

IN THE MATTER OF AN OPPOSITION
by Andres Wines Ltd. to applica-
tion No. 641,648 for the trade-
mark CHATEAU D'OR filed by Colio
Wines of Canada Limited (now
Village Contractors Limited
carrying on business as Colio
Wines of Canada)

On September 29, 1989, the applicant, Colio Wines of Canada Limited (now Village Contractors Limited carrying on business as Colio Wines of Canada), filed an application to register the trade-mark CHATEAU D'OR based on proposed use in Canada with "wines." The application was advertised for opposition purposes on May 2, 1990.

The opponent, Andres Wines Ltd., filed a statement of opposition on June 11, 1990, a copy of which was forwarded to the applicant on June 22, 1990. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark DOMAINE D'OR registered under No. 275,096 for "wine." The second ground of opposition is that the applicant is not the person entitled to registration in view of the opponent's prior use of its registered mark. The third ground is that the applicant's trade-mark is not distinctive because it is confusing with the opponent's mark.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Catherine Ann Allan and Robert W. Robbie. As its evidence, the applicant filed the affidavits of Alain Leclerc, Mary Noonan, Fay Haakman and Ray Martin. The applicant was subsequently granted leave pursuant to Rule 46(1) of the Trade-marks Regulations to file the affidavit of Gilles Marc Daigle and a reexecuted version of the affidavit of Ray Martin. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R. (3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The opponent's registered trade-mark is inherently distinctive although the words "domaine d'or" might possibly suggest that the opponent's wines come from a "golden estate." Consequently, the opponent's mark may have a slight laudatory connotation and is therefore not inherently strong.

As noted by the agent for the applicant, the Robbie affidavit is deficient in a number of respects. Although Mr. Robbie identifies himself as the Manager, Marketing Analysis of the opponent, he fails to describe his duties and functions. Furthermore, Mr. Robbie does not indicate the source of his knowledge about the opponent's activities nor does he provide detailed information about the opponent's activities relating to its trade-mark DOMAINE D'OR. For example, Mr. Robbie provides sales figures of DOMAINE D'OR wine by volume but does not indicate if those sales were made in bulk or in individual bottles.

In view of the foregoing, I have concluded that the Robbie affidavit is not entirely reliable and I have given it diminished weight. However, both Martin affidavits filed by the applicant establish that there have been fairly substantial sales of DOMAINE D'OR wine in bottles in Ontario for the period 1989-1990. Thus, given the fairly substantial sales figures for the period 1983 to 1990 attested to by Mr. Robbie and assuming that at least some of those sales were of labelled bottles as were those in Ontario in the period 1989-1990, I am able to conclude that the opponent's mark has become known to some extent throughout most of Canada.

The average bilingual consumer would view the applicant's mark CHATEAU D'OR as being somewhat suggestive of the character or quality of the applicant's wine. The word "d'or" is laudatory in that it suggests excellence. It may even be descriptive in the case of white wines, some of which may be golden in color. The word "chateau" refers not only to a castle or large mansion but also to a French vineyard. This latter meaning is underscored by the existence on the trade-marks register of a large number of marks incorporating the word "chateau" that are registered for wine (see the Noonan affidavit). The words "chateau d'or" suggest that the applicant's wines come from a "golden mansion" or a "golden vineyard." The applicant's mark is therefore inherently weak. There has been some minor use of the applicant's mark in Ontario such that I can conclude that it has become known to a very limited extent.

The length of time the marks have been in use favors the opponent. The wares and trades of the parties are identical. The applicant sought to differentiate its wares from those of the opponent on the basis that the applicant has commenced use of its mark with a product called Canadian Champagne which it submits is different from ordinary wine. However, the applicant's statement of wares is not restricted to any particular type of wine.

As for Section 6(5) (e) of the Act, I consider there to be some visual and phonetic resemblance between the marks at issue in view of the common use of the word "d'or." Furthermore, there is a resemblance in the ideas suggested by the two marks, one being a "golden estate" and the other being a "golden mansion" or a "golden vineyard."

The applicant contends that a surrounding circumstance in the present case which lessens the effect of any degree of resemblance between the marks is the state of the register evidence introduced by the Noonan affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R. (3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R. (3d) 205 (F.C.T.D.). Also of note is the recent decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R. (3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In the present case, the Noonan affidavit evidences only six third party registrations for trade-marks ending with the word "d'or" and registered for wine. In the absence of evidence of use, the existence of six registrations is insufficient to

allow me to conclude that any of those six marks have been used more than minimally in Canada. However, in the present case, the applicant has shown actual use of some of those marks. Ms. Haakman was able to purchase wines in Ottawa bearing the trade-marks LE PIAT D'OR, LION D'OR and CUVÉE D'OR. She was also able to purchase a wine in Hull, Quebec bearing the mark MOMMESSIN COTES DU RHONE VALLEE D'OR.

The Martin affidavit shows that there have been substantial sales of LE PIAT D'OR wine in Ontario for at least several years. His affidavit also shows that there have been at least some recent sales of LION D'OR wine in Ontario. Mr. Martin's evidence of those sales is not the best evidence but it appears to be fairly reliable. As a business executive in the Ontario wine industry, he relies on sales figures provided by the Liquor Control Board of Ontario (LCBO) in their publication referred to as the Blue Book. Mr. Martin states that his company and his competitors rely on the figures provided in that publication to monitor sales by competitors and to monitor whether or not particular products meet the quotas set by the LCBO although he recognizes that the figures provided are only accurate to within about five per cent.

Also of note is the fact that, unlike previous labels, the current label adopted by the opponent in the latter part of 1990 does not directly refer to the opponent. Instead, the current label bears the following information:

Bottled under licence from Guillaume M. Dumons,
Chagny (S&L) France by MAISON DOMAINE D'OR.

This suggests that, since the latter part of 1990, consumers have been associating the trade-mark DOMAINE D'OR not with the opponent but with an entity identified as Maison Domaine D'Or or with its French licensor.

The net effect of the foregoing is that consumers are used to seeing different trade-marks ending with the word "d'or" used for wines by various traders. Given the third party uses of that word and the fact that it is laudatory or descriptive and inherently weak, consumers are much more likely to center on the other components of such trade-marks when viewing them in the marketplace, particularly when those other components appear first in those marks.

Of minor note is the fact that Ms. Haakman was also able to purchase two third party wines bearing trade-marks commencing with the word "domaine", one mark being DOMAINE DU ROQUEVIGNAN and the other being DOMAINE DE MILLEFLEURS. To a very limited extent, this evidence suggests that consumers are used to seeing trade-marks commencing with the word "domaine" such that the ambit of protection to be accorded the opponent's registered mark is somewhat less than would otherwise be the case. Ms. Haakman also makes reference to numerous LCBO listings which incorporate the word "domaine" but her evidence on point appears to be unreliable. For example, most of the listings referred to by Ms. Haakman appear to be of the opponent's DOMAINE D'OR product.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. Furthermore, I am mindful of the fact that the marks at issue are not to be dissected but are to be considered in their entirety. However, that principle is of less effect in the present case due to the inherent weakness of the word "d'or" and the common use of that word by other traders. As noted, it appears that the opponent itself has contributed to this situation by identifying the source of its DOMAINE D'OR wine as an entity other than itself. Thus, in view of the inherent

weakness of the component "d'or", the third party uses of marks incorporating that word (including the opponent's own non-distinctive use of its mark) and the differences between the two marks at issue, I find that the applicant has satisfied the onus on it to show that its mark is not confusing with the opponent's registered mark. The first ground of opposition is therefore unsuccessful.

The remaining grounds also turn on the issue of confusion between the marks at issue although the material time respecting the second ground is the applicant's filing date and the material time respecting the third ground is the filing of the opposition. The circumstances that I considered respecting the first ground are essentially the same for the second and third grounds. The one notable exception is the opponent's more current labelling which was apparently not adopted until after the commencement of this opposition. However, that particular circumstance was not a significant factor in my assessment of the opponent's first ground. Thus, I find that the applicant has also satisfied the onus on it respecting the second and third grounds to show that its trade-mark was not confusing with the opponent's trade-mark at the material times. Those two grounds are therefore also unsuccessful.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 30th DAY OF NOVEMBER 1993.

David J. Martin,
Member,
Trade Marks Opposition Board.