



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

Citation: 2013 TMOB 160
Date of Decision: 2013-09-30

**IN THE MATTER OF AN OPPOSITION by
Tequila Supremo S.A. de C.V. to application
No. 1,470,856 for the trade-mark CASARENA in
the name of Bodegas Y Vinedos Filippo Figari S.A.**

FILE RECORD

[1] On February 24, 2010, Bodegas Y Vinedos Filippo Figari S.A. filed an application to register the trade-mark CASARENA, based on proposed use in Canada, in association with “wines and sparkling wines.”

[2] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated October 20, 2010 and was opposed by Tequila Supremo S.A. de C.V. on December 20, 2010. The Registrar forwarded a copy of the statement of opposition to the applicant on January 13, 2011, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[3] The opponent’s evidence consists of the affidavit of Ismael Abran Navarro Zermeno and certified copies of the opponent’s trade-mark application Nos. 1455648 and 1455649 for CAMARENA and FAMILIA CAMARENA, respectively, covering the

wares “tequila.” I note that the above mentioned applications are based on proposed use in Canada and were filed on October 16, 2009, that is, prior to the filing of the subject application for CASARENA

[4] The applicant’s evidence consists of the affidavit of Carlos J. MacCulloch. The opponent’s evidence in reply consists of the affidavit of Cesar Omar Castellanos Veloz. Both parties filed a written argument, however, only the opponent was represented at an oral hearing held on September 23, 2013.

STATEMENT OF OPPOSITION

[5] Various grounds of opposition are alleged, however, the determinative issue for decision is whether the applied-for mark CASARENA is confusing with the opponent’s mark CAMARENA. In this regard, the opponent claims that the applicant is not entitled to register its mark, pursuant to s.16(3)(b) of the *Trade-marks Act*, in view of the opponent’s previously filed application for CAMARENA,:

16(3) Any applicant who has filed an application . . . for registration of a proposed trade-mark . . . is entitled . . . to secure its registration in respect of the wares or services specified in the application, unless at the date of filing of the application it was confusing with

.
(b) a trade-mark in respect of which an application for registration had been previously filed in Canada by any other person;
(emphasis added)

Accordingly, the material date to consider whether the parties’ marks are confusing is the filing date of the application for CASARENA, that is, February 24, 2010.

OPPONENT’S EVIDENCE

Ismael Abran Navarro Zermeno

[6] Mr. Zermeno identifies himself as a Project Manager with the opponent company in Mexico. The opponent is a distiller of a number of different tequila products sold in many countries around the world including Canada. The opponent sells its tequila under various brand names including, for example, MARACAME and ANTGUO ORIGEN. In

the United States every bottle of the opponent's tequila that is sold displays the brand name as well as one or both of the opponent's "house marks" CAMARENA and FAMILIA CAMARENA, as illustrated in Exhibit 1 of Mr. Zereno's affidavit. The opponent sold about 3 million bottles of tequila (750 ml size) in the U.S. in 2010 and estimated sales for 2011 are 6.6 million bottles.

[7] As of the date of Mr. Zereno's affidavit, that is, December 19, 2011, the opponent has sold tequila in Canada under its brand names but not under its house marks. The opponent intends to commence use of its house marks in Canada in 2012.

[8] Mr. Zereno's evidence does little to advance the opponent's case, however, it does provide context for its objection to the applied-for mark CASARENA.

APPLICANT'S EVIDENCE

Carlos J. MacCulloch

[9] Mr. MacCulloch identifies himself as a lawyer for the applicant in Argentina. His affidavit serves to introduce into evidence, by way of exhibits, copies of trade-mark registrations for the applicant's mark CASARENA in Columbia, Japan, Mexico and the European Community.

[10] Mr. MacCulloch's evidence does not advance the applicant's case in Canada.

OPPONENT'S REPLY EVIDENCE

Cesar Omar Castellanos Veloz

[11] Mr. Veloz identifies himself as the general attorney for the opponent in Mexico. His affidavit serves to introduce the following exhibits into evidence:

Exhibit 1

[12] A copy of a trade-mark registration in Mexico, No.1038206 for CAMARENA, covering the wares alcoholic beverages, standing in the name of Elena Herrera Orendain.

Exhibit 2

[13] A copy of a certificate, dated December 9, 2009, confirming the assignment of the above-mentioned Mexican registration No. 1038206 to the opponent.

Exhibit 3

[14] A copy of the opponent's trade-mark registration in Mexico, No. 1143292 for FAMILIA CAMARENA, covering the wares alcoholic beverages.

Exhibit 4

[15] A copy of a Final Resolution issued by the Mexican Patent and Trademark Office dated July 26, 2011. The tribunal declared that the applicant's trade-mark registration No. 1148103 for the mark CASARENA, covering sparkling wine and wine, was invalid for the reason that it was "confusingly similar" to the opponent's mark CAMARENA.

[16] Mr. Veloz' evidence does not advance the opponent's case in Canada.

MAIN ISSUE

[17] As mentioned earlier, the determinative issue for decision is whether the applied-for mark CASARENA is confusing with the opponent's mark CAMARENA. The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of s.6(2) of the *Trade-marks Act*, shown below, between the applied-for mark and the opponent's mark:

The 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 . . . or performed by the same person, whether or not the wares or services . . . are of the same general class.

[18] Thus, s.6(2) does not concern the confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s.6(2) is whether Canadian wine consumers would believe that the applicant's wines sold under the mark CASARENA were produced or

authorized or licensed by the opponent who proposes to sell tequila under the mark CAMARENA.

Test for Confusion

[19] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances including” those specifically mentioned in s.6(5)(a) to s.6(5)(e) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors do not necessarily have equal weight as the weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 CPR(3d) 308 (FCTD). However, as noted by Mr. Justice Rothstein in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 CPR(4th) 361 (SCC), although the degree of resemblance is the last factor cited in s.6(5), it is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

Consideration of s.6(5) Factors

First and Second Factors

[20] The parties’ marks possess equal degrees of inherent distinctiveness. Neither party has shown any reputation for their marks in Canada at the material date February 24, 2010, that is, the marks in issue had not acquired any distinctiveness in Canada as of the filing date of the subject application. The first factor in s.6(5), which is a combination of inherent and acquired distinctiveness, therefore favours neither party. Similarly, as neither party has shown any use of its mark in Canada prior to the material date, the second factor in s.6(5), that is, the length of time that the marks have been in use, favours neither party.

Third and Fourth Factors

[21] With respect to nature of the parties' wares and businesses, the wares beer, wine and spirits are products of one industry: see *Carling Breweries Ltd. v. Registrar of Trade-marks* (1972), 8 CPR(2d) 247 (FCTD).

[22] In *Molson Companies Ltd. v. Gustav Adolf Schmittsches Weingut* (1991), 35 CPR(3d) 371 this Board considered the issue of confusion between the applied-for mark GOLDEN EAGLE for wine and the opponent's mark GOLDEN for beer. The Board's comments concerning the channels of trade for wine and beer are equally valid for wine and tequila:

at p. 375

With respect to the nature of the wares and the respective channels of trade associated with the wares of the parties, both brewed alcoholic beverages and wines are products of the alcoholic industry and might well be sold through the same establishments or retail outlets.

at p. 376

. . . the average consumer would not perceive there to be any measurable differentiation between the wares of the parties and that the channels of trade associated with these wares could in fact overlap in that beer and wine could be sold in close proximity to each other in the same retail outlet.

Accordingly, in the instant case, the third and fourth factors in s.6(5) favour the opponent.

Fifth Factor

[23] The parties' marks CASARENA and CAMARENA resemble each other to a fair extent visually and in sounding but not in ideas suggested. The visual resemblance and resemblance in sounding arises from the parties' marks differing only in their second consonant. However, neither mark suggests any idea in particular and therefore there can

be no overlap in the ideas suggested by the marks. Overall, the last and most important factor favours the opponent.

DISPOSITION

[24] Considering the factors in s.6(5) as discussed above, I find that at the date of filing the application, and at all material times, the applicant has not met the legal onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied-for mark CASARENA and the opponent's mark CAMARENA.

[25] Accordingly, the application is refused. This decision has been made pursuant to a delegation of authority under s.63(3) of the *Trade-marks Act*.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office