



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 102**

**Date of Decision: 2022-05-20**

**IN THE MATTER OF AN OPPOSITION**

**Camera Di Commercio Industria,  
Artigianato E Agricoltura Di Verona**

**Opponent**

**and**

**Schenk Italia S.p.A.**

**Applicant**

**1,788,483 for AMICONE**

**Application**

BACKGROUND

[1] On June 23, 2016, Schenk Italia S.p.A. (the Applicant), filed application No. 1,788,483 (the Application) to register the trademark AMICONE (the Mark) for use in association with “wines” (the Goods).

[2] The Application was filed on the basis of (1) use and registration of the Mark in the European Union (European Union Registration No. 11005725), (2) use and registration of the Mark in Italy (Italian Registration No. 1529381); and (3) proposed use in Canada.

[3] The Application was then advertised in the *Trademarks Journal* of January 17, 2018 and on March 12, 2018 Camera Di Commercio Industria, Artigianato E Agricoltura Di Verona (the Opponent) filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act).

[4] All references herein are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition, which refer to the Act before it was amended (see section 70 of the Act which provides that section 38(2) of the Act, as it read prior to June 17, 2019, applies to applications advertised before that date).

[5] The grounds of opposition alleged by the Opponent are that: the Application does not conform to sections 30(d) and (e) of the Act; the Mark is not registrable under sections 12(1)(a) and (d) of the Act; the Applicant is not the person entitled to registration of the Mark under section 16(2)(a) of the Act; and the Mark is not distinctive under section 2 of the Act.

[6] On May 15, 2018, the Applicant filed and served a counter statement denying all of the allegations contained in the statement of opposition.

[7] In support of its opposition, the Opponent filed the declarations of Giuseppe Riello, dated September 5, 2018 (the Riello declaration) and Marylène Gendron, dated September 14, 2018 (the Gendron declaration). The Applicant obtained an order for the cross-examination of the deponents on their declarations. However, Mr. Riello was unable to make himself available for cross-examination in Canada, resulting in the Riello declaration being returned to the Opponent pursuant to section 44(5) of the now repealed *Trade-Marks Regulations*, SOR/96-195. The Riello declaration is therefore no longer of record. Ms. Gendron, for her part, was cross-examined and the corresponding transcript is part of the record.

[8] In support of its Application, the Applicant filed the affidavit of Sarah Baird, dated July 17, 2019 (the Baird affidavit). Ms. Baird was not cross-examined.

[9] The Opponent did not file any evidence in reply.

[10] Both parties filed written submissions; no hearing was held.

## OVERVIEW OF THE EVIDENCE

### **Opponent's evidence**

#### Gendron declaration

[11] As of the date of her declaration, Ms. Gendron was a secretary employed by the agents representing the Opponent. [para 1]

[12] The Gendron declaration and its exhibits include searches on the Canada411 database (the Canada411 searches) conducted on September 6 and September 14, 2018 to locate references concerning individuals named AMICONE. The search results show 24 entries for AMICONE in Canada. [paras 4 to 7, Exhibits MG-1 to MG-3]

[13] The Gendron declaration also includes excerpts from the Canadian Trademarks Database concerning the Opponent's certification marks registration Nos. TMA722,054 and TMA722,055. [paras 8 to 11, Exhibits MG-4 to MG-6]

#### Gendron cross-examination

[14] Ms. Gendron was cross-examined on March 14, 2019. The information of note on cross-examination is outlined below.

[15] Ms. Gendron confirmed that she prepared her declaration based on instructions provided by the Opponent's agents. However, Ms. Gendron did not recall how she got the instructions. [page 7, lines 5 to 16]

[16] With respect to her Canada411 searches, Ms. Gendron confirmed that she clicked on each of the 24 yielded entries to display the details of the names, addresses and phone numbers. She did not recall conducting any other research, nor did she call any of the phone numbers related to any of the entries. [page 9, lines 15 to 24]

[17] Ms. Gendron also noted that some of the entries from her Canada411 searches show the same address. She did not know if these entries with the same address refer to the same person. [page 9, line 25 to page 11, line 19]

### **Applicant's evidence - Baird affidavit**

[18] As of the date of her affidavit, Ms. Baird was a paralegal employed by the agents representing the Applicant. [para 1]

[19] The Baird affidavit provides additional information on the 24 entries found in the Canada411 searches conducted by Ms. Gendron. Specifically, Ms. Baird called each of the 24 numbers located by Ms. Gendron. She then conducted searches using the Reverse Phone Search Tool available through the website at *whitepages.com* and contacted Bell Canada with respect to five phone numbers associated with the same address. As a result, though many of her calls were unanswered, she reports that:

- two numbers were directed to an automated message advising that they were no longer in service;
- three numbers were directed to a ring/dial tone “typically associated” with facsimile numbers;
- five numbers belong to the same individual.

[paras 3 to 13, Exhibits A to C]

### ANALYSIS OF THE GROUNDS OF OPPOSITION

[20] There are two main questions to be determined in this proceeding: first, whether the Mark is a word that is primarily merely the name or surname of an individual who is living or has died in the last 30 years, and second, whether the Mark is confusing with either of the Opponent's relied upon trademarks. For the reasons set out below, I find the answer to both of these questions is no.

[21] I will therefore begin my analysis with the registrability grounds of opposition considering them in an order similar to that in which they are pleaded in the parties' written arguments starting with the section 12(1)(a) ground.

**Section 12(1)(a) – registrability (primarily merely name or surname)**

[22] The Opponent pleads that the Mark is not registrable having regard to the provisions of section 12(1)(a) of the Act, because it is primarily merely the name or the surname of an individual who is living or has died within the preceding 30 years.

[23] Evidence has been submitted that AMICONE is a surname, which fact is also admitted to by the Applicant in its written argument. The point of disagreement between the parties here is rather centered on the question of whether this word is “primarily merely” a name or surname as opposed to something else.

[24] In this regard, it must be determined what would be the response of the general Canadian public to the Mark. For instance, if it is considered that a consumer of ordinary intelligence and of ordinary education in English or French would be more likely to respond to the Mark by thinking of it as a name or surname than as something else, the trademark would be primarily merely a family name and would not be registrable.

[25] Relying on the decision in *Pioneer Shoes Limited v FA Clemmer Enterprises Limited*, 1996 CanLII 11492 (TMOB), the Opponent submits that the only evidence on file is that AMICONE is a word that is nothing more than a surname, particularly as no other evidence was produced and no other significance has been put forward in this matter by the Applicant. The Opponent also submits that “[i]n view of the structure of the term AMICONE”, it would be viewed by the average Canadians as a family name.

[26] The Applicant, for its part, submits that it has not been held that the Applicant’s evidentiary onus can *only* be satisfied by adducing direct evidence that its Mark has another significance. Indeed, the Applicant submits that it has provided evidence to contradict the Opponent’s evidence. Specifically, the Applicant submits that the Baird affidavit demonstrates that the Opponent’s Canada 411 searches resulted in a number of duplicated hits, phone numbers not in service, facsimile lines or phone numbers owned by the same individual. In addition, the Applicant submits that the Registrar is permitted to take judicial notice of English and French dictionary meanings and that, in the present case, the fact that AMICONE has no meanings in the

English and French language may lead consumers to perceive the Mark as an invented word or a brand name.

[27] The Applicant points to the decision in *Claisse v Claisse Scientific Corporation Inc*, 2009 CanLII 82179 (TMOB) — also relied upon by the Opponent to its point that it is not pertinent to determine the exact number of individuals bearing the family name AMICONE. In this decision, the Registrar indeed found that the number of entries in a Canadian telephone directory is not determinative of the issue of whether a mark is primarily merely a surname. However, despite this finding, the Registrar ultimately reached the conclusion that the trademark at issue is not “primarily” a surname based on the following analysis:

[37] Considering first of all the frequency of the word “CLAISSE” used as a surname, there is no doubt in my mind that this is a rare surname in Canada. However, neither the figure of 11 entries listed in Canadian telephone directories, as adduced into evidence by the affidavit of Ms. Simard, nor the allegation in Mr. Claisse’s affidavit that there are 29 persons by the name of “CLAISSE” in Quebec is, by itself, determinative in this case. The practice notice stating that an objection under section 12(1)(a) of the Act will only be taken into consideration if there are at least 25 entries of the name or the surname in Canadian telephone directories is only provided as an indication and does not reduce the applicable test on the matter to mere mathematical considerations.

[38] Since it is a rare surname that, furthermore, does not correspond to any word defined in French or English dictionaries, the question is whether the average Canadian is more likely to associate the word “CLAISSE” with a family name or whether this word is primarily or equally perceived as an invented word that may be used as a trade-mark [see *Registrar of Trade-marks v. Coles Book Stores Limited*, 1972 CanLII 176 (SCC), [1974] S.C.R. 438; *Standard Oil Co. v. The Registrar of Trade-marks*, [1968] 2 Ex. C.R. 523; *Galanos v. Canada (Registrar of Trade-marks)* (1982), 69 C.P.R. (2d) 144 (F.C.T.)]. To me, the second scenario seems the most probable.

[39] Although the word “CLAISSE” does in fact correspond to a surname, the rarity of this surname, in conjunction with the fact that the word “CLAISSE” has no particular connotation, leads me to conclude that the two characteristics (surname and invented name) are equally important. Therefore, the word “CLAISSE” cannot be said to be “primarily” merely a surname.

[28] Applying these principles to the case at hand, I agree that AMICONE appears to be a relatively rare surname, and because of the rarity of AMICONE as a surname, and because AMICONE does not in fact have any meaning in English or French, I believe that the rare surname characteristic would, at most, be as equally important as the invented/brand name characteristic in the mind of the average Canadian consumer [see also *National Cheese Co v*

*Minerva Agricola Alimentare SRL*, 1999 CarswellNat 3468 (TMOB)]. In other words, based on the evidence of record, I do not find the surname characteristic here to be more dominant than other potential (fanciful word or mark) meanings. Accordingly, the section 12(1)(a) ground of opposition is rejected.

**Section 12(1)(d) – registrability (confusion with registered trademarks)**

[29] The Opponent pleads that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act because it is confusing with the certification marks of the Opponent registered in Canada as follows:

- AMARONE, registered on August 26, 2008 under No. TMA722,054 in connection with “alcoholic beverages (except beers), namely wines”;
- AMARONE DELLA VALPOLICELLA, registered on August 26, 2008 under No. TMA722,055 in connection with “alcoholic beverages (except beers), namely wines of the Valpolicella region”.

[30] As indicated above, the Opponent filed the particulars of these registrations through the Gendron declaration under Exhibit MG-6. Having exercised the Registrar’s discretion to check the register, I confirm that both of the Opponent’s registrations above are in good standing as of the date of this decision.

[31] As the Opponent has met its initial burden with respect to this ground of opposition, the Applicant must now establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and either of the Opponent’s relied upon trademarks.

[32] In this regard, I will focus my analysis on the Opponent’s trademark AMARONE as I consider it to represent the Opponent’s strongest case. In other words, if confusion is not likely between the Mark and this trademark, then it would not be likely between the Mark and the Opponent’s trademark AMARONE DELLA VALPOLICELLA.

### Test for confusion

[33] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates that the use of a trademark causes confusion with another if the use of both trademarks in the same area would likely lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[34] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act, namely: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time they have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, where the Supreme Court of Canada states at para 49 that the resemblance between the marks will often have the greatest effect on the confusion analysis.

### Inherent distinctiveness and extent known

[35] With respect to the Mark, I find that it has at least some measure of inherent distinctiveness despite its surname significance. As indicated above, AMICONE appears to be a relatively rare surname. Furthermore, as a matter of first impression, I believe that the rare surname characteristic would—at most—be as equally important as the invented/brand name characteristic in the mind of the relevant Canadian consumer.

[36] With respect to the trademark AMARONE, the Opponent submits that it possesses a higher degree of inherent distinctiveness as it is not a clear description of the character or nature of the goods in English or French, it is not a family name, and it is not the name of the goods in a foreign language. Attached to the Opponent's written argument as Annex A is a printout from



*wikipedia.org* for “Amarone”. The Applicant rightly objects to the inclusion of this printout, as it was not properly introduced as evidence, and I hereby confirm that Annex A to the Opponent’s written argument does not form part of the evidence in this proceeding.

[37] That said, I can take judicial notice of dictionary definitions and have consulted the *Collins English Dictionary* and *Merriam-Webster* dictionary available online which define AMARONE, respectively, as meaning “a strong dry red Italian wine” and “a robust dry red Italian wine with a high alcohol content”. In view of these definitions, the Opponent’s trademark is descriptive in the context of the goods covered in registration No. TMA722,054, identified above, and is therefore not inherently distinctive.

[38] Concerning the extent to which the trademarks have become known, neither party effectively filed evidence in that respect.

[39] Accordingly, I find this factor favours the Applicant.

#### Length of time in use

[40] As indicated above, the Application is based on proposed use in Canada and the Applicant has not provided any evidence that use of the Mark has commenced since its filing.

[41] There is also no evidence of use of record from the Opponent. In addition, while the registration for the trademark AMARONE contains a claim of use since at least as early as 1984, I am disinclined to even infer *de minimis* use of this trademark in Canada without a certified copy of the registration [*Tokai of Canada v Kingsford Products Company, LLC*, 2018 FC 951 at para 37]. In any event, such an inference would not support the finding that the Opponent’s trademark was known to any significant extent, or that it has necessarily been continuously used since the date claimed [*Krauss-Maffei Wegmann GmbH & Co KG v Rheinmetall Defence Electronics GmbH*, 2017 TMOB 50 at para 20].

[42] Accordingly, I find this factor does not favour either party.

### Nature of the goods or business and nature of the trade

[43] There is direct overlap between the parties' goods as the trademarks both cover wines. Considering that the goods at issue are identical, and in the absence of evidence or submissions to the contrary, there is no reason to find that their channels of trade could not also potentially overlap.

[44] Accordingly, I find these factors favour the Opponent.

### Degree of resemblance

[45] In its written argument, the Opponent submits that the trademarks at issue share multiple features including the same number of letters; the same number of syllables; the same composition; the same prefix; the same suffix; and that the variation which appears in the middle of the two trademarks has a common denominator since one vowel is replaced by another vowel (the vowel I is replaced by the vowel A) and one consonant is replaced by another consonant (the consonant C is replaced by the consonant R).

[46] In its written argument, the Applicant submits that:

49. [...] when considering the degree of resemblance, the trademarks must be considered in their totality. The appropriate test is not a side-by-side comparison but a matter of first impression of a consumer with an imperfect recollection of an opponent's trademark. In addition, the analysis of this confusion factor should not involve teasing out and analyzing each portion of a mark alone. Rather, one should consider the mark as a whole as it is encountered by the consumer and as a matter of first impression. [...]

50. The Opponent's analysis appears to be directly contrary to the Supreme Court of Canada's direction. It would appear that the analysis conducted was a side-by-side comparison, and an assessment by teasing out and comparing each portion of the marks.

51. Instead, it is submitted that the two marks should be considered in their entirety. When the appropriate test is conducted, it would be apparent, based on first impression, that the two marks contain a number of differences.

52. In terms of appearance, the Applicant submits that the overlap in each letter should not be the focus of the analysis. Many words in the English language share the same letters both at the beginning and at the end. However, despite sharing these letters, the average Canadian consumer is apt to distinguish such words on a regular basis. Some examples are set out below:

- Debone vs Define

- Forgone vs Fortune

[...]

53. It is submitted that the differences between the Applicant's Mark and the Opponent's mark AMARONE are of the same nature as the above examples. While the Applicant's Mark and the Opponent's mark AMARONE may share some of the letters, relevant consumers would more likely to be able to distinguish the respective parties' mark when the marks are viewed as a whole.

54. The Applicant also submits that if a consumer were to divide the marks into portions, contrary to the Opponent's view, these marks do not share the same prefixes and suffixes. The Applicant's Mark can be divided into the prefix AMI and the suffix CONE. In contrast, the Opponent's certification mark, AMARONE, would likely be considered to consist of the prefix AMA and the suffix RONE. These prefixes and suffixes are not the same.

55. In addition to appearance, the Applicant submits that the differences between the two marks are more apparent in terms of sound. When sounded, the Applicant's Mark would be "A-MI-CONE" while the Opponent's mark AMARONE would likely be pronounced as "A-MA-RONE". The overlapping syllable "A" is extremely common in the English language.

56. In terms of ideas suggested, while both marks may be viewed as either coined or foreign language words, they may nevertheless invoke different impressions in the minds of the average English/French-speaking or bilingual Canadian. When sounded, the Applicant's Mark sounds somewhat similar to some of the English words, including "amicable", "cone", and "silicone". In contrast, the Opponent's mark AMARONE may share some resemblance in sound with other English words, including "amazon", "amazing", "a drone" and "a throne". These words carry very different meanings. Therefore, when consumers encounter these two marks in the marketplace, they will likely question what each mark may mean and could result in very different answers.

[47] I am in general agreement with the Applicant's submissions above.

[48] When they are considered in their entirety, I find that the parties' trademarks are more different than alike. The trademarks resemble each other given that they are both composed of a single seven-letter word, no part of which however stands out to me as being more striking or unique. In other words, the striking aspect of the parties' trademarks AMARONE and AMICONE are the trademarks as a whole, respectively. Further, as submitted by the Applicant, it follows that there are aural and visual differences between the trademarks. There is also very little conceptual resemblance between them as, while the Opponent's trademark would, in my view, be perceived as referring to red Italian wine, the Mark could impart either a surname significance, suggest a coined word or brand, or even arguably a foreign connotation in the mind

of consumers. In short, the overall differences between the trademarks at hand in my view outweigh their similarities.

[49] Accordingly, I find this important factor favours the Applicant.

#### Conclusion on likelihood of confusion

[50] Having considered all the surrounding circumstances and applying the test of confusion as a matter of first impression and imperfect recollection, I find that the Applicant has met its onus to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark AMARONE. I reach this conclusion mainly due to the differences between the trademarks, which I find outweigh the overlap that exists with respect to the goods at issue and the potential for overlap with respect to their channels of trade.

[51] I will add that my finding would remain unchanged as applied to the other trademark relied upon by the Opponent in my assessment of this ground of opposition, as it is even more different than the Mark (per section 6(5)(e)).

[52] Accordingly, the section 12(1)(d) ground of opposition is rejected.

#### **Remaining grounds summarily rejected**

##### Sections 16(2)(a) and 2 – entitlement (prior trademark use) and distinctiveness

[53] With respect to its section 16(2)(a) ground of opposition, the Opponent relies on the same certification marks pleaded with respect to its section 12(1)(d) ground of opposition, previously used in Canada in connection with wines. With respect to its section 2 ground of opposition, the Opponent pleads that the Mark is not distinctive, first, in view of the Opponent's aforementioned certification marks and second, because it is a family name.

[54] The entitlement ground as well as the first prong of the distinctiveness ground fail because the evidence of record, as indicated above, does not effectively demonstrate use of the Opponent's certification marks in Canada at the filing date of the Application nor that any of these trademarks had acquired a reputation in Canada that was sufficient to affect the Mark's

distinctiveness at the date of filing the statement of opposition [see section 16(5) of the Act and *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 25-34 which sets out the Opponent's evidential burden].

[55] The second prong of the distinctiveness ground fails because the Mark is not primarily merely a surname as per my comments above respecting the section 12(1)(a) ground of opposition.

[56] Accordingly, the sections 16(2)(a) and 2 grounds of opposition are rejected in their entirety.

#### Sections 30(d) and (e) – compliance (Application requirements)

[57] The Opponent pleads that the Application does not comply with the requirements of section 30(d) of the Act because as of the Application filing date, the Mark was not used by the Applicant in Italy in connection with the goods listed in the Application, and because European Union Registration No. 11005725 has been cancelled and could not be relied upon as a basis for the Application.

[58] The Opponent also pleads that the Application does not comply with the requirements of section 30(e) of the Act because as of the Application filing date, the Applicant did not have the intention to use the Mark in connection with the Goods in Canada.

[59] However, no evidence or submissions were filed in support of these allegations. Accordingly, the sections 30(d) and (e) grounds of opposition are rejected because the Opponent has not met its initial evidential burden.

DISPOSITION

[60] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Iana Alexova  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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No Hearing Held

**AGENTS OF RECORD**

LAVERY, DE BILLY, LLP

For the Opponent

BORDEN LADNER GERVAIS LLP

For the Applicant