



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

Citation: 2014 TMOB 230
Date of Decision: 28/10/2014
TRANSLATION

**IN THE MATTER OF AN OPPOSITION
by Les Marques Metro / Metro Brands
s.e.n.c. against application No. 1,448,753
for the trade-mark IRRESISTIBLES in
the name of Julia Wine Inc.**

Introduction

[1] Les Marques Metro / Metro Brands s.e.n.c. (the Opponent) opposes registration of the trade-mark IRRESISTIBLES (the Mark) covered by application No. 1,448,753 in the name of Julia Wine Inc. (the Applicant).

[2] This application, filed on August 19, 2009, is based on the projected use of the Mark in association with the following wares: “wines” (hereafter occasionally referred to as the Wares).

[3] The Opponent bases its opposition on various grounds centered around the issue of compliance of the application with Section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), i.e. the issue of the likelihood of confusion between the Mark and one or more of the “IRRESISTIBLES” trade-marks covered by the registrations or applications described in the appendix, owned by the Opponent and having been used, as the case may be, in Canada by the Opponent and its predecessor-in-title, Métro Richelieu Inc. (Métro-Richelieu).

[4] Such as it will stem from my analysis, I consider there is reason to accept this opposition.

The record

[5] The statement of opposition was filed on March 7, 2011. The Applicant filed a counter statement denying each of the grounds of opposition argued. The Opponent also requested an interlocutory decision regarding the validity of paragraph 3(b) of the statement of opposition to the effect that the Applicant could not have been, and still cannot be, convinced that it is entitled to use the Mark in association with the Wares since this application was filed for the purpose of undermining the Opponent's rights over its trade-marks, and since the Applicant has adopted a modus operandi that consists in filing registration applications related to well-known marks in identical or related fields in Canada. Through a letter from the registrar dated August 29, 2011, the Applicant's request to have said paragraph 3(b) stricken was rejected.

[6] The Opponent then asked for permission to file an amended statement of opposition to reflect the fact that one of the applications referred to in the original statement of opposition was now registered. This permission was granted to the Applicant by the registrar on December 12, 2011.

[7] The Opponent has produced the following documents in support of its opposition:

- an affidavit from Francis Cournoyer, Director of Design and Packaging of the Opponent, sworn on November 24, 2011;
- an affidavit from Pierre Charron, Vice President, National Procurement and Private Brands, Métro-Richelieu, sworn on November 24, 2011;
- an affidavit from France Patenaude, Director of National Procurement, Métro-Richelieu, sworn on November 24, 2011.
- an affidavit from Patrick Garon-Sayegh, an intern with the firm representing the Opponent in these proceedings, sworn on November 16, 2011;
- certified copies of the ten (10) following trade-mark applications: COMPLIMENTS (TMA675,493); NOS COMPLIMENTS (TMA458,788); NOS COMPLIMENTS (TMA487,713); OUR COMPLIMENTS (TMA447,577); OUR COMPLIMENTS (TMA487,714); COMPLIMENTS (TMA675,272); LE CHOIX DU PRÉSIDENT (TMA469,003); LE CHOIX DU PRÉSIDENT & Design (TMA671,834);

IRRESISTIBLES À CAUSE DES INGRÉDIENTS (TMA796,552); and
IRRESISTIBLES À CAUSE DES INGRÉDIENTS BECAUSE OF THE
INGREDIENTS (TMA774,055);

- certified copies of the three (3) following trade-mark applications: IRRESISTIBLES (No. 1,344,171); IRRESISTIBLE (No. 1,329,344); and IRRESISTIBLES & Design (No. 1,452,360); and
- certified copies of the six (6) following trade-mark applications filed by the Applicant: CHOIX DU PRÉSIDENT (No. 1,448,752); COMPLIMENTS (No. 1,448,754); ZORK (No. 1,458,868); IRRESISTIBLES (No. 1,448,753); AOP APPELATION D'ORIGINE PROTÉGÉE & Design (No. 1,458,769); and AOP (No. 1,454,671).

[8] Mr. Charron was cross-examined with respect to his affidavit and the transcript of his cross-examination was made part of the record. It should be noted at this point in my decision that the Applicant has stated in its written argument that the affidavits by Mr. Charron and Ms. Patenaude should be declared inadmissible as evidence on the grounds that they present discussions and/or negotiations involving the outcome of this application and the settlement of these proceedings. I will come back to this issue later on.

[9] The Applicant produced the following documents in support of its application:

- certified copies of the nine (9) following trade-mark applications: UNE SAVEUR IRRESISTIBLE (TMA555,115); SIMPLY IRRESISTIBLE (TMA662,062); SIMPLY IRRESISTIBLE (TMA390,806); MR. KERNEL IRRESISTIBLE TASTE & Design (TMA671,505); IRRÉSISTIBLEMENT CANADIENNE (TMA663,827); IRRESISTIBLE INNOVATION (TMA820,353); Irresistible Elegance (TMA678,616); IRRESISTIBLE (TMA497,253); and FRAÎCHEMENT IRRÉSISTIBLE (TMA572,050);
- certified copies of the two (2) following trade-mark applications: Simply Irresistible & Design (application no. 1,532,903); and IRRESISTIBLES (application no. 1,333,541); and

- a certified copy of the eligibility letter for the Simply Irresistible & Design registration application (application no. 1,532,903).

[10] Each of the parties filed a written argument and was represented at the hearing held in this file.

Preliminary issue – Admissibility of the Charron and Patenaude affidavits

[11] As indicated above, the Applicant has stated in its written argument that the affidavits by Mr. Charron and Ms. Patenaude should be declared inadmissible as evidence on the grounds that they present discussions and/or negotiations involving the outcome of this application and the settlement of these proceedings. To do so, the Applicant used the decision *Mothercare Ltd v Precious Secret Maternity Inc* (1976), 27 CPR (2d) 171 (TMOB), in which settlement discussions were ruled as being inadmissible as evidence.

[12] The Opponent, for its part, stated during the hearing that the affidavits by Ms. Patenaude and Mr. Charron were, on the contrary, admissible as evidence. The Opponent namely referred to the publication by Prof. Léo Ducharme, *L'administration de la preuve*, to reiterate the four conditions of immunity, namely:

- The existence of a dispute;
- Communication aimed at settling the dispute;
- Made under the express or implicit condition that it shall remain confidential; and
- Did not result in a transaction.

[see Léo Ducharme, *L'administration de la preuve*, 4th Edition, Wislon & Lafleur, 2010, pp. 192 to 196]

[13] This brings me to review the content of each affidavit in light of the parties' representations.

Patenaude affidavit

[14] In her affidavit, Ms. Patenaude stated having met around mid-2010 Alain Lord Mounir, the Applicant's president, at her request, who wished to meet with her [paragraph 2 of her affidavit].

[15] Said meeting was about thirty minutes to one hour long. At the meeting, Mr. Mounir stated to Ms. Patenaude that the Applicant had filed an application for the Mark in association with wine [paragraphs 3 and 4].

[16] Mr. Mounir added that the fact that the Applicant owned the Mark in association with wine would allow the Opponent to produce wines that the latter could then sell under said mark, but that the Applicant would own the Mark [paragraph 5].

[17] Still according to Ms. Patenaude, Mr. Mounir mentioned during the meeting that he had met with some Loblaw's representatives regarding a registration application made by the Applicant for the CHOIX DU PRÉSIDENT trade-mark in association with wine and that he had met or was about to meet IGA representatives regarding a registration application made by the Applicant for the COMPLIMENTS trade-mark [paragraph 6].

[18] Ms. Patenaude told Mr. Mounir that she was giving full consideration to his proposals but that she would have to speak to some in-house people. The meeting was then brought to Mr. Charron's attention.

[19] As argued by the Opponent at the hearing, the discussions that occurred between Ms. Patenaude and Mr. Mounir can in no way be qualified as discussions aimed at settling a dispute. It was the Applicant's president who approached the Opponent to inform the latter of the fact that the Applicant had produced this registration application and to discuss a business proposal with the Opponent. There was no question of a dispute at the time. On the contrary, the Applicant was instead looking to enter into a business partnership with the Opponent. Therefore, I agree with the Opponent that Ms. Patenaude's affidavit can be admitted as evidence.

Charron affidavit

[20] Mr. Charron states having sent a letter to Mr. Mounir in his capacity as the Applicant's president with respect to the present registration application and has produced a copy of said

letter dated September 9, 2010 as Exhibit PC-1. Upon reviewing said letter, I see that it does not bear any indication such as “without prejudice” or other such indication [paragraph 2 of his affidavit].

[21] Mr. Charron explained that said letter follows prior discussions between Ms. Patenaude and Mr. Mounir [paragraph 3 of his affidavit].

[22] Following the mailing of said letter, Mr. Charron sent an e-mail dated January 25, 2011 to Mr. Mounir still on the same subject. A copy of the e-mail in question is submitted as Exhibit PC-2. Once again, this document does not contain any reservations [paragraph 4].

[23] Mr. Charron states having had a phone conversation with Mr. Mounir and of having subsequently met with him at the Opponent’s offices on February 3, 2011 to discuss the situation. The meeting in question lasted about one hour and a quarter [paragraph 5].

[24] Still according to Mr. Charron, Mr. Mounir appears to have told him at said meeting that he came to an agreement with Loblaws regarding the LE CHOIX DU PRESIDENT trade-mark and had convinced Sobeys to withdraw its registration application for the COMPLIMENTS trade-mark in association with wine [paragraph 6].

[25] At said meeting, Mr. Mounir also told Mr. Charron that the Applicant [TRANSLATION] “had registered the IRRESISTIBLES trade-mark in association with wine.” He added that he found a loophole in Quebec legislation regarding the sale of wine in connection with private brands, which is actually against the law, and he proposed that the Applicant sell the Opponent wine under the Mark, which the Opponent could not do directly. In exchange for such a contract, Mr. Mounir told Mr. Charron that he could assign the Mark in association with wine to the Opponent, which would then allow the Opponent to potentially step up the registration of its own IRRESISTIBLES trade-mark for wares in the “groceries category.” A copy of the documents submitted by Mr. Mounir at said meeting is produced as Exhibit PC-3. Mr. Charron told Mr. Mounir that he was not interested.

[26] As argued by the Opponent at the hearing, the discussions between Mr. Charron and Mr. Mounir can in no way be qualified as discussions aimed at settling a dispute. Although the context of the discussions suggested a potential or actual dispute, the facts related by

Mr. Charron show the discussions during which the Applicant, through Mr. Mounir, was looking to enter into a business deal with the Opponent. These discussions were of an exploratory nature. They did not actually consist of discussions for the purpose of settling a dispute.

[27] It should be recalled in this respect that the Applicant cross-examined Mr. Charron. However, no objection or reservation as to the admissibility of Mr. Charron's testimony was brought up during said cross-examination. On the contrary, several questions that were brought up specifically pertained to the context of the discussions between Mr. Charron and Mr. Mounir. Mr. Charron's responses clearly showed that it was a question of [TRANSLATION] "business discussions of an exploratory nature" [see p. 10 to 13 of the cross-examination transcript].

[28] To conclude on this point, I agree with the Opponent that Mr. Charron's affidavit can be admitted as evidence.

Analysis

The burden incumbent on the Parties

[29] It is initially for the Opponent to establish the well-foundedness of its opposition. However, the legal onus of showing that the Mark is registrable falls to the Applicant, according to the balance of probabilities [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (CF 1st. inst.) and *Dion Neckwear Ltd v Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

Grounds of opposition

[30] I will begin my analysis by the ground of opposition based on the absence of distinctiveness of the Mark.

Absence of distinctiveness of the Mark

[31] The Opponent argued that the Mark is not distinctive under Section 2 of the Act since it cannot truly distinguish and is not capable of distinguishing the Wares from the wares and

services in connection with which the Opponent and its predecessor-in-title, Métro Richelieu, have used and continue to use the marks listed in the appendix to my decision.

[32] The Opponent added in this respect that the aforementioned IRRESISTIBLES and IRRESISTIBLES & Design marks had been used in Canada by the Opponent and Métro Richelieu prior to August 19, 2009, and are still being used by the Opponent in connection with the following wares (hereafter the Products):

[TRANSLATION]

- (1) Cereal; breads and flat breads; pies; peanut butter; cookies; coffee; fruit juice; fish and seafood; napkins; non-alcoholic beverages; herbs and spices, cheese, eggs; pasta; maple syrup; chips and snacks; edible oils; spreads.

- (2) Crackers; croutons; cakes; facial tissues; prepared meals (lasagna); jams and marmalades; herbal teas; butter; ice cream and popsicles; milk; vegetables; margarine; chocolate and candy; salad dressings; Asian sauces; sorbets; meat; vinegar; canapés; yogurt; fruit; mustard; pizza; gravies and fish sauce; danishes; legumes; pasta sauce; meat pies; meat and fish marinades; honey.

- (3) Ketchup; pet food; broth; dessert sauces.

[33] To meet its initial burden of proof with regard to non-distinctiveness, the Opponent must show that one or more of its IRRESISTIBLES marks had become sufficiently known in Canada on the date of the statement of opposition, i.e. March 7, 2011, such as to deny the distinctiveness of the Mark [see *Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (CF 1st. inst.) and *Bojangles' International LLC and Bojangles Restaurants Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC, 1st. inst.)].

[34] As my review of the Opponent's evidence discussed hereafter will show, this burden was met by the Opponent, at least with respect to its IRRESISTIBLES brand name.

[35] Since the Opponent has met its initial incumbent burden of proof, the Applicant must now show, according to the balance of probabilities, that on the filing date of the statement of opposition, there was no risk of confusion between the Mark and this one of the Opponent's marks.

The test for confusion

[36] The test for confusion is that of first impression and imperfect recollection. According to subsection 6(2) of the Act, the use of a trade-mark creates confusion with another trade-mark when the use of both trade-marks in the same region would be likely to give the impression that the wares related to these trade-marks are manufactured, sold, leased or rented or that the services related to these trade-marks are leased or executed, by the same person, whether or not these wares or these services are in the same general category.

[37] In deciding whether these trade-marks are confusing, the registrar must take into account all circumstances in the case, specifically those listed in subsection 6(5) of the Act, i.e. 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; 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 could be given to each of these factors, depending on the situation [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée et al* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

[38] In the above-mentioned *Masterpiece* judgment, the Supreme Court addresses the importance of the degree of resemblance as follows:

[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. These 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 [...].

[39] Under the circumstances of the present case, I consider it appropriate to analyse the degree of resemblance between the parties' marks first.

The degree of similarity between the trade-marks in the presentation or sound, or in the ideas they suggest

[40] The parties' trade-marks are identical. Therefore, as the arguments in the *Masterpiece* judgment indicate, the remaining factors must be assessed carefully as they have a greater impact in the present case.

The inherent distinctiveness of the trade-marks and the extent to which they have become known

[41] The parties' marks have an equivalent inherent distinctiveness in the context of the wares and/or services associated with them. They both have a promotional tone. In this respect, I believe that their inherent distinctiveness is relatively small.

[42] However, I agree with the Opponent that the extent to which these trade-marks have become known significantly favours the Opponent.

[43] As indicated above, this application is based on the proposed use of the Mark in Canada and the Applicant has submitted no associated evidence of use.

[44] In comparison, the Opponent's evidence, introduced by way of Mr. Cournoyer's affidavit, basically establishes that:

- Metro Inc. is a company in the food and pharmaceutical industry operating in Quebec and Ontario. Metro Inc., Metro Richelieu and the Opponent are part of the same group of companies. Metro Inc. and Metro Richelieu are the sole partners of the Opponent. Metro Inc. has over 60 years of experience in the food industry and operates, as a retailer or distributor, various banners in the supermarket and discount store segments [paragraphs 5-7];
- The Opponent acquired all the rights, titles and interests, namely for the IRRESISTIBLE and IRRESISTIBLES trade-marks, as well as for the marks associated therewith, from Métro Richelieu on August 31, 2007 [paragraph 8 and copy of the assignment submitted as Exhibit FC-1];

- Metro Richelieu began using the THE-LES IRRESISTIBLES mark in Canada in 2002 in association with various food products. In 2003, Metro Richelieu began using the IRRESISTIBLE mark in Canada in replacement of the THE-LES IRRESISTIBLES trade-mark, still in association with food products [paragraph 9];
- In September 2007, the Opponent began using the IRRESISTIBLE trade-mark in Canada in replacement for the THE-LES IRRESISTIBLES trade-mark, still in association with food products; The Opponent continued to use the IRRESISTIBLE mark alongside the IRRESISTIBLES mark for about two and a half years, the time required to introduce the new products and make the transition from the former products [paragraphs 11 and 12];
- The Opponent has used the IRRESISTIBLES trade-mark on a continuous basis in Canada in connection with food products, namely in connection with the Products listed in paragraph 32 of my judgment [paragraph 13];
- On the date the affidavit was signed, there were 1100 stock keeping units (SKUs) for such Products [paragraph 14];
- The IRRESISTIBLES trade-mark has been used since at least as early as 2007 with the Products (1), 2008 with the Products (2), and the summer of 2009 with the Products (3) [paragraph 13];
- IRRESISTIBLES is a private brand. The same applied to the LES-THE IRRESISTIBLES and IRRESISTIBLE brands [paragraphs 3 and 15];
- The Products are sold by Metro Richelieu during the course of its operations, mainly to supermarkets bearing the banners METRO and METRO PLUS (hereafter the Supermarkets), which then resell them to consumers [paragraph 17];
- The Supermarket network included at least 240 stores in 2003 and at least 370 stores in 2011. The Products were sold in all these stores [paragraph 18];
- Since at least as early as October 2003, sales of Products by Metro Richelieu, and of the wares covered by the LES-THE IRRESISTIBLES and IRRESISTIBLES trade-marks, to

the Supermarkets totalled over \$940 million. A table listing these sales by year is included [paragraph 19]; and

- From 2003 to September 2006 inclusively, Metro Richelieu sold a beer to Supermarkets under the IRRESISTIBLE brand which was sold to consumers in these stores [paragraph 26].

[45] As support for his statements of use, Mr. Cournoyer is including the following documents:

- Exhibit FC-2 filed jointly: packaging specimens of the Products bearing the IRRESISTIBLES brand, representative of those used since 2007, as sold in Supermarkets;
- Exhibit FC-3 filed jointly: photographs of the packaging of the Products and wares covered by the LES-THE IRRESISTIBLES and IRRESISTIBLES brands, representative of those used since 2002;
- Exhibit FC-4 filed jointly: excerpts of copies of sales invoices for the Products and wares covered by the LES-THE IRRESISTIBLES and IRRESISTIBLES trade-marks, from 2003 to 2011, representative of sales invoices dating back to this time for all the Products and wares;
- Exhibit FC-5 filed jointly: specimens of Supermarket flyers from 2003 to 2011, representative of the other flyers from this time. Mr. Cournoyer indicated that each week since 2003 millions of such flyers have been distributed or made available to Supermarket customers. In 2005, at least 2.5 million flyers had been distributed or made available to consumers each week, while in 2011, the number of flyers had increased to about 6.5 million each week, including 3.5 million in Ontario and 3 million in Quebec;
- Exhibit FC-6: a copy of a review that appeared in Journal 24H for the Greater Montreal Area in the April 16-17, 2011 issue talking about pizzas, that of the Opponent sold under the IRRESISTIBLES brand.

[46] It should be mentioned at this stage of my analysis that I am in agreement with the Opponent that use of the LES-THE IRRESISTIBLES and IRRESISTIBLE marks, depending on the case, is applicable to the use of the IRRESISTIBLES mark [see *Registrar of Trade Marks v Compagnie Internationale pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA) and *Nightingale Interloc v Prodesign* (1984), 2 CPR (3d) 535 (TMOB)].

[47] Given the sales and the advertising through millions of flyers distributed each week in Quebec and Ontario, submitted as evidence by Mr. Cournoyer, I consider it reasonable to conclude that the Opponent's IRRESISTIBLES mark is well established in Canada and has become widely known in Canada, at least in the provinces of Quebec and Ontario. This recognition increases the distinctive character of the Opponent's IRRESISTIBLES mark.

[48] Accordingly, my overall assessment of this first factor, which is a combination of inherent and acquired distinctiveness, significantly favours the Opponent.

The period during which the trade-marks have been in use

[49] Given my comments above, this factor also significantly favours the Opponent.

Type of wares, services or enterprises and the nature of the business

[50] The Applicant's Wares consist of wines, while the Opponent's IRRESISTIBLES mark has been used on a continuous basis in Canada since 2007 in connection with over a thousand food products of all kinds and of a wide variety covering a very broad spectrum, including fruit juices and non-alcoholic beverages, sauces and marinades.

[51] The Applicant claims that the products being sold under the Opponent's IRRESISTIBLES mark are completely different than the Applicant's wines. The Opponent in fact argues that there are notable differences between a wine and a food product where one of the ingredients is wine, such as sauces, veloutés and marinades. Referring to the aforementioned *Mattel* case to the effect that [TRANSLATION] "we need to trust the average consumer to some extent," the Applicant argues that it is unlikely, if not impossible, for clients purchasing the Applicant's wines to make a mistake when shopping since there is a major difference between purchasing wine and purchasing a sauce, velouté or marinade containing wine.

[52] On the contrary, the Opponent is arguing that first with regard to distribution channels, we need to bear in mind that the Opponent's wares under the IRRESISTIBLES brand are sold in over 370 supermarkets operating under the METRO and METRO PLUS banners, and it appears from the flyers submitted as Exhibit FC-5 to Mr. Cournoyer's affidavit that wine is sold in the same stores as the Opponent's IRRESISTIBLES brand food products. The Opponent is in fact referring to the following flyers:

- Flyer for the week of November 10-16, 2003 featuring IRRESISTIBLE brand beer; and
- December 22-28, 2003 (page 4); March 8-14, 2004 (page 3); April 26 to May 2, 2004 (page 2); May 17-23, 2004 (page 5); July 12-18, 2004 (page 4); August 2-8, 2004 (page 6); August 9-15, 2004 (page 4); September 27 to October 3, 2004 (page 2); October 25-31, 2004 (page 3); November 1-7, 2004 (page 2); December 6-12, 2004 (page 6); January 17-23, 2005 (page 3); February 7-13, 2005 (page 3); February 21-27, 2005 (page 4); April 4-10, 2005 (page 4); June 20-26, 2005 (page 5); February 5-11, 2009 (page 3); March 5-11, 2009 (page 4); and April 23-29, 2009 (page 2) part of the promotion of IRRESISTIBLES wines and products on the same page.

[53] I agree with the Opponent that this clearly proves that wine is sold in supermarkets operating under the METRO and METRO PLUS banners and that wine is likely to use the same distribution channels as the Opponent's IRRESISTIBLES brand products. As rightly pointed out by the Opponent, it is further revealing that the president of the Applicant contacted Ms. Patenaude and Mr. Charron to have IRRESISTIBLES brand wine sold in supermarkets operating under the METRO and METRO PLUS banners.

[54] With respect to the parties' type of wares, the Opponent namely argued that the Applicant's wines and the Opponent's non-alcoholic beverages consist of beverages for human consumption. The Opponent also mentioned that its bottles of IRRESISTIBLES brand sparkling punch are made of glass and have a shape similar to the one generally used for sparkling wine sold in stores [see exhibits FC-3 and FC-5 included with Mr. Cournoyer's affidavit]. The Opponent further noted that from 2003 to September 2006 inclusively, Metro Richelieu sold to Supermarkets a beer under the IRRESISTIBLE brand that was sold to consumers. Citing in particular *T. Eaton v Viking GmbH & Co* (1998) 86 CPR (3d) 382 (TMOB), the Opponent argues

that similar past use in connection with beer militates in favour of significant “connectedness” in that it proves that the concept of “natural extension” with respect to alcoholic beverages in this case is an established fact rather than just a hypothesis. The Opponent added that this is all the more true in the present case since the Opponent’s IRRESISTIBLES brand consists of a private brand, sold in connection with a wide range of wares, and which has continuously expanded over the years.

[55] Lastly, the Opponent draws a parallel between the present case and *Heineken Brouwerijen BV v Marcon* (2012), 105 CPR (4th) 468 (TMOB); *Société Anonyme des Eaux Minérales d’Evian v Marcon*, 2010 TMOB 83 (CanLII); *MHCS v Marcon*, 2012 TMOB 195 (CanLII); and *Sobeys Capital Incorporated v Julia Wine Inc*, 2014 TMOB 34 (CanLII), where the concept of “connectedness” and/or of “natural extension” was retained by the registrar despite the fact that the wares in question differ through their inherent nature.

[56] I am in general agreement with the Opponent.

[57] It is appropriate to recall that it is not necessary for the parties to work in the same general field or in the same industry or that their respective wares and services are of the same type or same quality for there to be a likelihood of confusion. As indicated in section 6(2) of the Act, confusion can be created “whether or not the wares or services are of the same general class.”

[58] Although the Opponent does not sell wine under its private brand IRRESISTIBLES per se, the Opponent’s evidence clearly establishes that wine is being sold in METRO and METRO PLUS supermarkets.

[59] In the absence of evidence to the contrary, it cannot be ruled out that the Applicant’s wines are being sold in the same types of supermarkets as those of the Opponent. The steps undertaken by the president of the Applicant vis-a-vis Ms. Patenaude and Mr. Charron are along the same lines.

[60] Furthermore, although the Opponent is not selling any wine or alcoholic beverages under its IRRESISTIBLES private brand, it cannot be ruled out that similar products could be considered as a natural extension of the wide range of IRRESISTIBLES products sold by the

Opponent given the ongoing development of the products part of the Opponent's private brand, all the more so as the latter's predecessor-in-title has in fact sold IRRESISTIBLE brand beer in the past.

[61] My general assessment of the third and fourth factors favours the Opponent.

Additional circumstance – state of the register

[62] As indicated above, the Applicant has submitted as evidence certified copies of some nine registrations and two applications for trade-marks with the word "IRRESISTIBLE" used in combination with other words or components.

[63] The Applicant states that these registrations and applications prove that there are many trade-marks registered in the name of third parties that include the word "IRRESISTIBLE" (or "IRRESISTIBLES"), in addition to being associated with food products, snacks, confectionery products, household appliances and kitchen accessories, personal care and beauty products, greeting cards and toys. The Applicant adds that these products are generally found in grocery stores and supermarkets such as those operated by the Opponent and its related companies.

[64] The evidence regarding the state of the register is relevant only insofar as one can draw conclusions from it concerning the state of the market, and conclusions regarding the state of the market can only be drawn if a large number of relevant registrations are identified [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FC 1st inst); and *Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA)].

[65] In this case, I would conclude that the evidence regarding the state of the register presented by the Applicant is insufficient in itself to allow any inferences to be drawn as to the state of the marketplace and to significantly help with this case.

[66] In fact, as noted by the Opponent, only six of these trade-mark registrations pertain to food products. The remainder concerns stuffed toys, household appliances, perfume, cosmetics and/or other body products. As for the pending applications, only one appears to have reached

the letter of eligibility stage, and only pertains to greeting cards. I share the Opponent's opinion this does not represent a large number of registrations.

Conclusion – likelihood of confusion

[67] As indicated above, the test for confusion consists in asking whether an individual with an imperfect recollection of the Opponent's mark could conclude, on the basis of a first impression, that the Applicant's Wares associated with the Mark come from the same source or are otherwise related to or associated with the Opponent's wares. I believe this to be the case.

[68] As indicated above, the Opponent's IRRESISTIBLES brand enjoys substantial recognition in Quebec and Ontario. This recognition, combined with the fact that the Opponent's private brand is used in more than 1,000 different products sold in grocery stores, could lead consumers to mentally associate the Applicant's wines with the Opponent's products. Given that the Opponent's predecessor-in-title has actually put on the market alcoholic beers in the past, and that the Opponent is selling a number of non-alcoholic beverages under its private IRRESISTIBLES brand, to name only these products, and since it is in fact already selling wine in its supermarkets, I believe that such an association in the minds of consumers to be reasonable and likely.

[69] Accordingly, I have concluded that the Applicant has not met its legal onus of establishing, according to the balance of probabilities, that there is no risk of confusion between the Mark and the Opponent's same mark on the filing date of the statement of opposition.

[70] I therefore accept the ground of opposition based on the absence of distinctiveness of the Mark.

Ground based on section 30(i) of the Act

[71] As indicated above, the Opponent has argued that this application does not meet the requirements of Section 30(i) of the Act since the Applicant could not have been, and still cannot be, convinced that it is entitled to use the Mark in association with the Wares since this application was filed for the purpose of undermining the Opponent's rights over its trade-marks,

and since the Applicant has adopted a *modus operandi* that consists in filing registration applications related to well-known marks in identical or related fields in Canada.

[72] Once an applicant has provided the statement required under Section 30(i) of the Act, a ground of opposition based on such section should only be accepted in exceptional cases, such as when the evidence shows that the applicant was acting in bad faith [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB)].

[73] The relevant date for the assessment of the circumstances related to this ground of opposition is the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. In addition, the Opponent's evidentiary burden related to the ground of opposition is not as great since the Applicant is more aware of the facts used to establish that it is convinced of having the right to use the Mark [see *Cerveceria Modelo SA de CV v Marcon* (2008), 70 CPR (4th) 355 (TMOB) 645-365].

[74] In this case, the Opponent is arguing that the evidence shows, at least initially, that the Applicant adopted a *modus operandi* that consists in producing registration applications for well-known marks in identical or related fields in Canada.

[75] In addition, the Opponent argued that there can be no other explanation for why the Applicant filed the following registration applications on the same day in addition to the present application:

- Application no. 1,448,752 for the CHOIX DU PRÉSIDENT mark in association with wine; and
- Application no. 1,448,754 for the COMPLIMENTS mark in association with wine.

[76] To support its position, the Applicant referred to paragraph 27 of Mr. Cournoyer's affidavit in which the latter explains that the LE CHOIX DU PRÉSIDENT brand is the higher-end Loblaws private brand that is comparable to the Opponent's IRRESISTIBLES brand, and that the COMPLIMENTS brand is Sobeys' private brand. Mr. Cournoyer indicated that there are two major groups of supermarket banners in Quebec and in Ontario in addition to those operated by Metro Richelieu, which are the Opponent's main competitors in this field, i.e. Sobeys (namely

the IGA, IGA EXTRA and SOBEYS banners) and Loblaws (namely the LOBLAWS and PROVIGO banners).

[77] Although Mr. Cournoyer is not an independent witness in this case, I believe it reasonable to give credence to his explanations. Through his current and past functions with the Opponent's company since 1991 (he has held various positions, including the positions of Manager, Negotiations and Business Development, Manager, Support, Operations, Wholesalers, Management Process Consultant, and Purchasing Coordinator), Mr. Cournoyer is certainly well-suited to bear testimony regarding the Opponent's main competitors. This does not consist of a personal opinion as such, but rather facts which Mr. Cournoyer is aware of. What is more, his statements are corroborated by certified copies of the registrations respectively held by Loblaws and Sobeys with respect to the LE CHOIX DU PRÉSIDENT and COMPLIMENTS trade-marks, which were submitted as evidence by the Opponent.

[78] I agree with the Opponent that it is difficult to explain why the Applicant filed registration applications the same day in association with wine with identical marks as three private marks registered in association with an extensive range of food products.

[79] I also agree with the Opponent that the Applicant had ample opportunity to explain the situation in an affidavit, which the Applicant chose not to do despite the existence of this ground of opposition and the evidence produced by the Opponent in support of the latter specifically designed to challenge the Applicant on this point.

[80] Given the preceding, I believe that the Opponent has discharged the initial burden of proof.

[81] Due to a lack of evidence presented by the Applicant, I believe that the latter has not discharged the legal burden of proving that it could state being convinced to having the right to use the Mark at the time of filing the present application. Therefore, I am accepting the ground of opposition based on section 30(i) of the Act

Other grounds of opposition

[82] As I have already concluded in favour of the Opponent on two grounds of opposition, I believe it is not necessary to examine the remaining grounds of opposition.

Decision

[83] In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I refuse the opposition in application of subsection 38(8) of the Act.


Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Carole Biondic

Appendix

Mark	Registration or application no.	Date of registration or filing of the application	Wares and/or services
IRRESITIBLE À CAUSE DES INGRÉDIENTS BECAUSE OF THE INGREDIENTS	TMA774,055	10/08/2010	Wares: (1) Bread, ice cream, vegetable juice, pies. Services: (1) Operation of grocery stores Declaration of use filed July 14, 2010.
IRRESISTIBLE À CAUSE DES INGRÉDIENTS	TMA796,552	03/05/2011	Wares: (1) Organic bread, quiche, chicken and fennel pasta, pie, fruit and vegetable juice; ice cream. Services: (1) Operation of grocery stores. Used in CANADA as early as February 2006 in association with the wares. Used in CANADA as early as March 2006 in association with the services.
IRRESISTIBLES	1,344,171	19/04/2007	Wares: (1) Food and non-food products that can be sold in a grocery store, namely croutons, cakes, fruit juice, orange juice, grapefruit juice, apple juice, capers, nectar, cold cuts, canned vegetables, salmon, smoked salmon, honey, olive oil, assorted canapés, coquilles St. Jacques, salad dressing, sole fillets, puff pastry, smoked fish, Christmas logs, chocolate mini-profiteroles, cheese, fudge, wafers, scallops, carrots, flavoured butter, shrimp ring with cocktail sauce, seafood canapés, Asian hors d'oeuvres, seafood cocktail sauce, shrimp, shrimp and scallop mix, seafood mix, squid, seafood, scampi, frog's legs, cookies, ice cream bars, nut spread, flavoured vinegar, fresh fruit salad, crackers, pasta, herbal tea, organic oils, spices, mustard, Dijon mustard, quiches, pies, multi-grain puff pastry, hearts of palm and artichoke hearts, clam chowder, nut

		<p>oil, frozen desserts, eclairs, fresh sauces, potatoes, ice cream, fruit spread, coffee, sorbet, snow crab legs, rice vinegar, tilapia, tomatoes, vegetable dips, seafood mousse, three-meat and salmon pâté, trout, clams, stir-fry, focaccia bread, eggs, pasta sauce, namely [...], artichoke and lemon tapenade, black-olive and herb tapenade, green-olive tapenade, portobello-mushroom tapenade, tomato and roasted red pepper tapenade; packet sauces, namely [...]; marinades, namely red-wine and shallot meat marinade, white wine and tarragon chicken marinade, and lemon and pepper fish marinade; wine sauce, Forestière sauce, BBQ sauce, chicken sauce, hot-chicken sauce, poutine sauce, ready-to-serve sauce, namely three pepper, Bordelaise, Dijonnaise, cream of chicken, white wine, mornay and lemon and pepper sauces; Asian sauces, namely [...]; dipping sauces, namely [...]; vinaigrettes, namely [...], balsamic vinegar [...]; dessert sauces, namely [...]; pies, organic bread, chicken and fennel pasta, chips, milk, syrup, namely [...]; chocolate beverages, namely [...]; dried fruit, tea, molasses, soya oil, canned vegetables, ketchup, tomato juice, canned fruit, baked beans, tomato paste, rice, jams and marmalades, fruit punch, namely [...]; jelly powder, caramel spread, apple sauce, mineral water, spring water, pea soup, soft drinks, cake mix, canned soup, flour, relish, marinades, powdered crystals, namely for preparing various non-alcoholic juices; peanuts, vegetable juice, peanut butter, tuna, cereal, namely [...]; cherries, mints, onion, shortening, beef, pork, veal, lamb, chicken, ham, frozen meals, namely [...]; fish, baked goods namely [...], soft drinks, condiments, frozen treats, desserts, snacks, herbs and spices, fruits, vegetables, cake icing, edible oils, legumes, mayonnaise and salad dressing, nuts, flat breads, pasta, fish, meat, fruit and vegetable sauces, meat gravy and fish sauce, meat pies, danishes and pastries, dips, vinegar, yogurt, margarine, butter and non-food products, namely fabric softener, bleach, glass</p>
--	--	---

			<p>cleaner, all-purpose cleaner, bars of soap, toilet paper, aluminum foil, garbage bags, facial tissue, cotton swabs, light bulbs, wax paper, paper towels, shampoo, bandages, cotton, sanitary napkins, napkins, diapers, baby powder and baby oil, conditioner and bubble bath, paper plates and plastic glasses, laundry detergent and dishwashing liquid, pet food, cat litter.</p> <p>Services (1) Operation of grocery stores.</p> <p>Proposed use in CANADA.</p>
	1,452,360	18/09/2009	<p>Wares (1) Cereal; bread and flat bread. (2) Pies. (3) Peanut butter; cookies; coffee; fruit juice; fish and seafood; napkins. (4) Non-alcoholic beverages, namely non-alcoholic sparkling punch; herbs and spices; cheese; eggs; pasta; maple syrup. (5) Chips and snacks; edible oils; spreads. (6) Crackers; croutons; cakes; facial tissues; prepared meals (lasagna). (7) Jams and marmalades; herbal teas. (8) Butter; ice cream and frozen treats; milk; vegetables; margarine. (9) Salad dressings. (10) Asian sauces. (11) Sorbets; meats; vinegar. (12) Assorted canapés; yogurt. (13) Fruit; mustard; pizza; meat gravies and fish sauces; danishes. (14) Legumes; pasta sauce; meat pies. (15) Meat and fish marinades; honey. (16) Ketchup; pet food. (17) Broth; desert sauces. (18) Food products, namely bagels; soft drinks; non-alcoholic beverages, namely vitamin-enriched water; condiments, namely chutney, horseradish, mint jelly, capers; custard and pastry cream; crystals in packets for the preparation of various flavours of non-alcoholic juices; spring or mineral water;</p>

			<p>flour; puff pastry; baked beans; jelly powder; cake icing; vegetable juice; marinades; mayonnaise and salad dressing; cake mixes; molasses; muffins; nectar; nuts and peanuts; tomato paste; quiche; relish; rice; fruit and vegetable sauces; fruit sauces; shortening; chocolate syrup; corn syrup; table syrup; soup; tea; dips.</p> <p>Used in CANADA since at least as early as August 2007 in association with the wares (1).</p> <p>Used in CANADA since at least as early as September 2007 in association with the wares (2).</p> <p>Used in CANADA since at least as early as October 2007 in association with the wares (3).</p> <p>Used in CANADA since at least as early as November 2007 in association with the wares (4).</p> <p>Used in CANADA since at least as early as December 2007 in association with the wares (5).</p> <p>Used in CANADA since at least as early as January 2008 in association with the wares (6).</p> <p>Used in CANADA since at least as early as February 2008 in association with the wares (7).</p> <p>Used in CANADA since at least as early as March 2008 in association with the wares (8).</p> <p>Used in CANADA since at least as early as April 2008 in association with the wares (9).</p> <p>Used in CANADA since at least as early as June 2008 in association with the wares (10).</p> <p>Used in CANADA since at least as early as July 2008 in association with the wares (11).</p> <p>Used in CANADA since at least as early as August 2008 in association with the wares (12).</p> <p>Used in CANADA since at least as early</p>
--	--	--	--

			<p>as September 2008 in association with the wares (13).</p> <p>Used in CANADA since at least as early as October 2008 in association with the wares (14).</p> <p>Used in CANADA since at least as early as November 2008 in association with the wares (15).</p> <p>Used in CANADA since at least as early as February 2009 in association with the wares (16).</p> <p>Used in CANADA since at least as early as July 2009 in association with the wares (17).</p> <p>Proposed use in CANADA in association with the wares (18).</p>
IRRESISTIBLE	1,329,344	21/12/2006	Roughly the same wares as those described under Application no. 1,452,360