

**IN THE MATTER OF OPPOSITIONS by
Rothmans Benson & Hedges Inc. to
applications Nos. 1122419, 1122420, 1122421
and 1122422 for the trade-marks du
MAURIER PREFERENCE, du MAURIER
DISTINCTION, du MAURIER DELUXE and
du MAURIER COLLECTION respectively,
filed by Du Maurier Company Inc.**

[1]. On November 19, 2001, Du Maurier Company Inc. (the Applicant) filed applications to register the trade-marks du MAURIER PREFERENCE, du MAURIER DISTINCTION, du MAURIER DELUXE and du MAURIER COLLECTION (the Marks) based upon proposed use of the Marks in Canada in association with “manufactured tobacco products” (the Wares).

[2]. The applications were advertised for opposition purposes in the Trade-marks Journal of December 18, 2002.

[3]. On May 20, 2003, Rothmans Benson & Hedges Inc. (the Opponent) filed essentially identical statements of opposition against each application. The grounds of opposition, as amended, can be summarized as follows:

- a. The applications do not conform to the requirements of s. 30(e) of the *Trade-marks Act*, R.S.C. 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;
- b. The application for the du MAURIER PREFERENCE trade-mark does not conform to the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the said mark as a trade-mark in association with the wares set out in the application as the Applicant was aware of the Opponent’s registered trade-mark B & H PREMIUM (Reg. No. TMA293,722) prior to the filing date of the Applicant’s application;

- c. The Marks are not registrable, contrary to s. 12(1)(b) of the Act, since the Marks are clearly descriptive or deceptively misdescriptive of the character or quality of the wares in association with which they are proposed to be used;
- d. The trade-marks du MAURIER PREFERENCE, du MAURIER DELUXE and du MAURIER COLLECTION are not registrable because, contrary to s. 12(1)(d) of the Act, the trade-mark applications for the said marks are confusing with the registered trade-marks listed in Schedule “A” attached hereto to my decision;
- e. 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; and
- f. The Applicant is not the person entitled to registration of the trade-mark du MAURIER DELUXE. At the date on which the Applicant filed its application for the du MAURIER DELUXE trade-mark in association with the Wares, it was confusing with the trade-marks BENSON & HEDGES 100’S DELUXE ULTRA LIGHTS MENTHOL & DESIGN and BENSON & HEDGES 100’S DELUXE ULTRA LIGHTS & DESIGN previously used by the Opponent in association with the same or similar wares in Canada and for which applications for registration had been previously filed in Canada under Serial Nos. 1125912 and 1125913 respectively, neither of which were abandoned as of the date of advertisement of the Applicant’s application.

[4]. The Applicant filed and served a counter statement in each case in which it denied all grounds of opposition.

[5]. As its evidence in each case, the Opponent submitted an affidavit of Perry J. Lao. I will use the singular form to refer to all four affidavits of Mr. Lao, which share the same structure. The Applicant filed a single set of affidavits of Edmond Ricard, Chantal Dorais, Adamo Santoianni, Timothy Owen Stevenson, Eric Weaver, Iva Morina and Gay Owens in respect of the four present oppositions as well as two oppositions to other applications involving the same Applicant and Opponent. Only the aspects of evidence relevant to the present oppositions will be discussed herein.

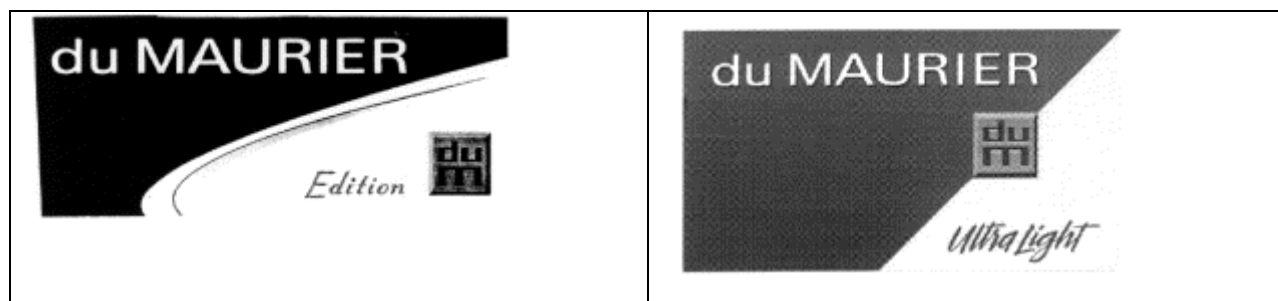
[6]. Each party filed a written argument in each case. Only the Applicant was represented at an oral hearing in each case.

Summary of the Opponent's Evidence

Affidavit of Perry J. Lao

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

[8]. Mr. Lao states that he obtained various cigarette packages of the Applicant on February 9, 2004, from a convenience store located in Toronto. He attaches as Exhibits "A" to "F" to his affidavit, scanned images of the front display panels featuring the design and text appearing on the "du MAURIER" and "du MAURIER Light/Extra Light/Ultra Light/Edition/ or Special Mild" cigarette packages of the Applicant. I am reproducing below the main features of the front display panels of the Applicant's "du MAURIER Edition" and "du MAURIER Ultra Light" cigarette packages that are being referred to in the present opposition proceedings:



[9]. 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" to "F" as well as a printout from the Canadian Intellectual Property Office's on-line trade-mark database attached to his affidavit as Exhibit "G" and pertaining to a trade-mark application of the Applicant for the mark "du MAURIER EDITION" that was, at the time of Mr. Lao's affidavit, also opposed by the Opponent, it is reasonable to conclude that the

applied for Marks would appear on packaging in a similar fashion to that of the commercially available products of the Applicant shown in Exhibits “A” to “G”, whereby the words “du MAURIER” would appear separate from the word “PREFERENCE” / “DISTINCTION” / “DELUXE” or “COLLECTION”. I am not prepared to accord any weight to this latter portion of Mr. Lao’s affidavit that constitutes pure speculation on his part.

[10]. Mr. Lao further includes in his affidavit, certified copies of each of the trade-mark registrations and applications that matured to registration, relied upon by the Opponent in support of the grounds of opposition d) and f) mentioned above, except for the trade-mark B & H PREMIUM for which no certified copy is included. Mr. Lao also includes in his affidavit, extracts from various paper and web-based dictionaries available in Canada defining the words “PREFERENCE”, “DISTINCTION”, “DELUXE”, and “COLLECTION”. Mr. Lao further includes certified copies of the Examiner’s reports requesting a disclaimer for the word “COLLECTION” for the marks that include that word and are listed in the attached Schedule “A”.

Summary of the Applicant’s Evidence

Affidavit of Edmond Ricard

[11]. 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”), Imperial Brands Limited/Les Marques Imperial Ltée (“Imperial Brands”) and the Applicant) and monitoring the use of these trade-marks.

[12]. Mr. Ricard states that pursuant to a licence agreement between the Applicant and Imperial Brands, Imperial Brands 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 Imperial Brands the right to sub-license its rights to others and Imperial Brands has sub-licensed its rights

to ITCan under the same terms as the license between the Applicant and Imperial Brands.

[13]. Mr. Ricard states that ITCan has manufactured, marketed and sold du MAURIER EDITION cigarettes in Canada since at least as early as May 6, 2002.

[14]. Mr. Ricard explains the manner in which the du MAURIER EDITION 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

[15]. 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 du MAURIER EDITION cigarette product.

[16]. 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.

[17]. 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 du MAURIER EDITION product, the customers have, in the majority of cases, referred to the product as "du MAURIER EDITION". Ms. Dorais further states that ITCan has received over 700 communications concerning ITCan's du MAURIER EDITION cigarettes and she attaches as Exhibit "A" to her affidavit, representative samples of communications received from Canadian consumers concerning same.

Affidavit of Adamo Santoianni

[18]. Adamo Santoianni identifies himself as a Sales Representative employed by ITCo. He has held his position with ITCo and its predecessors for 23 years.

[19]. 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 23 years, he has spoken to, or overheard 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 du MAURIER EDITION cigarettes, which are referred to by such customers as "du MAURIER EDITION".

[20]. 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.

[21]. 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, Timothy Owen Stevenson and Eric Weaver

[22]. Iva Morina, Timothy Owen Stevenson and Eric Weaver identify themselves as respectively paralegal, summer student and student-at-law employed by the law firm representing the Applicant in the present opposition proceedings.

[23]. Iva Morina and Timothy Owen Stevenson have each attended one or more convenience stores in November 2004 and verbally ordered a pack of du MAURIER EDITION cigarettes. Photocopies of the du MAURIER EDITION pack of cigarettes received as well as receipt for same are attached to each of their affidavits.

[24]. Eric Weaver viewed and printed excerpts from the web page www.whistlergrocery.com on November 23, 2004. On the same date, he purchased a single pack of du MAURIER EDITION cigarettes from this website. These excerpts as well as a confirmation of purchase page printed following his purchase are attached to his affidavit.

Affidavit of Gay Owens

[25]. Gay Owens identifies herself as a trade-mark searcher with the law firm representing the Applicant in the present opposition proceedings. She has attached to her affidavit, the results of computer-assisted state of the register searches that were conducted to locate active trade-mark registrations and applications that include the words “DISTINCTION”, “COLLECTION”, “DELUXE” or “PREFERENCE” in relation to wares and/or services. I will discuss the results of these searches later on in my decision.

Onus and relevant dates

[26]. 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.)].

[27]. The relevant dates for assessing the circumstances in regard to each of the grounds of opposition in the present cases are the following:

- Grounds 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.)];
- Grounds based on s. 12(1)(b) of the Act: the filing date of the applications [see *General Housewares Corp. v. Fiesta Barbeques Limited* (2003), 28 C.P.R. (4th) 60 (F.C.T.D.)]
- Grounds 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.)];
- Grounds based on s. 16(3)(a) and (b) of the Act: the filing date of the application;
- Grounds 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.T.D.)].

[28]. I will now analyze the grounds of opposition in regard to the evidence filed in the record, without necessarily respecting the order in which they were raised in the statements of opposition.

Section 30(e) grounds of opposition

[29]. The Opponent's first ground of opposition in each case 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 pursuant to s. 2 of the Act, in association with the general class of wares described in the applications. In its statement of opposition against the du MAURIER DISTINCTION trade-mark, the Opponent has detailed further that ground of opposition. More

particularly, the Opponent has pleaded that the Applicant will use the du MAURIER DISTINCTION trade-mark in a manner such that the public, as a matter of first impression, will not perceive the alleged mark as being used as a single or unitary trade-mark. The Opponent contends that the words “du MAURIER” and the word “DISTINCTION” will use different lettering or sizing and the word “DISTINCTION” will be perceived as being a laudatory term, such that the public will not perceive this element as forming part of the trade-mark as a whole, and will only perceive the words “du MAURIER” as functioning as a trade-mark.

[30]. While I have doubts as to the sufficiency of the s. 30(e) pleading with regard to the du MAURIER PREFERENCE, du MAURIER DELUXE and du MAURIER COLLECTION trade-marks, I understand from the Lao affidavit and the Opponent’s written argument in each case that the Opponent, is effectively relying on the same argument under this ground that it made in the du MAURIER DISTINCTION case. In this regard, relying on the Applicant’s commercially available products that are included as Exhibits “A” to “F” to the Lao affidavit, the Opponent argues that the Marks would appear on packaging in a similar fashion to that of the du MAURIER EDITION packaging (i.e. the words “du MAURIER” would appear separate from the word “COLLECTION”, “DELUXE” or “PREFERENCE”). Such use of du MAURIER PREFERENCE, du MAURIER DELUXE or du MAURIER COLLECTION trade-marks would therefore not constitute use as unitary trade-marks.

[31]. Conversely, the Applicant contends that at most, this evidence demonstrates the manner in which the Applicant sold its unrelated du MAURIER EDITION brand 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 du MAURIER PREFERENCE, du MAURIER DELUXE, du MAURIER DISTINCTION and du MAURIER COLLECTION brands of cigarettes. As such, the Applicant contends that it is not possible to conclude from the evidence filed in the record that the Applicant’s intention in 2001 was not to use the du MAURIER PREFERENCE, du MAURIER DELUXE, du MAURIER DISTINCTION and du MAURIER COLLECTION Marks, particularly in view of the Applicant’s unequivocal and contemporaneous statements in its applications that it would use the Marks as trade-marks. I agree.

[32]. Assuming that there would be evidence supporting the Opponent's contentions, I further agree with the Applicant's contention that such manner of use would qualify as use as trade-marks.

[33]. Indeed, if the Applicant were to use the Marks in the same format as its du MAURIER EDITION cigarette product, I believe that such manner of use would qualify as use as trade-marks since the fact that the words "du MAURIER" and "EDITION" ["COLLECTION", "DELUXE", "DISTINCTION" or "PREFERENCE"] appear [would appear] in different fonts, sizes 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 word mark du MAURIER EDITION [du MAURIER PREFERENCE, du MAURIER DELUXE, du MAURIER DISTINCTION or du MAURIER COLLECTION] as a whole. The words "du MAURIER" and "EDITION" ["COLLECTION", "DELUXE", "DISTINCTION" or "PREFERENCE"] 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.

[34]. The said use of du MAURIER PREFERENCE, du MAURIER DELUXE, du MAURIER DISTINCTION and du MAURIER COLLECTION as trade-marks on cigarette packages is further supported by the use made of du MAURIER EDITION on the invoices and order forms attached to the Ricard affidavit. "du MAURIER EDITION" appears in the body of the invoices and the invoices accompany the wares or are shipped to the purchasers. "du MAURIER EDITION" appears on order forms used by retailers and wholesalers to order cigarettes from ITCo. "du MAURIER EDITION" further appears on consumer sales receipts as evidenced by the Morina and Stevenson affidavits.

[35]. Furthermore, the samples of communications attached to the Dorais affidavit evidence that du MAURIER EDITION cigarettes are referred to by customers as "du MAURIER EDITION".

[36]. 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 du MAURIER EDITION cigarette product, such use would qualify as use of the proposed trade-marks.

[37]. 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 Wares. The s. 30(e) grounds of opposition are accordingly dismissed.

Section 12(1)(b) grounds of opposition

[38]. The Opponent contends that the Marks are not registrable, contrary to s. 12(1)(b) of the Act, since the Marks, whether depicted, written or sounded, are either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares in association with which they are proposed to be used. The Opponent has detailed further that ground of opposition in respect of the du MAURIER COLLECTION, du MAURIER DELUXE and du MAURIER PREFERENCE Marks as follows:

In the case of du MAURIER COLLECTION:

“COLLECTION clearly describes or deceptively misdescribes that the Applicant’s wares are part of a specific or identifiable collection. The word COLLECTION, when used in context with the wares, is also laudatory, describing a superior collection or selection of products. Used in conjunction with du MAURIER, du MAURIER COLLECTION is clearly descriptive or deceptively misdescriptive of the Applicant’s wares, indicating a superior collection or manufactured tobacco products of the Applicant.”

In the case of du MAURIER DELUXE:

“The word DELUXE is laudatory having a meaning of being luxurious or being of a superior kind. Used in conjunction with du MAURIER, du MAURIER DELUXE is clearly descriptive or deceptively misdescriptive of the Applicant’s Wares, indicating a more luxurious or superior character or quality relative to other manufactured tobacco products of the Applicant or other third parties.”

In the case of du MAURIER PREFERENCE:

“The word PREFERENCE is laudatory having a meaning of being preferred or being liked better or best. Used in conjunction with du MAURIER, du MAURIER PREFERENCE is clearly descriptive or deceptively misdescriptive of the Applicant’s Wares, having a preferred or better character or quality relative to other manufactured tobacco products of the Applicant or other third parties.”

[39]. The test under s. 12(1)(b) of the Act considers whether the trade-mark as a whole is clearly descriptive or deceptively misdescriptive of the character or quality of the wares or services in association with which it is used or proposed to be used. The trade-mark must not be dissected into its component elements and carefully analysed, but rather must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd. v. Canada (Registrar of Trade Marks)* (1978), 40 C.P.R. (2d) 25 (F.C.T.D.), at 27-28 and *Atlantic Promotions Inc. v. Canada (Registrar of Trade Marks)* (1984), 2 C.P.R. (3d) 183 (F.C.T.D.), at 186]. As a corollary, if only part of a proposed trade-mark is objectionable, the trade-mark as a whole may still be registrable provided that the objectionable part does not so dominate the applied for trade-mark as a whole such that the trade-mark would thereby be precluded from registration [see *Canadian Council of Professional Engineers v. John Brooks Co.* (2004), 35 C.P.R. (4th) 507]. “Character” means a feature, trait or characteristic of the product and “clearly” means self-evident, plain, easy to understand [see *Drakett Co. of Canada v. American Home Products Corp.* (1968), 55 C.P.R. 29 (Ex. Ct.), at 34].

[40]. Applying these principles to the present cases, I agree with the Applicant that the s. 12(1)(b) grounds of opposition ought to be dismissed, for the reasons set out below.

[41]. The Opponent has acknowledged in its written argument in each case that the Marks are made up of two components, namely “*the well-known house mark du MAURIER*” and the ordinary dictionary words “PREFERENCE”, “DISTINCTION”, “DELUXE” or “COLLECTION”, which are of low inherent distinctiveness. The Opponent has not alleged that the words “du MAURIER” are in a way descriptive or misdescriptive of the character or quality of the Wares. Accordingly, each of the Marks as a whole cannot be clearly descriptive of

deceptively misdescriptive of the character or quality of the wares. The component “du MAURIER” dominates each of the Marks and renders the entirety of the Marks non-descriptive.

[42]. The variety and number of trade-marks comprising the words “PREFERENCE”, “DISTINCTION”, “DELUXE” or “COLLECTION” presently on the register as evidenced by the Owens affidavit further supports the finding that the words “PREFERENCE”, “DISTINCTION”, “DELUXE” and “COLLECTION” by themselves do not necessarily render the entirety of the Marks clearly descriptive or deceptively misdescriptive, as follows:

In the case of du MAURIER PREFERENCE: As of the date of the search, there were over 30 active trade-mark registrations or allowed applications for trade-marks containing the word PREFERENCE, one of which being for tobacco products in the name of a third party.

In the case of du MAURIER DISTINCTION: As of the date of the search, there were over 40 active trade-mark registrations or advertised applications for trade-marks containing the word DISTINCTION, two of which being for tobacco products in the name of third parties.

In the case of du MAURIER DELUXE: As of the date of the search, there were over 50 active trade-mark registrations or advertised applications for trade-marks containing the word DELUXE, five of which being the registrations relied upon by the Opponent in support of its s. 12(1)(d) ground of opposition, and two of which being the applications relied upon by the Opponent in support of its s. 16 grounds of opposition.

In the case of du MAURIER COLLECTION: As of the date of the search, there were over 30 active trade-mark registrations or advertised applications for trade-marks containing the word COLLECTION, four of which being the registrations relied upon by the Opponent in support of its s. 12(1)(d) ground of opposition.

[43]. I agree with the Applicant that the fact that many of these registrations and applications do contain a disclaimer of the right to the exclusive use of the words “PREFERENCE”, “DISTINCTION”, “DELUXE” or “COLLECTION” apart from the trade-mark by no means implies that the present applications should be refused on the basis that “PREFERENCE”, “DISTINCTION”, “DELUXE” and “COLLECTION” on their own are clearly descriptive and should therefore have been disclaimed. While not pleaded by the Opponent in the present cases, the absence of a disclaimer is not, in any event, a valid ground of opposition [see *Canadian Schenley Distilleries Ltd. v. Registrar of Trade-marks and Bodegas Rioja Santiago, S.A.* (1974), 15 C.P.R. (2d) 1 at 10 (F.C.T.D.)].

[44]. Having regard to the foregoing analysis, I find that the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Marks are clearly descriptive or deceptively misdescriptive of the character or quality of the Wares. Accordingly, the s. 12(1)(b) grounds of opposition are dismissed.

[45]. In its written argument in each case, the Opponent has submitted in the alternative the following:

“In the alternative, if the Hearing Officer finds the subject mark not to be clearly descriptive on the basis that the component du MAURIER is distinctive, it is submitted that the word COLLECTION [DELUXE/DISTINCTION/ or PREFERENCE] itself is clearly descriptive and no one party is entitled to the exclusive use of this term.”

[46]. Given my comments above and the fact that the Applicant does not seek to register the words “PREFERENCE”, “DISTINCTION”, “DELUXE” and “COLLECTION” *per se* but rather the combination of these words with other elements (like other entities including the Opponent itself that did obtain trade-mark registrations which include the component DELUXE or other laudatory terms used in combination with other distinctive elements), I do not find it necessary to comment further on these latter contentions of the Opponent.

Section 12(1)(d) grounds of opposition

[47]. As indicated above, the Opponent has filed in each case, certified copies of the trade-mark registrations relied upon by the Opponent in support of that ground, except for the trade-mark B & H PREMIUM. I have exercised my discretion to review the register of trade-marks and confirm the current status of these registrations. As they are in good standing, the Opponent's initial burden with respect to each of these grounds of opposition has been satisfied.

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

[49]. 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.

[50]. 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].

[51]. A detailed analysis of the s. 6(5) factors is not required in the present cases. Suffice it to

say that although the wares and channels of trade of the marks at issue might overlap, each of the third party marks is sufficiently different from the du MAURIER COLLECTION, du MAURIER DELUXE or du MAURIER PREFERENCE Marks to make confusion unlikely.

[52]. Indeed, and as per my comments above, the Marks are made up of two components, namely “*the well-known house mark du MAURIER*” appearing at the start of the Applicant’s Marks and the ordinary dictionary words “PREFERENCE”, “DELUXE” or “COLLECTION”. Their only resemblance with the cited registrations, which contain other distinguishing features and for which no evidence of use or making known in Canada has been provided, is that they share one of these ordinary dictionary words. Considering the very significant differences existing between the Marks and each of the cited marks in appearance, sound and the ideas suggested by them, and the fact that both the Applicant and the Opponent have acknowledged in their written arguments that the words “PREFERENCE”, “DELUXE” and “COLLECTION” are of low inherent distinctiveness, I do not find it necessary to detail here the analysis made in regard to each of these marks. As stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstering Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149:

“It is axiomatic that all these factors are not of necessity to be accorded equal weight and in some instances one or more of the factors mentioned might not even be present. Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

[53]. In view of my conclusions above, 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. The s. 12(1)(d) grounds of opposition are accordingly dismissed.

[54]. In its written argument in the du MAURIER COLLECTION and du MAURIER DELUXE Marks, the Opponent has submitted in the alternative the following:

“C.3.(j) In the alternative, if the Hearing Officer finds the subject mark 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 COLLECTION [DELUXE] in the subject mark is a non-distinctive and weak component which is a common English word that ought to be available to all traders in the field.”

[55]. Given my comments above with respect to the s. 12(1)(b) grounds of opposition, I do not find it necessary to comment further on these latter contentions of the Opponent.

Non-distinctiveness grounds of opposition

[56]. The Opponent contends 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. In its statements of opposition against the du MAURIER COLLECTION and du MAURIER DISTINCTION trade-marks, the Opponent has detailed further that ground of opposition as follows:

In the case of du MAURIER COLLECTION:

“The mark du MAURIER COLLECTION is not distinctive of the Applicant (...) as it is clearly descriptive and confusing with the registered trade-marks [that is the registered trade-marks listed in attached Schedule “A”] described herein.”

In the case of du MAURIER DISTINCTION:

“The alleged trade-mark du MAURIER DISTINCTION is not distinctive of the Applicant. Distinctive, in relation to a trade-mark means a trade-mark that actually distinguishes the wares in association with which it is being used by its owner from the wares of others or is so adapted so to distinguish them. The alleged trade-mark du MAURIER DISTINCTION is not distinctive as it is not, nor will it be perceived as being, a trade-mark, for the reasons described in paragraph 3(a) [that is ground a)] above.”

[57]. The non-distinctiveness ground of opposition against each application fails at the very least for the same reasons that the s. 30(e), s. 12(1)(b) or s. 12(1)(d) grounds of opposition failed.

Section 30(i) ground of opposition

[58]. The Opponent contends that in view of the existence of Canadian trade-mark registration No. TMA293,722 for the trade-mark B & H PREMIUM, of which the Applicant was allegedly aware, the Applicant could not have been satisfied that it was entitled to registration of its trade-mark du MAURIER PREFERENCE.

[59]. This ground is dismissed because the Opponent has not met its initial evidential burden in regard thereto. Specifically, there is no evidence that the Applicant was aware of the said trade-mark registrations, no evidence of the reasons why it should have been aware of these registrations and no evidence that the Applicant was not in fact satisfied that it was not entitled to use its Mark in Canada. 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, which is not the case here.

Section 16 grounds of opposition

[60]. The Opponent contends that the Applicant is not the person entitled to registration of the trade-mark du MAURIER DELUXE because at the date on which the Applicant filed its application for the said mark, it was confusing with the trade-marks BENSON & HEDGES 100'S DELUXE ULTRA LIGHTS MENTHOL & DESIGN and BENSON & HEDGES 100'S DELUXE ULTRA LIGHTS & DESIGN previously used by the Opponent in association with the same or similar wares in Canada and for which applications for registration had been previously filed in Canada under Serial Nos. 1125912 and 1125913 respectively.

[61]. As stressed by the Applicant, the Opponent's applications were not filed until December 20, 2001, which is after the date of filing of the application for the Applicant's du MAURIER DELUXE trade-mark. Accordingly, these applications cannot be relied upon for the purposes of paragraph 16(3)(b) of the Act. Furthermore, if the Opponent intended to rely on s. 16(3)(a) of the Act, it failed to meet the initial evidential burden upon it as it did not evidence use of its alleged BENSON & HEDGES 100'S DELUXE ULTRA LIGHTS MENTHOL & DESIGN and

BENSON & HEDGES 100'S DELUXE ULTRA LIGHTS & DESIGN trade-marks prior to the Applicant's filing date and non-abandonment of these marks at the date of advertisement of the Applicant's application. The s. 16 grounds of opposition are accordingly dismissed.

Disposition

[62]. Having been delegated authority 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 pursuant to s. 38(8) of the Act.

DATED AT Montréal, Québec, THIS 16th DAY OF July 2009.

Annie Robitaille
Member
Trade-marks Opposition Board

SCHEDULE “A”

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>	<u>Current Owner</u>
In the case of du MAURIER PREFERENCE			
TMA293,722	B & H PREMIUM <i>(The right to the exclusive use of the word PREMIUM is disclaimed apart from the trade-mark)</i>	Cigarettes	the Opponent
In the case of du MAURIER DELUXE			
TMA392,027	BENSON & HEDGES 100’S & DESIGN <i>(The right to the exclusive use of the words DE LUXE ULTRA LIGHTS and 100% is disclaimed apart from the trade-mark)</i>	Cigarettes	the Opponent
TMA489,833	BENSON & HEDGES 100’S DE LUXE ULTRA LIGHT & DESIGN <i>(The right to the exclusive use of the words DE LUXE ULTRA LIGHTS and 100% is disclaimed apart from the trade-mark)</i>	Manufactured tobacco products.	the Opponent
TMA258,121	BENSON & HEDGES DELUXE FILTER <i>(The right to the exclusive use of the words DELUXE FILTER is disclaimed apart from the trade-mark)</i>	Cigarettes.	the Opponent
TMA155,356	BLACK & WHITE & DESIGN <i>(The right to the exclusive use of the words MARCOVITCH and DE LUXE is disclaimed apart from the trade-mark)</i>	Cigarettes.	Philip Morris Products S.A.
TMA535,917	STATOS DE LUXE <i>(The right to the exclusive use of the words DE LUXE is disclaimed apart from the trade-mark)</i>	Cigars, cigarillos, cigarettes, and cut tobacco	Corporacion Habanos, S.A.

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Wares</u>	<u>Current Owner</u>
In the case of du MAURIER COLLECTION			
TMA524,696	CANADIAN COUNTRY COLLECTION & DESIGN <i>(The right to the exclusive use of the words CANADIAN and COLLECTION is disclaimed apart from the trade-mark)</i>	“Souvenir items, namely, (...) vases and ashtrays.. Operation of a business establishment dealing in the distribution of retail and souvenir store items.”	Canadian Duty Free Group Inc.
TMA391,118	CHARTER COLLECTION <i>(The right to the exclusive use of the word COLLECTION is disclaimed apart from the trade-mark)</i>	“Household electric and non-electric appliances, namely (...) tobaccos and smokers' accessories, namely, cigarettes, cigars, tobacco, pipes, pipe racks, tobacco jars, reamers, humidors, cigarette and cigar holders, cigarette and cigar cases, lighters, lighter cases, book matches; (...)”	HUDSON'S BAY COMPANY
TMA308,810	COLLECTION VENICE SIMPLETON-ORIENT-EXPRESS <i>(The right to the exclusive use of the words VENICE and COLLECTION is disclaimed apart from the trade-mark)</i>	“Bleaching preparations; soaps; perfumery, essential oils, hair lotions; (...) Tobacco, raw or manufactured, cigars; matches.”	Société Nationale Des Chemins De Fer Français
TMA551,902	ISLAND COLLECTION <i>(The right to the exclusive use of the word COLLECTION is disclaimed apart from the trade-mark)</i>	Cigars.	DSI, LIMITED