

**IN THE MATTER OF OPPOSITIONS by
Rothmans Benson & Hedges Inc. to
applications Nos. 1122382 and 1122376 for
the trade-marks BOURGOGNE and
BURGUNDY respectively filed by Matinée
Company Inc.**

On November 19, 2001, Matinée Company Inc. (the “Applicant”) filed applications to register the trade-marks BOURGOGNE and BURGUNDY (the “Marks”) based upon proposed use of the Marks in Canada in association with “Manufactured tobacco products” (the “Wares”).

The applications were advertised for opposition purposes in the Trade-marks Journal of February 26, 2003.

On July 24, 2003, Rothmans Benson & Hedges Inc. (the “Opponent”) filed essentially identical statements of opposition against each of the applications. The grounds of opposition can be summarized as follows:

1. The Marks are not registrable contrary to s. 12(1)(b) of the *Trade-marks Act* (R.C.S. 1985, c.T-13, as amended) (the “Act”) since the Marks, whether depicted, written or sounded, are either clearly descriptive or deceptively misdescriptive in the English or French language of the geographical place of origin of the Wares; and
2. The Marks are not distinctive of the Applicant within the meaning of s. 2 of the Act as they do not distinguish the Wares of the Applicant nor are they adapted so as to distinguish them.

The Applicant filed and served a counter statement in each case in which it denied both grounds of opposition.

As its evidence in each case, the Opponent submitted an affidavit of Perry J. Lao. The Applicant filed a single set of affidavits of Edmond Ricard, Chantal Dorais, Timothy Owen Stevenson,

Adamo Santoianni and Iva Morina in respect of the two present oppositions as well as oppositions to two other applications involving the same Applicant and Opponent.

Each party filed a written argument in each case. Only the Applicant was represented at an oral hearing in each case.

Summary of Opponent's Evidence

Perry J. Lao identifies himself as a lawyer employed by the trade-mark agent for the Opponent in the present opposition proceedings.

Mr. Lao essentially provides copies or printouts of the definitions obtained for the words "BOURGOGNE" and "BURGUNDY" from various paper-based and web-based dictionaries available in Canada as well as reference materials relating to France and the Burgundy (or Bourgogne) region from the Opponent's agent's library in Toronto.

Summary of Applicant's Evidence

As indicated above, the Applicant filed the affidavits of Edmond Ricard, Chantal Dorais, Timothy Owen Stevenson, Adamo Santoianni and Iva Morina. Each of these affidavits was filed with respect to the present opposition proceedings and oppositions to two other applications involving the same Applicant and Opponent. None of the Applicant's evidence is relevant to the present oppositions.

Onus and relevant dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its applications comply with the requirements of the Act. There is, however, an initial 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior*,

S.A. et al. (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

The relevant dates for considering the circumstances in regard to each of the grounds of opposition in the present proceedings are the following:

- Ground based on s. 12(1)(b) of the Act: the filing date of the applications [see *General Housewares Corp. v. Fiesta Barbeques Limited* (2003), 28 C.P.R. (4th) 60 (F.C.)];
- Ground based on non-distinctiveness of the Marks: generally accepted as being the filing date of the statements of opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

I will now analyze these grounds of opposition in turn in regard to the evidence filed in record.

Section 12(1)(b) ground of opposition

The first ground of opposition is that the Marks, whether depicted, written or sounded, are either clearly descriptive or deceptively misdescriptive in the English or French language of the geographical place of origin of the Wares, contrary to s. 12(1)(b) of the Act.

To succeed on this ground, the actual place of origin of the Wares must first be established.

As there is no evidence that the Applicant's Wares are (will be) actually produced in a region known as Burgundy (or Bourgogne), the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Marks are clearly descriptive of the place of origin of the Wares [see *Molson Breweries, A Partnership v. Labatt Brewing Co Ltd.* (1996), 69 C.P.R. (3d) 274 (T.M.O.B.); *Bio Generation Laboratories Inc. v. Pantron I, Corp.* (1991) 37 C.P.R. (3d) 546 (T.M.O.B.)].

The next step then is to determine if the Marks can be found deceptively misdescriptive of the place of origin of the Wares.

As indicated above, the Opponent has provided through the Lao affidavit copies or printouts of the definitions obtained for the words “BOURGOGNE” and “BURGUNDY” from various paper-based and web-based dictionaries available in Canada as well as reference materials relating to France and the Burgundy (or Bourgogne) region from the Opponent’s agent’s library in Toronto.

While tobacco is being identified as an agricultural product of France, the said materials fall short of establishing that Burgundy (or Bourgogne) is generally known or recognized as a locality connected to the Wares. I reproduce below the most relevant parts of the very only excerpt filed by the Opponent in this regard, which consists in a 1931 (outdated) American publication entitled *Atlas of the World and Gazetteer*:

“FRANCE:

Area and Population. [...]

Climate. [...]

Government. [...]

Agriculture. A greater proportion of land is capable of cultivation than in any other large countries of Europe. The largest grain acreage is devoted to wheat, the leading districts in its production being the basins of the Seine, Loire and Garonne rivers. Among the cereals, [...]

Vineyards occupy about 4,000,000 acres, and great quantities of wine are produced. The great wine regions are the departments Hérault, Aude, Gironde, Côte-d’or, Charente, Gers, the Rhône and Saône valleys, and the districts known under the old names of Champagne, Anjou, and Touraine. France is the greatest grape-raising and wine-producing country in the world.

Potatoes and sugar beets are also grown extensively. Other agricultural products are maize, buckwheat, tobacco, colza and hemp.

Fruits and nuts yield crops of great value. Cider apples, plums, olives, walnuts, and chestnuts are the leading products.

Silk culture is carried on extensively in the warm areas of the lower Rhône, and is progressing with government aid.

Stock raising receives much attention, especially among the hills in the northwest, where fine pasture lands abound. Great quantities of butter and cheese are produced.

Fisheries. [...]

Forests. [...]

Minerals. [...]

Manufactures. [...]

Colonies. [...]”

The dictionary definitions filed by the Opponent do not assist it further. None of the definitions for the words “BOURGOGNE” or “BURGUNDY” refer in any way to tobacco or the like.

According to the various dictionary definitions filed by the Opponent, the words “BOURGOGNE” and “BURGUNDY” may be defined as follows:

- A region of east central France (the region is noted for its wine);
- The wine (usually red) of Burgundy (France) or a similar wine from another place (as California);
- The reddish purple colour of burgundy wine or a dark reddish brown colour or a dark purplish red to blackish red; and
- A Portuguese dynasty that existed from the years 1139 to 1383.

Furthermore, s. 11.18(3)(g) of the Act specifically states that “BOURGOGNE” and “BURGUNDY” are considered generic terms for wines and that all traders are free to adopt, use and register same as a trade-mark in respect of wines.

The Applicant contends that the above dictionary definitions suggest that when used in association with tobacco products, the Marks may suggest any of the following:

- That the tobacco products are refined or sophisticated, characteristics associated with burgundy wines or the consumption thereof;
- That the tobacco products are appropriate for consumption while drinking burgundy wines;
- That the tobacco product itself is burgundy in colour; or
- That the packaging of the tobacco product is burgundy in colour.

The proper approach in determining whether a trade-mark in its entirety is deceptively misdescriptive is whether the general public in Canada would be misled into the belief that the product with which the trade-mark is associated had its origin in the place of a geographic name in the trade-mark [see *Atlantic Promotions Inc. v. Registrar of Trade-marks* (1984), 2 C.P.R. (3d) 183 at 186 (F.C.)].

The Applicant contends that the Opponent has failed to provide evidence to establish that the general public in Canada would be misled into a belief that the Applicant's Wares had their origin in Burgundy (or Bourgogne). I agree.

As indicated above, there is no evidence that the Burgundy region of France produces tobacco or tobacco products; much less that it is generally known or recognized as a locality connected to the Wares.

As also indicated above, there are several different meanings for the words "BOURGOGNE" and "BURGUNDY".

Furthermore, and as contended by the Applicant, even if it is shown that a geographical region is well-known for producing one type of product (for example wines), a mark containing that region may still be registered in relation to other products (for example tobacco) [see *Institut National des Appellations d'Origine v. Pepperidge Farm, Inc.* (1997), 84 C.P.R. (3d) 540 at 556 (T.M.O.B.) where BORDEAUX in association with cookies was found registrable despite well-known Bordeaux wines; and *Institut National des Appellations d'Origine v. Chock Full O'Nuts Corp.* (2000), 9 C.P.R. (4th) 394 at 401 (T.M.O.B.) where LA TOURAINE in association with coffee, tea, cocoa and spices was found registrable despite Touraine wine and Sainte-Maure de Touraine cheese].

Conclusion Re : descriptiveness

As acknowledged by the Opponent in its written argument, the intent of the prohibition in s. 12(1)(b) against geographical names is to prevent a person from acquiring a monopoly on a word that is generally recognized as a locality connected to the wares or services at issue [see *Molson Breweries* supra]. Having regard to foregoing analysis, I find that the Opponent has not met its initial evidential burden necessary to put into issue the allegations that the Marks are clearly descriptive or deceptively misdescriptive of the place of origin of the Wares. Accordingly, the s. 12(1)(b) ground of opposition is unsuccessful.

Non-distinctiveness ground of opposition

The second ground of opposition is that the Marks are not distinctive of the Applicant within the meaning of s. 2 of the Act as they do not distinguish the Wares of the Applicant nor are they adapted so as to distinguish them. The Opponent did not provide any further particulars in support of this pleading. Thus, that second ground of opposition does not comply with s. 38(3)(a) of the Act and is therefore unsuccessful.

Even if the distinctiveness ground of opposition had been sufficiently pleaded, I still would find that ground unsuccessful as the Opponent has not met its initial evidential burden with respect to its distinctiveness ground of opposition as there is no evidence of any other trader having used the trade-marks BOURGOGNE or BURGUNDY in association with manufactured tobacco products. Indeed, there is no evidence that anyone has used any mark containing the words “BOURGOGNE” or “BURGUNDY” at all. Furthermore, if the distinctiveness ground were considered to be based on the allegation that the applied-for Marks are clearly descriptive of the place of origin of the Wares, it would also fail for the same reasons that the descriptiveness ground of opposition failed.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the oppositions to the registration of the marks BOURGOGNE and BURGUNDY, the whole pursuant to s. 38(8).

DATED AT Montréal, Québec, THIS 13th DAY OF February 2008.

Annie Robitaille
Member
Trade-marks Opposition Board