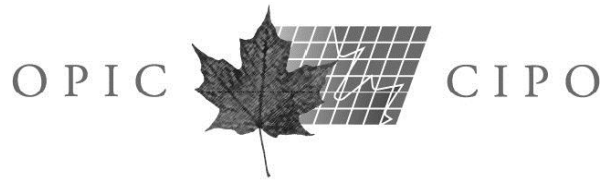


# TRADUCTION/TRANSLATION



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

**Citation: 2012 TMOB 60**  
**Date of Decision: 2012-04-19**

**IN THE MATTER OF AN OPPOSITION by  
Monte Carlo Holdings Corp. to application  
No. 1 304 899 for the trade-mark JAZZ A  
MONTE-CARLO & Design in the name of  
Société Anonyme des Bains de Mer et du Cercle  
des Étrangers à Monaco**

## Introduction

[1] On June 9, 2006, the Société Anonyme des Bains de Mer et du Cercle des Étrangers à Monaco (the Applicant), filed application No. 1 304 899 to register the trade-mark JAZZ A MONTE-CARLO & Design (the Mark) as shown below:



**JAZZ A MONTE-CARLO**

[2] This application was filed on the basis of proposed use. Following a written exchange with the examiner of this application, the Applicant filed an amended application that covered a multitude of wares and services. It is unnecessary to reproduce

this list in its entirety for the purposes of this decision, as the opposition only concerns certain services, namely:

restaurant (food) services; temporary accommodations, namely: hotels, hotel reservations, motels, rental of furnished apartments for short-,long-, or medium-term stays (the Services).

as indicated in paragraph 6.1 of the Opponent's written argument (as defined below).

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of April 2, 2008. On May 23, 2008, Monte Carlo Hotel-Motel International Inc. filed a statement of opposition which was forwarded by the Registrar to the Applicant on June 19, 2008. The statement of opposition was then amended on two occasions, to change the address and name of the Opponent. At present, the Opponent is identified by the name Monte Carlo Holdings Corp. I will use the term "Opponent" to refer indistinctively to Monte Carlo Hotel-Motel International Inc. and/or Monte Carlo Holdings Corp. However, if it becomes necessary, I will refer to each of these entities by their specific names.

[4] On June 30, 2008, the Applicant filed a counter statement in which it denied all the grounds of opposition listed below.

[5] The Opponent filed the affidavit of Dominic Meffe, sworn on October 27, 2008, as well as additional evidence in the form of a second affidavit from Dominic Meffe, sworn May 5, 2009. The Applicant filed a statutory declaration from Marie-Michèle McDuff, a certificate of authenticity for registration TMA719591 for the trade-mark MONTE CARLO SPA & Design, and the excerpts of the record herein, namely the original application as well as the amended application.

[6] Only the Opponent filed a written argument, although both parties were represented at the oral hearing.

## Grounds of Opposition

[7] The grounds of opposition raised by the Opponent, as indicated in its statement of opposition, amended once again on May 28, 2009, are:

1. The application does not conform to the requirements of section 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in that it does not include any registrable trade-marks pursuant to section 12 of the Act having regard to the previous use and registration of the trade-marks described in Annexes A and B attached to the reamended statement of opposition;
2. The application does not satisfy the requirements of section 30 of the Act, as the Applicant could not be satisfied that it was entitled to use and register the Mark in Canada having regard to the previous use and registration of the trade-marks described in Annexes A and B attached to the reamended statement of opposition;
3. The Mark is not registrable pursuant to paragraph 12(1)(d) of the Act, as it is confusing with the Opponent's registered trade-marks listed in Annex A attached to the reamended statement of opposition;
4. The Applicant is not the person entitled to registration of the Mark pursuant to paragraph 16(3)(a) of the Act because, as of the filing date of the application, the Mark was confusing with the trade-marks described in more detail in Annexes A and B attached to the reamended statement of opposition, which had been previously used and made known in Canada by the Opponent and its predecessor in title, 593416 Ontario Inc.;
5. The Applicant is not the person entitled to the registration of the Mark pursuant to paragraph 16(3)(b) of the Act because as of the filing date of the application, the Mark was confusing with the trade-marks described in more detail in Annex A attached to the reamended statement of opposition, in regards to which applications for registration had previously been filed in Canada by the Opponent;
6. The Applicant is not the person entitled to registration of the Mark pursuant to paragraph 16(3)(c) of the Act because, as of the filing date of the application, the Mark was confusing with the commercial name Monte Carlo Hotel-Motel International Inc. previously used in Canada by the Opponent;
7. Pursuant to paragraph 38(2)(d) and section 2 of the Act, the Mark is not distinctive in that it does not distinguish nor is it adapted to distinguish the Applicant's wares and services from those of others, namely the wares and services of the Opponent.

## Onus

[8] While the onus is on the Applicant to demonstrate that its application complies with the provisions of the Act, the Opponent has the initial burden to present sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.); *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.), and *Wrangler Apparel Corp. v. The Timberland Company* [2005] F.C. 722].

## Material Dates

[9] The material date for the analysis of each ground of opposition varies according to the ground of opposition to be assessed:

- non-compliance with the requirements of section 30 of the Act: the filing date of the application (June 9, 2006);
- registrability of the Mark according to paragraph 12(1)(d) of the Act: the date of the Registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413, at 424 (F. C.A.)];
- entitlement to registration of the Mark, where the application is based on proposed use: the filing date of the application (June 9, 2006) [see subsection 16(3) of the Act];
- distinctiveness of the Mark: the filing date of the statement of opposition (May 23, 2008) [see *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.), and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 38 C.P.R. (4th) 317 (F.C.T.D. )].

#### Grounds of Opposition based on section 30 of the Act

[10] The first ground of opposition, as it is written, is not a valid ground of opposition. If an application concerns the registration of a trade-mark that is not registrable pursuant to section 12, the appropriate ground of opposition is that concerning the registrability of that mark pursuant to that section. The first ground of opposition is therefore rejected.

[11] The second ground of opposition is not a valid ground of opposition either. Paragraph 30(i) of the Act requires only that the Applicant declares itself satisfied that it is entitled to use the Mark. This statement appears in the application. Previous use of trade-marks that are similar enough to create confusion is covered by the ground of opposition described in section 16 of the Act, known as "entitlement to registration", which has already been raised by the Opponent. As for the registered trade-marks, as I explained above, the appropriate ground of opposition is that which is based on section 12 of the Act. The second ground of opposition is therefore rejected.

#### Ground of Opposition based on paragraph 16(3)(b) of the Act

[12] Previous applications filed by the Opponent and making up the basis for this ground of opposition must be pending as of the date of advertisement of the present application [see subsection 16(4) of the Act]. The Opponent's applications 744288 and 744289 led to, on May 5, 1995, the registration of the trade-marks MONTE CARLO INN & Design and MONTE CARLO INN & Design of a crown, reproduced in the following paragraph. They were no longer pending as of April 2, 2008. The fifth ground of opposition is therefore rejected.

#### Registrability of the Mark pursuant to paragraph 12(1)(d) of the Act

[13] To support this ground of opposition, the Opponent may simply rely on its certificates of registration without establishing the existence of prior use of the trade-marks that are subject to these registrations. I consulted the register, and the marks subject to registrations TMA442550 and TMA442551, reproduced below, are extant:

# Monte Carlo Inn (MONTE CARLO INN &

Design)

and



(MONTE CARLO INN & Design of a

crown)

(collectively referred to hereafter as the marks MONTE CARLO INN) [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats Ltée v. Manu Foods Ltd.*, 11 C.P.R. (3d) 410]. The Opponent has therefore met its initial evidential burden.

[14] It thus falls upon the Applicant to prove, on a balance of probabilities, that use of the Mark in association with the Services is not likely to cause confusion with one or the other of the MONTE CARLO INN marks. The test to determine this issue is set out in subsection 6(2) of the Act. I must take into consideration all relevant circumstances, including those listed in subsection 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares, services, or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[15] This list is not exhaustive, and it is unnecessary to give each factor equal weight.

[16] During the oral hearing, the Applicant brought attention to what it considers to be faults in the chain of titles for the MONTE CARLO INN marks. It maintains that, in reading the second affidavit of Mr. Meffe, president of the Opponent, one does not know

exactly which entity is the owner of the MONTE CARLO INN marks and which may claim previous use of it. The Applicant did not contest the fact that these trade-marks had been used in Canada in association with hotel services and certain personal care products, but maintains that the Opponent cannot claim this prior use. As this decision will show, I do not need to address this issue in order to render a decision on the current ground of opposition. In any event, the present opposition proceeding is not the appropriate forum to debate, in any way whatsoever, the validity of the Opponent's registrations. It suffices to say at this point in time that Monte Carlo Holdings Corp. is recorded in the register as the owner of the MONTE CARLO INN marks.

[17] The faults in the chain of titles of ownership of the MONTE CARLO INN marks, if there are any, would have no bearing on the examination of the second portion of the first factor and of the second factor listed in subsection 6(5) of the Act. However, I find that the degree of resemblance between the parties' respective trade-marks is the primary factor in this case. I refer to the Supreme Court of Canada, which clearly indicated in *Masterpiece Inc. v. Alavida Lifestyles Inc. et al.* 2011 SCC 27, that the degree of resemblance between marks is the most important factor among those listed in subsection 6(5) of the Act.

[18] I consider that the Opponent has more chances of success with its mark MONTE CARLO INN & Design, because its graphic design is limited only to the typeface of the letters. Further, during the oral hearing, the Opponent emphasized this mark rather than the other. In the case of the mark MONTE CARLO INN & Design of a crown, the design, which is the dominant part of the mark, is so different from the design making up part of the Mark that this difference only serves to benefit the Applicant. I will therefore proceed to the analysis of the criteria under subsection 6(5), limiting myself to the mark MONTE CARLO INN & Design. If the Opponent cannot succeed with this mark, it cannot claim to have better luck with its mark MONTE CARLO INN & Design with a crown.

[19] It has been established, using dictionary definitions annexed to the affidavit of Marie-Michèle McDuff, a student working for the Applicant's agent at the time of her affidavit, that Monte Carlo is a ward in the Principality of Monaco.

[20] The word "inn" is highly suggestive when the mark MONTE CARLO INN & Design is used in association with hotel services. The word "jazz" is a known word in English and in French. Therefore, the Mark, when used in association with wares and services related to music, is suggestive.

[21] The distinctiveness of a mark may be enhanced through its use and the extent to which it has become known in Canada. There is no evidence of use of the Mark in Canada by the Applicant.

[22] It is unnecessary to summarize in detail the content of Mr. Meffe's first and second affidavits. As I have already mentioned, the affidavits clearly establish the use of the MONTE CARLO INN marks in Canada since as early as 1992.

[23] Certificate of registration TMA442550 also covers hotel services. Thus there is definitely an overlap with respect to the Services.

[24] It is true that the Opponent's trade-mark MONTE CARLO INN & Design and the Applicant's Mark resemble each other phonetically, due to the presence of the geographic designation MONTE CARLO. Nevertheless, MONTE CARLO is the dominant element of the mark MONTE CARLO INN & Design because the graphic portion is limited to the typeface used to illustrate said mark. That being said, this is not the case for the Mark. Its graphic component appears to me to be as important as the word component. It is an original graphic that combines palm tree fronds with a bird, a woman's silhouette, or even the representation of an angel. Further, the first portion of the Mark is the word "jazz". The idea suggested by the Mark, being [TRANSLATION] "jazz in Monte Carlo" differs from the idea suggested by the MONTE CARLO INN & Design mark, in which the word "inn" suggests a location where one expects to find temporary accommodations in the form of a room or apartment in a lodge.



[25] It has often been asserted that the first component of a trade-mark is often the element that serves to distinguish one trade-mark from another. In this regard, I refer to *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183.

[26] The Opponent argues that the Mark, when used in association with the Services, provides the consumer who has an imperfect recollection of the mark MONTE CARLO INN & Design, with the impression that the Opponent operates a jazz club within its establishment. However, the Opponent's certificate of registration does not cover the services of a bar or club in which one might be entertained while listening to music. Further, by deciding to incorporate the name of a known geographic designation as the dominant element of its mark, the Opponent must accept that its monopoly will have a more limited scope than if the mark were made up of unique elements. Apart from the presence of the known geographic designation, both parties' marks are different when considered as a whole, both visually and in terms of the ideas they suggest. This factor favours the Applicant.

[27] As a further surrounding circumstance, the Applicant relies on the fact that it obtained registration of the trade-mark MONTE-CARLO SPA & Design (certificate of registration TMA719591), the graphic component of which is identical to the graphic component of the Mark. It pleads that it should therefore have the right to secure the registration of the Mark because its dominant feature is also the graphic that can be found in the registered mark MONTE-CARLO SPA & Design.

[28] It has been stated on multiple occasions that the issue of a certificate of registration for a trade-mark does not provide the right to secure the registration of another trade-mark, regardless of the degree of resemblance between this new trade-mark and that which is the object of a previous registration [see *Coronet Heinrich Schlerf GmbH v. Produits Ménagers Coronet Inc.* (1984), 4 C.P.R. (3d) 108 (T.M.O.B.)]. Nevertheless, the Applicant's agent would like this principle to be elaborated upon since the Mark is substantially the same as the MONTE CARLO SPA & Design mark, and one cannot disregard the fact that the Applicant had already obtained a certificate of

registration for its MONTE CARLO SPA & Design mark. One must, according to this logic, give more weight to the obtainment of a certificate of registration. That being said, the circumstances that led to the registration of the Applicant's other mark are unknown. I cannot not presume that if there has been no opposition, it is due to the Opponent's decision to not contest the registration of that mark, having judged that there was no likelihood of confusion. There can be many reasons to justify the lack of opposition from the Opponent. I do not see how I could distinguish *Coronet* from the present record.

[29] I conclude that the Applicant has met its burden to prove, on a balance of probabilities, that the Mark, if used in association with the Services, does not create confusion with the trade-mark MONTE CARLO INN & Design, as the latter possesses a low distinctiveness, and that the Mark stands out from that mark both visually and by the ideas it suggests.

[30] Therefore, I reject the third ground of opposition.

Grounds of Opposition based on paragraphs 16(3)(a) and (c) of the Act

[31] In regards to the ground of opposition based on paragraphs 16(3)(a) and (c) of the Act, the Opponent bears the initial burden of proving that its trade-marks and its commercial name MONTE CARLO HOTEL-MOTEL INTERNATIONAL INC. had been previously used or made known in Canada by the Opponent or its predecessors in title prior to the material date of June 9, 2006.

[32] It is unnecessary to summarize in detail the contents of the affidavits signed by Mr. Meffe. As I previously mentioned, they clearly establish the use of the MONTE CARLO INN marks. This fact is not contested by the Applicant.

[33] However, the Applicant claims that there is no proof of the existence of a valid chain of titles; as such, the Opponent cannot rely on the previous use of its alleged predecessors in title. If this is the case, the Applicant maintains that the grounds of opposition based on previous use of said marks by the Opponent should be rejected on the ground that the Opponent has not met its initial burden.

[34] For the purposes of the ground of opposition based on paragraph 16(3)(a) of the Act, I will assume that the Opponent has met its burden to prove use of the MONTE CARLO INN marks prior to the filing date of the present application. Nevertheless, I conclude to reject this ground of opposition for the same reasons listed under the previous ground of opposition. The primary issue remains the likelihood of confusion between the Mark and the MONTE CARLO INN marks belonging to the Opponent. The analysis of the various relevant criteria listed in subsection 6(5) leads to the same result, even if this analysis were performed on a different material date, namely that of June 9, 2006.

[35] In terms of the ground based on paragraph 16(3)(c) of the Act, the evidence on record filed by the Opponent is insufficient to support this ground of opposition. In fact, the only paragraph that addresses the use of the Opponent's commercial name in the normal course of its business affairs is paragraph 47 of Mr. Meffe's first affidavit and Exhibits P1 and P2, namely a sample letterhead and business card. However, Mr. Meffe does not indicate the date on which the stationery was used, nor the frequency of its use. Incidentally, the Opponent did not insist on this ground of opposition in its written argument and did not make representations in its respect during the oral hearing. Under these circumstances, I consider that the Opponent has not fulfilled its initial evidential burden.

[36] Even if the Opponent fulfilled its initial evidential burden, I would have ruled in favour of the Applicant for reasons similar to those developed under the ground of opposition regarding the registrability of the Mark, adding that the degree of resemblance between the Mark and the Opponent's commercial name, be it phonetic, visual, or related to the ideas suggested thereby, is even weaker than that between the Mark and the MONTE CARLO INN marks.

[37] Thus I reject the fifth and sixth grounds of opposition.

Ground of opposition based on the lack of distinctiveness of the Mark

[38] The Opponent must first demonstrate that its MONTE CARLO INN marks had become sufficiently known upon the filing date of the statement of opposition, namely

May 23, 2008, to negate any distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58]. Once the Opponent has met its burden, the Applicant has a legal onus to show, on a balance of probabilities, that the Mark was not likely to cause confusion with one or the other of the Opponent's aforementioned trade-marks. In this manner, the Mark would be adapted to distinguish or would actually distinguish throughout Canada, on the material date, the Services from the Opponent's services and wares [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272].

[39] If the marks MONTE CARLO INN had become known in Canada within the context of their use prior to the material date, it would matter little which entity (or entities) had used them in order to address this ground of opposition. Even in the belief that this use would favour the Opponent, I reject this ground of opposition for the same reasons described under the ground of opposition regarding the registrability of the Mark.

[40] This is so since the lack of a likelihood of confusion between the Mark and the MONTE CARLO INN marks belonging to the Opponent upon the material date shows that the Mark was distinctive or apt to distinguish the Services from the services and wares of the Opponent on that date. I wish to add that the fact that the material date relating to the present ground of opposition is prior to that which is associated with the ground of opposition pursuant to paragraph 12(1)(d) has no bearing on the analysis of the surrounding circumstances listed in subsection 6(5) of the Act, said analysis having been discussed in detail in that ground of opposition.

[41] Thus I reject the seventh and last ground of opposition.

Disposition

[42] Having been delegated authority by the Registrar of Trade-marks by virtue of subsection 63(3) of the Act, I reject the opposition pursuant to subsection 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation  
[Jane Kuna]