

**IN THE MATTER OF OPPOSITIONS by
Rothmans Benson & Hedges Inc. to
applications Nos. 1122426 and 1122428 for
the trade-marks MATINÉE OR and
MATINÉE GOLD respectively filed by
Matinée Company Inc.**

On November 19, 2001, Matinée Company Inc. (the “Applicant”) filed applications to register the trade-marks MATINÉE OR and MATINÉE GOLD (the “Marks”) based upon proposed use of the Marks in Canada in association with “Manufactured tobacco products” (the “Wares”).

The applications were advertised for opposition purposes in the Trade-marks Journal of March 5, 2003.

On August 5, 2003, Rothmans Benson & Hedges Inc. (the “Opponent”) filed essentially identical statements of opposition against each of the applications. The grounds of opposition can be summarized as follows:

1. The applications do not conform with the requirements of s. 30(e) of the *Trade-marks Act* (R.C.S. 1985, c. T-13, as amended) (the “Act”) in that the Applicant does not intend to use the Marks, as trade-marks, in association with the general class of wares described in the applications;
2. The Marks are not registrable because, contrary to s. 12(1)(d) of the Act, the trade-mark applications for the Marks are confusing with the following registered trade-marks:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>	<u>Current Owner</u>
UCA32508	A BUFF LABEL HAVING READING MATTER...OF GOLD COINS	Cigarettes.	British American Tobacco (Brands) Inc.
TMA362227	ALSBO GOLD & Design	Tobacco, raw and	Peter Stokkebye

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>	<u>Current Owner</u>
		manufactured.	International A/S
TMA496655	ATLANTIC PREMIUM GOLD <i>(The exclusive use of the word PREMIUM is disclaimed apart from the trade-mark)</i>	Tobacco; tobacco products, namely cigarettes.	Maritime Tobacco Corporation
TMA427462	CANADIAN GOLD <i>(The exclusive use of the word CANADIAN is disclaimed apart from the trade-mark)</i>	Smoking tobacco, cigarettes and cigarette papers.	Imperial Tobacco Products Limited
TMA453962	CANADIAN GOLD & Design <i>(The exclusive use of all the reading matter except for the word GOLD is disclaimed apart from the trade-mark)</i>	Tobacco products.	Imperial Tobacco Products Limited
TMA111508	GOLD BAND	Cigars, cigarettes and tobacco of every kind and description.	Dunhill Tobacco of London Limited
TMDA44706	GOLD BAND & Design	Cigars, cigarettes and tobacco of every kind and description.	Dunhill Tobacco of London Limited
TMA177604	GOLD BLEND <i>(The exclusive use of the word BLEND is disclaimed apart from the trade-mark)</i>	Cigarettes, tobacco and cigars.	Dunhill Tobacco of London Limited
TMA279372	GOLD BLOCK	Manufactured tobacco products.	Imperial Tobacco Products Limited
TMA185438	GOLD COAST	Cigarettes, cigars and tobacco products.	Japan Tobacco Inc.
TMA300504	GOLD COAST	Cigarettes.	Japan Tobacco Inc.

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>	<u>Current Owner</u>
TMDA52285	GOLD FLAKE	Tobacco in all its forms and particularly to be used in connection with the sale of cigarettes, cigarette papers, cigarettes tubes, tobacco, snuffs and cigars.	Imperial Tobacco Products Limited
TMA486928	GOLD SEAL	Tobacco products.	P.T. Djarum
TMA195576	GOLD SHAG <i>(The exclusive use of the word SHAG is disclaimed apart from the trade-mark)</i>	Smoking tobacco.	Lane Limited
TMDA52298	OLD GOLD	Tobacco in all its forms and particularly to be used in connection with the sale of cigarettes, cigarette papers, cigarettes tubes, tobacco, snuffs and cigars. Manufactured tobacco products.	British American Tobacco (Brands) Inc.
TMA199239	MACDONALD'S & Design	Cigarettes, cigars, pipe tobacco and tobacco products.	JTI-Macdonal TM Corp.

3. The Marks are not distinctive of the Applicant as they do not distinguish the wares of the Applicant nor are they adapted so as to distinguish them.

The Applicant filed and served a counter statement in each case in which it denied all grounds of

opposition.

As its evidence in each case, the Opponent submitted an affidavit of Perry J. Lao. The Applicant filed a single set of affidavits of Edmond Ricard, Chantal Dorais, Timothy Owen Stevenson, Adamo Santoianni and Iva Morina in respect of the two present oppositions as well as two oppositions to other applications involving the same Applicant and Opponent.

Each party filed a written argument in each case. Only the Applicant was represented at an oral hearing in each case.

Summary of Opponent's Evidence

Perry J. Lao identifies himself as a lawyer employed in the law firm representing the Opponent in the present opposition proceedings.

Mr. Lao states that he obtained various cigarette packages of the Applicant on May 10, 2004, from the International News store located at Scotia Plaza, in Toronto, Ontario. He attaches as Exhibits "A" and "B" to his affidavit, scanned images of the primary front display panels featuring the design and text appearing on the Applicant's "MATINÉE EXTRA MILD" and "MATINÉE ULTRA MILD" cigarette packages. I am reproducing below the main features of the front display panels of the Applicant's "MATINÉE EXTRA MILD" and "MATINÉE ULTRA MILD" cigarette packages that are being referred to in the present opposition proceedings:



Mr. Lao makes various observations regarding the indicia appearing on the said packaging. He

further states that based on the Applicant's commercially available products that are included as Exhibits "A" and "B", it is reasonable to conclude that the applied for Marks MATINÉE OR and MATINÉE GOLD, would appear on packaging in a similar fashion to that of the "MATINÉE EXTRA MILD" and "MATINÉE ULTRA MILD" packaging, whereby the word "MATINÉE" would appear separate from the word "OR" or "GOLD". I am setting aside this latter portion of Mr. Lao's affidavit that constitutes inadmissible opinion evidence.

Mr. Lao further files certified copies of the sixteen above-listed registrations for the "GOLD" marks relied upon by the Opponent, obtained from the Canadian Trade-marks Office.

Summary of Applicant's Evidence

Affidavit of Edmond Ricard

Edmond Ricard identifies himself as the Division Head, Marketing Futures and Development of the Marketing Division of Imperial Tobacco Canada Limited/Imperial Tobacco Canada Limitée ("ITCan"). He states that in his position, he is responsible for, among other things, maintaining trade-marks owned by ITCan and its subsidiaries (including Imperial Tobacco Company Limited ("ITCo"), Allan Ramsay & Company Ltd. ("Allan Ramsay") and the Applicant) and monitoring the use of these trade-marks.

Mr. Ricard states that pursuant to a licence agreement between the Applicant and Allan Ramsay, Allan Ramsay is licensed to use all of the Applicant's trade-marks in association with the manufacture and sale of tobacco products. The license also grants Allan Ramsay the right to sub-license its rights to others and Allan Ramsay has sub-licensed its rights to ITCan under the same terms as the license between the Applicant and Allan Ramsay.

Mr. Ricard states that ITCan has manufactured, marketed and sold "MATINÉE EXTRA MILD" cigarettes in Canada since at least as early as June 2001.

Mr. Ricard explains the manner in which the "MATINÉE EXTRA MILD" cigarettes are being sold in Canada. He further attaches to his affidavit, representative samples of packaging, order

forms and invoices for same.

Affidavit of Chantal Dorais

Chantal Dorais identifies herself as the Consumer Relations Team Leader for ITCan. Ms. Dorais states that her department handles customer communications, including questions, compliments, comments and complaints, concerning the products manufactured by ITCan, including ITCan's "MATINÉE EXTRA MILD" cigarette product.

Ms. Dorais states that communications concerning ITCan's products are most often received by telephone, via a phone number printed on the outside of packages for ITCan's products. She further states that employees within the department, including her, take these calls and enter the subject of the discussion directly in an electronic database. At the conclusion of these calls, the department asks the customer to provide details of the communication in writing via a comment form, which is mailed to the customer by the department. These forms are then returned to the department.

Ms. Dorais states that in the majority of cases customers refer to the product in issue by its full name. Thus, if a customer is contacting the department concerning ITCan's "MATINÉE EXTRA MILD" product, the customers have, in the majority of cases, referred to the product as "MATINÉE EXTRA MILD". Ms. Dorais further states that ITCan has received over 450 communications concerning ITCan's "MATINÉE EXTRA MILD" cigarettes and she attaches as Exhibit "A" to her affidavit, representative samples of communications received from Canadian consumers concerning same.

Affidavit of Adamo Santoianni

Adamo Santoianni identifies himself as a Sales Representative employed by ITCO. He has held his position with ITCO and its predecessors for twenty-three years.

He states that his role is to work with retailers in the Montreal area in the merchandising of products manufactured by ITCan, for whom ITCO distributes cigarettes. Mr. Santoianni explains that he speaks with retailers regularly and also visits them in their stores to hand over

informational documents, to maintain their stock of cigarette displays, etc. He further states that he often has the opportunity to speak with or overhear customers who enter retail stores while he is visiting the retailers. He states that over the past twenty-three years, he has spoken to, or overhear thousands of customers discussing or purchasing their cigarettes and that in the vast majority of cases (in his estimation, about 95% of the time), these customers refer to the cigarette brand in issue using its full name. He states that this is true of ITCan's "MATINÉE EXTRA MILD" cigarettes, which are referred to by such customers as "MATINÉE EXTRA MILD".

Mr. Santoianni further continues his affidavit by stating that this is not surprising as in his experience it has been and continues to be commonplace for a given tobacco manufacturer to offer a number of brands whose names use a common first element. He states as examples without further supporting facts, PLAYER'S FILTER, PLAYER'S LIGHT SMOOTH, PLAYER'S SILVER and PLAYER'S SPECIAL BLEND; and EXPORT A EXTRA LIGHT, EXPORT A LIGHT, EXPORT A MEDIUM, EXPORT A MEDIUM FLAVOUR, and EXPORT A MILD.

While the Opponent has not objected to the admissibility as evidence of Mr. Santoianni's statements, I will discuss same later on in my decision.

Affidavits of Iva Morina and Timothy Owen Stevenson

Iva Morina and Timothy Owen Stevenson identify themselves as respectively paralegal and summer student employed in the law firm representing the Applicant in the present opposition proceedings.

Each of them has attended one or more convenience stores and verbally ordered a pack of "MATINÉE EXTRA MILD" cigarettes. Photocopies of the "MATINÉE EXTRA MILD" pack of cigarettes received as well as receipt for same are attached to each of their affidavits.

Onus and relevant dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its

applications comply with the requirements of the Act. There is, however, an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

The relevant dates for appreciating the circumstances in regard to each of the grounds of opposition in the present cases are the following:

- Ground based on s. 30 of the Act: the filing date of the applications [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M. O.B.)];
- Ground based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)]; and
- Ground based on non-distinctiveness of the Marks: generally accepted as being the filing date of the statements of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

I will now analyze these grounds of opposition in turn in regard to the evidence filed in record.

Section 30(e) ground of opposition

The Opponent's first ground of opposition is that the applications do not conform to the requirements of s. 30(e) of the Act, in that the Applicant does not intend to use the Marks, as trade-marks, in association with the general class of wares described in the applications.

While I have doubts as to the sufficiency of that pleading, I understand from the Lao affidavit and the Opponent's written argument in each case that the Opponent, relying on the Applicant's commercially available products that are included as Exhibits "A" and "B" to the Lao affidavit, contends that it is reasonable to conclude that the applied for Marks MATINÉE OR and MATINÉE GOLD would appear on packaging in a similar fashion to that of the "MATINÉE

EXTRA MILD” and “MATINÉE ULTRA MILD” packaging, whereby the word “MATINÉE” would appear separate from the word “OR” / “GOLD” and that such use of MATINÉE OR or MATINÉE GOLD would not constitute use as a unitary trade-mark.

Conversely, the Applicant contends that at most, this evidence demonstrates the manner in which the Applicant sold its unrelated “MATINÉE EXTRA MILD” and “MATINÉE ULTRA MILD” brands of cigarettes in 2004 and cannot possibly be taken as evidence of what the Applicant’s intention may have been some three years earlier, as to how it would sell its MATINÉE OR and MATINÉE GOLD brands of cigarettes. As such, the Applicant contends that it is not possible to conclude from the evidence filed in record that the Applicant’s intention in 2001 was not to use the MATINÉE OR and MATINÉE GOLD Marks, particularly in view of the Applicant’s unequivocal and contemporaneous statements in its applications that it would use its MATINÉE OR and MATINÉE GOLD Marks as trade-marks. I agree.

Nevertheless, in the event that I am wrong in so doing, I will address further the Opponent’s contentions made in this respect keeping in mind that the Opponent’s initial burden concerning a ground based upon non-compliance with s. 30(e) is a relatively light one [see *Molson Canada c. Anheuser-Busch Inc.* (2003), 29 C.P.R. (4th) 315 (F.C.)].

In its written argument in each case, the Opponent contends that:

“B. 6. The evidence shows that the Applicant does not intend to use the subject trade-mark as a trade-mark. The Applicant confirms that the packaging design for its “Matinée family” of products is consistent. The Applicant’s evidence further acknowledges that the typical manner of use of its MATINÉE brand on packaging is represented by its MATINÉE EXTRA MILD packaging. All of the packaging for this product shows the initial component “MATINÉE” in prominent red script separate from the second component “EXTRA MILD” which appears in faint colouring and in smaller size and different font from the word “MATINÉE”. The two components always appear in different upper and lower case letter combinations, namely “EXTRA MILD” versus “Matinée”. (my underlining)

The evidence does not support the contentions above quoted and underlined, which are contested by the Applicant.

All that the evidence put forward by both the Opponent and the Applicant does is to clearly show that “MATINÉE EXTRA MILD” cigarettes packages are being sold in Canada, though the Lao affidavit also introduces into evidence a sample of packaging for the Applicant’s “MATINÉE ULTRA MILD” cigarette packages.

In its written argument in each case, the Opponent further contends that:

“C. 1 (k) The evidence establishes that the Applicant does not intend to use the [M]ark as a trade-mark for the purpose of distinguishing or so as to distinguish its wares from those of other traders. The word GOLD [OR] will be physically separated from the component MATINÉE, it will appear in a different font which is much fainter in colouring and much smaller in size than the component MATINÉE, and it will appear in a different upper and lower case letter combination than the component MATINÉE.
[...]

(m) [...] The Applicant itself acknowledges that the manner of use of the subject mark will be in the same format as its MATINÉE EXTRA MILD and other MATINÉE products”.

Again, there is no evidence supporting these contentions that I dismiss as pure speculation. Assuming that there would be, I agree with the Applicant’s contention that such manner of use would qualify as use as trade-marks.

Indeed, if the Applicant were to use the Marks in the same format as its “MATINÉE EXTRA MILD” cigarette product, I believe that such manner of use would qualify as use as trade-marks since the fact that the words “MATINÉE” and “EXTRA MILD” [or “GOLD” / “OR”] appear [would appear] in different fonts and colours on the front, side and top panels of the cigarette packages does not in itself prevent the words from being considered use of the mark “MATINÉE EXTRA MILD” [or MATINÉE GOLD / MATINÉE OR] as a whole. The words “MATINÉE” and “EXTRA MILD” [or “GOLD” / “OR”] always appear [would always appear] in close proximity with each other, and with either no other indicia (side panel) or no other wording (top panel) surrounding them. They are the only words of significant size appearing on the front panel.

Pushing the comparison further, the said use of “MATINÉE GOLD” and “MATINÉE OR” as

trade-marks on cigarettes packages is supported by the use made of “MATINÉE EXTRA MILD” on the invoices and order forms attached to the Ricard affidavit. “MATINÉE EXTRA MILD” appears in the body of the invoices and the invoices accompany the wares or are shipped to the purchasers. “MATINÉE EXTRA MILD” appears on order forms used by retailers and wholesalers to order cigarettes from ITCO. “MATINÉE EXTRA MILD” further appears on consumer sales receipts as evidenced by the Stevenson affidavit.

Furthermore, the samples of communications attached to the Dorais affidavit evidence that “MATINÉE EXTRA MILD” cigarettes are referred to by customers as “MATINÉE EXTRA MILD”.

I do not need to determine the admissibility of the statements made by Mr. Santoianni as I consider the above outlined evidence sufficient to conclude in the circumstances that if the Applicant were to use the applied for Marks in the same format as its “MATINÉE EXTRA MILD” cigarette product, such use would qualify as use of the proposed trade-marks.

Based on the foregoing analysis, I find that the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Applicant does not intend to use the Marks, as trade-marks, in association with the general class of wares described in the applications. Accordingly, the s. 30(e) ground of opposition is unsuccessful.

Section 12(1)(d) ground of opposition

As indicated above, the Opponent has filed certified copies of the sixteen above-listed registrations for the “GOLD” marks relied upon by the Opponent, obtained from the Canadian Trade-marks Office. As pointed out by the Applicant in its written argument in each case, three of the cited registrations [ALSBO GOLD & Design; GOLD SHAG; and MACDONALD’S Design] were active at the time of the Applicant’s applications in 2001, but have been expunged for failure to renew after the evidence was filed in the present oppositions. Accordingly, and as contended by the Applicant, these registrations are not relevant to the oppositions of the Applicant’s Marks based on s. 12(1)(d).

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no risk of confusion between the Marks and the said registrations.

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 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.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have 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 and different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée and al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

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

As acknowledged by the Opponent in its written argument in each case, the Marks are made up of two components, namely “*the well-known house mark*” “MATINÉE” and the word “GOLD” / “OR”. The word “GOLD” / “OR” may suggest that the Wares are of a high standard or quality or that the tobacco products or their packaging are gold in colour. That said, I consider the Marks to have some degree of inherent distinctiveness.

The cited trade-mark registrations also possess some degree of inherent distinctiveness.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, the parties have provided no evidence that any of the marks in issue have become known in Canada to any extent. The most that can be inferred from the mere existence of the cited registrations is *de minimis* use that is not sufficient to conclude that the marks have become known in Canada [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)].

Accordingly, this first factor favours neither party.

(b) the length of time the trade-marks have been in use

As there is no evidence for concluding to continuous use of the cited marks since the claimed dates of first use in the registrations, I find this factor is of no significance.

(c) the nature of the wares, services or business; and (d) the nature of the trade

The marks in issue cover either identical wares or closely related wares. Accordingly, these third and fourth factors favour the Opponent.

(e) the degree of resemblance between the trade-marks

The only common feature between each of the cited registrations and the Applicant's MATINÉE GOLD Mark is the word "GOLD". Except for the fact that "OR" is the French equivalent to the English word "GOLD", there is no common feature between each of the cited registrations and the Applicant's MATINÉE OR Mark.

Considering the very significant differences existing between the Marks and each of the cited marks in appearance, sound and the ideas suggested by them, I do not find it necessary to detail

here the analysis made in regard to each of the thirteen marks in issue. Suffice it to say that the Marks are made up of the distinctive element “MATINÉE” appearing at the start of the Applicant’s Marks whereas the cited registrations contain other distinguishing features. Accordingly, this fifth factor unequivocally favours the Applicant.

Additional circumstances

The cited marks amount to thirteen trade-mark registrations owned by six different entities. While this latter number may not necessarily be considered by the jurisprudence large enough to make inferences about the state of the marketplace that marks containing the word “GOLD” are common in the marketplace for tobacco products, I nevertheless believe that such inferences can fairly be made in the circumstances of the present opposition proceedings given the suggestive character of the word “GOLD” discussed above and the fact that both the Applicant and the Opponent have acknowledged in their written arguments that the said word is of low inherent distinctiveness.

Conclusion re likelihood of confusion

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the marks in issue as to the source of the parties’ wares. Accordingly, the s. 12(1)(d) ground of opposition is unsuccessful.

In its written argument in each case, the Opponent has submitted in the alternative the following:

“2.(j) In the alternative, if the Hearing Officer finds the subject [M]ark[s] not to be confusing with the registered trade-marks identified on the basis that the other components in each of the trade-marks at issue is sufficient to distinguish each mark, it is submitted that the word GOLD [OR] in the subject [M]ark[s] is a non-distinctive and weak component which is a common English [French] word that ought to be available to all traders in the field.”

Given my findings made above that the word “GOLD” is common to the trade and the fact that the Applicant does not seek to register the marks GOLD and OR *per se* but the Marks MATINÉE OR and MATINÉE GOLD as a whole, I do not wish to comment further on this latter contention of the Opponent.

Non-distinctiveness ground of opposition

The third ground of opposition is that the Marks are not distinctive of the Applicant as they do not distinguish the wares of the Applicant nor are they adapted so as to distinguish them. The Opponent did not provide any further particulars in support of this pleading. Thus, that third ground of opposition does not comply with s. 38(3)(a) of the Act and is therefore unsuccessful.

Even if the distinctiveness ground of opposition had been sufficiently pleaded, I still would find that ground unsuccessful as the Opponent has not met its initial evidential burden to show that as of the filing of the oppositions, the cited marks had become known sufficiently to negate the distinctiveness of the applied-for Marks. Furthermore, if the distinctiveness ground of opposition were considered to be based on the allegation that the applied-for Marks will not be used for the purpose of distinguishing the Wares from those of other traders as contended by the Opponent in its written argument in each case, it would also fail at the very least for the same reasons that the s. 30(e) ground of opposition failed.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the oppositions to the registration of the Marks MATINÉE OR and MATINÉE GOLD, the whole pursuant to s. 38(8).

DATED AT Montréal, Québec, THIS 13th DAY OF February 2008.

Annie Robitaille
Member, Trade-marks Opposition Board