



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 33

Date of Decision: 2025-02-26

IN THE MATTER OF AN OPPOSITION

Opponent: Viña La Rosa S.A.

Applicant: Miguel Torres S.A.

Application: 1933687 for MAS DE LA ROSA

INTRODUCTION

[1] Miguel Torres S.A. (the Applicant) has filed application No. 1933687 (the Application) to register the trademark MAS DE LA ROSA (the Mark). The Application is based on proposed use of the Mark in association with “wines”.

[2] Viña La Rosa S.A. (the Opponent) opposes the Application. The opposition is primarily based on an allegation that the Mark is confusing with the Opponent’s trademark VIÑA LA ROSA, previously used and registered in association with wine.

[3] For the reasons that follow, the opposition is rejected.

THE RECORD

[4] The Application was filed on December 3, 2018 and includes the following foreign character translation:

As provided by the [A]pplicant, MAS DE LA ROSA translates to COUNTRY HOUSE OF THE ROSE.

[5] The Application was advertised for opposition purposes in the *Trademarks Journal* on July 20, 2022.

[6] On September 20, 2022, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. As the Application in this case was advertised after June 17, 2019, the Act as amended applies (see section 69.1 of the Act).

[7] The statement of opposition raises grounds of opposition based on non-registrability of the Mark under section 12(1)(d) of the Act, non-entitlement of the Applicant to register the Mark under section 16(1)(a) of the Act, non-distinctiveness of the Mark under section 2 of the Act, and non-entitlement of the Applicant to use the Mark under section 38(2)(f) of the Act.

[8] The Applicant filed a counter statement denying the grounds of opposition.

[9] In support of the opposition, the Opponent filed an affidavit of its Chief Executive Officer, Daniel Eyzaguirre Perez-Cotapos, sworn May 19, 2023 (the Perez-Cotapos Affidavit). The Perez-Cotapos Affidavit provides information on the Opponent's business, including the use and promotion of the Opponent's trademark VIÑA LA ROSA in association with wine in Canada. The Applicant obtained an order for the cross-examination of Mr. Perez-Cotapos, but the Applicant did not cross-examine Mr. Perez-Cotapos.

[10] In support of the Application, the Applicant filed four affidavits, namely:

- an affidavit of Bianca Beauchamp, sworn January 18, 2024 (the Beauchamp Affidavit). At the time of swearing her affidavit, Ms. Beauchamp was a college

student working occasionally as a part-time clerk with the agent for the Applicant. The Beauchamp Affidavit provides, *inter alia*, the results of marketplace searches conducted both online and in brick and mortar stores by Ms. Beauchamp between January 13 and 17, 2024 in respect of wines that display in a prominent way either of the words “ROSA”, “ROSE” or “ROSÉ” on the labels affixed to the wine bottles;

- three affidavits of Mariola Grabinski, an administrative assistant employed by the agent for the Applicant, namely a first one sworn January 15 and the other two sworn January 17, 2024 (respectively the Grabinski Affidavit #1, Grabinski Affidavit #2 and Grabinski Affidavit #3, collectively the Grabinski Affidavits). The Grabinski Affidavits provide, *inter alia*, the results of state of the register searches and marketplace searches conducted by Ms. Grabinski in respect of wines that comprise either of the words “ROSA”, “ROSE” or “VINA” in their names.

[11] The Opponent obtained an order for the cross-examination of Mss. Beauchamp and Grabinski, but the Opponent did not cross-examine them.

[12] Neither party submitted written representations and no hearing was held.

THE PARTIES’ RESPECTIVE BURDEN OR ONUS

[13] The Opponent has the initial evidential burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. Once that burden is met, the Applicant bears the legal onus of establishing, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059, 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Non-entitlement of the Applicant to register the Mark under section 16(1)(a) of the Act

[14] The Opponent has pleaded that the Applicant is not the person entitled to register the Mark pursuant to section 16(1)(a) of the Act because, at the filing date of the Application, the Mark was confusing with the VIÑA LA ROSA trademark previously used and made known by the Opponent in Canada in association with wine.

[15] The material date to assess this ground of opposition is the filing date of the Application, namely December 3, 2018 as there is no evidence that the Applicant commenced use of the Mark prior to this date [Act, section 16(3)].

[16] To meet its initial burden, the Opponent must show that it had used its VIÑA LA ROSA mark in Canada prior to the filing date of the Application. Further, the Opponent must show that it had not abandoned its trademark at the date of advertisement of the Application, namely July 20, 2022.

[17] Per my review below of the Perez-Cotapos Affidavit, I find the Opponent has met its evidential burden under this ground.

The Perez-Cotapos Affidavit

[18] In his affidavit, Mr. Perez-Cotapos essentially attests to the following:

- the Opponent was established in 1824 within the Cachapoal Valley, Peumo, Chile. As one of Chile's most reputed and award-winning wineries, the Opponent is one of the few Chilean family-owned producers who are in control of their entire production, from vineyard to bottle [paras 3-4];
- since at least as early as 1998 and continuously through the present day, the Opponent has provided consumers in Canada, the U.S., South America, and Europe, amongst other countries, with their wines under the VIÑA LA ROSA trademark [para 5];
- all VIÑA LA ROSA-branded wine sold in Canada has been, and continues to be, sold in bottles prominently marked with the VIÑA LA ROSA trademark [para 9];

and Exhibit OP-3: images which are generally representative of how the VIÑA LA ROSA trademark has appeared on the labelling of the Opponent's wine bottles in Canada since at least as early as 1998 and continuously through to present day];

- through substantial effort and investment, the Opponent has since 1998 built an extensive network of retailers providing its wines throughout Canada in association with the VIÑA LA ROSA trademark [para 10];
- the Opponent's VIÑA LA ROSA-branded wines have been and continue to be available for sale to Canadians in a variety of channels of trade. For example, in provinces where wine is distributed through government-run retail outlets, such as Ontario and Quebec, the Opponent's VIÑA LA ROSA-branded wine are available for purchase through the government-run retail outlets themselves, such as the Liquor Control Board of Ontario (LCBO) and the Société des alcools du Québec (SAQ). In other provinces where spirits and liqueurs are available through third-party, privately-owned retail stores, the Opponent sells VIÑA LA ROSA-branded wine to the public through, for example, wine agencies and restaurants [paras 11-14; Exhibit OP-4: copy of the webpage headed "About the LCBO" on the LCBO website that describes the LCBO as one of the largest retailers and wholesalers of beverage alcohol in the world; Exhibit OP-5: copy of the wine agency Richmond Hill Wines webpage featuring the VIÑA LA ROSA-branded wine; and Exhibit OP-6: copies of restaurant menus in Toronto and Windsor, Ontario, featuring the VIÑA LA ROSA-branded wine];
- total sales of the VIÑA LA ROSA-branded wine in Canada since 2016 has been in excess of USD 1,300,000 [para 16 which includes a table that sets out the total volume of bottles of VIÑA LA ROSA-branded wine per year during the 2016-2022 period, which varied between a minimum of 35,000 bottles in 2022 and a maximum of 120,000 bottles in 2016; and Exhibit OP-7: representative invoices issued by the Opponent showing sales of the VIÑA LA ROSA- branded wine made in Montreal, Halifax, Vancouver, Edmonton and Toronto during the 2016-2022 period];
- the Opponent has heavily invested in advertising and marketing to promote the VIÑA LA ROSA- branded wine around the globe, including in Canada. One way

that the Opponent advertises its VIÑA LA ROSA-branded wine is through its official website at <https://larosa.cl> (the Vina La Rosa Site), which has always been accessible to Canadians [paras 19-20; and Exhibits OP-8 and OP-9: screenshots from the Vina La Rosa Site (both current and from the Wayback Machine Internet Archive captured on March 14, 2023)];

- in addition, the Opponent's VIÑA LA ROSA-branded wine has been referenced in Canadian wine club catalogues and magazines, as well as in articles published in national and local publications [paras 24-28; Exhibit OP-10: representative examples of i) Opimian wine club catalogues which feature the VIÑA LA ROSA-branded wine, and ii) articles featuring the VIÑA LA ROSA-branded wine which were circulated to Opimian Wine Club's Canadian members over the 2008-2021 period—Mr. Perez-Cotapos indicates that Opimian is Canada's oldest and largest wine club with more than 20,000 members from across Canada; Exhibit OP-11: a screen capture of a CBC radio webpage referencing a 2006 radio program in which the VIÑA LA ROSA-branded wine was featured as the wine of the week; Exhibit OP-12: copies of various Canadian magazine references which feature the VIÑA LA ROSA-branded wine; and Exhibit OP-13: copies of representative examples of articles from the 1999-2018 period that reference the VIÑA LA ROSA-branded wine in Canadian print and online media]; and
- the Opponent has won numerous awards worldwide recognising the fine quality of its VIÑA LA ROSA-branded wine [paras 21-22, which includes a listing of some of these recognitions].

[19] As the Opponent's burden has been satisfied as it has shown use of its trademark on labels of wine sold in Canada before the material date in accordance with section 4(1) of the Act, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's VIÑA LA ROSA trademark.

The test for confusion

[20] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to 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. Thus, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods or services from one source as being from another.

[21] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act. The weight to be given to each factor may vary, depending on the circumstances [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 for a thorough discussion of the general principals that govern the test for confusion]. These factors are considered below.

The inherent distinctiveness of the trademarks and the extent to which they have become known

[22] The inherent distinctiveness of a trademark refers to its originality. Trademarks consisting wholly or in part of words descriptive of the articles to be sold or of the services to be rendered attract a more limited range of protection than does an invented, unique, or non-descriptive word or an original design [see *General Motors Corp v Bellows*, [1949] SCR 678, citing *Office Cleaning Services Ltd v Westminster Window & General Cleaners, Ltd* (1946), 63 RPC 39 at 41 (HL); and *Fairmount Properties Ltd v Fairmount Management LLP*, 2008 FC 876].

[23] In this case, the parties' trademarks both consist of foreign phrases (MAS DE LA ROSA and VIÑA LA ROSA).

[24] In this regard, the evidence establishes that the Opponent's trademark VIÑA LA ROSA contains a geographically descriptive reference. More particularly, the printouts from the Vina La Rosa Site comprising Exhibit OP-9 to the Perez-Cotapos Affidavit and Exhibits D to F to the Grabinski Affidavit #1 indicate that the Opponent's vineyards are located in "three very diverse areas" of Chile, one of which being the geographical location "La Rosa" ("close to the town of Peumo, where the Opponent was founded")—"an internationally recognized appellation".

[25] Exhibits G to J to the Grabinski Affidavit #1 also comprise printouts from third party websites referring to the aforementioned geographical location in Chile and/or other places in the world named "La Rosa" (like for example, "Mexico [which] has the highest number of places called La Rosa, spread across 12 regions", and Spain which has "2 places named La Rosa", one in Canarias and one in Andalucia [Exhibit J]). In this regard, I note that Exhibit K to the Beauchamp Affidavit comprising a printout of the information retrieved by Ms. Beauchamp from the website of the SAQ in respect of the Applicant's MAS DE LA ROSA-branded wine indicates that this wine originates from the Spanish Mediterranean coast. However, it is not clear whether the Applicant's MAS DE LA ROSA-branded wine actually refers to a place called "La Rosa".

[26] In the absence of any written representations or oral submissions from the parties, I consider the descriptive or suggestive nature of the term "La Rosa" lowers the trademarks' inherent distinctiveness and the ambit of protection to which they are entitled, especially the Opponent's VIÑA LA ROSA mark in view of the clear evidence on this issue as provided by the Vina La Rosa Site [see by analogy, the decision *La Molisana SpA v Falesca Importing Ltd*, 2024 TMOB 222 (*Molisana*), in which the Registrar, bearing in mind the policy considerations underlying geographically descriptive words in trademarks, found the geographic significance of the word "Molisana" to lower the parties' trademarks' inherent distinctiveness and their ambit of protection, although there was no evidence that average Canadian consumers would be aware of the meaning and geographic significance of the word "Molisana" in the Italian language].

[27] Considering the parties' trademarks as a whole, the Mark is, arguably, more inherently distinctive than the Opponent's trademark VIÑA LA ROSA in the context of their associated goods. Indeed, the word VIÑA, through its resemblance to the French word "vin" (wine in English), is arguably less inherently distinctive than the word "MAS", which holds no readily apparent connotation in the context of wine. I will return to this point when considering the degree of resemblance between the parties' trademarks and the additional surrounding circumstances.

[28] The degree of distinctiveness of a trademark may be increased by means of it becoming known through promotion or use.

[29] The Applicant has not filed any evidence that would enable me to determine the extent to which the Mark had become known in Canada as of the filing date of the Application. Exhibit K to the Beauchamp Affidavit merely shows a 750ml bottle of the Applicant's MAS DE LA ROSA-branded wine offered for sale on the website of the SAQ at the price of CAD 560,25. This evidence not only postdates the material date but is also much too vague and insufficient to permit me to draw any meaningful conclusion with respect to the extent known of the Mark in Canada at any time.

[30] In comparison, the Opponent's evidence filed through the Perez-Cotapos Affidavit establishes relatively steady use of the VIÑA LA ROSA trademark in Canada in association with wine. While the penetration of the Opponent's advertising efforts in Canada remain unclear in that for example, the number of Canadians who have visited the Vina La Rosa Site are not provided, and none of the recognitions/awards won by the Opponent are Canadian, I find it reasonable to conclude, based on the Opponent's sales figures, that the VIÑA LA ROSA trademark has become known in association with wine to at least a minimal extent.

[31] The overall assessment of the section 6(5)(a) factor, which is a combination of inherent and acquired distinctiveness, therefore slightly favours the Opponent insofar as that factor refers to the extent to which the trademarks have become known. However, transposing the comments of the Registrar at paragraph 36 of the *Molisana* decision to the present case, it is important to bear in mind that the inherent distinctiveness of the

trademarks cannot be ignored in the confusion analysis, even if an originally weak trademark has subsequently acquired a significant reputation [*London Drugs Ltd v International Clothiers Inc*, 2014 FC 223 at para 53]. Geographically descriptive trademarks are inherently weak, and small differences are sufficient to distinguish between them.

The length of time the trademarks have been in use

[32] As noted by the Federal Court of Appeal, “[a] mark that has been in use a long time, versus one newly arrived on the scene, is presumed to have made a certain impression which must be given some weight” [*United Artists Pictures Inc v Pink Panther Beauty Corp*, 1998 CanLII 9052 (FCA), [1998] 3 FC 534].

[33] As there is no conclusive evidence of continuous use of the Mark in Canada and as the Perez-Cotapos Affidavit attests to the use of the VIÑA LA ROSA trademark in Canada in association with wine since at least as early as 1998 (which, in passing, is consistent with the claimed date of first use of the VIÑA LA ROSA trademark set out in the Opponent’s Canadian registration for same under No. TMA515488), this factor favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[34] Both of the parties’ trademarks are for use in association with wine. In the absence of evidence to the contrary, there is no reason to conclude that the parties’ goods would not travel through the same channels of trade and be directed to the same types of clientele.

[35] In fact, as noted above, the Applicant’s evidence filed through the Beauchamp Affidavit shows that the Applicant’s MAS DE LA ROSA-branded wine has been offered for sale at the SAQ, which is one of the channels of trade through which the Opponent’s VIÑA LA ROSA-branded wines have been sold per Mr. Perez-Cotapos’s uncontradicted testimony. I shall add that the mere fact that the parties’ wines be sold at different prices is not a significant consideration as this factor alone does not result in the inference that consumers would distinguish the source of wine on this basis. One can only speculate

as to the reason why that particular wine of the Applicant was offered for sale at such a high price (be it the year (2017), the designation of origin (Priorat), or any other attributes or characteristics of that bottle of wine). More importantly, as stated in *Masterpiece, supra*, the test for confusion remains one of both first impression and imperfect recollection, even when the goods are expensive and likely to be researched by consumers.

[36] Accordingly, these factors favour the Opponent.

The degree of resemblance between the trademarks, including in appearance or sound or in the ideas suggested by them

[37] As noted by the Supreme Court in *Masterpiece, supra*, at paragraph 49, “the degree of resemblance, although the last factor listed in [section] 6(5) [of the Act], is the statutory factor that is often likely to have the greatest effect on the confusion analysis [...] if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion”.

[38] Moreover, as previously mentioned, it is well-established in the case law that likelihood of confusion is a matter of first impression and imperfect recollection. In this regard, “[w]hile the marks must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public’s perception of it” [see *Pink Panther Beauty Corp v United Artists Corp*, 1998, CanLII 9052 (FCA), 80 CPR (3d) 247 (FCA), at para 34]. Even though the first word or portion of a trademark is generally the most important for the purpose of distinction, the preferable approach is to first consider whether any aspect of the trademark is particularly striking or unique [see *Masterpiece, supra*, at para 64].

[39] As indicated above, each of the parties’ trademarks consists of a foreign phrase. As there is no evidence that the average Canadian consumer of wines speaks or understands Spanish, or would be aware of the geographic significance of the term “LA ROSA”, I consider each of the entire phrases MAS DE LA ROSA and VIÑA LA ROSA to be the striking element of each of the parties’ trademarks.

[40] Considering the parties' trademarks in their entirety, I find them to be more different than they are similar. While the parties' trademarks both possess a Spanish (or foreign) connotation or sounding and share the same ending "LA ROSA", their first portions are entirely different. As discussed above, the first element of the Opponent's trademark arguably brings to mind the French word "vin" (wine in English), whereas that idea is totally absent in the Mark—the first portion of the Mark holding no readily apparent connotation in the context of wine.


[41] My finding is reinforced if I factor in the policy considerations underlying geographically descriptive words in trademarks, as discussed in the *Molisana* decision, *supra*. Indeed, considering the low inherent distinctiveness of the Opponent's VIÑA LA ROSA trademark, and the term "LA ROSA" in particular, and the fact that small differences are sufficient to distinguish such inherently non-distinctive trademarks, I consider the differences between the Opponent's VIÑA LA ROSA mark and the Mark to be sufficient to distinguish the two.


Additional surrounding circumstances—state of the register and state of the marketplace

[42] State of the register evidence is introduced to show the commonality or lack of distinctiveness of a trademark or of a portion of a trademark. It is established that where trademarks contain a common element that is also contained in a number of other trademarks in the same market, this tends to cause consumers to pay more attention to the marks' other non-common features to distinguish them [*K-Tel International Ltd v Interwood Marketing Ltd* (1997), 77 CPR (3d) 523 (FCTD); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327]. That said, such evidence is relevant only insofar as it allows for inferences concerning the state of the marketplace, which can only be drawn when a significant number of relevant *extant registrations* (i.e. not pending/abandoned applications or expunged registrations) are located and/or where there is evidence of common use in the marketplace of relevant third party marks [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, *supra*; *Cie Gervais Danone v Astro Dairy Products Ltd* (1999), 87 CPR (3d) 262 (FC); *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB)].

Relevant trademarks to consider are notably those that are for similar goods as the trademarks at issue and include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*, 2015 TMOB 197 at para 38, aff'd 2017 FC 38].

[43] Again, in the absence of any written representations or oral submissions from the parties, I note the following third party registrations that I consider the more relevant and which were introduced into evidence through the Grabinski Affidavit #1 under Exhibits A and B respectively:

Trademark	Reg. No./(Date)	Goods	Owner
<p>STELLA ROSA (word mark)</p> <p>and</p>  <p>STELLA ROSA</p>	<p>TMA867446 (16-DEC-2013)</p> <p>and</p> <p>TMA954524 (07-NOV-2016)</p>	<p>Wine</p>	<p>San Antonio Winery, Inc., a California corporation</p>
<p>CIMAROSA</p>	<p>TMA1063279 (15-NOV-2019)</p> <p>and</p> <p>TMA658720 (10-FEB-2006)</p>	<p>Alcoholic beverages (except beers), namely [...] wines [...]</p>	<p>Lidl Stiftung & Co. KG</p>
<p>ROSA DI SERA</p>	<p>TMA796842 (17-MAY-2011)</p>	<p>Wines</p>	<p>Catina Sociale Beato Bartolomeo da Breganze Società Cooperativa Agricola a Responsabilità Limitata</p>

ROSA DE ARGENTINA	TMA801518 (06-JUL-2011)	Wines	Juan Ignacio Belasco Baquedano
ROSADO SPLASH	TMA813668 (08-DEC-2011)	Wine	Oliver Twist Estate Winery
MAGLIA ROSA	TMA749700 (07-OCT-2009)	[...] wines [...]	Spinelli S.r.l.
ROSA REGALE	TMA666289 (19-JUN-2006)	Wine	Banfi Products Corporation, a New York Corporation
	TMA610190 (13-MAY-2004)	Wines	Bodegas Hermanos Perez Pascuas, S.L.
ROSATO BAMBINO	TMA473746 (26-MAR-1997)	Wines	Arterra Wines Canada, Inc.

[44] In this regard, I note that Exhibit B lists several registrations for trademarks comprising the French and English word “ROSE” in association with alcoholic beverages, including wines, like for example, COTE DES ROSES Logo (TMA1079500), CUVÉE PÉTALE DE ROSE (TMA398412), LA VIE EN ROSE (TMA986572), L’ÉPINE DE LA ROSE (TMA965155), LA ROSE DES VENTS (TMA455869), APOTHIC ROSE (TMA916837), ROSEROCK (TMA986271), TAR & ROSES (TMA968483), THE ROSE GARDEN (TMA970810), ROSECREEK (TMA670695), ROSE Design (TMA613650), WILD IRISH ROSE (TMA190894), Roseyard Estate (TMA750068), etc. Even if I were to accept that the number of third party trademark registrations revealed in Exhibit B supports the position that the word “ROSE” is quite common in Canada as a component of trademarks in association with wines, I fail to see how this would assist the Applicant to any meaningful degree. Indeed, these third party “ROSE”-comprising marks are very different from the parties’ trademarks. They do not have a foreign sounding and do not include the word or element “ROSA” *per se*.

[45] Returning to the trademark registrations listed in my table above, I am not prepared to consider the number of third-party “ROSA”-comprising marks in association with wines sufficient by itself to draw inferences about the state of the marketplace. Indeed, while I am mindful that there is no precise threshold of number of similar marks

needed to establish that an element of a mark is commonly adopted as a component of trademarks used in association with relevant goods or services, the Federal Court cautioned in *Hawke & Company Outfitters LLC v Retail Royalty Company*, 2012 FC 1539, that a register search is not the best way to establish the state of the marketplace, since the fact that a mark appears on the register does not show that it is in use, was in use at the material date, or is used in relation to goods or services similar to those of the parties, or the extent of any such use [see also *Canada Bread Company, Limited v Dr Smood ApS*, 2019 FC 306].

[46] This brings me to turn to the state of the marketplace evidence introduced through the Beauchamp Affidavit and Grabinski Affidavit #2.

[47] In their respective affidavits, Mss. Beauchamp and Grabinski include results of various searches of provincial liquor board websites and/or third-party privately-owned websites that sell wine, screen captures/printouts from these websites, images of labels shown on the wine bottles they either found and/or purchased on these websites and/or through a physical store location (all of which were captured/printed in mid-January 2024).

[48] From what I can gather, except for the trademark STELLA ROSA of registration Nos. TMA867446 and TMA954524, none of Mss. Beauchamp's and Grabinski's state of the marketplace searches provide any examples of use of the "ROSA"-comprising trademark registrations listed in my table above. Likewise, they apparently only provide a very few examples of use of some of the "ROSE"-comprising trademark registrations revealed in Exhibit B to the Grabinski Affidavit #1 (namely, COTE DES ROSES Logo (TMA1079500), and CUVÉE PÉTALE DE ROSE (TMA398412)). I find this is an illustration of the accuracy of the Federal Court's warning in *Hawke & Company Outfitters LLC v Retail Royalty Company*, *supra*.

[49] That said, the state of the marketplace evidence introduced through the Beauchamp Affidavit and Grabinski Affidavit #2 do provide examples of use of various third party "ROSA"-branded wines, as per some of these examples reproduced in Schedule A attached hereto.

[50] I accept that this evidence shows that there is at least some commercial co-existence of third party “ROSA”-comprising marks in association with wine. However, I am reluctant to accord significant weight to this surrounding circumstance for the following reasons.

[51] As mentioned above, all of Mss. Beauchamp’s and Grabinski’s state of the marketplace searches are dated mid-January 2024, that is more than five years after the material date for this ground of opposition. In this regard, I acknowledge that several of the wines described by Mss. Beauchamp and/or Grabinski would appear to be available for sale at more than one location (like for example, the Fontanafredda Barolo Vigna La Rosa-branded wines available at the SAQ, the LCBO and the ANBL, and the Valle della Rosa-branded wine available in different grocery stores of the province of Quebec, like IGA, Metro, and Super C). However, I am not prepared to infer that this was necessarily the case back in 2018, not to mention that the mere fact that a given product would happen to be offered for sale at more than one location does not necessarily imply that it has become known to any significant extent to consumer. Notably, the website printouts comprising the state of the marketplace exhibits do not establish the extent of any sales of the wines featured on these websites nor do they establish how long these products have appeared on the respective sites. In this regard, I note that in other opposition proceedings before the Registrar, the same Applicant did substantiate its state of the marketplace evidence with sales data pertaining to third party products [see for example *Miguel Torres, S.A. v Vins Arterra Canada, division Québec, Inc.*, 2021 TMOB 200; and *Miguel Torres S.A. and Wines and Company Brokerage & Consulting, S.L.U.*, 2024 TMOB 9]. I consider that it would not have been overly cumbersome for the Applicant to provide similar data in the present case.

[52] Before concluding, I note that the state of the register and marketplace evidence introduced through the Grabinski Affidavits also comprise the results of Ms. Grabinski’s searches of the trademarks register for marks that contain the element “VINA” in Nice class 33 (which covers alcoholic beverages, including wines, spirits and liqueurs) [Exhibit C to the Grabinski Affidavit #1] and the LCBO website for “VINA [Exhibit H to the Grabinski Affidavit #2]. Again, in the absence of any written representations or oral

submissions from the parties, this arguably supports the position outlined above regarding the resemblance of the word “VINA” to the French word “vin” (“wine” in English).

Conclusion—likelihood of confusion

[53] As noted by the Federal Court of Appeal in *Dion Neckwear*, *supra*, at page 163, the Registrar “need not be satisfied beyond doubt that confusion is unlikely. Should the ‘beyond doubt’ standard be applied, applicants would, in most cases, face an insurmountable burden because certainty in matters of likelihood of confusion is a rare commodity.”

[54] Given my analysis above, I find that the Applicant has established, according to the balance of probabilities, that a consumer having an imperfect recollection of the Opponent’s VIÑA LA ROSA trademark would be unlikely to conclude that the Applicant’s wines originate from the same source or are otherwise related to or associated with the Opponent’s wines.

[55] I find that the differences existing between the parties’ trademarks are determinant in themselves and more than sufficient to outweigh the factors favouring the Opponent in this case. As discussed above, the parties’ trademarks are inherently weak, especially the Opponent’s trademark, such that small differences are sufficient to distinguish them. I reach this conclusion despite the distinctiveness the Opponent’s VIÑA LA ROSA trademark has acquired in the Canadian marketplace, the length of time for which it has been used, and the identical nature of the goods and the trade.

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

Remaining grounds of opposition

[57] The grounds of opposition pleaded under sections 2 and 12(1)(d) of the Act are also premised on an allegation that there is a likelihood of confusion between the Mark and the Opponent’s VIÑA LA ROSA trademark.

[58] As neither of these two grounds of opposition are stronger than the section 16(1)(a) ground of opposition, they are also rejected. In fact, if anything, the Applicant's position is potentially stronger under both of these grounds of opposition given the later material dates governing the non-registrability and non-distinctiveness grounds of opposition under section 12(1)(d) and 2 respectively, and thus the assessment of the state of the register/marketplace evidence of record.

[59] Finally, with respect to the section 38(2)(f) ground of opposition, I note that the Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark because the Applicant knew, or should have known, about the Opponent's prior use and/or making known of the Opponent's confusingly similar VIÑA LA ROSA mark.

[60] However, I find this ground of opposition, as pleaded, does not raise a proper ground of opposition. Section 38(2)(f) of the Act addresses an applicant's entitlement to use its trademark (i.e., per relevant federal legislation or other legal obligations) as opposed to an applicant's entitlement to register its trademark (relative to another's trademark, pursuant to section 16 of the Act). In my view, merely pleading that an applied-for trademark was confusing with a previously used or registered trademark is not a fact that can support a section 38(2)(f) ground of opposition [see *DCK Concessions Ltd v Hong Xia Zhang*, 2022 TMOB 200 and *Smarte Carte, Inc v Sandals Resorts International 2000 Inc*, 2023 TMOB 67 for similar findings]. Accordingly, this ground of opposition is also rejected.

DISPOSITION

[61] 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.

Annie Robitaille
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Examples of use of various third party "ROSA"-branded wines





Quinta de la Rosa
Vintage Port 2020



Dourosa Douro 2019



Quinta de la Rosa
La Rosa Reserva 2019



Parés Baltà Cava Rosa
Cuisiné 2016



Fonterenza Semplice
Rosa 2022



Umathum Rosa 2021



Si Rosa
Terre Siciliane 2016



Valentina Passalacqua
Rosa Terra Puglia 2019



Fontanafredda Barolo
Vigna La Rosa 2016



Fontanafredda Barolo
Vigna La Rosa 2017



Fontanafredda Barolo
Vigna La Rosa 2000



Fontanafredda
La Rosa 2016



Fontanafredda
Vigna La Rosa 1999



Fontanafredda
Vigna La Rosa 1997



FONTANAFREDDA
Vigna La Rosa
Barolo 1996



FONTANAFREDDA
Vigna La Rosa
Barolo 2001



Quinta de la Rosa
La Rosa 2021



Quinta de la Rosa
Vintage Port 2020



Dourosa Douro 2019



Quinta de la Rosa
La Rosa Reserva 2019



Parés Baltà Cava Rosa
Cuisiné 2016



Fonterenza Semplice
Rosa 2022



Umathum Rosa 2021



Si Rosa
Terre Siciliane 2016



Valentina Passalacqua
Rosa Terra Puglia 2019

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Opponent: Smart & Biggar LP

For the Applicant: Aventus IP Law LLP