

IN THE MATTER OF AN OPPOSITION by Institut National des
Appellations d'Origine to application No. 563,018 for the trade-mark
BORDEAUX filed by Pepperidge Farm, Incorporated

On May 21, 1986, the applicant, Pepperidge Farm, Incorporated, filed an application to register the trade-mark **BORDEAUX** based on use and registration in the U.S. The application covers the following wares: cookies. The application was advertised for opposition purposes in the Trade-Marks Journal of January 12, 1994.

The opponent, Institut National des Appellations d'Origine (hereinafter "INAO"), filed a statement of opposition on March 11, 1994. The opponent was subsequently granted leave to amend its statement of opposition on August 31, 1994.

The first ground of opposition is that the trade-mark is not registrable pursuant to the provisions of ss.9(1)(d) and 12(1)(e) of the *Trade-Marks Act*, R.S.C. 1985 c.T-13 (hereinafter the *Act*) because it is likely to lead to the belief that the wares in association with which it is used have received, or are produced or sold under, the approval or authority of the government of France. As its second ground of opposition, the opponent submits that the trade-mark is not registrable pursuant to the provisions of ss. 10 and 12(1)(e) of the *Act* in that it consists of the appellation of origin Bordeaux which by ordinary and 'bona fide' commercial usage has become recognized in Canada as designating the kind, quality and place of origin of Bordeaux wine. The opponent alleges as its third ground of opposition that the trade-mark is not distinctive in that it is not adapted to distinguish the wares in association with which it is alleged to have been used by its owner from wares entitled to be used with the appellation of origin Bordeaux. On the contrary, the opponent pleads that its use is calculated to give rise to confusion and deception, and to misappropriate the reputation and goodwill of the appellation of origin Bordeaux. The fourth ground of opposition is that the applied for trade-mark is not registrable in view of the provisions of s.12(1)(b) of the *Act*. In this regard, the opponent has argued that the applicant's mark, as written or sounded, is deceptively misdescriptive in the English and French languages of the character and quality of the wares in association with which it is used, and of their place of origin, in that it deceptively connotes a product having the characteristics, qualities and place of origin of wine produced in the Bordeaux district of France. As its fifth ground of opposition the opponent submits that the application does not comply with the provisions of Section 30(i) of the *Act*. In support of this ground the opponent has alleged that the applicant could not have been satisfied that it was entitled to use its mark in Canada because such use would be unlawful under the provisions of several federal statutes including ss. 7(b) and (d) of the *Trade-Marks Act*, Section 52 of the *Competition Act*, Section 5 of the *Food and Drugs Act* and Section 7 of the

The applicant filed and served a counter statement on June 1, 1994, in which it denied the allegations asserted by the opponent in its statement of opposition. The applicant was subsequently granted leave to amend its counter statement on October 31, 1994. As its evidence, the opponent filed the affidavits of Elliott S. Simcoe, David L. McCormack, A. David Morrow, and Pascale Patte-Connan. Two affidavits of Anne Grosheitsch-Donnelly as well as the affidavits of Carol Luciani, Barbara Gallagher, Generosa Castiglione and Charles Platt were submitted as the applicant's evidence. Both the opponent and the applicant filed written arguments and both were represented at an oral hearing.

As a preliminary matter, a ruling was made at the oral hearing regarding whether an agent who has sworn an affidavit on behalf of his client can also act on behalf of his client at the oral hearing. Both parties' submissions on this matter were considered. In deciding this issue, I considered the following findings made by the Chairman of the Opposition Board in a ruling dated January 22, 1982, regarding the trade-marks NHL & Design and NATIONAL HOCKEY LEAGUE (Application Nos. 315,116 and 315,118):

“While the rules of evidence of the Federal Court may well be applicable to opposition proceedings, the matter of the propriety of a lawyer representing a client in court putting his personal credibility in issue by testifying as a witness on behalf of his client is not a rule of law, but rather is a matter of legal ethics and as such, can not be applied as a rule of evidence (see Major v. Higgins (1932), 53 Que. K.B., cited by Cartwright J. in Stanley v. Douglas, [1952] S.C.R. 260 at page 274).”

In view of Mr. Partington's findings, and also having regard to the Opposition Board decision in *Champagne Moët & Chandon v. Ridout Wines Ltd.* (1983), 77 C.P.R. (2d) 63 at 67-68, I concluded at the oral hearing that the Registrar of Trade-Marks in an opposition proceeding does not have any jurisdiction to exclude a registered trade-mark agent from acting on behalf of his client where the agent has put in evidence on behalf of his client in the opposition. Accordingly, I decided that the Morrow affidavit would be considered as part of the opponent's evidence in this opposition proceeding.

The evidence of the opponent can be summarized as follows. The dictionary, encyclopaedia, and other publications evidenced by the Simcoe affidavit clearly show that Bordeaux is a well known wine growing region of France, although these excerpts also show that the term Bordeaux is capable of other meanings including a type of colour and as a copper sulphate mixture for fungicides. The opponent's evidence also shows that because the term

Bordeaux has been designated by the French government as an appellation of origin, the origin and characteristics of Bordeaux wines are strictly controlled under French law. Bordeaux wines have been available in Canada since at least as early as 1972 and are known in Canada as one of the best known appellations of origin because of the excellent reputation these wines have earned for quality (see MacCormack affidavit, paras. 6 & 9). Evidence of the exportation of Bordeaux wines to Canada and an explanation about the labelling practices of wines emanating from the Bordeaux growing region was provided in the Morrow affidavit.

In her affidavit at paragraph 6, Ms. Patte-Connan states that of the approximately \$1.2 - \$1.36 million dollars spent on promoting French wines and spirits in Canada, about 50% is spent promoting Bordeaux wines. At paragraph 9 of her affidavit, she testifies that articles written about Bordeaux wines have been published in numerous Canadian newspapers and magazines and have acquired notoriety, reputation and goodwill. The opponent submits that the Patte-Connan affidavit also provides evidence of Canadian sales and market share of Bordeaux wines. However, I find that the Patte-Connan affidavit is deficient in this respect. Ms. Patte-Connan identifies herself as vice-president of the Canadian office of SOPEXA (la Société pour l'Expansion des Ventes de Produits Agricoles et Alimentaires). Although she attaches as Exhibit PPC-2 a table summarizing sales and market share of Bordeaux wines in Canada for 1990-1993, Ms. Patte-Connan states in her affidavit at paragraph 10 that the figures in this table were compiled from statistics furnished by L'Institut Canadian du Vin. As I do not consider this information to have been within Ms. Patte-Connan's personal knowledge, I consider this part of her evidence to be hearsay. As the opponent's agent did not provide submissions about the reliability of this hearsay evidence nor any explanation as to why it was necessary to include this information as evidence, I am not prepared to give this part of Ms. Patte-Connan's evidence much weight. I further note that included in the opponent's evidence was a collection of articles about Bordeaux wines and promotional materials for Bordeaux wines, some of which appear to be SOPEXA publications. However, as this collection of materials was not identified in the Patte-Connan affidavit, nor properly attached or sworn as exhibits, I am not prepared to give any weight to it.

Before I begin my analysis, I would like to point out that there are many Canadian cases that have considered issues similar to those listed above between an appellation of origin for wines or other alcoholic beverages and a similar trade-mark used in association with wines or other alcoholic beverages. The present case can be distinguished from these cases, however, as it may be the first of its kind in Canada to involve an appellation of origin for wines and an applied

for mark (that is identical to the appellation of origin) to be used in association with a product that is not related to wine or other alcoholic beverages. In situations such as this, it may be helpful to have regard to analogous cases in other jurisdictions. As the opponent pointed out, the English Court of Appeal had the opportunity in a passing off case to consider the issue of confusion between an appellation of origin used in association with an alcoholic beverage and a similar trade-mark used in association with a ware that is not related to wine or alcohol (see *Taittinger v. Allbev Ltd.* (1993), [1994] 4 All E.R. 75 (hereinafter *Taittinger*)). In *Taittinger*, the court found, *inter alia*, a likelihood of confusion between the appellants' Champagne appellation of origin and the respondents' ELDERFLOWER CHAMPAGNE mark used in association with a non-alcoholic beverage. In my view, this case can be distinguished from the present case on its facts because it considered wares that are more closely related (wine and non-alcoholic beverages) than those in the present case (wine and cookies). As I consider this case to be of little relevance, I will not be referring to it in my decision.

Central to most of the opponent's grounds of opposition is its contention that it is well known in Canada that Bordeaux is a city and region in France; that the term Bordeaux is an appellation of origin for wine, serving to distinguish wine produced in the Bordeaux region of France from those produced elsewhere; that the appellation of origin Bordeaux is famous as designating what is generally considered a wine of excellent quality, and as such, has an extensive and favourable reputation and goodwill in Canada; that the appellation of origin Bordeaux is protected by Canadian law; that the applicant's trade-mark is calculated to attract and benefit from the reputation and goodwill attaching to the appellation of origin of Bordeaux in Canada and that broad protection accorded to famous trade-marks should equally be accorded to "famous appellations of origin" such as Bordeaux.

The opponent has not obtained a Canadian registration for Bordeaux as a trade-mark or a certification mark. However, the opponent's evidence establishes that the French government has designated the term Bordeaux as an appellation of origin for French wines. Appellations of origin function much like certification marks under our *Act* and have been characterized as such by analogy (see *Chateau-Gai v. INAO* (1974), 14 C.P.R. (2d) 1 at pp. 11-12, 15 (S.C.C.); *INAO v. Bright* (1987), 14 C.P.R. (3d) 197 at 202 (T.M.O.B.)).

The first ground of opposition is based on the provisions of Sections 9(1)(d) and 12(1)(e) of the *Act*. Section 9(1)(d) of the *Act* states the following:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for,...

(d) any word or symbol likely to lead to the belief that the wares or services in association with which it is used have received, or are produced, sold or performed under, royal, vice-regal or government patronage, approval or authority;...

The material time respecting the first ground is the date of my decision (see *Allied Corporation v. Canadian Olympic Association* (1989), 28 C.P.R. (3d) 161 (F.C.A.)).

The first issue raised with respect to Section 9(1)(d) of the *Act* is whether the provisions of the sub-section relate to foreign governments or whether the governmental patronage, approval or authority referred to in this paragraph refer strictly to Canadian federal, provincial or municipal governments. The agent for the opponent submitted that if the *Act* intended to restrict the provision of para. (1)(d) to the government of Canada, it would have stated so (as it did in other provisions under s.9). The Chairman of the Opposition Board had the opportunity to consider this issue in *United States Government v. Amada Co. Ltd.* (1983), 75 C.P.R.(2d) 228 wherein he stated the following at page 230-231:

“Initially, I would note that there are no provisions under the Convention of the Union of Paris which point to any international obligation on the part of Canada to provide such broad protection to foreign governments, as contrasted to the specific provisions contained in para. 9(1)(i) of the Act. Further, I would speculate that the absence of specific reference to either domestic (whether federal, provincial or municipal) or foreign governments in para. 9(1)(d) was intentional in that the subparagraph may have been intended to prohibit the adoption of any word or symbol which, depending upon the nature of wares or services in association with which the term might be used, might be associated with a governmental body, thereby precluding as trade-marks such terms as “Government House”, “Parliament Hill”, “House of Commons”, or the like. In any event, the parties failed to bring to my attention any relevant jurisprudence which may have been of assistance in considering the opponent’s first ground of opposition and I have been unable to find any case law relating to the interpretation of para. 9(1)(d). As a result, and in view of the comments noted above, I have rejected the opponent’s first ground of opposition in that I do not consider that para. 9(1)(d) of the Act was intended to, nor do I consider that it does, accord protection to foreign governments such as the opponent.”

Mr. Partington’s approach was subsequently followed in *Government of Spain v. T.G. Bright & Co., Limited* (1987), 16 C.P.R.(3d) 308 (T.M.O.B.) and *Institut National des Appellations D’Origine v. Brick Brewing Co., Ltd.* (1995), 66 C.P.R. (3d) 351(T.M.O.B.) (hereinafter *Brick Brewing*). As the opponent failed to bring to my attention any new jurisprudence which may have been of assistance in considering this ground of opposition, I agree with Mr. Partington’s conclusions that the provisions of Section 9(1)(d) of the *Act* do not accord protection to foreign governments.

Even if I were to assume that s.9(1)(d) does extend protection to foreign governments and is therefore applicable in the present case, I would not have been satisfied that the opponent had

met the evidential burden upon it to support its argument. In this regard, the opponent failed to show that the average consumer: 1) knows that the INAO is a French government body; 2) is aware that Bordeaux wines are produced, sold or performed under the INAO; and 3) may be led to the belief that the applicant's **BORDEAUX** cookies have received or are produced, sold or performed under the approval or authority of the INAO. Consequently, the first ground of opposition is unsuccessful.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(e) of the *Act* because it contravenes Section 10 of the *Act* which reads as follows:

Where any mark has by ordinary and 'bona fide' commercial usage become recognized in Canada as designating the kind, quality, quantity, destination, value, place of origin or date of production **of any wares** or services, no person shall adopt it as a trademark **in association with such wares or services or others of the same general class** or use it in a way likely to mislead, nor shall any person so adopt or so use any mark so nearly resembling that mark as to be likely to be mistaken therefor (emphasis mine).

The relevant date for determining the "ordinary and bona fide commercial usage" of the mark for the purposes of Section 10 would appear to be the date of my decision (see *Olympus Optical Company Ltd. v. Canadian Olympic Association - Association Olympique Canadienne* (1991), 38 C.P.R. (3d) 1 at 3-4 (F.C.A.)). The three specific prohibitions in Section 10 to consider, as set out in *Brick Brewing, supra*, at pp.358-359, are as follows: 1) no one shall adopt the prohibited mark as a trade-mark; 2) no one is to use the prohibited mark in a way likely to mislead; and 3) no person shall adopt or use a mark so nearly resembling as to be likely to be mistaken for the opponent's mark.

In the present case, some of the opponent's evidence establishes that the term Bordeaux has by ordinary and 'bona fide' commercial usage become recognized in Canada as designating **a type of wine** originating in France. However, although the applicant's **BORDEAUX** trade-mark is identical to the opponent's appellation of origin Bordeaux, I do not consider that the applicant's use of the mark would be use in a way likely to mislead. In my view, cookies and wine do not fall within the same class. Even if they did, I would not consider that use of **BORDEAUX** on cookies would be **likely to mislead** customers into thinking there is a connection with Bordeaux wines. Consequently, this ground of opposition is unsuccessful.

As for the third ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.*

(1985), 4 C.P.R.(3d) 272 (T.M.O.B.). As stated above, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (*i.e.* March 11, 1994): see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness.

As discussed, I agree with the opponent's submission that Bordeaux wines are extremely well-known, if not famous, in Canada and enjoy a reputation as wines of high quality. The issue is, however, whether consumers would associate **BORDEAUX** for cookies with a particular geographic source (*i.e.* Bordeaux, France) or as a trade-mark of the applicant. Some of the opponent's evidence shows that consumers may associate Bordeaux with Bordeaux, France, although some of the evidence may equally be consistent with Bordeaux functioning simply as the name of a type of wine (see for example the Ontario Liquor Store Price List attached as exhibit 8 to the McCormack affidavit) or having other meanings (see the Simcoe affidavit). Further, recent amendments to the *Trade-Marks Act* provide that the term Bordeaux is considered generic for wines in Canada.¹ The heading found in section 11.18(3) of the *Act* refers to a list of wines as being "Exceptions for generic names for wines." Section 11.18(3) of the *Act* reads as follows:

"Exceptions for generic names for wines - Notwithstanding sections 11.4 and 11.5 and paragraphs 12(1)(g) and (h), nothing in any of those provisions prevents the adoption, use or registration as a trade-mark or otherwise, in connection with a business, of the following indications in respect of wines:

...
(m) Bordeaux

In my view, if the term Bordeaux is considered by the *Act* as a generic term and not a "geographic indication" for wines in Canada, it is unlikely that the term Bordeaux would be recognized as a geographical source for cookies. Further, I agree with the applicant's submission that although famous marks may be entitled to a broad ambit of protection, the same does not apply to generic terms, such as Bordeaux for wines.

In evaluating the distinctiveness of the applicant's mark, I have also considered the applicant's extensive use of **BORDEAUX** cookies in the United States for the past 40 years. At

¹ I note in passing that the amendments to the *Act* were assented to on December 15, 1994, although they did not come into force until January 1, 1996. This to me indicates that the term Bordeaux was considered generic as of December 15, 1994 and presumably some time before that assuming that the amendments encoded what must have been a matter of fact at that time.

paragraph 8 of his affidavit, Mr. Platt states that the **BORDEAUX** brand of cookies is part of a line up of premium cookies (including brands such as CHANTILLY, BRUSSELS/BRUXELLES, GENEVA, MONACO, SAUSALITO and CHESAPEAKE) sold by the applicant in Canada and the United States. Mr. Platt further states that **BORDEAUX** cookies have been sold in the United States since at least December 12, 1955, with annual sales ranging between \$1,300,000 and \$4,006,000 during the years 1978-1995. Finally, Mr. Platt testifies that at no time during the 40 years the applicant has sold the **BORDEAUX** brand of cookie in the U.S. did anyone inquire as to any connection between **BORDEAUX** brand of cookie and Bordeaux wines, or express confusion regarding whether **BORDEAUX** cookies consist of or include Bordeaux wines.

The opponent submits that the absence of any instances of confusion between the applicant's mark and the opponent's mark is not relevant as there is no evidence of the significance of the appellation of origin Bordeaux in the U.S. At the same time, however, it is the opponent's submission that Bordeaux has an **international** reputation indicating wines emanating from France (see McCormack affidavit, para. 6). Presumably, the international reputation of Bordeaux would extend to the United States. It follows that if both the applicant's mark and the opponent's appellation of origin co-existed in the United States, in a market presumably similar to our own, there would be some instances of mistake or confusion. However, as the opponent did not file any evidence in this regard, I consider that the absence of confusion between the opponent's appellation of origin and the applicant's mark is a relevant circumstance weighing in the applicant's favour. In considering this issue, I had regard to the decisions in *Endo Laboratories Inc. v. Dow Chemical Co.* (1972), 8 C.P.R. (2d) 149 at 154 (F.C.T.D.); *Sun-Maid Growers of California v. Williams and Humbert Ltd.* (1981), 54 C.P.R. (2d) 41 at 49 (F.C.T.D.) and *McDonald's Corp. v. Alberto-Culver Co.* (1995), 61 C.P.R. (3d) 382 at 397 (T.M.O.B.).

Having regard to the above, and in particular the fact that: 1) Bordeaux is considered by the *Act* to be a non-distinctive term for wines in Canada; 2) the term Bordeaux is capable of other meanings; and 3) there is little if any likelihood that a consumer who is aware that Bordeaux signifies a wine originating from a particular region of France would consider that **BORDEAUX** cookies are somehow associated with Bordeaux, France, I am satisfied that the applicant's mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada. This ground of opposition is therefore unsuccessful.

The opponent's fourth ground of opposition is that the applicant's mark is clearly

descriptive or deceptively misdescriptive of the character or quality or place of origin of the wares. In its written argument, the applicant submitted that the s.12(1)(b) ground was irrelevant since the Examiner had accepted the applicant's Section 14 claim. Further, the applicant argued that because the opponent had not challenged the Section 14 claim, that claim is not in issue in this opposition. I respectfully disagree with the applicant on these submissions. Having regard to the decision of Mr. Justice Strayer in *Molson Breweries v. Canada (Registrar of Trade-Marks)* (1992), 41 C.P.R. (3d) 234 (F.C.T.D.) and the opposition decision in *Toronto Salt & Chemicals Ltd. v. Softsoap Enterprises Inc.* (1993), 50 C.P.R. (3d) 549 (T.M.O.B.), I consider that since the opponent has raised a s.12(1)(b) ground of opposition, the onus is on the applicant to show that its mark does not offend s.12(1)(b) of the *Act* or, if it does, it falls within the exception provided in s.14 of the *Act*.

Section 12(1)(b) of the *Act* reads as follows:

12. (1) Subject to section 13, a trademark is registrable if it is not...

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin...

The material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) is the date of my decision: see the decision in *Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers* (1992), 41 C.P.R.(3d) 243 (F.C.A.). Further, the issue is to be determined from the point of view of an everyday user of the wares. Finally, the trade-mark in question must not be carefully analysed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see *Wool Bureau of Canada Ltd. v. Registrar of Trade Marks* (1978), 40 C.P.R.(2d) 25 at 27-28 and *Atlantic Promotions Inc. v. Registrar of Trade Marks* (1984), 2 C.P.R.(3d) 183 at 186 (hereinafter *Atlantic Promotions*).

Whether a trade-mark is deceptively misdescriptive is a question of fact. The proper test to be applied when assessing whether a trade-mark is deceptively misdescriptive of wares emanating from a particular geographical origin was stated in *Atlantic Promotions, supra*, at 186 as follows:

"...the proper test to be applied to the determination as to whether a trade-mark in its entirety is deceptively misdescriptive must be whether the general public in Canada would be misled into the belief that the product with which the trade-mark is associated had its origin in the place of a geographic name in the trade-mark."

Mr. Justice Cattnach went on to state that if a geographical name is attached to wares made in

that geographical region, it is “clearly descriptive of the origin”. If the wares are not made there then the word is misdescriptive and may be deceptively so depending on the circumstances.

In the present case, the applicant’s cookies are not made in Bordeaux, France. The issue under this ground, therefore, is whether the mark **BORDEAUX** is deceptively misdescriptive of the applicant’s wares. While the legal burden is upon the applicant to show that its trade-mark is registrable, there is an initial evidentiary burden upon the opponent in respect of this ground to adduce sufficient evidence which, if believed, would support the truth of its allegations that the trade-mark **BORDEAUX** is deceptively misdescriptive of the character or quality of the wares in association with which the applicant’s mark is used or of their place of origin.

The opponent’s evidence is sufficient to allow me to conclude that a significant number of Canadians are aware of the word Bordeaux and that it is a wine making region in France. However, the evidence does not establish that the average consumer of the applicant's wares would think that **BORDEAUX** cookies are only produced in the Bordeaux region of France or that they must meet certain production standards. Thus, it seems unlikely that the average consumer or purchaser of cookies would react to the trade-mark **BORDEAUX** for cookies as being misdescriptive. Knowing that Bordeaux is a type of wine produced in France may leave such a consumer somewhat puzzled about the character of the applicant's cookies although, in my view, they would not likely assume they contained wine. Further, I do not think that because Bordeaux wines have an extensive reputation for high quality that consumers of the applicant’s cookies would expect the applicant’s cookies to be of the same high quality as the wines produced in Bordeaux, France. As to the origin of the applicant's cookies, even if the average consumer of the applicant's cookies knew that Bordeaux is a geographic region in France, he or she would not, in my view, conclude that the applicant's cookies also came from France. Thus, I consider that the fourth ground is unsuccessful.

As for the fifth ground of opposition, the applicant has formally complied with the provisions of Section 30(i) of the *Act* by including the required statement in its application. The issue then becomes whether or not the applicant has substantively complied with that subsection - *i.e.*- was the statement true when the application was filed? The opponent contends that the statement could not have been true because the applicant's use of its mark was contrary to the provisions of several federal statutes including ss. 7(b) and (d) of the *Trade-Marks Act*, Section 52 of the *Competition Act*, Section 5 of the *Food and Drugs Act* and Section 7 of the *Consumer Packaging and Labelling Act*.

Where the opponent asserts that an applicant could not have been satisfied that it was entitled to use its mark because its use was in violation of a federal statute, the onus on the opponent is to make out a *prima facie* case of such (*E. Remy Martin & Co. S.A. v. Magnet Trading Corp. (HK) Ltd.* (1988), 23 C.P.R. (3d) 242 (T.M.O.B.) and *Co-operative Union of Canada v. Tele-Direct (Publications) Inc.* (1991), 38 C.P.R. (3d) 263 (T.M.O.B.)). The basis for the *prima facie* test is the usual evidential burden on an opponent respecting a Section 30 ground in an opposition proceeding, *i.e.* the opponent must prove the allegations of fact made in support of its ground of opposition (*Canada Post Corporation v. Comdata Services Ltd.* (1996), 69 C.P.R. (3d) 398 at 405 (T.M.O.B.)). The onus or legal burden is then on the applicant is to show its compliance with the provisions of Section 30 of the *Act*.

In the present case, it was incumbent on the opponent to adduce sufficient evidence from which it could reasonably be concluded that the applicant's use of its mark **BORDEAUX** in association with cookies would be in contravention of ss. 7(b) and (d) of the *Trade-Marks Act*, Section 52 of the *Competition Act*, Section 5 of the *Food and Drugs Act* and Section 7 of the *Consumer Packaging and Labelling Act*. In my view, the determination about whether any or all of these provisions have been violated turns on the determination of whether the applicant's use of the mark **BORDEAUX** in association with cookies would mislead or deceive the public in some material way. In this regard, my conclusions above, and in particular my conclusion that the applicant's mark is not deceptively misdescriptive of the character or quality of the wares in association with which it is used or of their place or origin, are equally applicable to this ground of opposition. Consequently, this ground of opposition is not successful.

In view of the reasons stated above, and with the authority delegated to me under s. 63(3) of the *Act*, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 30th DAY OF October, 1997.

C. R. Vandenakker
Hearing Officer
Trade-Marks Opposition Board