



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

Citation: 2010 TMOB 83
Date of Decision: 2010-06-04

**IN THE MATTER OF AN OPPOSITION
by Societe Anonyme des Eaux Minerales
d'Evian, S.A. to application No. 1,188,155
for the trade-mark EVIAN filed by
Robert Marcon**

[1] On September 2, 2003, Robert Marcon (the Applicant) filed an application to register the trade-mark EVIAN (the Mark), based upon proposed use of the Mark in Canada. The statement of wares currently reads: “(1) Distilled spirits, namely vodka, gin and tequila (2) ice cream”, (the “Wares”).

[2] The application was advertised for opposition purposes in the Trade-marks Journal of March 8, 2006. On May 8, 2006 Société Anonyme des Eaux Minerales d'Evian, S.A. (the Opponent) filed a statement of opposition. The statement of opposition was amended on January 29, 2007 and June 9, 2008. The Opponent pleaded grounds of opposition under s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[3] The Opponent filed the affidavits of Thelma Thibodeau and Jérôme Buscaïl as evidence in chief; in reply the Opponent filed another affidavit of Thelma Thibodeau and well as the affidavit

of Stéphane Rolland. The Applicant filed the affidavit of Robert Victor Marcon in support of its application.

[4] Both parties filed written arguments; only the Opponent was represented at the oral hearing.

Grounds of opposition

[5] The grounds of opposition are summarized as follows:

1. Section 38(2)(a) of the Act

a. The Application does not conform to the requirements of Section 30(e) because the Applicant's Mark was in use by the Applicant prior to the filing date of September 2, 2003,

b. In the alternative, Applicant never intended to use the Mark in Canada; in fact the Applicant has adopted a *modus operandi* of filing a multitude of trade-mark applications for known trade-marks used in related domains,

c. The Applicant cannot be satisfied under Section 30(i) since the Applicant has adopted a *modus operandi* of filing a multitude of trade-mark applications for known trade-marks used in related domains for the purpose of diminishing the goodwill attached to the known marks.

2. Section 38(2) (b) of the Act

a. The Application is not registrable in view of s.12(1)(b) since when written or sounded the Mark is deceptively misdescriptive in English and French, of the nature or the quality of the wares, namely that the products contain water from the city of Evian and or that the products contain water sold under the Mark of the Opponent- EVIAN; of the place of origin of the wares, namely that the wares emanate from the city of Evian.

b. The Applicant's Mark is not registrable in view of s. 12(1)(d) because it is confusing with the following trade-marks of the Opponent:

i. EVIAN registered under No. TMA 306,440 in association with mineral water,

- ii. EVIAN & Design registered under No. TMA 376,331 in association with: (among other wares) mineral water,
- iii. EVIAN & Design registered under No. TMA 593,803 in association with: (among others wares), cosmetics, and
- iv. EVIAN logo ellipse & Design registered under No. TMA 586,839 in association with: (among other wares) beer, still or sparkling water and non-alcoholic beverages.

3. Section 38(2)(c) of the Act

a. Contrary to s. 16(3)(a) the Applicant is not the person entitled to the to the registration since at the date of filing, namely September 2, 2003 it the Mark was confusing with the trade marks as set out above, which were used by the Opponent or its predecessors in title in association with, among other wares, mineral water, beer, and non- alcoholic beverages.

b. Contrary to s. 16(3)(c) the Applicant is not the person entitled to registration since at the date of filing, namely September 2, 2003, the Mark was confusing with the trade-names: EVIAN and SOCIETY ANONYME DES EAUX MINERALES D'EVIAN.

4. Section 38(2)(d) of the Act

a. Pursuant to s. 38(2)(d) of the Act, the Mark is not distinctive within the meaning of s. 2 and does not distinguish the wares of the applicant and is not capable of doing so for the following reasons:

- i. The Mark does not distinguish the wares with which it is proposed to be used, or has been used by the applicant from those of the Opponent;
- ii. The applicant has permitted third party users without a license agreement pursuant to Section 50 of the Act;
- iii. Following the transfer concurrent rights existed in the Mark that were exercised concurrently contrary to Section 48(2) of the Act.

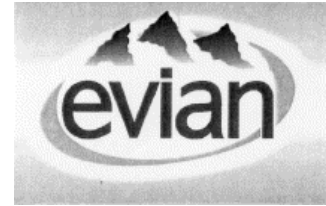
The Design Marks referenced in Opponent's statement of opposition are shown below:



TMA376,331



TMA593,803



TMA586,839

Opponent's Evidence

[6] The affidavit of Jérôme Buscail sets out that he is Corporate Counsel and Director of Intellectual Property of Groupe Danone composed of several related companies, one of which is the Société Anonyme Des Eaux Minérales D'Evian S.A. (SAEME), the Opponent. Groupe Danone manages the trade-mark portfolio for SAEME, and thus Mr. Buscail has knowledge of the affairs relating to these proceedings.

[7] Mr. Buscail provides that SAEME is a company in France that bottles mineral water in the town of Evian that it exports under the trade-mark EVIAN to more than 125 countries including Canada; 1.5 billion bottles of EVIAN water are sold annually, six million bottles daily. The first water was bottled under the EVIAN mark in 1969. Global sales annually from 2003 to 2007(projected) are in excess of 450 million Euros per year. In Canada, the EVIAN mark has been used in association with water since at least as early as 1978. Between 2002 and 2006 including the projected sales of 2007, total sales in Canada will have been in the area of \$98,400,000 CAD.

[8] EVIAN water is sold throughout Canada including bars, restaurants and hotels. Expenditures for marketing and promotion between 1990 and 1997 were in the area of \$12,665,000 USD. EVIAN water has been the official water of Tennis Canada at the Canadian Open between at least 1988 and 1995, of the Alberta Volleyball Association, the 15th Commonwealth Games, the Cirque du Soleil and the Toronto International Film Festival.

[9] Mr. Buscail states that the trade-mark EVIAN has also been used in Canada by the Opponent in association with “un atomiseur”, since at least as early as January 1996. The trade-mark EVIAN has also been used under license for skin and body care products; these products are available in pharmacies and other stores across Canada.

[10] In view of the foregoing it is reasonable to conclude that EVIAN is a well known trade-mark in Canada for water.

[11] Although there may have been use of EVIAN accruing to the Opponent on other products such as personal care and skin products and cosmetics, and although the opponent’s registrations include clothing items, there is insufficient evidence to conclude that the Opponent’s trade-mark is well known for such products.

[12] The affidavit of Ms. Thelma Thibodeau, a self-employed trade-mark agent, sets out particulars Canadian and United States trade-mark applications and registrations; some market research is also provided.

[13] More specifically, Ms. Thibodeau provides particulars of other applications for registration of trade-marks applied for by the Applicant in Canada and the United States. It appears that as at the date of the filing of the application, the Applicant had filed multiple applications for trade-marks already registered. As at the date of Ms. Thibodeau’s affidavit some 22 trade-mark applications had been filed by Mr. Marcon in Canada (with similar filings in the United States) for trade-marks that are the subject of long standing Canadian trade-mark registrations. The applications filed by Robert Marcon, (Robert Victor Marcon; Robert V. Marcon) are as follows, many of which have been abandoned following opposition proceedings:

Trade-Mark	Application No.	Filing Date
BAYER	1201366	2003-12-11
BEEFEATER	1168023	2003-02-18
BUDWEISER	1168020	2003-02-18
COORS	1168021	2003-02-18
CORONA	1168019	2003-02-18
DOM PERIGNON	1168014	2003-02-18
EVIAN	1188155	2003-09-02
FINLANDIA	1168024	2003-02-18

HEINEKEN	1168025	2003-02-18
JACK DANIEL'S	1168016	2003-02-18
JACK DANIEL'S	1202335	2003-12-29
NESCAFÉ	1201480	2003-12-11
NESTLÉ	1201360	2003-12-11
SENSODYNE	1186813	2003-08-18
TIM HORTONS	1186804	2003-08-18
ABSOLUT	1168026	2003-02-18
CANADIAN CLUB	1168022	2003-02-18
SOUTHERN COMFORT	1168272	2003-02-24
CHANEL	1202435	2003-12-30

[14] Ms. Thibodeau provides evidence of some of the existing trade-mark registrations for the above trade-marks, standing in the name of different owners, for example:

Trade-mark	Registration Number	Registered Owner
BAYER	TMDA24895	Bayer Aktiengesellschaft
BEEFEATER	TMA120,981	Allied Domecq Spirits & Wine Limited
CHANEL	UCA18468	Chanel S. de R.L.
COORS	TMA230,978	Coors Global Properties, Inc.
CORONA	TMA598,045	Cerveceria Modelo, S.A. de C.V.
DOM PERIGNON	UCA38900	Champagne Moët & Chandon
FINLANDIA & DESIGN	TMA259,325	Finlandia Vodka Worldwide Ltd.
HEINEKEN	TMA554,809	Heineken Brouwerijen B.V.
L'OREAL PARIS	TMA655,217	L'Oreal
NESTLE	TMDA36039	Société des Produits Nestlé S.A.
SENSODYNE	TMA124,139	GlaxoSmithKline Consumer Healthcare Inc.
TIM HORTONS & DESIGN	TMA226,560	The TDL Marks Corporation

[15] Similar evidence was provided of Mr. Marcon's applications in the United States, as well as particulars of existing U.S. registrations for the same trade-marks in the name of different owners. This evidence is virtually identical to the Canadian evidence as shown above and is not reproduced here.

[16] Ms Thibodeau also provides particulars from the Canadian trade-marks register of NESTLÉ trade-marks that are used in association with both water and ice cream, as well as SILHOUETTE trade-marks for use in association with water and yogurt (Exhibit TT-41). The affiant provides that she visited a Loblaws store in Montreal and purchased NESTLÉ brand bottled water, NESTLÉ brand ice cream, a bottle of SILHOUETTE brand flavoured water and a container of SILHOUETTE brand yogurt. Photographs of the purchases and a copy of the related receipt are attached as Exhibit TT-42 to TT-48 to the affidavit.

[17] The reply evidence of Ms. Thibodeau provides that she was instructed to visit several different supermarket stores with the goal of purchasing both alcoholic and non-alcoholic beverages, as well as EVIAN brand water, and to observe and list different types of alcoholic beverages offered for sale in these stores. Ms. Thibodeau was also instructed to visit 2 different conveniences stores, commonly referred to in Quebec as “depanneurs”, with a similar purpose.

[18] Attached to this affidavit are photographs of the affiant’s purchases, related invoices and lists of different types of alcoholic beverages found on the premises of: Loblaws, Provigo, Metro, IGA, Monoprix, Couche-Tard, and Marche Bonichoix (Exhibits TT-1 to TT-5, TT-7 to TT-11, TT-13 to TT-16, TT-18 to TT-22, TT-33 to TT-38).

[19] It appears clear from this evidence that these establishments in Quebec sell EVIAN brand water as well as a variety of non-alcoholic and alcoholic beverages of the mixed drink or cooler type, some of which contain vodka, gin or tequila. For example, Ms. Thibodeau has listed some 19 types of flavoured alcoholic beverages (Exhibit TT-5), as well as beer and wine, found for sale in Loblaws in Quebec.

[20] The reply affidavit of Stéphane Rolland provides a drink menu (Exhibit SR-1) that he consulted on May 16, 2007 at a restaurant in Laval, Quebec. The drink menu lists alcoholic and non-alcoholic beverages in addition to EVIAN brand water and SAN PELLEGRINO brand water.

Applicant’s Evidence

[21] The applicant’s evidence is the affidavit of Robert Marcon. The affidavit attaches printouts from Wikipedia detailing geographic significances of EVIAN, such as the town of Evian located in France, the “North Evian Gulf” and “South Evian Gulf” located in Greece. As well, printouts are attached of organizations and corporations with Evian in their name. Attached as Exhibit D to the Marcon affidavit is a printout from Peoplefinders.com with 56 listings of people in the United States with Evian as a surname.

[22] Mr. Marcon also attaches copies of various third party Canadian trade-mark registrations for trade-marks such as/or including CORONA, FINLANDIA, PERRIER, apparently to demonstrate analogous situations of co-existing use of trade-marks similar to each other in the Canadian marketplace. Of the copies of registration pages appended to the affidavit it appears that the only two that are actually identical, are FINLANDIA for vodka and FINLANDIA for cheese (both having different owners). In my view the applicant's information regarding third party trade-marks is completely irrelevant to the situation at hand; one cannot infer the state of the marketplace or the general mindset of consumers from evidence of two registrations in the names of two different owners for FINLANDIA. Further in the absence of information negating the possibility of some kind of co-existence agreement between the two, I am unable to make any analogous inferences to the situation at hand. Finally, in order to appreciate any analogy between identical trade-marks on the register and the current situation, I would have to accept that such trade-marks (i.e. FINLANDIA) are well known in Canada, which I cannot do without evidence.

Section 12(1)(d) Ground of Opposition

[23] The material date for assessing the likelihood of confusion under this ground is the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks*, 37 C.P.R. (3d) 413 (F.C.A.)]. The Opponent has pleaded that the Mark is not registrable because it is confusing with its trade-marks as listed above; the Opponent filed certified copies of its trade-mark registrations as identified above, and has therefore met its initial burden with respect to s.12(1)(d) of the Act.

[24] The Applicant must establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark EVIAN. For the purposes of analysis of confusion, I will refer to the Opponent's registrations relied on in this proceeding simply as EVIAN or the EVIAN marks. I do not consider the design elements to be so strong that use of one trade-mark would not be use of any of the other three.

[25] The test for confusion is one of first impression and imperfect recollection on the part of a hurried consumer. 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[26] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 wares, 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. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily given equal weight. The weight to be given to each depends on the circumstances (see in general *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349).

(a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[27] Mr. Marcon's evidence appears directed to demonstrating that EVIAN is a weak mark entitled to a narrow ambit of protection. However, by themselves the printouts from the internet are insufficient to establish that EVIAN is a weak mark and that the average Canadian consumer would, as a matter of first impression, perceive EVIAN as a geographic location, surname, or corporate name. In any event, although EVIAN may have some geographic significance, there is ample evidence (Buscail affidavit) that the Opponent's Marks have become well-known in Canada through use and promotion and have therefore acquired a high degree of distinctiveness. In contrast, the Applicant's mark has not become known at all. I am therefore able to conclude that this factor is in the Opponent's favour.

(b) the length of time each has been in use

[28] The evidence demonstrates that the Opponent has been using its EVIAN mark in Canada since at least as early as 1978; there is no evidence that the Applicant has commenced use of its mark.

(c) the nature of the wares, services or business

[29] The applicant has applied for EVIAN for use in association with “(1) Distilled spirits, namely vodka, gin and tequila (2) ice cream.” In terms of overlap in the wares and nature of the business, the relevant wares of the Opponent are: “mineral water, cosmetics, and beer, still or sparkling water and non-alcoholic beverages.” Included in the Opponent’s registrations are also clothing items. The evidence provided by the Opponent, as set out above, relates to the notoriety of EVIAN for water.

[30] Clearly, there is some overlap in the statement of wares, since both include beverages and alcoholic beverages; I note that Opponent’s Registration No. TMA 586,839 includes “beer”, although no evidence of use on beer has been provided.

[31] On the issue of the nature of the parties’ respective wares and their channels of trade, I refer to comments made by my colleague Jill Bradbury in *Moosehead breweries Ltd. v. Stokely-Van Camp Inc.* (2001), 20 C.P.R. (4th) 181, where she stated:

The applicant's lager beer and the opponent's non-alcoholic, non-carbonated fruit-flavoured drinks belong to the same general class of wares, namely beverages. The applicant argues that the parties' wares should be considered as two different general classes of wares, namely alcoholic beverages and non-alcoholic beverages. In any event, it must be remembered that s-s. 6(2) of the *Act* states that: "The 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, *whether or not the wares or services are of the same general class* " (emphasis added).

[32] In *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C), the Supreme Court considered the relevance of resemblance or connection between the wares when assessing confusion and noted that the wares need not be of the same general class for a finding of confusion. The Court stated that all the surrounding circumstances must be considered, and

reasoned that “a difference in wares or services does not deliver a knockout blow, but nor does the fame of the trade-mark” (para 72).

[33] Given the reputation of the Opponent’s marks and the fact that sales of bottled water, ice cream and alcoholic beverages overlap in some retail outlets (e.g. Quebec), as well as in restaurants, I am prepared to find that the reputation of EVIAN would transcend the market into wares that are not necessarily of “the same general class”.

(d) the nature of the trade

The applicant presents the argument that the nature of the trade is different. A letter from the LCBO for example, indicates that non-alcoholic beverages are not sold on the premises (Exhibit P). Not only is this letter hearsay and therefore inadmissible, it is irrelevant, as it is commonly known that not all jurisdictions in Canada (e.g. Quebec) restrict the sale of alcoholic beverages to liquor and/or beer stores.

[34] In any event, it is apparent from the drink menu attached to Mr. Rolland’s affidavit, and Ms Thibodeau’s evidence from grocery and convenience stores in Quebec, that bottled water, distilled spirits and ice cream are sold in the same outlets. More specifically, it is apparent that these outlets sell prepared alcoholic beverages containing vodka, gin or tequila.

[35] As stated by member David Martin in *T.G. Bright & co. V Blake* (1985), 4 C.P.R. (3d) 368:

There would appear to be a potential overlap between the channels of trade of the parties throughout Canada in that the ware of both parties could easily be sold through bars and restaurants. The possibility of confusion arising in such circumstances would seem to be greater since it is relatively easy to envision a customer ordering a glass of Spritzig and being given a glass of the applicant’s miner water by mistake.

[36] I would add that I am satisfied that the Opponent has demonstrated that the wares would be sold in the same outlets, including restaurants that sell alcoholic beverages. I am in agreement with the argument that when in a restaurant faced with the possibility of ordering EVIAN water or EVIAN alcoholic beverage or EVIAN ice cream, there would be a real risk of confusion as to the source of the goods.

[37] Accordingly, it is not apparent that there would be any significant differences between the trades associated with each mark.

e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[38] The trade-marks at issue are identical when sounded; the design elements which are incorporated in three of the Opponent's registrations are not strong and accordingly I find those marks virtually identical in appearance to the subject Mark; the applicant's trade-mark and Opponent's word mark TMA 306,440 are identical in appearance, sound and ideas suggested.

[39] In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. The prospective purchaser in mind is described as the casual consumer somewhat in a hurry (*Mattel* at para 58). The question is whether this mythical consumer with a vague recollection of the first mark will, on seeing the second comer's mark, infer as a matter of first impression that the wares with which the second mark is used are in some way associated with the wares bearing the first mark (*United States Polo Assn. v. Polo Ralph Lauren Corp.*, [2000] 9. C.P.R. (4th) 51 (F.C.A.) at 58).

[40] Having considered all the surrounding circumstances, I find that the Applicant has not satisfied the onus on it to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties' wares. I reach this conclusion particularly in view of the extensive use and pervasiveness of the Opponent's registered trade-marks EVIAN, the similarities or overlap existing between the parties' wares and channels of trade and the degree of resemblance between the parties' marks. I reach this conclusion on the basis that the Opponent's trade-mark EVIAN is distinctive and well-known in Canada and transcends the beverage market. Both parties' respective wares could be sold in the same restaurants, bars and grocery stores.

[41] The s. 12(1)(d) ground of opposition accordingly succeeds.

Section 16(3)(a) ground of opposition

[42] The material date for assessing entitlement pursuant to s. 16(3) is the date of the subject application (September 2, 2003). The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act on the basis that the Mark is confusing with the Opponent's registered trade-marks, which had been previously used and made known in Canada by the Opponent, and which had not been abandoned by the Opponent at the date of advertisement of the Applicant's application for the Mark.

[43] In order for this ground of opposition to be considered at all, the Opponent must meet an initial evidentiary burden establishing that the relied on marks were used prior to the filing date of the subject application and non-abandonment of its mark as of the date of advertisement of the Applicant's application [s. 16]. As outlined above, the Opponent has met this burden as well.

[44] As the difference between the relevant dates for the grounds of opposition based on s. 12(1)(d) and s. 16(3)(a) does not affect my earlier analysis following which I determined that there is a likelihood of confusion between the marks under review, the s. 16(3)(a) ground of opposition also succeeds insofar as it is based on prior use of the Opponent's registered trade-mark(s) EVIAN and EVIAN & Design.

Non-distinctiveness

[45] An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark or trade name had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D)]. As outlined above, the Opponent has met this burden well. Based on the evidence filed, the Mark is confusing with the Opponent's trade-mark and because the difference in relevant dates does not affect my analysis, the non-distinctiveness ground of opposition succeeds.

[46] As the Opponent has succeeded on more than one ground of Opposition, it is not necessary to make a determination on the remaining grounds of Opposition.

[47] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application with respect to the all the wares pursuant to s. 38(8) of the Act.

P.Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office