), 2005 FC 707 (CanLII), 41 CPR (4th) 8 (FC)]. Moreover, I do not consider the position taken by the parties in other jurisdictions to be relevant either, as the state of the register, the state of the marketplace and the law in those jurisdictions may be vastly different.

Conclusion

[52] In coming to my conclusion in this case, I would be remiss not to mention the decision in *San Miguel Brewing International Limited v Molson Canada 2005*, 2013 FC 156, reversing 2012 TMOB 65. In that decision, the Court overturned the finding of the Registrar (acting through

Member Bradbury) that there was a reasonable likelihood of confusion between the trade-mark RED HORSE & Design and the trade-mark BLACK HORSE, both of which were essentially associated with “beer”. In doing so, the Court commented as follows [at para 40]:

The Board did not consider that what it was doing was, in effect, granting to Molson a trade-mark monopoly over the word HORSE of any colour (green, brown, blue, etc.) in relation to beer. The breadth of that monopoly is unreasonable

[53] In *San Miguel*, the Court took into consideration the fact that the relevant consumer (i.e. the beer consumer) is sensitive to the names of beers and to what they know and like, and that the confusion test is premised on that consumer – not on what might be a legal fiction of the non-beer drinking life partner who is asked to pick up beer [para 33]. The Court also referred to the earlier decision in *Carling O’Keefe Breweries of Canada Ltd v Anheuser-Busch* (1982) 68 CPR (2d) 1 at 20-21 (FCTD), in which the Honourable Mr. Justice Walsh observed that regular beer drinkers will have considerable loyalty to their favourite brand. In *San Miguel*, the Court concluded that one look at the parties’ labels was sufficient to dispel any notion of confusion between RED HORSE (with just a horse’s head) and BLACK HORSE (with a horse in profile).

[54] Notably, in *San Miguel*, there was state of the register evidence, as well as marketplace evidence (provincial liquor store listings and sworn statements from an affiant) relating to “horse” marks, some of which consisted of a color or other descriptor in combination with the word “horse”, not unlike the parties’ trade-marks.

[55] I am mindful of the Court’s comments in *San Miguel* and I acknowledge that consumers, including beer consumers, are owed a certain amount of credit for their intelligence or knowledge. However, having considered all of the surrounding circumstances in the present case, I conclude that the Applicant has not met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent’s trade-mark.

[56] I have come to this conclusion because despite their differences, due to the presence of the element ESTRELLA, there is still some degree of resemblance between the parties’ trade-marks. The word ESTRELLA is featured in a fairly dominant position or manner in both of the

parties' marks and it is quite distinctive in nature (unlike the word HORSE in *San Miguel*). There is no evidence that other traders are using trade-marks comprising ESTRELLA in the marketplace. Thus, while the average beer drinking Canadian may well be sensitive to the names of beers and to what they know and like, there is no evidence that such consumers are accustomed to seeing and having to distinguish between trade-marks containing ESTRELLA and only the Opponent has demonstrated any use or reputation of its mark in Canada.

[57] The question that must be asked in this case is whether the ordinary beer drinking consumer somewhat in a hurry who hears or sees the Mark ESTRELLA GALICIA (& Design) when he or she has no more than an imperfect recollection of the Opponent's trade-mark ESTRELLA DAMM, would, as a matter of first impression, and without pause to give the matter any detailed consideration or scrutiny, be likely to believe that the beer associated with the Mark originates from the same source as the beer of the Opponent [*Veuve Clicquot Ponsardin, supra*]. Based upon the evidence which is before me and having considered all of the relevant surrounding circumstances in this case, I consider it likely that he or she would.

[58] Accordingly, the section 12(1)(d) ground of opposition is successful.

Non-distinctiveness – Section 2

[59] The Opponent initially pleaded that the Mark is not distinctive “because it is not capable of distinguishing the Applicant's wares from the wares and services of others, particularly beer sold by the Opponent under the trade-mark ESTRELLA DAMM, nor is it adapted to distinguish them”. However, the reference to “the wares and services of others” was struck from the pleading by way of an interlocutory ruling dated December 19, 2013.

[60] While there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada, there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[61] Pursuant to its evidential burden, the Opponent is under an obligation to show that, as of the date of filing of the statement of opposition, its trade-mark had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)].

[62] As discussed more fully in the analysis of the section 12(1)(d) ground of opposition, the Opponent has established that its ESTRELLA DAMM trade-mark had become known sufficiently as of the date of filing the statement of opposition. As a result, the Opponent has met its evidential burden in respect of this ground of opposition.

[63] The difference in material dates is insignificant and for the reasons as identified above in my analysis of the section 12(1)(d) ground of opposition, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' trade-marks.

[64] Accordingly, the non-distinctiveness ground is also successful.

Non-Entitlement – Section 16(3)(a)

[65] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because at the time of filing of the application, the Mark was confusing with its trade-mark ESTRELLA DAMM, which it had been previously used or made known in Canada in association with “beer”.

[66] The Opponent's evidence, as detailed above in my analysis under the section 12(1)(d) ground of opposition, is sufficient for the Opponent to meet the burden upon it to show that its trade-mark was used in Canada prior to the filing date of the application for the Mark and had not been abandoned at the date of advertisement of the application (section 16(5) of the Act).

[67] The difference in material dates is insignificant and for the reasons as identified above in my analysis of the section 12(1)(d) ground of opposition, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' trade-marks.

[68] Accordingly, the non-entitlement ground of opposition is also successful.

Disposition

[69] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: 2015-08-06

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