

IN THE MATTER OF AN OPPOSITION BY Baron Philippe de  
Rothschild to application No. 642,180 for the trade-mark  
SÉLECTION PHILIPPE LE GRAND filed by Dumont Vins &  
Spiritueux Inc.

On October 5, 1989, the applicant, Dumont Vins & Spiritueux Inc., filed an application to register the trade-mark SÉLECTION PHILIPPE LE GRAND based upon use of the trade-mark in Canada in association with "vins" since at least as early as June 27, 1986.

The opponent, Baron Philippe de Rothschild S.A., filed a statement of opposition on October 1, 1990. In its statement of opposition, the opponent alleged that the applicant's application is not in compliance with Sections 30(b) and 30(i) of the Trade-marks Act in that the applicant has not used its trade-mark since at least as early as June 27, 1986 and that the applicant could not have been satisfied that it was entitled to use its trade-mark in Canada in view of its knowledge of the existence of the opponent's trade-marks referred to below. Next, the opponent alleged that the applicant's trade-mark is not registrable in that it is confusing with its registered trade-marks listed below:

<u>Trade-mark</u>	<u>Registration No.</u>
CHATEAU MOUTON BARON PHILIPPE	214,704
RESERVE BARON PHILIPPE DE ROTHSCHILD	266,397
CHATEAU MOUTON BARONNE PHILIPPE	247,297
BARON PHILIPPE DE ROTHSCHILD	255,328
MOUTON-CADET Label Design	328,701
LE GRAND BARON	297,043
PHILLIP BARON & Design	277,294
PHILLIP BARON & Design	277,295

The third ground of opposition is based on Sections 12(1)(e) and 9(1)(k) of the trade-marks Act, the opponent alleging that the applicant's trade-mark is not registrable in that, at the time of adoption, the trade-mark SÉLECTION PHILIPPE LE GRAND suggested a connection with and an endorsement by a living individual, namely Baron Philippe de Rothschild, a well-known producer of wines.

As its fourth ground, the opponent has alleged that the applicant is not the person entitled to registration of the trade-mark SÉLECTION PHILIPPE LE GRAND in that the trade-mark was confusing with the following trade-marks and trade-names that had previously been used in Canada by the opponent:

CHATEAU MOUTON BARON PHILIPPE

RESERVE BARON PHILIPPE DE ROTHSCHILD  
CHATEAU MOUTON BARONNE PHILIPPE  
BARON PHILIPPE DE ROTHSCHILD  
BARON PHILIPPE  
BARON PHILIPPE & Design  
BARON PHILIPPE DE ROTHSCHILD S.A.  
PHILIPPE DE ROTHSCHILD  
UN VIN BARON PHILIPPE  
PHILIPPE  
BARONNE PHILIPPE  
PHILLIP BARON  
PHILLIP BARON & Design  
PHILLIP BARON & Design  
LE GRAND BARON

Finally, the opponent alleged that the applicant's trade-mark is not distinctive of the applicant's wares in view of the prior use by the opponent in Canada of the trade-marks and trade-names identified above and in view of the personality rights of Baron Philippe de Rothschild and Baroness Philippine de Rothschild who are well-known and associated with wine.

The applicant served and filed a counterstatement in which it denied the allegations set forth in the statement of opposition.

The opponent filed as its evidence the affidavit of Gilles Aguetant d'Aubigny, Controleur de Gestion of the opponent, while the applicant filed as its evidence the affidavits of Gilles Mélançon, Director of Marketing of the applicant, and Jocelyne Lamontagne, an employee of the applicant's trade-mark agents.

Both parties filed written arguments and both were represented at an oral hearing.

The first ground of opposition is based on Section 30(b) of the Trade-marks Act, the opponent alleging that the applicant has not used the trade-mark in association with wines since at least as early as June 27, 1986. While the legal burden is upon the applicant to show that its application complies with Section 30 of the Trade-marks Act, there is an initial evidential burden on the opponent in respect of the Section 30 grounds (see Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd., 3 C.P.R. (3d) 325, at pp. 329-330). To meet the evidential burden upon

it in relation of a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. In the decision of the Federal Court, Trial Division in John Labatt Limited v. The Molson Companies Limited, 30 C.P.R. (3d) 293, at pg. 298, Mr. Justice McNair characterised the evidential burden on an opponent as follows:

"The evidential burden is the burden of adducing sufficient evidence to persuade the trier of fact that the alleged facts are true: see Sopinka and Lederman, *The Law of Evidence in Civil Cases* [Butterworths], 6th ed., pp. 107-08; Phipson *On Evidence*, 13th ed., para. 44-03; McCormick *On Evidence* [Hornbook Series, West Publishing Co.], 3rd. ed., pp. 946-48; and Thayer, *Preliminary Treatise On Evidence at the Common Law* (1898), ch. 9."

An opponent may also rely on the evidence or submissions of the applicant to meet the initial evidential burden upon it. In this regard, in its written argument, the opponent submitted the following:

"45. The Application claims that the mark "SELECTION PHILIPPE LE GRAND" has been used in Canada in association with wines since at least as early as June 27, 1986. However, the evidence establishes that the earliest use of the mark "SELECTION PHILIPPE LE GRAND" in association with wines in Canada is December 18, 1987.

Melançon Affidavit, Exhibit "GM-1"

48. Furthermore, while the Application claims that the Applicant itself has used the mark "SELECTION PHILIPPE LE GRAND" since June 27, 1986, the evidence establishes that the mark was in fact first used by Vignobles Chantecler Ltée. and not the Applicant.

Melançon Affidavit, Exhibit "GM-1"

A review of the photocopies of the invoices annexed to the Mélançon affidavit confirms the opponent's submissions in that the first nine invoices comprising Exhibit GM-1 identify the entity Vignobles Chantecler Ltée and not Dumont Vins & Spiritueux Inc. Despite being alerted by the opponent's written argument to the deficiency in its evidence, the applicant neither amended its application to identify Vignobles Chantecler Ltée as a predecessor-in-title, nor did it seek leave prior to the oral hearing to adduce evidence in order to establish that Vignobles Chantecler Ltée and Dumont Vins & Spiritueux Inc. are the same person and that there was a change in name from Vignobles Chantecler to Dumont Vins.

At the oral hearing, the trade-mark agent for the opponent repeated the submissions set forth in the opponent's written argument relating to the applicant's non-compliance with Section 30(b) of the Act. Subsequent to requesting a short adjournment of the oral hearing, the trade-mark agent for the applicant contacted his client concerning this issue. When the oral hearing was reconvened, the agent requested that the applicant be granted leave to adduce evidence that there had been a mere change in name of the applicant in this instance. However, having regard to the lateness of the

applicant's request and the fact that the opponent in its written argument had specifically identified the deficiencies in the applicant's evidence, I refused the applicant's request that it now be granted leave to file further evidence in this opposition. While the applicant's agent provided an explanation as to why this matter had not been dealt with earlier by the applicant's agents, I would have expected that applicant's agent to have reviewed the evidence and the opponent's written argument prior to the hearing and, even had the agent not had the time to prepare an affidavit and seek leave to clarify the alleged change in name prior to the hearing, the agent certainly could have informed himself as to the situation and have alerted the other party prior to the oral hearing that it would be requesting leave at the hearing.

In view of the above, I have concluded that the applicant's evidence raises a serious issue as to its compliance with Section 30(b) of the Trade-marks Act insofar as the applicant having used the trade-mark SÉLECTION PHILIPPE LE GRAND since the claimed date of first use. I have therefore refused the applicant's application.

As I have refused the present application for failure to comply with Section 30, I do not propose to consider the remaining grounds of opposition relied upon by the opponent. However, had it been necessary to do so, I suspect that I would have concluded that the applicant has failed to meet the legal burden upon it in respect of the Section 12(1)(d) grounds of opposition. In particular, the opponent has relied upon several registered trade-marks including the registered trade-mark LE GRAND BARON covering "wine" in relation to the Section 12(1)(d) ground and, as a further surrounding circumstance in respect of the issue of confusion, has shown that there has been very significant use of the trade-marks BARON PHILIPPE and UN VIN BARON PHILIPPE in Canada in association with wines. Further, the wares associated with the applicant's trade-mark and the opponent's registered trade-marks are wine and would therefore travel through the same channels of trade. More importantly, however, the applicant has not challenged the opponent's evidence and its own evidence does little to assist it in meeting the legal burden upon it in respect of the issue of confusion.

In view of the above, I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 30th DAY OF November, 1994.

G.W.Partington,  
Chairman,  
Trade Marks Opposition Board.