



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

Citation: 2011 TMOB 65
Date of Decision: 2011-04-18

**IN THE MATTER OF AN OPPOSITION
by Tradall S.A. to application
No. 1,036,153 for the trade-mark THE
DEVIL'S MARTINI in the name of The
Devil's Martini Inc.**

[1] On November 16, 1999, The Devil's Martini Inc. (the Applicant) filed an application to register the trade-mark THE DEVIL'S MARTINI (the Mark) based on proposed use of the Mark in Canada. The current statement of wares reads:

beverages, namely, non-alcoholic cocktail mixes, carbonated beverages, fruit juices and vegetable juices;

alcoholic beverages, namely, vodka-based cocktails, rum-based cocktails, whiskey-based cocktails, gin-based cocktails, liqueur-based cocktails, brandy-based cocktails, vermouth-based cocktails, wine-based cocktails; vodka, rum, whiskey, and gin.

[2] The Applicant has disclaimed the right to the exclusive use of the word MARTINI apart from the Mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 22, 2001.

[4] On March 26, 2002, Tradall S.A. (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the affidavits of MaryAnne Lefebvre and Anthony Amato. The Applicant obtained orders for the cross-examination of these affiants, but did not conduct any cross-examinations.

[6] The Applicant elected to not file any evidence in support of its application.

[7] Only the Opponent filed a written argument. An oral hearing was held in which both parties participated.

Summary of Grounds of Opposition and Applicable Material Dates

[8] The Opponent has pleaded the following grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. contrary to s. 30(e), the Applicant did not intend to use the Mark in Canada, by itself or through a licensee or by itself and through a licensee, in association with all of the wares set forth in the application at the date of the application;
2. contrary to s. 30(i), the Applicant could not have been satisfied that it was entitled to use the Mark in association with the wares described in the application for the reasons set out below;
3. contrary to s. 12(1)(d), the Mark is not registrable because it is confusing with 16 trade-marks registered by the Opponent, each of which includes the word MARTINI;
4. contrary to s. 16(3)(a), the Applicant is not the person entitled to registration of the Mark because, at the date of filing of the application, the Mark was confusing with the Opponent's registered trade-marks, which had been previously used in Canada in association with the wares set forth in the registrations;
5. contrary to s. 2, the Mark is not distinctive of the Applicant for the reasons set forth above.

[9] The material dates with respect to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];

- s. 12(1)(d) - the date of my decision [*Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 16(3) - the filing date of the application;

- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Onus

[10] 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 C.P.R. (3d) 293 (F.C.T.D.) at 298].

The Opponent's Evidence

Lefebvre Affidavit

[11] Ms. Lefebvre, a legal assistant, simply provides copies of 15 registrations owned by the Opponent for various MARTINI marks, namely;

1. MARTINI FIERO registered for alcoholic beverages consisting of wines mixed with orange juice or orange extracts (TMA512,391)
2. MARTINI & Label Design registered for alcoholic beverages, namely, vermouth, alcoholic aperitives, wines and spirits (TMA502,486)
3. MARTINI & ROSSI ASTI SPUMANTE & Design registered for sparkling wines (TMA436,346)
4. MARTINI SPORTLINE & Belt Design registered for clothing and shoes (TMA399,681)
5. MARTINI & Ball Design registered for almonds and other food snacks (TMA311,312)
6. MARTINI registered for clothing (TMA284,026)
7. MARTINI (front label) Design registered for vermouth, sparkling and still wines and prepared aperitifs (TMA664,889)

8. MARTINI & Ball Design registered for wines, vermouth wine, liquor and spirits (TMA194,734)
9. MARTINI & ROSSI registered for alcoholic beverages namely, vermouth and sparkling wines (TMA140,457)
10. MARTINI ELIXIR DI CHINA & Design registered for alcoholic beverages containing quinine (TMA125,763)
11. MARTINI & Label (#2) Design registered for vermouth (TMA105,899)
12. MARTINI & Ball Design (green) registered for alcoholic and non-alcoholic beverages and syrups for the latter (UCA050,801)
13. MARTINI & Ball Design (red) registered for alcoholic and non-alcoholic beverages and syrups for the latter (UCA050,803)
14. MARTINI & Green Label Design registered for vermouth wines (UCA000,214)
15. MARTINI registered for appetizers, vermouth, liquors, sparkling wines, wines (TMDA057,478)

Amato Affidavit

[12] In his affidavit of December 18, 2006, Mr. Amato identified himself as the Group Brand Manager for MARTINI Products for Bacardi Canada Inc.

[13] Mr. Amato defines the 16 registered marks listed in the statement of opposition as the MARTINI Trade-marks; I note that the 16 include the 15 evidenced by Ms. Lefebvre plus MARTINI & ROSSI & Design registration No. TMA207,908 which was expunged on February 28, 2006. Mr. Amato attests that the MARTINI Trade-marks have been used in Canada by the Opponent, and/or its predecessors, licensees and distributors, including Bacardi Canada Inc., in association with the wares listed in their registrations (to which Mr. Amato has assigned the term “the MARTINI Products”) for many decades.

[14] Paragraph 7 of Mr. Amato’s affidavit reads:

MARTINI Products consisting of alcoholic beverages are packaged in glass bottles of various sizes. These products bear the MARTINI Trade-marks and are distributed by [Bacardi Canada Inc.] to approximately 2000 retail outlets across Canada, with

approximately 650 retail outlets in Ontario alone. Retail channels throughout Canada are typically through provincial liquor control boards.

[15] In paragraph 8, Mr. Amato provides the approximate total Canadian sales for each of the fiscal years 1989-2006 expressed in 9L cases (more than 200,000 9L cases each year since 2000). In paragraph 10, Mr. Amato states that approximately \$900,000 has been spent annually to support MARTINI Products with “various marketing, advertising and promotional expenditures, including creative production, packaging expenses, and media spending”, but he does not specifically state that such relates exclusively to Canada.

[16] Mr. Amato has provided samples of bottle labels, representative of those used in Canada since at least as early as 1995 (Exhibit “A”). These show use of MARTINI, MARTINI & Ball Design, and MARTINI & ROSSI in association with vermouth and sparkling wine.

[17] Mr. Amato has provided sample packaging and advertising representative of those used to promote MARTINI Products in association with the MARTINI Trade-marks since at least as early as 1995 (Exhibit “B”). I note that these materials only relate to sparkling wine and show the trade-marks MARTINI, MARTINI & ROSSI, and MARTINI & Ball Design.

[18] Mr. Amato attests that other merchandise bearing the MARTINI Trade-marks (the MARTINI Merchandise) is distributed throughout Canada by means of consumer promotions and through his company’s sales representatives. Exhibit “C” shows examples of MARTINI Merchandise, namely stickers, garden umbrellas, key-rings, watches, posters, mirrors, signs, chalkboards, stirrers, shakers, ashtrays, trays, table tents, menu holders, napkin holders, ice buckets, bowls and glasses that display MARTINI or MARTINI & Ball Design.

[19] Mr. Amato’s company employs 65 representatives whose responsibilities include setting up displays with MARTINI Products and MARTINI Merchandise to increase the visibility of MARTINI Trade-marks throughout Canada.

[20] Mr. Amato tells us that MARTINI & ROSSI Asti is the best-selling Asti in the world, and the No. 1 imported sparkling wine in Canada, and that MARTINI brand vermouths are the No. 1 selling vermouth in Canada and the world (paragraph 13).

[21] I note that Mr. Amato's evidence shows use of only three of the MARTINI marks pleaded by the Opponent, namely: MARTINI & Ball Design for vermouth, MARTINI & ROSSI for sparkling wine, and MARTINI for vermouth and sparkling wine (in other words those registered marks identified as Nos. 8, 9 and 15 in my summary of the Lefebvre evidence). The mark referred to as MARTINI & Ball Design is shown below:



[22] I also note that even though Mr. Amato says that he is providing the sales figures for MARTINI Products, given that those figures are expressed in litres it is only reasonable to treat those figures as relating only to the Opponent's beverages.

Section 30(e) Ground of Opposition

[23] The s. 30(e) ground of opposition is dismissed because the Opponent has not met its initial burden in respect thereof. Contrary to the Opponent's submissions, the Applicant is not required to prove its intent to use the Mark in the absence of any evidence suggesting that the Applicant was lacking the necessary intent.

Section 30(i) Ground of Opposition

[24] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Section 12(1)(d) Grounds of Opposition

[25] I have exercised the Registrar's discretion to check the register in order to confirm the existence of the registrations relied upon by the Opponent under s. 12(1)(d) [see *Quaker Oats of*

Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd. (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)). Of the 16 registrations pleaded, only 10 are currently extant. The following registrations have been expunged or cancelled: TMA436,346; TMA399,681; TMA140,457; TMA125,763; UCA000,214; and TMA207,908. The Opponent's initial burden under s. 12(1)(d) has therefore only been met with respect to the registered marks identified above under my summary of the Lefebvre affidavit as numbers 1, 2, 5, 6, 7, 8, 11, 12, 13, and 15.

[26] Of the 10 extant registrations, registration No. TMDA057,478 for MARTINI presents the Opponent's strongest case, both because that registration is for MARTINI *simpliciter* and because there is evidence concerning the use of that mark in association with at least some of the wares covered by its registration. I shall therefore focus my assessment of the likelihood of confusion on that registered mark – if confusion is not likely between that mark of the Opponent and the Applicant's Mark, then confusion will not be likely between the Applicant's Mark and any of the Opponent's other registered marks.

[27] 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.

[28] In applying the test for confusion, I must have regard to all the surrounding circumstances, including those specifically enumerated in s. 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 C.P.R. (4th) 321 (S.C.C.).]

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

[29] A trade-mark is not inherently distinctive if it is suggestive of a characteristic of the associated wares. I believe that I can take judicial notice that today's average Canadian consumer of alcoholic beverages would be aware that there is a type of cocktail drink called a "martini". In any event, I can take judicial notice of dictionary definitions for the word "martini" [see *Envirodrive Inc. v. 836442 Canada Inc.* 2005 ABQB 446.; *Aladdin Industries, Inc. v. Canadian Thermos Products Ltd.* (1969), 57 C.P.R. 230 (Ex. Ct.), affirmed (1974), 6 C.P.R. (2d) 1 (S.C.C.)]. The word "martini" is defined in *The Canadian Oxford Dictionary* as "a cocktail made of dry vermouth and usu. gin." and in *Webster's Third New International Dictionary* as "a cocktail consisting of two or more parts gin to one of dry vermouth usu. stirred with ice and garnished with an olive, pearl onion, or slice of lemon peel". I therefore accept that "martini" is the generic name of a certain type of mixed alcoholic drink.

[30] None of the wares listed in the Opponent's registrations fall within the definition of the noun "martini", whereas some of the wares listed in the Applicant's application do fall within the definition (e.g. gin-based cocktails). Nevertheless, "martini" is a dictionary word that has a meaning related to the general category of wares in which both parties trade (alcoholic beverages) and the noun "martini" is not an inherently distinctive formative for a trade-mark in the alcoholic beverages field. In contrast, the words "the devil's" are inherently distinctive, since they have no particular meaning in association with alcoholic beverages.

[31] A mark may acquire distinctiveness through use or promotion and there is evidence that the Opponent's MARTINI mark has acquired distinctiveness through its use and promotion in association with vermouth and sparkling wine. The evidence before me lacks specificity because it provides a single lump figure for the sales of all of the Opponent's MARTINI Products (which extend beyond vermouth and sparkling wine); in addition, the figure presented is for all of the Opponent's MARTINI Trade-marks, not simply MARTINI *simpliciter*. Nevertheless, it is clear that the Opponent's MARTINI mark has acquired distinctiveness in association with vermouth and sparkling wine, in part due to Mr. Amato's uncontested statement that they were the No. 1 selling vermouth and No. 1 imported sparkling wine in Canada in 2006. This is in sharp contrast with the lack of any evidence of the Applicant's Mark having acquired any distinctiveness.

[32] Thus the Applicant's Mark has a greater degree of inherent distinctiveness but only the Opponent's mark has become known.

length of time each trade-mark has been in use

[33] The Opponent's registration claims a date of first use in Canada of July 1, 1906 and Mr. Amato discusses its Canadian sales from 1986. In contrast, there is no evidence that the Applicant's Mark has been used to date.

nature of the wares, services, business or trade

[34] The Applicant has applied to register its Mark in association with a variety of beverages, both alcoholic and non-alcoholic. The Opponent's registration No. TMDA057,478 does not cover any non-alcoholic beverages, but I note that its registrations for red and green versions of MARTINI & Ball Design do cover non-alcoholic beverages. The Opponent has only evidenced use of its MARTINI mark in association with two types of alcoholic beverages, namely vermouth and sparkling wine – the statement of wares in the Applicant's application does not list vermouth or sparkling wine, but it does list "vermouth-based cocktails" and "wine-based cocktails".

[35] The parties' wares are of a similar nature and so, in the absence of evidence to the contrary, it is reasonable to conclude that their channels of trade could overlap.

degree of resemblance between the trade-marks

[36] It is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction. The first portions of the marks at issue are not the same, resulting in significant differences between the marks as a whole in their appearance and sound. In idea suggested, the Opponent's mark suggests a certain type of mixed drink, namely a "martini"; moreover, the Opponent's mark is used in association with an important ingredient of a "martini", namely vermouth. On the other hand, the Applicant's Mark suggests a fanciful version of the type of drink that is known as a "martini".

Conclusion

[37] This is an unusual case. Typically, as argued by the Opponent, where an applicant files a proposed use trade-mark that incorporates a registered mark in its entirety for wares similar to those of the registered mark and the applicant files no evidence, the opponent would be likely to succeed on the basis that the applicant has not met its legal onus. However, what sets this case apart from that scenario is that the Opponent's registered mark is a word that is a generic term in the parties' field and the applied-for mark uses the Opponent's registered mark essentially as a generic term/noun.

[38] The question is whether the typical Canadian consumer who has an imperfect recollection of the Opponent's MARTINI brand of alcoholic beverage (most significantly vermouth or sparkling wine) would, upon seeing THE DEVIL'S MARTINI alcoholic or non-alcoholic beverage, assume as a matter of immediate impression that the beverages all share a common source. Given the meaning of "martini" and the distinctive nature of the dominant first portion of the Applicant's Mark, I conclude that confusion is not reasonably likely with respect to all of the Applicant's wares with the exception of "vermouth-based cocktails" and "wine-based cocktails". As stated in *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70: "Realistically appraised it is the degree of resemblance between trade marks in appearance, sound or in ideas suggested by them that is the most crucial factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances." However, regarding "vermouth-based cocktails" and "wine-based cocktails", I have concluded that the probabilities are equally balanced due to the distinctiveness that the Opponent's mark has acquired in association with vermouth and sparkling wine. As the legal onus is on the Applicant, the application will be refused with respect to those two wares.

[39] In reaching my conclusion, I am not considering the validity of the Opponent's registered trade-mark, merely the scope of protection to which it might be entitled [see *Molson Canada 2005 v. Anheuser-Busch, Incorporated* (2010), 82 C.P.R. (4th) 169 (F.C.)]. In other words, I am of the view that the scope of protection to be accorded to the Opponent's MARTINI mark is not

so broad as to prevent third parties from using the generic noun “martini” combined with a distinctive prefix in association with beverages that do not comprise vermouth or sparkling wine.

[40] The s. 12(1)(d) grounds are therefore dismissed with respect to all of the wares other than “vermouth-based cocktails” and “wine-based cocktails”. The s. 12(1)(d) ground based on registration No. TMDA057,478 succeeds insofar as the wares “vermouth-based cocktails” and “wine-based cocktails” are concerned.

Section 16(3)(a) Ground of Opposition

[41] In order to meet its initial burden under s. 16(3)(a), the Opponent must show that its mark was in use in Canada prior to November 16, 1999. This has been done.

[42] As the surrounding circumstances do not favour the Opponent any more as of November 16, 1999 than they do as of today’s date, the success of the s. 16(3)(a) ground is no greater than the success of the s. 12(1)(d) grounds.

Distinctiveness Ground of Opposition

[43] The date for considering the likelihood of confusion under the distinctiveness ground is March 26, 2002. The Opponent has met its initial burden regarding the likelihood of confusion as of that date since it has shown that its mark was known in Canada as of that date [see *Bojangles’ International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. However, once again the surrounding circumstances do not favour the Opponent any more as of March 26, 2002 than they do as of today’s date, so the success of this ground is also no greater than the success of the s. 12(1)(d) grounds.

Disposition

[44] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act with respect to only the following wares: “beverages, namely, non-alcoholic cocktail mixes, carbonated beverages, fruit juices and vegetable juices; alcoholic beverages, namely, vodka-based cocktails, rum-based cocktails, whiskey-based cocktails, gin-based cocktails, liqueur-based cocktails, brandy-based cocktails; vodka, rum, whiskey, and gin.”

The application is refused with respect to “vermouth-based cocktails” and “wine-based cocktails”. [See *Produits Ménagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 482 (F.C.T.D.) as authority for a split decision.]

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office