

**IN THE MATTER OF AN OPPOSITION by
Tradall S.A. to Application No. 1083924 for the
Trade-mark MARTINI MASSAGE & Design
filed by Martini S.p.A.**

I The Pleadings

On November 22, 2000, Martini S.p.A. (the “Applicant”) filed an application to register the trade-mark MARTINI MASSAGE & Design as illustrated hereinafter:



(the “Mark”), application number 1083924, in association with hand-operated massage apparatus, namely massage gloves and massage brushes; massage accessories in wood or in plastic, namely massage brushes; massage strip; sponges, cleaning gloves, massage brushes, make-up applicators, namely small sponges, paint brushes for make-up; hair combs and brushes in wood or in plastic, face powder and foundation cream puffs and sponges. (the “Wares”).

The application is based on proposed use and the Applicant claims a priority date of October 25, 2000 on the basis of an application filed in Italy, its country of origin, application number MI20000C 011745 for the same or substantially the same trade-mark in association with the same kind of wares set out hereinabove. It was advertised on November 6, 2002 in the Trade-marks Journal for opposition purposes.

Tradall S.A. (the “Opponent”) filed on April 7, 2003 a statement of opposition forwarded on May 6, 2003 by the Registrar to the Applicant.

The grounds of opposition can be summarized as follow:

- (1) The application does not comply with the provisions of s. 30 (e) of the *Trade-marks Act* R.S.C. 1985 c. T-13 (the “Act”) in that the Applicant did not have a bona fide intention to use the Mark in Canada in association with the Wares;
- (2) The mark is not registrable pursuant to s. 12(1)(d) of the Act as it is confusing with the following Opponent’s registered trade-marks:

MARTINI FIERO	TMA512391
MARTINI & Design	TMA502486
MARTINI & Rossi & Design	TMA436346
MARTINI SPORTLINE & Belt Design	TMA399681
MARTINI & Design	TMA311312
MARTINI	TMA284026
MARTINI & ROSSI Design	TMA207908
MARTINI & Design	TMA194734
MARTINI & ROSSI	TMA140457
MARTINI & Design	TMA125763
MARTINI & Design	TMA109536
MARTINI & Design	TMA105899
MARTINI & Design	UCA050801
MARTINI & Design	UCA508803
MARTINI & Design	UCA000214
MARTINI	TMDA057478

- (3) The Applicant is not the person entitled to the registration of the Mark, pursuant to the provisions of s. 16(3)(a) of the Act, as at the filing date of the application the Mark was confusing with the Opponent’s registered trade-marks previously used in Canada in association with the wares listed in the certificates of registration for each of the Opponent’s trade-marks;
- (4) For the reasons outlined above, the Mark is not distinctive within the meaning of s. 2 of the Act.

The Applicant filed on May 9, 2003 a counter statement denying all grounds of opposition.

The Opponent filed the affidavits of Mr. Anthony Amato, Ms. Jennifer Galeano and Sheree Smyth while the Applicant filed the affidavit of Ms. Thelma Thibodeau.

Only the Opponent filed written submissions and an oral hearing was held during which both parties made representations.

II Preliminary remarks

The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial onus is met, the Applicant still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [See *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

I shall point out at the outset that none of the allegations contained in the affidavits of Mr. Anthony Amato, Ms. Jennifer Galeano and Sheree Smyth support the first ground of opposition. There is no evidence of material facts that would lead me to conclude that the Applicant did not have a bona fide intention to use the Mark in Canada in association with the Wares when it filed its application. The Opponent argues that the Applicant's evidence supports such ground of opposition. The Opponent's contention is that the catalogues filed in the record are written in a foreign language as are the packaging of some of the Wares. Finally it alleges that there is no evidence of a marketing plan for the Wares in association with the Mark in Canada. Those arguments are ill founded. The application is based on proposed use and there is no obligation for the Applicant to demonstrate use of the Mark in Canada at this stage. If the application is allowed, the Applicant will have to file a declaration of use of the Mark in Canada and pay the registration fees to obtain its registration. For these reasons I dismiss the first ground of opposition.

The critical date to assess the remaining grounds of opposition varies from one ground to another. Thus, evidence relevant to one issue might not be so under a different ground of opposition. However in this case, the parties agree that the difference in the relevant dates would not be a determining factor in its outcome.

The issue of likelihood of confusion is the central concern of all the remaining grounds of opposition. The Opponent is arguing that its trade-mark MARTINI is well known and that it owns a family of trade-marks that gives the Opponent's trade-mark MARTINI a wider scope of protection than normally afforded to trade-marks in general. I shall review the evidence filed by both parties and then analyze the grounds of opposition.

III The Opponent's evidence

Ms. Smyth has been a legal assistant with the Opponent's agents firm and simply filed copies of the Opponent's registrations for the trade-marks cited in its statement of opposition except for MARTINI & Design, certificate of registration TMA109536. All of the aforesaid registrations cover alcoholic beverage, wine or vermouth, except for the following registrations:

MARTINI SPORTLINE & Belt Design TMA399681: Polo shirts, T-shirts, sweaters, shorts and skirts for sportswear, socks and stockings, sweat-bands, caps and hats, bathrobes, swimming-suits, shirts, ties, belts and sports shoes



MARTINI & Design

TMA311312 : Almonds, prepared nuts, hot-dogs, cashew nuts and processed peanuts; preserved olives; preserved onions; cheese, capers, raisins, potato chips and crisps, corn flakes and pop corn



MARTINI

TMA284026 : Pants, jeans, sweaters, blouse, jacket, belts.

Mr. Amato has been the Senior Brand Manager at Bacardi Canada Inc. (“Bacardi”). It would appear that it distributes in Canada the wares covered by the various certificates of registration listed in the statement of opposition and defined in his affidavit as the “MARTINI Products”. There is no evidence of use of the three trade-marks MARTINI SPORTLINE & Belt Design, certificate of registration TMA399681, MARTINI & Design, certificate of registration TMA311312 and MARTINI, certificate of registration TMA284026 in association with any of the wares covered by those registrations.

Mr. Amato does provide in paragraph 7 of his affidavit the total sales figures from 1989 to 2003 “Expressed in 9L Cases” of the MARTINI Products. However such term, as mentioned above, is a defined term covering all the wares listed in the certificates of registration filed by Ms. Smyth. There is obviously a mistake, as one cannot describe the volume of sales of articles of clothing in “cases of 9L”. I shall therefore interpret those figures to refer to the sale of alcoholic beverages, wine and vermouth in association with one of the trade-marks listed in the statement of opposition covering such wares. There is also no breakdown of the volume of sales per trade-mark and thus it is impossible to determine the extent of use of each of the Opponent’s registered trade-marks. Since all of the registered trade-marks covering alcoholic beverages include the word MARTINI, I shall treat the Opponent’s evidence as use of the word trade-mark MARTINI.

Mr. Amato lists the sums of money spent since 1995 to promote, advertise and market the MARTINI Products. Again the sample packaging and advertising filed in support of such allegation only concern alcoholic beverages, wine or vermouth. There is no evidence of advertisement, marketing or promotional material related to other types of wares except for what is described hereinafter.

Mr. Amato alleges that the Opponent licensed others to manufacture and distribute for sale in Canada merchandise bearing one of the MARTINI trade-marks. Such merchandise would include stickers, umbrellas, key rings, chronographs, posters, mirrors, metal signs, chalkboards, stirrers, shakers, ash trays, water trays, table tents, trays, napkin holders, menu holders, ice buckets, glass bowls, tumblers and glassware. There is no evidence of a single sale of any of these products and therefore there is no evidence of use, as defined in s. 4(1) of the Act, of any of

the Opponent's registered trade-marks listed above or of the word mark MARTINI in association with wares other than alcoholic beverages. In fact in paragraph 11 of his affidavit, Mr. Amato states that Bacardi "regularly distributes MARTINI Merchandise for consumer promotions and golf tournaments..." This statement falls short from establishing "use" of any of the Opponent's trade-marks, within the legal sense of the word, in association with wares other than alcoholic beverages. There are "photographs" of merchandise other than alcoholic beverages annexed to his affidavit. However they appear to be extracts of a catalogue. In any event photographs or extracts of a catalogue *per se* do not constitute proper evidence of use of a trade-mark in the absence of evidence of sales of those products. Moreover we have no indication on the volume of sales and since when each of these products have been sold. There is a general statement that the illustrated merchandise would be representative of the use of the MARTINI trade-marks since at least as early as 1995. In the absence of satisfactory documentary evidence, I cannot conclude that any of the Opponent's trade-marks has been used in Canada in association with products other than alcoholic beverages.

Ms. Galeano was, at the time of execution of her affidavit, a student-at-law with the Opponent's agent firm. She filed various excerpts of the website located at www.martini.com. We have no proof that such website is the Opponent's website. Assuming that it is the case, the evidence filed by Ms. Galeano constitutes hearsay evidence in so far as the content of the excerpts filed are concerned. On this issue I refer to the following analysis made by Mr. Justice Slatter of the Alberta Court of Queen's Bench in *Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446:

The fact that this information was printed off the internet does not directly affect its admissibility. There is no particular magic in information obtained on the internet. If the basic information would be admissible under some other rule of evidence, the fact that it comes off the internet is not determinative. For example, the courts routinely take judicial notice of encyclopedias and dictionaries, which are now frequently found in electronic format. The admissibility of this information does not change because of its source. On the other hand, the mere fact that something is publicly available and readily producible from the internet does not make it admissible. Such evidence must still pass the normal tests for evidence, including the hearsay rule and the opinion evidence rule. Of course, if the information is merely tendered to show that certain information was known to the public, or for a purpose other than the truth of its contents (for example in a defamation case), then the information would be

admissible: *ITV Technologies Inc. v. WIC Television Ltd.*, [2003] F.C. 1056, 239 F.T.R. 203 (F.C.) at para. 23.

The question to ask is whether the information, if it had been obtained from some other source, would be admissible. For example, if the Minority Shareholders had tendered the annual report of this competitor, would it have been admissible? The answer is clearly that it would not. The annual report itself would be hearsay, and it could only be admitted if somebody from the company could testify as to the truth of its contents. The financial statements could only be proven in a similar way. Furthermore, the attempt to use the salary paid by the competitor as a benchmark for the proper salary to be paid to Chief Executive Officer of Envirodrive Inc. appears to be an attempt to use a type of similar fact evidence. This type of evidence calls out for cross-examination to test if it really has any probative value. Alternatively, it is an attempt to introduce opinion evidence indirectly. The internet evidence tendered was accordingly not admitted.

IV The Applicant's evidence

We have no information as to the status of Ms. Thelma Thibodeau. She filed extracts of the Applicant's website. In the absence of information on her relationship with the Applicant I consider such evidence to be hearsay evidence for the same reasons outlined in my analysis of similar evidence contained in Ms. Galeano's affidavit.

She also filed two catalogues of the Applicant's products, publicity pamphlets allegedly used by the Applicant and various labels bearing the Mark that she received from the Applicant. It is apparent from the content of paragraph 5 of her affidavit that she is not a representative of the Applicant. Therefore these documents, in so far as their content is concerned, constitute inadmissible hearsay evidence and I shall disregard them. Moreover we have no confirmation that this material was ever used in Canada and if so since when.

V Assessment of the likelihood of confusion

I shall assess the likelihood of confusion between the Mark and the trade-mark MARTINI. For the purpose of this analysis I will treat the trade-mark MARTINI as a well-known trade-mark in the area of alcoholic beverages only as the evidence described above permit me to reach such conclusion. There is no evidence of use of the trade-mark MARTINI in other areas than alcoholic beverages. In any event, should I be wrong in reaching such conclusion, the

promotional items illustrated in exhibit C to Mr. Amato's affidavit, are for the most part accessories to alcoholic beverages or accessories that you would find in a bar or on a terrace where one would order a drink, such as glasses, ashtrays, posters, stirrer, table tent, umbrellas, waiter tray to name a few. There is also a watch and a key-ring but, as concluded earlier, there is no evidence in the record of a single sale in Canada of such items.

Recently the Supreme Court of Canada in *Mattel, Inc. v. 3894207 Canada Inc.*, (2006) 49 C.P.R. (4th) 321 discussed the test of confusion set out in s. 6(2) of the Act and how the relevant criteria should be analysed when dealing with a famous trade-mark. However the principles set out in *Mattel* would be applicable to well-known trade-marks in so far as how to consider the criteria listed under s. 6(5) of the Act. I may add that the conclusion of my analysis of these criteria would not differ if I had concluded that the trade-mark MARTINI is famous.

It is obvious that if a trade-mark is well known it will be recognized by the consumers. For example, in the case of the trade-mark BARBIE, the average consumer would associate such trade-mark with dolls and its accessories. Likewise, the average consumer will associate MARTINI with alcoholic beverages. However the question to be resolved is: would the average consumer create a link or an association between the Wares and the Opponent. Therefore the fact that instinctively a consumer first immediate reaction when he sees the word MARTINI alone is to associate that word with alcoholic beverages is not the appropriate test to determine the likelihood of confusion. The Applicant must satisfy the Registrar, on a balance of probabilities, that the average consumer seeing the Wares bearing the Mark would not think that the Opponent is the source of the Wares.

The surrounding circumstances to be considered include: i) the inherent distinctiveness of the trade-marks or trade names and the extent to which they have become known; ii) the length of time the trade-marks or trade-names have been in use; iii) the nature of the wares, services, or business; iv) the nature of the trade; and v) the degree of resemblance between the trade-marks or trade names in appearance or sound or in the ideas suggested by them.

The Mark has some degree of inherent distinctiveness. However the word “massage” is descriptive of the use of the Wares to be sold in association with the Mark. There is a design feature that serves to enhance the distinctiveness of the Mark. The Applicant argued at the oral hearing that MARTINI is the name of an individual and therefore should have a low degree of inherent distinctiveness. To support such contention, it referred solely to a label filed as Exhibit A to Mr. Amato’s affidavit. On such label there is the following text:

“In 1863 a company was founded in Turin by Alessandro Martini and...”

There is very little evidence that MARTINI is a surname or family name. In any event the evidence summarized above does show use of the trade-mark MARTINI in association with alcoholic beverages since at least 1989. Therefore I do not accept the Applicant’s contention that it should have a low degree of inherent distinctiveness. This factor favours the Opponent.

There is no connection whatsoever between alcoholic beverages and the Wares. I make the same conclusion when comparing the Wares to articles of clothing or food items covered by registrations TMA284026 and TMA311312. This circumstance does favour the Applicant.

There has been no evidence of the Applicant’s channels of trade for the Wares. Because of the dissimilarities between the Wares and the products listed under the various certificates of registration of the Opponent’s trade-marks, it is reasonable to conclude that the Wares would circulate through different channels of trade than those used by the Opponent. This factor also favours the Applicant.

The Mark includes the totality of the Opponent’s trade-mark MARTINI. It is the first word of the Mark and such portion has been considered in the past as an important factor to be considered. The idea suggested by the Mark differs with the addition of the word “MASSAGE” as the Mark will automatically be associated with such activity. MARTINI alone being a coined word does not suggest anything in particular, save and except its connection with alcoholic beverages because of its extensive use as discussed above. I conclude that this factor favours the Opponent because of the resemblance in sound of the trade-marks in issue.

As an additional surrounding circumstance the Opponent would like the Registrar to consider that its trade-mark MARTINI is well known to Canadians and as such its scope of protection is broader. I already stated that the evidence filed allows me to conclude that the trade-mark MARTINI is well-known to Canadians. However as mentioned earlier its notoriety is with respect to alcoholic beverages. The issue of the scope of protection to be given to famous marks has been discussed in *Mattel* supra, Mr. Justice Binnie made the following comments:

In opposition proceedings, trade-mark law *will* afford protection that transcends the traditional product lines unless the applicant shows the likelihood that registration of its mark will *not* create confusion in the marketplace within the meaning of s. 6 of the *Trade-Marks Act*. Confusion is a defined term, and s. 6(2) requires the Trade-marks Opposition Board (and ultimately the court) to address the *likelihood* that in areas where both trade-marks are used, prospective purchasers will infer (incorrectly) that the wares and services - though not being of the same general class - are nevertheless supplied by the same person. Such a mistaken inference can only be drawn here, of course, if a link or association is likely to arise in the consumer's mind between the source of the well-known BARBIE products and the source of the respondent's less well-known restaurants. If there is no likelihood of a link, there can be no likelihood of a mistaken inference, and thus no confusion within the meaning of the Act. (My underline)

(...)

No doubt some famous brands possess protean power (it was submitted, for example, the distinctive red and white "*Virgin*" trade-mark has now been used in connection with such a diversity of wares and services that it knows virtually no bounds), but other famous marks are clearly product specific. "*Apple*" is said to be a well-known trade-mark associated in separate markets simultaneously with computers, a record label and automobile glass. The Board's conclusion that BARBIE's fame is limited to dolls and dolls' accessories does not at all mean that BARBIE's aura cannot transcend those products, but whether it is likely to do so or not in the context of opposition proceedings in relation to restaurant, catering and banquet services is a question of fact that depends on "all the surrounding circumstances" (s. 6(5)). Neither the "*Virgin*" nor "*Apple*" situations are before us and I make no pronouncement on either except to note them as illustrations that surfaced in the course of argument. (My underline)

(...)

Trade-mark confusion is a term defined in s. 6(2) and arises if it is likely in *all* the surrounding circumstances (6(5)) that the prospective purchaser will be led to the mistaken 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.]

This is not to say the nature of the wares or services is irrelevant. Section 6(5) specifically identifies "the nature of the wares, services or business" as a relevant consideration. The point of the underlined words in s. 6(2) is simply to lay it down in

clear terms that the general class of wares and services, while relevant, is not controlling.

(...)

If the result of the use of the new mark would be to introduce confusion into the marketplace, it should not be accepted for registration "whether or not the wares or services are of the same general class" (s. 6(2)). The relevant point about famous marks is that fame *is* capable of carrying the mark across product lines where lesser marks would be circumscribed to their traditional wares or services. The correct test is that which Linden J.A. earlier stated at para. 33:

The totality of the circumstances will dictate how each consideration should be treated.

(...)

The point, I think, is that the law of trade-marks is based on use. In an earlier era it was not possible to register a "proposed" use. Here, expansion of the BARBIE mark is more than just speculation, but if the BARBIE mark is not famous for anything but dolls and doll accessories in the area where both marks are used and there is no evidence that BARBIE's licensees, whoever they may be, are in the marketplace using the BARBIE mark for "restaurant services, take-out services, catering and banquet services", it is difficult to see the basis on which the mistaken inference is likely to be drawn.

(...)

No doubt, as an abstract proposition, the appellant's mark is "famous" whereas the respondent's applied-for mark is not. The question, however, is whether there will likely be (or has been) confusion in the marketplace where both may operate.

I shall apply the same reasoning to the case at bar even though I am dealing with a well known trade-mark as opposed to a famous mark. The evidence in the record does not enable me to conclude that there is a widespread use of the Opponent's trade-mark MARTINI outside the sphere of alcoholic beverages. Therefore the consumer is not accustomed to see wares bearing the trade-mark MARTINI other than alcoholic beverages or its accessories. Therefore a consumer seeing one of the Wares bearing the Mark would not likely associate the Wares with the Opponent as to their source of origin.

The Opponent has argued that it owns a family of trade-marks. However, the Opponent did not establish use of each trade-mark part of the alleged family of trade-marks. Consequently it cannot rely on the argument that it is the owner of a family of registered trade-marks having as a component the word MARTINI. Mr. Justice Cattanach in *McDonald's Corporation et al. v. Yogi Yogurt Ltd. et al.* (1982), 66 C.P.R. (2d) 101 (F.C.T.D.) stated at page 114:

“While the presumption of the existence of a series of trade marks can arise at the time of an application for the registration of a trade mark with the consequence indicated the same presumption does not arise in opposition proceedings. Before any similar inference as would arise from the presumption can arise in the opposition proceedings based upon the use of other marks any such use must be established by evidence.

The question therefore is whether the appellants have discharged the onus cast upon them of establishing the existence of a series of marks owned by the corporate appellant with which the application by the corporate respondent for the registration of the trade mark MCYOGURT may conflict. That is to be discharged by the establishment of the use of the trade marks sufficient to constitute a family.” (My underlines)

Accordingly I conclude on a balance of probabilities that a consumer seeing the Wares bearing the Mark would not think that they originate from the Opponent in view of the difference in the parties respective wares and their channels of trade.

VI Conclusion

Having concluded the absence of a likelihood of confusion between the Mark and the Opponent’s trade-mark MARTINI, I dismiss the second, third and fourth grounds of opposition.

Therefore, having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I dismiss the Opponent’s opposition to the registration of the Mark, the whole pursuant to s. 38(8) of the Act.

DATED IN BOUCHERVILLE, QUEBEC, THIS 5th DAY OF MARCH 2007.

Jean Carrière,
Member,
Trade-marks Opposition Board