

IN THE MATTER OF AN OPPOSITION by G.H. Mumm & Cie,
Société Vinicole de Champagne Successeur to application No.
640,204 for the trade-mark MAGNUMMM DE BISCUITS OF
COOKIES filed by Monsieur Félix & Mr. Norton Cookies Inc.

On September 11, 1989, Monsieur Félix & Mr. Norton Cookies Inc. filed an application to register the trade-mark MAGNUMMM DE BISCUITS OF COOKIES based upon proposed use of the trade-mark in Canada in association with "cookies". The applicant disclaimed the right to the exclusive use of the words BISCUITS and COOKIES apart from its trade-mark.

The opponent, G.H. Mumm & Cie, Société Vinicole de Champagne Successeur, filed a statement of opposition on July 23, 1990 in which it alleged the following grounds of opposition:

- (a) That the applicant's application for registration does not comply with Section 30 of the Trade-marks Act in that the applicant has already used its trade-mark in Canada or, in the alternative, that it never had the intention of using the trade-mark in Canada, and further that the applicant's assertion in its application that it is convinced that it is entitled to use its trade-mark in Canada is false in view of the remaining allegations set forth in the statement of opposition;
- (b) That the applicant's trade-mark is not registrable in that it is confusing with one, or more, of the opponent's registered trade-marks: MUMM REIMS & Design, registration No. TMDA 43052; MUMM & Design, registration No. 43053; G.H. MUMM & CO & Design, registration No. TMDA 43054; and MUMM, registration No. 318,082;
- (c) That the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark was confusing with one or other of the opponent's MUMM trade-marks previously used or made known in Canada by the opponent or its predecessors-in-title;
- (d) That the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark was confusing with its pending trade-mark application No. 625,653 for the trade-mark MUMM DE MUMM which had been previously filed in Canada;
- (e) That the applicant is not the person entitled to registration of the trade-mark MAGNUMMM DE BISCUITS OF COOKIES in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the trade-name G.H. MUMM & CIE, SOCIÉTÉ VINICOLE DE CHAMPAGNE SUCCESSEUR previously used in Canada by the opponent or its predecessors-in-title in association its wares, services and business;
- (f) That the applicant is not the person entitled to registration in that: the applicant's application does not comply with Section 30 of the Trade-marks Act; the applicant's trade-mark is not registrable; and the applicant does not intend to use its trade-mark as alleged but rather has used or abandoned it;
- (g) That the applicant's trade-mark is not distinctive in that it does not distinguish and is not adapted to distinguish the applicant's wares from the wares of the opponent and others.

The applicant served and filed a counter statement in which it asserted that its trade-mark is registrable and distinctive, and that it is the person entitled to registration of the trade-mark MAGNUMMM DE BISCUITS OF COOKIES. Further, the applicant asserted that its application complies with the requirements of Section 30 of the Trade-marks Act.

The opponent filed as its evidence the affidavits of Anne-Marie Filion, Marilyn Hertz and Jean Montet-Jourdran, together with certified copies of the trade-mark registrations relied upon by it in this opposition. The applicant submitted as its evidence the affidavit of Michael Eskenazi.

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

No evidence has been adduced by the opponent in respect of its Section 30 grounds of opposition and no submissions were made by the opponent either in its written argument or at the oral hearing concerning these grounds. As a result, the opponent has failed to meet the evidential burden upon it in respect of these grounds which have therefore been rejected.

The remaining grounds of opposition are based on allegations of confusion between the applicant's trade-mark MAGNUMMM DE BISCUITS OF COOKIES and one or other of the opponent's trade-marks and trade-name relied upon by it in its statement of opposition. Accordingly, the determination of the issue of confusion will resolve all the remaining grounds in this proceeding. In determining whether there would be a reasonable likelihood of confusion between the trade-marks and trade-name at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks and trade-name at issue.

With respect to the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (F.C.A.); and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)). Further, the material date in respect of the non-entitlement and non-distinctiveness grounds of opposition are the applicant's filing date (September 11, 1989) and the date of opposition (July 23, 1990) respectively.

Considering initially the inherent distinctiveness of the trade-marks at issue, the opponent's trade-marks MUMM, MUMM DE MUMM and MUMM & Design and its trade-name possess some measure of inherent distinctiveness even though the mark MUMM might be perceived by some consumers as having a surname significance. Further, the applicant's trade-mark MAGNUMMM DE BISCUITS OF COOKIES, when considered in its entirety, is inherently distinctive even though

the words BISCUITS and COOKIES are the name of the applicant's wares and therefore add no inherent distinctiveness to the applicant's mark.

The applicant's evidence establishes that its trade-mark MAGNUMMM DE BISCUITS OF COOKIES has become known to some minor extent in Canada. In particular, Mr. Eskenazi, President of the applicant, attests to sales of approximately 18,000 units of the applicant's MAGNUMMM DE BISCUITS OF COOKIES cookies in Quebec and Ontario from November, 1989 to August, 1991. On the other hand, the opponent's MUMM and MUMM & Design trade-marks and its trade-name have become known in Canada in association with wine. In this regard, Jean Montet-Jourdran, Secretary General of the opponent, attests in his affidavit to approximately \$25,000,000 in sales of the opponent's MUMM wine in Canada from 1986 to 1990 inclusive while advertising expenditures attributable to the opponent's wines in Canada from 1985 to 1991 inclusive exceeded \$1,100,000. As a result, the extent to which the trade-marks and trade-name at issue have become known clearly favours the opponent in this opposition.

The length of time that the trade-marks at issue have been in use also favours the opponent in this opposition. In his affidavit, Jean Montet-Jourdran states that the opponent has used the MUMM trade-marks in Canada in association with wines since at least 1893 while the applicant's use of its trade-mark MAGNUMMM DE BISCUITS OF COOKIES in association with cookies only commenced November 1, 1989.

The applicant's cookies associated with its trade-mark MAGNUMMM DE BISCUITS OF COOKIES differ from the opponent's wine and champagne associated with its MUMM trade-marks. Additionally, the channels of trade associated with these wares would differ except in the province of Quebec where wines are sold through grocery stores and supermarkets.

As to the degree of resemblance between the trade-marks of the parties, I consider there to be no similarity in appearance, sounding or in the ideas suggested between the applicant's trade-mark MAGNUMMM DE BISCUITS OF COOKIES and the opponent's trade-marks MUMM, MUMM DE MUMM and MUMM & Design and its trade-name G.H. Mumm & Cie, Société Vinicole de Champagne Successeur.

In view of the differences in the nature of the wares and the absence of any resemblance between the trade-marks and trade-name at issue, I have concluded that the applicant has met the legal burden upon it of establishing that there would be no reasonable likelihood of confusion

between its trade-mark MAGNUMMM DE BISCUITS OF COOKIES and the opponent's MUMM trade-marks and its trade-name when considered in their entirety as a matter of first impression and imperfect recollection. Accordingly, I have rejected the opponent's grounds of opposition based on the allegations of confusion set forth in the statement of opposition.

In view of the above, I reject the opponent's opposition pursuant Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 31ST DAY OF AUGUST 1994.

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