

**IN THE MATTER OF AN OPPOSITION by  
Spirits International B.V. to application No.  
1242207 for the trade-mark NEMIROVSKAYA  
NEMIROFF (Design) in the name of Nemiroff  
Intellectual Property Establishment**

[1] On December 29, 2004, BREYFIELD Trust reg. (the “Applicant”) filed an application to register the trade-mark NEMIROVSKAYA NEMIROFF (Design) (the “Mark”), which is shown below:



[2] The application is based upon use and registration of the Mark abroad in association with alcoholic beverages, namely vodka. In particular, the Applicant claims use of the Mark in Ukraine and registration of the Mark in or for Liechtenstein.

[3] The Applicant disclaims the right to the exclusive use of all of the reading matter apart from the Mark except the words NEMIROFF and NEMIROVSKAYA.

[4] The application was advertised for opposition purposes in the Trade-marks Journal of October 26, 2005. On December 23, 2005, Spirits International N.V. (the “Opponent”) filed a statement of opposition. On December 29, 2005, the Opponent filed a substitute statement of opposition.

[5] The Applicant filed and served a counter statement. It subsequently obtained leave to file an amended counter statement.

[6] On June 29, 2006, an assignment of the application was recorded in favour of Nemiroff Intellectual Property Establishment (also the “Applicant”).

[7] In support of its opposition, the Opponent filed the affidavits of Stanislaw Brasiler and Céline Deschambault.

[8] By letter dated May 28, 2007, the Opponent informed the Registrar that it had changed its name to Spirits International B.V. (also the “Opponent”).

[9] In support of its application, the Applicant filed the affidavit of George J. Primak.

[10] No reply evidence was filed and no cross-examinations were conducted.

[11] On May 9, 2008, the Opponent requested leave to file an amended statement of opposition.

[12] Only the Opponent filed a written argument. An oral hearing was not held.

### Preliminary Issues:

#### 1. Outstanding Request for Leave

[13] It appears that through oversight the Opponent’s May 9, 2008 request for leave has not been addressed to date. The Registrar did seek the Applicant’s comments by letter of June 10, 2009 but, contrary to the Opponent’s written submissions, the failure of the Applicant to object to the amendment did not result in the automatic granting of leave. I shall therefore address the request now.

[14] The Opponent submitted in its covering letter that it was amending its statement of opposition in part to “plead particulars in support of allegations of non-registrability of the Applicant’s mark already raised in the Statement of Opposition.” Originally, the Opponent pleaded the following as paragraph 5 of its statement of opposition:

5. The Opponent further bases its opposition on the grounds as set out in Subsection 38(2)(a), namely, that the Application was not filed in compliance with Subsection 30(i). The Application does not comply with the requirements of Subsection 30(i) because the Applicant cannot be satisfied that it is entitled to register the opposed trade-mark since:

- (a) the Applicant adopted its trade-mark when it knew, or ought to have known, that NEMIROVSKAYA or NEMIROFF or both are primarily merely the name or surname of an individual who is living or has died within the preceding thirty years contrary to Subsection 12(1)(a) of the *Act*;
- (b) the Applicant adopted its trade-mark when it knew, or ought to have known, that it was either clearly descriptive or deceptively misdescriptive of the place of origin contrary to Subsection 12(1)(b) of the *Act* since:
  - 1. Luka Nemirovskaya , is in the NEMIROV/YARY region in the Ukraine;
  - 2. The Applicant is located in the NEMIROV/YARY region in the Ukraine.
- (c) the Applicant’s mark is confusing pursuant to Subsection 12(1)(d) of the *Act* with the existing registered marks for the Opponent listed in para. 6(a) herein; and
- (d) the Applicant cannot be said to have been satisfied that it was entitled to register the subject trade-mark in light of para. 4 herein and all the factors mentioned previously.

[15] In its proposed amendment, the Opponent deleted paragraph 5(c) (presumably because there is an independent s. 12(1)(d) ground of opposition) and added the following paragraph 6:

6. The Opponent bases its opposition on the grounds as set out in Subsection 38(2)(b), since the Applicant’s subject mark is not registrable because:

- (a) NEMIROVSKAYA or NEMIROFF or both are primarily merely the name or surname of an individual who is living or has died within the preceding thirty years contrary to Subsection 12(1)(a) of the *Act*;
- (b) the Applicant [sic] trade-mark is either clearly descriptive or deceptively misdescriptive of the place of origin contrary to Subsection 12(1)(b) of the *Act* since:
  - 1. Luka Nemirovskaya, is in the NEMIROV/YARY region in the Ukraine;
  - 2. The Applicant is located in the NEMIROV/YARY region in the Ukraine.

[16] Given that the Applicant's counter statement asserted that its application was in compliance with s. 12(1)(a) and (b), I agree with the Opponent that, in the absence of any objection from the Applicant, it is reasonable to conclude that the Applicant was aware of the case that it was to meet, namely that the Applicant interpreted the original statement of opposition as pleading grounds of opposition under s. 12(1)(a) and (b) both independently and as a basis for a s. 30(i) ground of opposition, which according to the Opponent was the Opponent's original intent. In these circumstances, I grant the Opponent leave to amend the original paragraph 5 and add paragraph 6.

[17] Numerous other amendments were submitted, which may be classified into three groups. My ruling with respect to each group is set out below:

- i) the amendments made simply to reflect the change in name are accepted;
- ii) the amendments that consist of deletions are accepted;
- iii) the addition of s. 16(1)(b) to the ground pleaded under s. 38(2)(c) is refused since s. 16(1) only applies to applications based on the use or making known of a mark in Canada, which is not the case at hand.

[18] To summarize, all of the requested amendments, other than the inappropriate reliance on s. 16(1)(b), are allowed.

## 2. Admissibility of Evidence

[19] In its written argument, the Opponent has submitted that the Applicant's evidence is inadmissible because the affiant, Mr. Primak, is a trade-mark agent with the Applicant's former agents of record. Relying on *Cross-Canada Auto Body Supply (Windsor) Ltd. v. Hyundai Auto Canada*, 2006 FCA 133 (F.C.A.), the Opponent submits that investigations and opinions on matters of substance should be provided by an objective party and that it is improper for an agent to act in a proceeding in which he himself has given affidavit evidence on a point of substance.

[20] It is interesting to note that the Opponent has also introduced evidence from an employee of its agent of record: Ms. Deschambault identifies herself as a student-at-law employed by the Opponent's agents. Therefore, to use an old expression, "what's sauce for the goose is sauce for the gander."

[21] I shall summarize the nature of the evidence in order to assess what is admissible.

[22] Mr. Primak's evidence includes the following:

1. printouts from the Canadian Trade-mark Database ([strategis.ic.gc.ca](http://strategis.ic.gc.ca))
2. correspondence from the prosecution of a trade-mark application file for a mark that is associated with the Mark
3. full details of a search conducted on [strategis.ic.gc.ca](http://strategis.ic.gc.ca) for active marks ending in AYA in association with vodka
4. a page from [en.wikipedia.org](http://en.wikipedia.org)
5. discussion of the normal course of trade of spirits in Canada, supported by pages from the Internet
6. pages from [www.lcbo.com](http://www.lcbo.com)
7. a page from [www.multimap.com](http://www.multimap.com)
8. pages concerning Nemiroff Ukrainian Vodka Company's vodka from [www.nemiroff.ua](http://www.nemiroff.ua) and [www.diwinetaste.com](http://www.diwinetaste.com)

[23] Ms. Deschambault's evidence includes the following:

1. certified copies of the Opponent's trade-mark registrations
2. a certified copy of the prosecution file regarding the present trade-mark application
3. extract from www.411.ca
4. extract from www.amazon.ca
5. an article from the September 28, 2006 edition of the Ottawa Citizen
6. an extract from www.fallingrain.com
7. an extract from www.nemiroff.ru
8. an extract from www.bharatbook.com
9. extracts from www.patentsoffice.ie

[24] I have no difficulty in accepting the evidence from each party that originates with the Canadian Trade-marks Office's records (items 1 and 2, Deschambault list; items 1 and 3, Primak list). I also do not consider there to be any controversy concerning an article from the Ottawa Citizen; its purpose is to show a reference to an individual with the surname Nemiroff. In addition, given that Examiners rely upon www.411.ca to determine if a word is a surname, I also consider item 3 from the Deschambault list to be admissible. However, I consider the rest of the evidence to not be admissible, primarily because it is hearsay. There is no basis on which to accept that statements appearing on any of the other websites are true. Also, Mr. Primak has not been established as an individual who can give evidence as to the normal course of trade of spirits in Canada.

### Onus

[25] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

#### Section 12(1)(a) Ground of Opposition

[26] The Opponent's evidence establishes that Nemiroff is a surname. However, even if Nemiroff is a word that is primarily merely a surname, the s. 12(1)(a) ground cannot succeed, because the Mark comprises much more than just this word. The Mark as a whole cannot be said to be primarily merely a surname. [See *Molson Companies Ltd. v. John Labatt Ltd.* (1981), 58 C.P.R. (2d) 157 (F.C.T.D.).] The s. 12(1)(a) ground is accordingly dismissed.

#### Section 12(1)(b) Ground of Opposition

[27] Similarly, if I was satisfied that NEMIROVSKAYA describes a place of origin of vodka (which I am not), then the Mark as a whole still could not be said to be descriptive of a place of origin. The s. 12(1)(b) ground is accordingly dismissed.

#### Section 12(1)(d) Grounds of Opposition

[28] Paragraph 7 of the Opponent's amended statement of opposition reads:

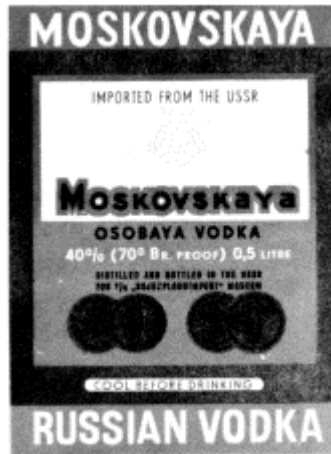
7. Opponent bases its opposition on the grounds as set out in Subsection 38(2)(b), since the Applicant's subject mark is not registrable because:

(a) it is confusing, by virtue of Subsection 12(1)(d) of the *Act* within the meaning of Sections 2 and 6 with the Opponent's family of STOLICHNAYA, MOSKOVSKAYA and SIBIRSKAYA trade-marks including the Opponent's trade-mark RUSSIAN VODKA & Design covered by Canadian Registration No. TMA208,808 registered August 15, 1975 on the basis of use in Canada since at least as early as June 6, 1966 in association with vodka; the Opponent's trade-mark RUSSIAN VODKA & Design covered by Canadian Registration No. TMA208,809 which was registered August 15, 1975 based on use in association with vodka since at least as early as July, 1971; the Opponent's trade-mark VODKA SIBIRSKAYA & Design covered by Canadian Registration No. TMA283,218 which was registered on September 9, 1983 for use in association with wines, alcoholic drinks, namely vodka, liqueurs; the Opponent's trade-mark STOLICHNAYA RAZBERI & Design covered by Canadian Registration No. TMA538,598 registered December 12, 2000 for use in association with vodka; the Opponent's trade-mark STOLI OHRANJ & Design covered by Canadian

Registration No. TMA540,828 registered on February 6, 2001 for use in association with vodka; the Opponent's trade-mark STOLICHNAYA VANIL & Design covered by Canadian Registration No. TMA540,830 registered on February 6, 2001 for use in association with vodka; the Opponent's trade-mark STOLICHNAYA CRISTALL & Design covered by Canadian Registration No. TMA544,670 registered May 8, 2001 for use in association with vodka;

[29] The material date with respect to this ground of opposition is the date of my decision [see *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 met its evidential burden because its registrations Nos. 1) TMA208,808, 2) TMA208,809, 3) TMA283,218, 4) TMA538,598, 5) TMA540,828, 6) TMA540,830 and 7) TMA544,670 are extant. The marks that correspond to such registrations are shown below.

1)





2)



3)



4)



5)



6)



7)



*Family of marks*

[30] The Opponent has pleaded that it has a family of STOLICHNAYA, MOSKOVSKAYA and SIBIRSKAYA trade-marks. Since the concept of a family of trade-marks is based on trade-marks sharing a common feature, I shall assume that the Opponent is claiming that it has a family of trade-marks that include a word that ends in the letters AYA.

[31] In order to claim the benefit of a family of marks, the Opponent must prove use of each mark in its alleged family. [*McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 (T.M.O.B.)] In addition, a relevant consideration when a family of marks is pleaded is whether the feature common to the Opponent's marks is found in trade-marks owned by others. [*Canadian Olympic Association v. Techniquip Limited* (1999), 3 C.P.R. (4th) 219 (F.C.A.)]

[32] In the present case, Mr. Brasiler, the Opponent's Managing Director, has attested that 23 registered trade-marks owned by the Opponent have been used and advertised extensively in Canada in association with vodka since at least as early as the 1970s. (paragraphs 5 and 6) As Exhibit "B", he provides representative samples of labels applied to the Opponent's vodka products sold in Canada. These labels resemble, but are not identical to, those design trade-marks identified above as numbers 1, 2 and 4. However, the labels provided do not refer to the Opponent. Instead they read, "distilled and bottled for ZAO 'Sojuzplodimport', Moscow, Russia" or "Product of S.P.I. Group distilled in Russia". Elsewhere in the affidavit, there are the following references to these third parties (see paragraph 2, and Exhibits "D" and "G"):

- "References to "MY COMPANY" in this Affidavit also includes, as the case may be, MY COMPANY's acquired rights in 1999 from Closed Joint Stock Company Sojuzplodimport and its predecessors."
- S.P.I. Group SA holds 83.5% of the issued capital of the Opponent
- S.P.I. Group SA indirectly holds 69% of the entire issued share capital of ZAO Sojuzplodimport, a joint stock company
- invoices allegedly corresponding to sales of the Opponent's brand products are issued by SPI Limited of Gibraltar or S.P.I. Spirits (Cyprus) Limited and identify the supplier as ZAO Sojuzplodimport or S.P.I. Spirits (Cyprus) Limited

- S.P.I. Group SA indirectly holds 70% of the entire issued share capital of S.P.I. Spirits (Cyprus) Limited
- the Opponent, ZAO Sojuzplodimport, and S.P.I. Spirits (Cyprus) Limited are affiliated companies of S.P.I. Group SA

[33] The certified copy of registration No. TMA208,808 provided as part of Exhibit “A” of the Deschambault affidavit indicates that an assignment effective October 26, 1999 was registered on February 10, 2000, transferring the registration from Closed Joint Stock Company Sojuzplodimport to Spirits International N.V. However, Closed Joint Stock Company Sojuzplodimport is not the name that appears on the representative labels and there is no evidence that such company is also known as ZAO Sojuzplodimport.

[34] Section 50 of the Act sets out when the use of a mark by a party other than its owner will enure to the benefit of its owner. I reproduce s. 50 below.

50. (1) For the purposes of this Act, if an entity is licensed by or with the authority of the owner of a trade-mark to use the trade-mark in a country and the owner has, under the licence, direct or indirect control of the character or quality of the wares or services, then the use, advertisement or display of the trade-mark in that country as or in a trade-mark, trade-name or otherwise by that entity has, and is deemed always to have had, the same effect as such a use, advertisement or display of the trade-mark in that country by the owner.

(2) For the purposes of this Act, to the extent that public notice is given of the fact that the use of a trade-mark is a licensed use and of the identity of the owner, it shall be presumed, unless the contrary is proven, that the use is licensed by the owner of the trade-mark and the character or quality of the wares or services is under the control of the owner.

[35] The facts before me do not fall under either s. 50(1) or s. 50(2). Accordingly, I cannot conclude that the use shown by Mr. Brasiler (especially that which postdates the 1999 assignment) qualifies as use by the Opponent. In this regard, I note that corporate structure alone does not establish the existence of a licensing arrangement. [*MCI Communications Corp. v. MCI Multinet Communications Inc.* (1995), 61 C.P.R. (3d) 245 (T.M.O.B.)]

[36] Accordingly, as there is no evidence of use of the Opponent's marks by the Opponent, the Opponent has not established a family of marks. Even if the use shown was that of the Opponent, three marks is not a very significant family. Moreover, there is evidence from Mr. Primak that the Opponent is not the only party to register a trade-mark that includes a word that ends with the letters AYA for vodka (paragraph 9, Exhibits 15 and 17).

*Section 6(5) analysis*

[37] 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 specifically enumerated in s. 6(5) of the Act. Each of these is discussed below. My discussion is focused on the Opponent's MOSKOVSKAYA & Design registered trade-mark (No. 1 above) as the first word in that design mark arguably is closest to the first word in the Applicant's Mark, making it the Opponent's best case scenario.

[38] s. 6(5)(a): Each party's mark is inherently strong since each incorporates words and designs that are not directly related to vodka. Only the Opponent has evidenced that its mark has acquired reputation through use or promotion but, as discussed earlier, the Opponent has not shown that such acquired distinctiveness has been to its benefit. If it has instead benefited another party, then such use and promotion may have decreased the distinctiveness of the mark in the hands of the Opponent, rather than strengthened it.

[39] s. 6(5)(b): The Opponent claims that its mark has been used in Canada since at least as early as June 6, 1966, but again the evidence does not show that it is the Opponent who has been using the MOSKOVSKAYA & Design mark. There is no evidence that the Applicant's Mark has been used to date in Canada.

[40] s. 6(5)(c): The party's wares are identical.

[41] s. 6(5)(d): It is fair to assume that both parties' wares would travel similar channels of trade.

[42] s. 6(5)(e): Overall, there is only a very small degree of resemblance between the Applicant's trade-mark NEMIROVSKAYA NEMIROFF (Design) and the Opponent's trade-mark MOSKOVSKAYA & Design in appearance, sound and ideas suggested.

[43] Having considered all of the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between the parties' marks. The most crucial or dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks and there are major differences between the marks at hand [see *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].

[44] Accordingly, all of the s. 12(1)(d) grounds are dismissed.

#### Section 16 grounds of opposition

[45] Paragraph 8 of the Opponent's amended statement of opposition reads (with the reference to s. 16(1)(b) omitted as per my preliminary ruling above):

8. The Opponent bases its opposition on the grounds as set out in Subsection 38(2)(c), namely that by virtue of Subsection 16(2)(a)(b)(c) of the *Act*, the Applicant is not entitled to registration of the subject trade-mark because at the date of filing in Canada, namely December 29, 2004, it was confusing with the Opponent's trade-marks listed in para. 7(a) herein; which had been previously filed in Canada by the Opponent in association with related wares.

[46] In order to meet its initial burden with respect to s. 16(2)(a), the Opponent must evidence that it has used its marks in Canada prior to December 29, 2004. I have already ruled that the

Opponent has not shown use that accrues to its benefit and so this ground fails. If the Opponent had met its initial burden, the ground would still not succeed for reasons similar to those discussed with respect to the s. 12(1)(d) grounds; specifically, the major differences between the Opponent's individual marks and the Applicant's Mark make confusion unlikely regardless of the date at which it is assessed.

[47] The s. 16(2)(b) grounds also fail because s. 16(4) requires that applications relied upon be pending as of the advertisement date of the opposed application. As each of the Opponent's marks was registered prior to October 26, 2005, there is no basis for the s. 16(2)(b) grounds of opposition. [*Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528]

[48] The s. 16(2)(c) grounds of opposition fail because that section is dependent on there being a confusingly similar trade-name and no trade-names have been pleaded or evidenced.

[49] For the foregoing reasons, all of the s. 16 grounds of opposition are dismissed.

#### Distinctiveness ground of opposition

[50] Paragraph 9 of the Opponent's amended statement of opposition reads:

9. The Opponent bases its opposition on the grounds as set out in Subsection 38(2)(d), namely that the Applicant's opposed trade-mark is not distinctive within the meaning of Section 2 of the *Act*. That is, the Applicant's subject trade-mark does not distinguish, and is neither adapted to distinguish, from the wares of others and more particularly from the wares of the Opponent's, as described as part of the list of the Opponent's registered trade-marks in Canada in para. 7(a) herein.

[51] The Opponent is essentially pleading that the Mark is not distinctive because it is confusing with the Opponent's marks. The date to assess confusion under this ground is the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]. However, an assessment of the likelihood of confusion as of such date does not

differ significantly from my assessment of the likelihood of confusion as of today's date pursuant to s. 12(1)(d). For reasons similar to those discussed with respect to the s. 12(1)(d) grounds, specifically, the major differences between the Opponent's individual marks and the Applicant's Mark, I find that confusion is not likely as of any date.

[52] The distinctiveness ground of opposition is accordingly dismissed.

#### Section 30(d) ground of opposition

[53] Paragraph 4 of the Opponent's amended statement of opposition reads:

4. The Opponent bases its opposition on the grounds as set out in Subsection 38(2)(a) namely, that the Application was not filed in compliance with Subsection 30(d). The Application does not comply with the requirements of Subsection 30(d) since:

- (a) the Applicant failed to comply with Subsection 31(1) of the *Act* because the Applicant did not file a copy of the corresponding foreign registration certificate certified by the Office in which it was made;
- (b) the Applicant failed to comply with Subsection 31(1) of the *Act* because the English translation of the document filed by the Applicant does not include information appearing in the German language and thus does not establish fully nor set out particulars of the Applicant's trade-mark and the right to registration under the *Act*;
- (c) the Applicant failed to comply with Subsection 31(1) of the *Act* since it has not used nor duly registered the mark as stated with the wares;
- (d) the Applicant failed to comply with Subsection 31(1) of the *Act* because the document filed by the Applicant does not originate from the Applicant's country of origin; and
- (e) the Applicant cannot be said to have been satisfied that it was entitled to use the subject mark in Canada in light of the factors mentioned previously.

[54] For ease of reference, I reproduce s. 30(d) of the Act below:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing



...

(d) in the case of a trade-mark that is the subject in or for another country of the Union of a registration or an application for registration by the applicant or the applicant's named predecessor-in-title on which the applicant bases the applicant's right to registration, particulars of the application or registration and, if the trade-mark has neither been used in Canada nor made known in Canada, the name of a country in which the trade-mark has been used by the applicant or the applicant's named predecessor-in-title, if any, in association with each of the general classes of wares or services described in the application;

[55] It is my view that paragraphs 4(a) through (d) do not plead an acceptable ground of opposition. The Act is quite specific about what can and what cannot form a ground of opposition. Section 38(2)(a) of the Act provides that an opposition may be based on an allegation that an application does not conform to the requirements of s. 30. However, while the Opponent refers to s. 30(d) in the preamble of paragraph 4, it goes on to more particularly plead that the Applicant has not complied with s. 31. The Act does not provide that an opposition may be based on an allegation that an application does not comply with s. 31 and s. 30(d) does not incorporate s. 31. Accordingly, for the purposes of an opposition, it matters not whether s. 31 was complied with. Paragraphs 4(a) through (d) therefore do not plead a proper ground of opposition and those portions of the pleading are dismissed.

[56] As an aside, I will add that it appears to me that the Applicant did in fact comply with both s. 30(d) and s. 31. Its application provided the particulars of the application or registration in a Union country on which it based its right to registration. Moreover, its letter of August 5, 2005 stated that it was enclosing a certified copy of the original Liechtenstein registration on which the application was based, together with an English translation thereof, and the enclosed documents appear to be as stated. In addition, I have no reason to doubt the Applicant's claim that it used the Mark in Ukraine. Overall, the Opponent has not provided any evidence that would support a conclusion that s. 30(d) has not been complied with.

[57] The wording of paragraph 4(e) appears to be referring to s. 30(i) of the Act, even though the preamble refers to s. 30(d). In any event, paragraph 4(e) does not support a successful ground of opposition regardless of which part of s. 30 one considers. The specifics pleaded do not

support a claim of non-compliance with s. 30(d). Nor do they support a claim of non-compliance with s. 30(i) because, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] In the present case, the Applicant has provided the statement required by s. 30(i) and there is no evidence of bad faith. Accordingly, paragraph 4 of the pleadings is dismissed in its entirety.

#### Section 30(i) ground of opposition

[58] Paragraph 5 of the Opponent's amended statement of opposition reads:

5. The Opponent bases its opposition on the grounds as set out in Subsection 38(2)(a) namely, that the Application was not filed in compliance with Subsection 30(i). The Application does not comply with the requirements of Subsection 30(i) because the Applicant cannot be satisfied that it is entitled to register the opposed trade-mark since:

- (a) the Applicant adopted its trade-mark when it knew, or ought to have known, that NEMIROVSKAYA or NEMIROFF or both are primarily merely the name or surname of an individual who is living or has died within the preceding thirty years contrary to Subsection 12(1)(a) of the *Act*;
- (b) the Applicant adopted its trade-mark when it knew, or ought to have known, that it was either clearly descriptive or deceptively misdescriptive of the place of origin contrary to Subsection 12(1)(b) of the *Act* since:
  - 1. Luka Nemirovskaya, is in the NEMIROV/YARY region in the Ukraine;
  - 2. the Applicant is located in the NEMIROV/YARY region in the Ukraine.
- (c) the Applicant cannot be said to have been satisfied that it was entitled to register the subject trade-mark in light of para. 4 herein and all the factors mentioned previously.

[59] As stated earlier, a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.*, *supra*] There is no evidence of bad faith in the present case. I will also add that since the

independent s. 12(1)(a) and (b) grounds of opposition have not succeeded, the claims made in paragraphs 5(a) and (b) are without merit.

[60] For the foregoing reasons, the s. 30(i) ground of opposition is dismissed.

Disposition

[61] Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 18th DAY OF AUGUST 2009.

Jill W. Bradbury  
Member  
Trade-marks Opposition Board