



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

Reference: 2013 TMOB 185
Date of Decision: 2013-10-29
TRANSLATION

**IN THE MATTER OF THE
OPPOSITION submitted by Clos
St-Denis Inc. against registration
application No. 1,253,017 for the
CRÉMANT DE GLACE trade-mark in
the name of Verger du Minot Inc.**

Introduction

[1] Clos St-Denis Inc. (the Opponent) opposes registration of the CRÉMANT DE GLACE trade-mark (the Mark) covered by application No. 1,253,017 in the name of Verger du Minot Inc. (the Requesting Party).

[2] This application, submitted on April 5, 2005, is based on the planned use of the Mark in Canada in association with the following statement of wares (as amended on February 10, 2012 by the Requesting Party and accepted by the Registrar on February 17, 2012): “Alcoholic drinks, excluding wines and beers, specifically apple ciders” (the Wares).

[3] The statement of opposition originally submitted by the Opponent claimed several grounds of opposition based specifically on the probability of confusion pursuant to the *Trade-marks Act*, RSC 1985, c. T-13 (the Act) between the Mark and the registered POMME DE GLACE trade-mark previously used in Canada by the Opponent. As it will appear from my review of the file, the only remaining ground of opposition is based on subsections 38(2)(b) and 12(1)(b) of the Act, to the effect that the Mark is not registrable since it is deceptively

misdescriptive of the nature or quality of the Wares. In other words, this is the only issue to be decided.

The file

[4] The statement of opposition was submitted on 2011-05-16. The Requesting Party submitted a counter-statement denying all of the grounds of opposition contained in the said statement of opposition.

[5] In support of its opposition, the Opponent submitted an affidavit from Kimberly Sévigny, paralegal in the trade-marks department of the agent representing the Opponent, sworn on December 8, 2011. This affidavit aims to enter into evidence various definitions from online and traditional dictionaries.

[6] In support of its application, the Requesting Party submitted an affidavit from its president, Robert Demoy, sworn on March 28, 2012, as well as an affidavit from Jessica Rodrigues-Cerqueira, paralegal in the trade-marks department of the agent representing the Requesting Party, also sworn on March 28, 2012 and certificates of authenticity of registrations TMA361,242 and TMA581,504 for the CREMANT DE POMME DU MINOT and CRÉMANT DE POMME marks, respectively, in the name of the Requesting Party. Mr. Demoy's affidavit aims primarily to explain the scope and manner in which the Mark was used and promoted in Canada since 2005. Ms. Rodrigues-Cerqueira's affidavit aims primarily to list a series of registered marks appearing in the trade-marks register that include the word "glace" in association with ciders and alcoholic drinks.

[7] None of the parties submitting evidence were cross-examined.

[8] Each of the parties produced a written argument and attended a hearing. At the hearing, the Opponent returned to its written argument in which it had indicated that it was in fact withdrawing all grounds of opposition except that founded on subsections 38(2)(b) and 12(1)(b) of the Act claiming that:

[T]he Mark is not registrable [...] since it is clearly descriptive or is deceptively misdescriptive in French of the nature or quality of the Wares in that the Mark indicates,

rightly or wrongly, that the Wares are a crémant, namely a slightly sparkling wine, fermented from fruit exposed to a period of natural freezing. Moreover, the [a]pplication being founded on a claim of planned use of the Mark in Canada, the Mark cannot have become distinctive as at the date of submission of the [a]pplication.

[9] More specifically, the Opponent indicated that it was restricting this ground to the deceptively misdescriptive aspect of the Mark only. Accordingly, only this aspect will be examined.

The burden placed on the Parties

[10] 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 Requesting Party, according to the balance of probabilities [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (CF); and *Dion Neckwear Ltd. v. Christian Dior, SA et al.* (2002), 20 CPR (4th) 155 (FCA)].

Analysis

[11] The Opponent submits that the general meaning of the words that make up the Mark is sufficient to enable it to meet its initial burden of proof. In this regard, it refers me to the definitions in various French language dictionaries, such as *Le Grand Dictionnaire Terminologique de l'Office Québécois de la Langue Française* and the *Dictionnaire Français Larousse*, submitted in support of Ms. Sévigny's affidavit for the words and terms “crémant,” “cidre,” “vin,” “cidre de glace” and “vin de glace.”

[12] I agree.

[13] The issue of knowing whether a mark is clearly descriptive or deceptively misdescriptive must be studied from the viewpoint of the average consumer of wares and services. Furthermore, the mark must not be broken down into its various elements and analyzed minutely, but considered as a whole from the view of the first impression it gives [see *Wool Bureau of Canada Ltd. v. Registrar of Trade-Marks* (1978), 40 CPR (2d) 25 (CF 1st inst); and *Atlantic Promotions Inc. v. Registrar of Trade-Marks* (1984), 2 CPR (3d) 183 (CF 1st inst)]. The word “character” refers to a feature, trait or characteristic of the product and the word “clear” means “easy to

understand, evident or simple” [*Drackett Co. of Canada Ltd. v. American Home Products Corp.* (1968), 55 CPR 29 (Ex.Ct.)].

[14] To be considered clearly descriptive, it must be more than merely suggestive. The prohibition in regard to the marks giving a clear description aims to prevent a merchant from monopolizing a word that gives a clear description or which is generally used in the trade, and thus place legitimate merchants at a disadvantage [see *Canadian Parking Equipment Ltd. v. Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (CF 1st inst)]. To be considered deceptively misdescriptive, a trade-mark must mislead the public as to the character or quality of the wares or services. The mark must give a description suggesting that the wares or services contain something that in fact they do not contain. The prohibition in regard to deceptively misdescriptive trade-marks aims to prevent the public from being misled [see *Atlantic Promotions, supra*; and *Provenzano v. Canada (Registrar of Trade-marks)* (1977), 37 CPR (2d) 189 (CF 1st inst)].

[15] Furthermore, as mentioned by Judge Martineau in *Neptune SA v. Canada (Attorney General)* (2003), 29 CPR (4th) 497 (CF), paragraph 11:

In order to determine whether a trade-mark falls under this exclusion [subsection 12(1)*b*], the registrar must not only take into account the available elements of evidence, but also apply common sense in assessing the facts. The final decision on the character of clear description, or even deceptively misdescriptive, is based on his/her first impression. He/she must not consider this in isolation, but in light of the product or service in question.

See also *Ontario Teachers' Pension Plan Board v. Canada (Attorney General)* (2010), 89 CPR (4th) 301 (CF), paragraph 48; conf. in (2012), 99 CPR (4th) 213 (FCA)].

[16] The Relevant Date for analysis of a ground of opposition based on subsection 12(1)(b) of the Act is the date of submission of the application, in this case April 5, 2005 [see *Fiesta Barbecues Ltd. v. General Housewares Corp.* (2003), 28 CPR (4th) 60 (CF)]. Accordingly, given that Mr. Demoy's affidavit aims to show use of the Mark in Canada since the date of submission of the application, based as he agrees to recall on the planned use of the Mark, this evidence proves irrelevant as it is posterior to April 5, 2005.

[17] This leads me to discuss in greater detail the evidence submitted by the parties in regard to this ground of opposition in light of their respective representations.

[18] As indicated above, the Opponent placed in evidence definitions from various dictionaries for following words or terms: “crémant,” “cidre,” “vin,” “cidre de glace” and “vin de glace.”

[19] The Opponent asserted in a general and somewhat unanimous manner that these words or terms have the following meanings:

- “crémant”: a slightly effervescent/sparkling wine whose pressure is lower than that of Champagne;
- “cidre”: drink resulting from the fermentation of apple juice;
- “vin”: drink resulting from the fermentation of grapes or grape juice;
- “cidre de glace”: sweet cider made from naturally frozen apples or apple juice;
- “vin de glace”: sweet wine made from naturally frozen grapes.

[20] In light of these definitions, the Opponent asserts that the relevant consumer must understand that “cidres de glace” and “vins de glace” are sweeter than “regular” ciders and wines and that the manufacturing process involves frozen fruit (apples or grapes) in order to obtain a higher sugar content. As to “crémant,” the Opponent asserts that it is defined as a sparkling wine whose activity is less than Champagne, for example.

[21] In this regard, the Opponent submits that the Mark can only “clearly describe a type of ice wine.” Accordingly, the Opponent submits that “[t]he first part of the relevant test, i.e. that the Mark is firstly clearly descriptive in a manner to suggest something that is not the case (it suggests a sort of wine whereas it is a cider) is therefore satisfied. It remains to determine whether the Mark would lead a person to believe that it identifies something that it is not.”

[22] Concerning this second part of the test, the Opponent asserts that Mr. Demoy’s affidavit establishes that the Requesting Party’s ciders are sold by the Société des alcools du Québec (SAQ), which also sells large volumes of wine [see Exhibit RD-3]. In addition, on one of the samples of advertising submitted by Mr. Demoy, two bottles of cider and three bottles of wine

are advertised on the same page [see Exhibit RD-6]. (These exhibits are posterior to the Relevant Date. This said, I have no difficulty in immediately understanding that ciders and wines are alcoholic drinks generally sold and promoted by way of the same distribution channels.) Accordingly, the Opponent submits that it is therefore easy to imagine an average consumer procuring a bottle on which is written “crémant de glace” and believing it to be a type of ice wine whereas in this case it is a cider.” Therefore, the Opponent submits that this consumer would be misled by the Mark “as though he/she were facing the terms ‘Champagne de glace’ or ‘riesling de glace’.” The Opponent adds that this is an issue of terms that no one can monopolize as trade-marks in association with wine since this would prevent other producers of crémants, champagnes or rieslings from developing a ‘de glace’ version and generically call them thus.

[23] In contrast, the Requesting Party asserts that the word “crémant” is not exclusive to the field of wine and that the Mark must be viewed as a whimsical mark able to suggest several ideas.

[24] More specifically, the Requesting Party asserts that the word “crémant” is defined in one excerpt from the dictionary definitions appended to Ms. Sévigny’s affidavit as referring to “de crémér” [see Exhibit KS-12 which consists in an isolated definition taken from the *Le Nouveau Petit Robert* dictionary defining the word “crémant” as follows: [translation] “noun – 1846; to cream. Mildly sparkling wine. *Crémant d’Alsace*.”] In this case, the Wares consist in apple ciders, the Requesting Party asserted at the hearing that “it is the first definition that applies,” i.e. “de crémér” that the Requesting Party assimilates to the fact of “giving [to the ciders in question] a slight sparkling sensation.” Accordingly, considering the Mark overall, the Requesting Party asserts that “this only suggests one condition and/or state of the apple cider from among many possibilities.” The Requesting Party also submits that “these conditions are not essential characteristics for the consumer, unlike ingredients and quality which are important.” It also asserts that the Mark “is not clearly descriptive of an essential characteristic of apple ciders which can present in many other forms. In fact, apple ciders can present in the form of vinegars, pure ciders (alcoholic or not), beer, etc.”

[25] Returning to the dictionary definitions summarized above, the Requesting Party asserts that the Opponent's position according to which the word “crémant” must necessarily infer a

wine is countered by the fact that it stems from these definitions that the fields of wine and cider both employ common terms such as the term “de glace.” Accordingly, the Requesting Party submits that the Opponent’s position according to which the Mark wrongly indicates that the Wares are a slightly sparkling wine, fermented from naturally frozen fruit, does not hold and is only pure speculation on the part of the Opponent.

[26] Returning to the various ideas that the Mark can suggest, the Requesting Party asserts that it can suggest “the idea that apple cider comprises ice crystals, that it must be served on ice or very cold, that it is sparkling, that it is obtained by fermenting extracts of frozen apples, etc.” The Requesting Party also asserts that the Mark is not a term generally found in everyday use since it is not found as such in the dictionary (as demonstrated by Ms. Rodrigues-Cerqueira’s affidavit), Mr. Demoy himself claiming to have “invented” it [see paragraph 22 of his affidavit: “I am able to state that I invented the term CRÉMANT DE GLACE, a term that did not exist before I invented it in 2005.”]

[27] However, as rightly recalled by the Opponent, the fact that the term “crémant de glace” is not found as such in the dictionary is not relevant in itself, since this does not necessarily imply that this term has no meaning and provides no description [see particularly Kelly Gill & R. Scott Joliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th Ed, (Toronto: Carswell, 2003), page 5-30.3: “[...] the fact that a particular combination of words is not present in any dictionary does not necessarily mean that it is not descriptive or deceptively misdescriptive. If each portion of a mark has a well-known meaning, the combination could be contrary to s. 12(1)(b) [of the Act]].”

[28] Similarly, the fact of whether or not Mr. Demoy “invented” the Mark is not in itself relevant and would not have constituted a guarantee of registrability. Accordingly, I do not feel the need to rule on the issue of knowing the extent to which Mr. Demoy’s testimony on this matter is admissible as evidence (the Opponent having claimed at the hearing that Mr. Demoy cannot testify on this matter since it is a question of linguistic opinion for which he is not an expert).

[29] However, I cannot subscribe to the Requesting Party’s argument to the effect that the Mark, in the context of the Wares, must necessarily be viewed as a whimsical mark. The Mark is

comprised of the word “crémant” and the term “de glace,” which is an accepted term currently used (as acknowledged by the Requesting Party itself, specifically in its written arguments) to designate wines and ciders made from naturally frozen fruit (or juice). Accordingly, the Requesting Party’s argument to the effect that the Mark could suggest the idea that its ciders are comprised of ice crystals or must be served on ice or very cold stems from a scenario that mocks the everyday meaning given to the term “de glace” in the context of the Wares. Similarly, the Requesting Party’s argument to the effect that its ciders “can present in the form of vinegars, pure ciders (...), beer, etc.” mocks the Wares in question, which expressly exclude wines and beers, not to mention the fact that vinegar cannot be qualified as a cider (or vice-versa) from the sole fact that one can be derived from the other.

[30] Furthermore, with respect to the Requesting Party, I poorly conceive how the word “crémant,” in the context of the Wares, can be considered by some in the “pictured” meaning of “to cream” rather than the regular meaning of a wine covered by a light froth. In this regard, I note the word “crémer” is defined in the *Larousse* as follows: [translation] “v.t. COOK. Add cream to a sauce. p.p. adj. *Creamed sauce*. v.i. Rare. Become covered with cream (referring to milk).” The position sustained by the Opponent cannot be qualified as purely speculative. On the contrary, it appears to me rather that it is the Requesting Party’s position that may be speculative.

[31] On this point it is appropriate to produce an excerpt from *Hugues on Trade-marks* (Hugues, Roger T., *et al.*, Second Edition, LexisNexis, Markham, 2005-2012), pages 630 and 631, cited by the Opponent, discussing the applicable test to determine whether a given mark is deceptively misdescriptive. It is noted in passing that a mark can be deceptively misdescriptive despite it being likely to have more than one meaning:

To be deceptively misdescriptive, a mark must first be found to be descriptive so as to suggest that the wares are or contain something that is not the case. The deceptively misdescriptive part must lead a person to believe that the mark identifies something that is, in fact, not true. Where the mark is a combination of words, the deceptively misdescriptive part must so dominate the mark as applied for such that it would be precluded from registration. [...] Where a word or phrase is capable of more than one meaning, it still may be descriptive or misdescriptive if one of those meanings is descriptive or misdescriptive. To determine whether a trade-mark in its entirety is deceptively misdescriptive, the test is whether the general public in Canada would be misled into belief that the product with which the trade-mark is associated would, for example, have its origin in the geographical name in the trade-mark. [my underlining]

[32] In this case, considering the context of the Wares, I believe that the average consumer is more likely than not to think that the word “crémant” followed by the accepted term “de glace” would infer its everyday meaning. Accordingly, I deem it more probable than not that the Mark would lead people to wrongly believe that the Wares consist in a slightly sparkling wine, fermented from naturally frozen fruit, whereas these are in fact “apple ciders.” On this point, I would add that the fact that the labels on the products marketed under the Mark describe them as a “sparkling cider” [see specifically Exhibit RD-5 submitted in support of Mr. Demoy’s affidavit] is not relevant. The Mark must be considered as it is and not as it appears on the labels. Furthermore, it should be recalled that these labels are posterior to the Relevant Date.

[33] Before concluding, I would like to discuss a final argument raised by the Requesting Party to the effect that the latter “owns a family of trade-marks, i.e. the “Famille Crémant” and that it alone would hold trade-marks registered in Canada containing the word “crémant.”

[34] Firstly, regarding the fact that the Requesting Party holds registrations TMA361,242 and TMA581,504 for the CREMANT DE POMME DU MINOT and CRÉMANT DE POMME trade-marks, respectively, it is well recognized in law that Section 19 of the Act does not confer on the owner of a registration the automatic right to obtain the registration of other marks, even if the latter are closely related to the mark covered by the initial registration [see *Coronet-Werke Heinrich Schlerf GmbH v. Produits Menagers Coronet Inc.* (1984), 4 CPR (3d) 108 (TMOB); and (1990), *Groupe Lavo Inc. v. Proctor & Gamble* 32 CPR (3d) 533 (TMOB)].

[35] Secondly, the existence of a family of marks could not have been presumed in a procedure of opposition. A party that tries to establish the existence of a family of marks must prove that it uses more than one or two trade-marks making up the claimed family (the registration not establishing use of the mark) [see *Techniquip Ltd. c. Canadian Olympic Assn.* (1998), 145 FTR 59 (CF 1st inst), conf. in 250 NR 302 (FCA); and *Now Communications Inc. v. CHUM Ltd.* (2003), 32 CPR (4th) 168 (TMOB)]. In this case, Mr. Demoy’s affidavit aims to show use of the Mark rather than the CREMANT DE POMME DU MINOT and CRÉMANT DE POMME marks. Although some of the exhibits submitted in support of the latter also refer to ciders sold under the CREMANT DE POMME DU MINOT and CRÉMANT DE POMME marks, these are posterior to the Relevant Date. Furthermore, these exhibits do not make it

possible to determine the extent of use of the CREMANT DE POMME DU MINOT and CRÉMANT DE POMME marks. According, the Requesting Party's argument submitted at the hearing to the effect that the average Canadian consumer would be accustomed to seeing the word "crémant" associated with something other than wine, more specifically the Requesting Party's ciders, is not supported by the evidence on file.

[36] Thirdly, the third-party registrations presented by Ms. Rodrigues-Cerqueira showing trade-marks that include the word "glace" in association with ciders or alcoholic drinks are not relevant in themselves for determining the extent to which the Mark is registrable or not pursuant to subsection 12(1)(b) of the Act. It is sufficient to say that the marks in question in these registrations differ from the Mark.

[37] Lastly, each case must be determined on merit, as recalled by Judge Hughes of the Federal Court in the case of *Continental Teves AG & Co. OHG v. Canadian Council of Professional Engineers*, 2013 FC 801, paragraphs 42 and 43:

[42] [...] Whether a trade-mark is deceptively misdescriptive is as much a question of fact as is whether one trade-mark is confusing with another.

[43] [...] Each case will turn on its own facts. Those experienced in the trade-mark field may remark on the seeming contradictions in the jurisprudence where "Tavern" for beer has been held to be registrable, but "Java Café" for coffee has not; by way of example.

[38] Also, I will content myself to add that I find it unnecessary to discuss in detail the cases of *Reed Stenhouse Co. v. Canada (Registrar of Trade-Marks)* (1992) 45 CPR (3d) 79 (CF 1st inst) (concerning the PET PLAN mark), *Registrar of Trade-Marks v. Provenzano* (1979), 40 CPR (2d) 288 (FCA) (concerning the KOLD ONE mark), *Jordan & Ste-Michelle Cellars Ltd. – Les Caves Jordan & Ste-Michelle Ltée v. TG Bright & Co. Ltd.* (1984) 1 CF 964 (concerning the BRIGHTS CHILLABLE RED mark), and *RJ Reynolds Tobacco Co. v. Rothman, Benson & Hedges Inc.* (1993), 47 CPR (3d) 439 (CF 1st inst) (concerning the THE MILD ONE mark), cited by the Requesting party, other than to reiterate that each one is a separate case and can be easily distinguished from the matter at hand, in that in this case the word "crémant" and the term "de glace" making up the Mark cannot be considered as having any relation to the nature and quality of alcoholic drinks.

[39] Given all of the above, I deem that the Requesting Party has not met the burden of proof it is required to establish that, based on the balance of probabilities, as at the date of submitting the application, the Mark was not deceptively misdescriptive of the nature of the Wares.

[40] Therefore, the ground of opposition based on subsection 12(1)(b) of the Act is accepted.

Decision

In exercising the authority delegated to me pursuant to subsection 63(3) of the Act, I reject the application by virtue of subsection 38(8) of the Act.

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

Traduction certifiée conforme
Alan Vickers