



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2013 TMOB 184
Date of Decision: 2013-10-28

**IN THE MATTER OF AN OPPOSITION
by Miguel Torres, S.A. to application
No. 1,449,032 for the trade-mark SOL
AMANTE in the name of S.A.
Establecimientos Vitivinícolas Escorihuela**

[1] On August 21, 2009, S.A. Establecimientos Vitivinícolas Escorihuela (the Applicant) applied to register the trade-mark SOL AMANTE (the Mark), based upon proposed use in Canada in association with wines.

[2] Miguel Torres, S.A. (the Opponent) is the owner of the trade-marks VIÑA SOL (Registration No. TMA171, 384) and GRAN VIÑA SOL (Registration No. TMA692,412), which were previously registered and used in Canada by the Opponent in association with wines.

[3] The Opponent has opposed the Applicant's application under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on the basis that: (i) it does not conform to the requirements of sections 30(e) or (i) of the Act; (ii) the Applicant is not the person entitled to registration of the Mark under section 16(3)(a) of the Act, in view of the Opponent's prior use of its trade-marks VIÑA SOL and GRAN VIÑA SOL in association with wines; (iii) the Mark is not registrable under section 12(1)(d) of the Act in view of the Opponent's registered trade-marks VIÑA SOL (Registration No. TMA 171,384) and GRAN VIÑA SOL (Registration No. TMA692,412); and iv) the Mark is not distinctive within the meaning of s. 2 of the Act.

[4] In support of its grounds of opposition, the Opponent has filed the affidavit of Mr. Antonio Batet Collado, Area Manager for Canada for the Opponent, sworn December 15, 2011.

In addition, the Opponent filed certified copies of its registrations for VIÑA SOL (Registration No. TMA 171,384) and GRAN VIÑA SOL (Registration No. TMA692,412).

[5] Both of the parties filed written arguments.

[6] No oral hearing was held.

[7] For the reasons that follow, the opposition is rejected.

Onus

[8] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Analysis

Grounds of Opposition Summarily Dismissed

Section 30(e) of the Act

[9] Section 30(e) of the Act requires an Applicant to make a statement that it, either by itself or through a licensee intends to use the Mark in Canada. Since the application contains such a statement, it formally complies with section 30(e) of the Act.

[10] However, the Opponent alleges that by virtue of having deemed knowledge of the existence of the Opponent's trade-marks VIÑA SOL and GRAN VIÑA SOL, the Applicant could not have had a *bona fide* intention to use the Mark.

[11] I am of the view that the Applicant's knowledge or deemed knowledge of the existence of the Opponent's trade-marks would not necessarily preclude the Applicant from having a *bona fide* intention to use the Mark in Canada. Furthermore, I note that there is no evidence of record to suggest a lack of intention to use the Mark on the part of the Applicant.

[12] Accordingly, this ground of opposition is summarily dismissed.

Section 30(i) of the Act – Conformity

[13] The Opponent has alleged that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada at the time of filing of the application as the Applicant must be deemed to have been aware of the Opponent's prior rights in its trade-marks VIÑA SOL and GRAN VIÑA SOL.

[14] Section 30(i) of the Act merely requires that an Applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of the Opponent's trade-marks does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark [see *Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[15] The Opponent has also alleged that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as such use would have the effect of depreciating the value attached to the Opponent's trade-marks VIÑA SOL and GRAN VIÑA SOL, which would be contrary to section 22 and because such use would also violate section 7 of the Act.

[16] Neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of section 22 is a valid ground of opposition [see *Parmalat Canada Inc v Sysco Corp* (2008), 69 CPR (4th) 349 (FCTD) at paras 38-42]. Even if I found this to be a valid ground of opposition, the Opponent has failed to adduce sufficient evidence supporting a likelihood of depreciation of goodwill which would support a violation of section 22 [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) at paras 46 and 63-68]. It would therefore have no chance of success. The same is true with respect to the allegation of the use being contrary to section 7 of the Act.

[17] For the reasons set out above, all grounds of opposition based upon section 30(i) of the Act are summarily dismissed.

Remaining Grounds of Opposition

Section 12(1)(d) – Registrability

[18] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registered trade-marks VIÑA SOL and GRAN VIÑA SOL.

[19] The material date for assessing a ground of opposition under section 12(1)(d) of the Act is the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)].

[20] The Opponent's initial burden has been satisfied with respect to its section 12(1)(d) ground of opposition because it has filed certified copies of its registrations for VIÑA SOL (Registration No. TMA171,384) and GRAN VIÑA SOL (Registration No. TMA692,412) and both registrations are extant.

[21] I must therefore go on to consider whether the Applicant has met the burden upon it to show, on a balance of probabilities, that there is no likelihood of confusion between its Mark and the Opponent's marks.

[22] 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.

[23] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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 each has 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. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – inherent distinctiveness and the extent to which the marks have become known

[24] In the application for the Mark the Applicant states that the Mark is the Spanish translation of the English words “sun” and “lover”. The Opponent’s registration for GRAN VIÑA SOL, indicates that the words GRAN VIÑA SOL in its mark translate into English as “great sun vineyard”. There is no translation provided in the Opponent’s registration for VIÑA SOL. However, in its written argument the Opponent submits that the VIÑA is suggestive of wine and that SOL is suggestive of “sun”. It also submits that SOL is the more distinctive component of its marks, as VIÑA is suggestive of wine and “sun” has nothing to do with the wares.

[25] I note that there appears to be a discrepancy between the Opponent’s translation of VIÑA in its registration for GRAN VIÑA SOL and the translation of VIÑA which it puts forward in its written argument (i.e. in its registration, VIÑA has been translated into “vineyard” and in its written submissions, the Opponent suggests that it means “wine”).

[26] In any event, I have no evidence that the average Canadian consumer of wines speaks or understands Spanish. As a result, I am of the view that such a consumer would not necessarily attribute any specific meaning to either of the parties’ marks. I therefore find that the parties’ marks possess about the same degree of inherent distinctiveness in the context of wines.

[27] As the Opponent has noted, a trade-mark may also acquire distinctiveness through use or promotion. As evidence in support of its opposition, the Opponent has filed the affidavit of Antonio Batet Collado, sworn, December 15, 2011. Mr. Collado is the Area Manager for Canada for the Opponent.

[28] In his affidavit, Mr. Collado describes the Opponent as a wine-grower and wine and brandy producer, seller and exporter. Mr. Collado indicates that the Opponent has distributors in the Provinces of Alberta, New Brunswick, Ontario and Quebec [see para 6]. He states that

Canadian sales of the Opponent's products bearing the trade-marks VIÑA SOL and GRAN VIÑA SOL date back to September of 1965 and August of 1969, respectively [see para 7].

[29] Mr. Collado provides volume figures for 1966-1993 and both volume and value of sales figures for the years of 1993-2011(September) for sales of its VIÑA SOL wines in Canada [see paras 8 and 9]. He also provides volume figures for 1969-1992 and both volume and value of sales figures for the years of 1993-2011 (September) for sales of its GRAN VIÑA SOL wines in Canada [see paras 10 and 11]. These figures suggest that over the past few decades, the Opponent has sold a fair amount of its products in association with its trade-marks in Canada. In more recent years, the value of the Opponent's annual sales of its VIÑA SOL wines in Canada has ranged between \$198,133 and \$351, 014 (2006-2010) and the value of its annual sales of its GRAN VIÑA SOL wines in Canada has ranged between \$116,489 and \$185,376 (2006-2010). The Opponent was only able to provide figures for part of 2011 at the time of the swearing of Mr. Collado's affidavit. However, the figures which were provided suggest that the Opponent's sales were on track to fall within similar ranges in 2011 as well.

[30] Attached as Exhibits "A" and "B" to Mr. Collado's affidavit, are samples of invoices and purchase orders which Mr. Collado states relate to sales of the Opponent's VIÑA SOL and GRAN VIÑA SOL wines in Canada. Mr. Collado has also provided advertising figures dating as far back as 1993. Mr. Collado points out that despite the fact that the Opponent must abide by advertising restrictions when promoting its wines in Canada, it has still incurred some promotional and advertising expenses over the years [see paras 14-16]. For example, the Opponent's annual advertising expenditures for the years of 2006-2011 (September) ranged between \$9,907 and \$17,551.

[31] Attached as Exhibit "C" to Mr. Collado's affidavit are samples of product brochures which Mr. Collado states are made available to Canadian consumers in various establishments which sell the Opponent's VIÑA SOL and GRAN VIÑA SOL wines. Attached as Exhibit "D" to Mr. Collado's affidavit are samples of labels bearing the Opponent's trade-marks, which Mr. Collado states appear on goods which are sold to the Opponent's customers in Canada. In paragraph 18 of his affidavit, Mr. Collado states that the Opponent and its products have also been promoted in a number of newspaper and magazine articles and reviews in publications

which are distributed in Canada. Photocopies of some of these articles are attached as Exhibit ‘E’ to Mr. Collado’s affidavit.

[32] Based upon the Opponent’s evidence, I can conclude that the Opponent’s trade-marks have become known to some extent in Canada. By contrast, the Applicant has not filed any evidence which would enable me to conclude that its Mark has become known at all in Canada.

[33] The first factor in section 6(5), which is a combination of inherent and acquired distinctiveness, therefore favours the Opponent owing to the greater acquired distinctiveness of the Opponent’s marks.

Section 6(5)(b) – length of time in use

[34] The Opponent’s registrations claim September 1965 (VIÑA SOL) and August 1969 (GRAN VIÑA SOL) dates of first use and Mr. Collado confirms that there have been Canadian sales of the Opponent’s products bearing its trade-marks dating back to these dates in his affidavit [see para 7]. Since the Applicant’s application is based upon proposed use and the Applicant has not filed any evidence of use, I must conclude this factor also favours the Opponent.

Sections 6(5)(c) and (d) – the nature of the wares, services or business and trade

[35] The wares associated with the parties’ trade-marks are essentially identical. The Applicant’s application for the Mark covers “wines” and the Opponent’s registrations for VIÑA SOL and GRAN VIÑA SOL cover “grape wine of Spanish origin” and “wine”, respectively.

[36] Mr. Collado outlines the Opponent’s normal course of trade in paragraph 6 of his affidavit. In particular, he states that the Opponent sells its products through Canadian distributors and provincial liquor control agencies in several Canadian provinces. He indicates that the distributors sell the Opponent’s wines to liquor control boards and other wine vendors in Canada which in turn sell the wines to Canadian consumers as well as to commercial establishments such as restaurants, bars and pubs. Mr. Collado identifies distributors in the Provinces of Alberta, New Brunswick, Ontario and Quebec [see para 6].

[37] The Applicant has not filed any evidence regarding the nature of its business or normal course of trade. However, in view of the fact that the parties' wares are essentially identical, it is reasonable to conclude that their channels of trade would overlap.

Section 6(5)(e) – degree of resemblance between the trade-marks

[38] In most instances, the dominant factor in determining the issue of confusion is the degree of resemblance between the trade-marks in their appearance or sound or in the ideas suggested by them, and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf. 60 CPR (2d) 70 (FCTD)].

[39] In *Masterpiece*, the Supreme Court of Canada considered the importance of section 6(5)(e) in conducting an analysis of the likelihood of confusion (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5) is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start.

[40] I do not consider there to be a particularly high degree of resemblance between the Opponent's trade-marks and the Applicant's Mark. The first portion of a mark is generally considered to be the more important for the purposes of distinction [see *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 26 CPR(2d) 183 at 188 (FCTD)]. In the present case, the only common component between the marks is the word SOL and it appears in the first position in the Applicant's Mark (SOL AMANTE), but only in the second position (VIÑA SOL) or third position (GRAN VIÑA SOL) of the Opponent's marks. Thus, the first portion of the parties' marks assists in differentiating them in this case. Overall, the marks at issue are quite visually and phonetically distinct from one another and for the reasons mentioned above in my

analysis under section 6(5)(a) of the Act, I am unable to conclude that consumers would consider the marks to have any similarities in connotation.

[41] I am of the view that none of the other factors set out in section 6(5) can assist the Opponent in overcoming the differences between the marks. While the Opponent's marks have been used and become known to a greater extent and while the parties' channels of trade and wares overlap, this is insufficient to result in a likelihood of confusion given the differences between the marks.

[42] Having considered all of the surrounding circumstances, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between its Mark and those of the Opponent.

[43] Accordingly, the section 12(1)(d) ground of opposition is rejected.

Section 16(3)(a) – Entitlement

[44] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark in view of the provisions of section 16(3)(a) of the Act since at the date of filing of the Applicant's application, the Mark was confusing with the Opponent's trade-marks VIÑA SOL and GRAN VIÑA SOL.

[45] An opponent meets its evidentiary burden with respect to a section 16(3)(a) ground if it shows that as of the date of filing of the applicant's application, its trade-mark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act].

[46] I am satisfied from my review of the Collado affidavit that the Opponent has met its burden with respect to both of its trade-marks. However, assessing each of the section 6(5) factors as of the Applicant's filing date rather than as of today's date does not significantly impact my previous analysis of the surrounding circumstances of this case.

[47] Accordingly, for the same reasons which were set out above in my analysis under the section 12(1)(d) ground of opposition, this ground of opposition is rejected.

Non-distinctiveness Ground – section 38(2)(d) of the Act

[48] The Opponent has alleged that the Applicant's Mark is not distinctive as it does not distinguish and is not adapted to distinguish the wares in association with which it is proposed to be used in Canada from those of the Opponent or from those of a third party, namely, Falkner Winery, which the Opponent alleges has sold wines branded by the trade-mark AMANTE in Canada.

[49] While there is a legal onus on the Applicant to show that the 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 CPR (3d) 272 (TMOB)], there is an initial evidential burden on the Opponent to establish the facts relied upon in support of the ground of non-distinctiveness. In the present case, the Opponent is under an obligation to show that, as of the date of filing of the statement of opposition, one or both of its trade-marks had become known sufficiently to negate the distinctiveness of the Mark [see *Bojangles' International, LLC v Bojangles Café Ltd* (2004), 40 CPR (4th) 553, affirmed (2006), 48 CPR (4th) 427 (FC)]. The material date for considering the distinctiveness of the Mark is the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)].

[50] The Opponent has not submitted any evidence to support its allegation that the Mark is not distinctive as a result of third party use in Canada of the trade-mark AMANTE by Falkner Winery in association with wines. However, as discussed more fully in the analysis of the section 12(1)(d) and 16(3)(a) grounds of opposition, the Opponent has established that its trade-marks had become sufficiently known in association with wines as of the date of filing the statement of opposition. As a result, the Opponent has met its evidential burden with respect to this part of its non-distinctiveness ground.

[51] However, this ground of opposition essentially turns on the issue of confusion between the parties' marks and the difference in material dates is insignificant. For the same reasons as outlined above in my analysis of the section 12(1)(d) and 16(3)(a) grounds of opposition, I am satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities that there is no reasonable likelihood of confusion between the parties' marks.

[52] Accordingly, the non-distinctiveness ground is rejected.

Disposition

[53] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

Lisa Reynolds
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office