

Federal Court



Cour fédérale

**Date: 20160630**

**Docket: T-2-15**

**Citation: 2016 FC 738**

[UNREVISED ENGLISH CERTIFIED TRANSLATION]

**Ottawa, Ontario, June 30, 2016**

**PRESENT: The Honourable Madam Justice Tremblay-Lamer**

**BETWEEN:**

**JULIA WINE INC.**

**Applicant**

**and**

**LES MARQUES METRO, S.E.N.C., ALSO  
KNOWN AS LES MARQUES  
METRO/METRO BRANDS S.E.N.C.**

**Respondent**

**REASONS FOR JUDGMENT AND JUDGMENT**

I. Nature of the Matter

[1] This is an appeal from a decision of the Registrar of Trademarks at the Canadian Intellectual Property Office under subsection 56(1) of the *Trade-marks Act*, RSC 1985, c T-13

(the Act). The Registrar rejected the application to register the trademark “Irresistibles” filed by the applicant after the respondent filed a statement of opposition.

## II. The Facts

[1] The applicant, Julia Wine inc., is a Quebec company that sells affordable wines at retailers such as Costco and Couche-Tard. The respondent, Les Marques Metro / Metro Brands S.E.N.C., is a Canadian food distribution company that has its head office in Quebec and operates hundreds of stores in Quebec and Ontario.

[2] On August 19, 2009, the applicant filed registration application #1448753 for the “Irresistibles” trademark (the Mark) based on the planned use of the Mark in connection with wines.

[3] On March 7, 2011, the respondent filed a statement of opposition based on the likelihood of confusion between the Mark and one or more “Irresistibles” trademarks owned by the respondent and having been used by it or its predecessor in title, Métro Richelieu, and on the application’s compliance with section 30 of the Act.

[4] On October 28, 2014, the Registrar allowed the respondent’s statement of opposition.

III. Decision

[5] The Registrar found that the respondent had discharged its initial burden with regard to the Mark's non-distinctiveness by proving that its "Irresistibles" mark and its derivatives were known well enough in Canada on the date on which the statement of opposition was filed, and that it was up to the applicant to prove, on a balance of probabilities, that there was no risk of confusion between the Mark and the respondent's marks.

[6] She then reviewed each of the factors stated in subsection 6(5) of the Act and found that there was a risk of confusion. With regard to the degree of resemblance between the two marks, she noted that they were identical and that, consequently, the remaining factors had to be closely reviewed because they took on greater significance.

[7] With regard to the Mark's distinctiveness, the Registrar agreed that it had a relatively low degree of inherent distinctiveness because it was a common adjective, but that the extent to which the respondent's mark had become known clearly favoured the respondent. The respondent had submitted into evidence documents to the effect that it had started using a version of its mark around 2002 in connection with various food products and that it had decided on the final version, "Irresistibles," in September 2007. Since then, the respondent's mark was used for about 1100 food products in 370 stores, mainly in Quebec and Ontario, for sales since October 2003 totalling over \$940 million. In addition, since 2011, almost 6.5 million flyers advertising "Irresistibles" products were distributed in Canada. Given this analysis, the period during which the trademark had been in use favoured the respondent.

[8] The Registrar dismissed the applicant's argument to the effect that wine was a type of ware that was distinct from the respondent's products. She noted that the respondent's mark extended to fruit juices, non-alcoholic beverages, sauces, and marinades and that the fact that wines could be considered a natural extension of this range of products marketed by the respondent could not be excluded, given the continuous expansion of its private-label products. She also pointed out that wines were sold in the respondent's stores and that the applicant's products could use the same distribution channels as the respondent's products. She also noted that the applicant's representatives had approached the respondent's representatives about distributing wines bearing the Mark in Metro and Metro Plus food stores. The Registrar therefore allowed this ground of opposition because the respondent's mark was known substantially in Ontario and Quebec, which strengthens the distinctiveness of the respondent's "Irresistibles" mark.

[9] She also allowed the ground of opposition based on paragraph 30(i) of the Act. Noting that such a ground of opposition could be allowed only in exceptional cases (e.g. bad faith) and that the relevant date to assess the circumstances with regard to this ground was that on which the application for registration was filed, she agreed with the respondent that it was difficult to explain that the applicant had, on the same day, filed applications to register—in connection with wine—marks identical to three private labels registered in connection with a wide range of food products. Given that the applicant failed to explain itself on this issue, the Registrar found that it did not discharge its burden of proving that it was satisfied that it was entitled to use the Mark at the time the application for registration was filed.

[10] Having allowed two of the respondent's grounds of opposition, the Registrar did not find it necessary to address any further such grounds.

#### IV. Issues

[11] There are three issues:

1. What standard of review applies to the issues?
2. Did the Registrar err on the confusion issue?
3. Did the Registrar err in allowing the ground of opposition based on paragraph 30(i) of the Act?

#### V. Relevant Provisions

[12] The relevant provisions are subsections 6(2), 6(5) and paragraph 30(i) of the Act, reproduced in the appendix.

#### VI. The Parties' Positions

##### A. *The applicant*

[13] The applicant submits that the respondent's private label has only a low degree of inherent distinctiveness and therefore warrants only limited protection. It maintains that alcoholic beverages differ from beverages sold in grocery stores and that *Société Anonyme des Eaux Minérales d'Evian, S.A. v. Marcon*, [2010] TMOB No. 5083 [*Evian*], *Heineken Brouwerijen B.V.*

*v. Marcon*, [2012] TMOB No. 5164 [*Heineken*] and *MHCS v. Marcon*, [2012] TMOB No. 5195 [*Dom Pérignon*] do not apply because the marks' reputation in connection with the beverages in these decisions was such that it transcended their products. The respondent's mark is not associated with beverages of all types in the same way. In its history, the respondent has marketed only one private-label alcoholic beverage (a beer whose sales were discontinued in 2006), showing the respondent's lack of interest in selling alcoholic beverages.

[14] It also notes that the Registrar should have considered the fact that the respondent's private-label products are marketed only in its own food stores and that this private label itself is not registered. The products therefore do not share the same distribution channels. In addition, consumers who shop at other food stores would not make connections between its products and the respondent's because the respondent's mark has no reputation in these other establishments. The Registrar's finding on this issue was therefore not reasonable.

[15] The applicant argues that the Registrar's finding based on paragraph 30(i) of the Act is also not reasonable. The mere filing of three applications for registration for everyday words cannot constitute bad faith, even though these marks are unregistered private labels. The situation differs from that in the cases involving Mr. Marcon, who tried to register over 15 known marks. The applicant also notes that the respondent itself unsuccessfully tried to register its mark. This case does not involve exceptional circumstances like the ones stated in paragraph 30(i) of the Act.

B. *The respondent*

[16] The respondent maintains that the Registrar committed no error that could warrant the Court's intervention because the decision is justified, transparent and intelligible and falls within a range of possible, acceptable outcomes which are defensible in respect of the facts and the law. It reiterates that the applicant had the sole burden of proving that the Mark was distinctive throughout Canada and did not cause any confusion. The Registrar correctly conducted the analysis by applying the test of the first impression of a casual consumer somewhat in a hurry. Despite having a low degree of inherent distinctiveness, its private label has acquired significant distinctiveness through its use. In addition, the marks are identical and its private label was used in connection with beverages such as fruit juices and non-alcoholic drinks. The concept of natural extension therefore reasonably lent itself to the analysis in this case.

[17] The respondent submits that it is wrong to consider the reasonableness of the decision based solely on the distribution channels factor and that consumers may not be aware that its products are distributed only in its own stores. In addition, the evidence shows that the applicant intended to distribute wines bearing the Mark at issue in Metro and Metro Plus food stores, which differentiates this case from *Hayabusa Fightwear Inc. v. Suzuki Motor Corporation*, 2014 FC 784 [*Hayabusa*].

[18] The respondent submits that the Registrar's finding on the ground of opposition based on paragraph 30(i) was reasonable because the applicant's filing, on the same day, of applications for registration in connection with wines identical to three well-known private labels used for a

wide range of food products is difficult to explain. It claims that the application for registration at issue was filed to take advantage of its private label's goodwill and notes that there are only three major food store chains in Quebec. The applicant filed applications for registration for each of its private labels on the same day, but provided no explanations regarding this before the Registrar. It therefore did not discharge its burden of proving that it believed that it had the right to register the Mark.

## VII. Analysis

### A. *What standard of review applies to the issues?*

[19] It is well established that the Registrar's decisions are to be reviewed on a standard of reasonableness unless additional evidence that could have been vital to the Registrar's findings is filed before the Court (*Molson Breweries v. John Labatt Ltd.* [2000] 3 FCR 145 (FCA), at paragraph 29; *United Grain Growers Ltd. v. Michener*, 2001 FCA 66, at paragraph 8). When the Court reviews a decision on a standard of reasonableness, it shall intervene only when the decision is not transparent, justified and intelligible and does not fall within a range of possible, acceptable outcomes which are defensible in respect of the facts and the law. The Supreme Court stated that deference in the context of the reasonableness standard requires respect for the legislative choices to leave some matters in the hands of administrative decision makers who have particular expertise and experience (*Dunsmuir v. New Brunswick*, 2008 SCC 9, at paragraphs 47–49 [*Dunsmuir*]).

[20] With regard to the ground based on the likelihood of confusion, the parties acknowledge that the standard of reasonableness applies.

[21] However, with regard to the ground based on paragraph 30(i) of the Act, the applicant claims that the standard of correctness applies whereas the respondent maintains that the applicable standard is that of reasonableness.

[22] The applicant's submission rests on the additional evidence filed in this case—evidence that, had it been before the Registrar, would have had a major impact on her decision. In its memorandum, the respondent opposed the admissibility of part of this additional evidence (the affidavits supporting H el ene Vall e's statutory declaration). Although these affidavits are admissible, they have low probative value given that their affiants cannot be cross-examined (*594872 Ontario Inc. v. Canada*, [1992] FCJ No. 253; *Zaman v. Canada (Minister of Citizenship and Immigration)*, [1997] FCJ No. 646, 131 FTR 54).

[23] After having reviewed the additional evidence at issue, I note that it consists of applications for registration filed by the respondent for its private label and of proceedings instituted by various parties to which it had to respond.

[24] I note from the outset that most of the documents produced are after the material date in this case (August 19, 2009), the filing date of the application for registration (*Cerverceria Modelo, S.A. de C.V. v. Marcon*, [2008] TMOB No. 131 [*Cerverceria Modelo*], at paragraphs 25 and 28).

[25] With regard to the statement in the letter dated December 11, 2013, to the effect that the respondent's "Irresistibles" mark has a relatively low degree of inherent distinctiveness, this fact was acknowledged by the Registrar in her decision.

[26] As for the statements in this letter with regard to the distribution channels, I agree with the respondent. These representations were made in a separate record containing facts that differ from those in this case.

[27] The fact that the respondent itself tried to register its private label despite the presence of other "Irresistibles" products on the market has no effect on the applicant's alleged good or bad faith. This case includes distinctive elements, including the extent of the respondent's operations and evidence of business proposals from the applicant regarding use of the respondent's mark; the impact of these elements is not affected by the additional evidence. There is no need to apply the standard of correctness.

[28] The applicable standard of review is therefore that of reasonableness.

As Mr. Justice de Montigny stated in *Hawke & Company Outfitters LLC v. Retail Royalty*

*Company*, 2012 FC 1539, at paragraph 31:

It is well established that when additional evidence is filed, the test is "one of quality, not quantity": see *Canadian Council of Professional Engineers v APA – The Engineered Wood Assn*, [2000] FCJ no 1027 (QL), 7 CPR (4<sup>th</sup>) 239 (FC) at para 36; *Wrangler Apparel Corp v Timberland Co*, 2005 FC 722 at para 7. Evidence that merely supplements or confirms earlier findings, or which pertains to facts posterior to the relevant material date, will be insufficient to displace the deferential standard of reasonableness.

B. *Did the Registrar err on the confusion issue?*

[29] Confusion between two trademarks is defined in subsection 6(2) of the Act:

The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[30] To determine whether the trademarks cause confusion, the Court or the Registrar must consider all of the circumstances of the case, including the criteria set out in subsection 6(5) of the Act:

- (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
- (b) the length of time the trade-marks or trade-names have been in use;
- (c) the nature of the goods, services or business;
- (d) the nature of the trade; and
- (e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

[31] Once the party opposing the registration of a proposed mark has discharged its initial burden (i.e. establishing that its own mark has become known sufficiently in Canada to negate the distinctiveness of the proposed mark), it is up to the other party to prove that there is no risk of confusion between the opposing party's mark and the proposed mark (*Bojangles' International, LLC v. Bojangles Café Ltd.*, 2006 FC 657, at paragraph 29).

[32] The test of assessment is that of the casual consumer somewhat in a hurry, possessed of an average memory with its usual imperfections; if ordinary casual consumers somewhat in a hurry are likely to be deceived about the origin of the wares or services, then the statutory test is met (*Mattel, Inc. v. 3894207 Canada Inc.*, 2006 SCC 22, at paragraphs 56–58).

[33] The applicant uses mainly paragraphs 6(5)(a) and 6(5)(c) of the Act to support its argument; it maintains that the Mark has a low degree of inherent distinctiveness and that the nature of the goods and their distribution channels are distinct enough not to cause confusion.

(i) The Mark's inherent distinctiveness

[34] The applicant makes much of the Mark's low degree of inherent distinctiveness and claims that the respondent's private label has only a low degree of protection for that reason. The respondent does not dispute that the word "irresistibles" is common and, in itself, not distinctive. However, the applicant errs by not considering the second part of paragraph 6(5)(a), i.e., the extent to which the mark has become known.

[35] It has been established in case law that a mark with a low degree of inherent distinctiveness can still acquire a high degree of distinctiveness through the use made of it:

Where a mark does not have inherent distinctiveness, it may still acquire distinctiveness through continual use in the marketplace. To establish this acquired distinctiveness, it must be shown that the mark has become known to consumers as originating from one particular source. In *Cartier, Inc. v. Cartier Optical Ltd./Lunettes Cartier Ltée*, Dubé J. found that the Cartier name, being merely a surname, had little inherent distinctiveness, but, nevertheless, it had acquired a great deal of distinctiveness through publicity.

Likewise in *Coca-Cola Ltd. v. Fisher Trading Co.*, the Judge found that the word “Cola” in script form had become so famous that it had acquired a very special secondary meaning distinctive of the beverage and was, therefore, worthy of protection.

(*Pink Panther Beauty Corp. v. United Artists Corp.* [1998] 3 FC 534, at paragraph 24).

[36] The Registrar’s decision takes into account the abundant evidence submitted by the respondent to prove its mark’s acquired distinctiveness (e.g. the mark’s sales, sample flyers and packaging, and copies of reviews of “Irresistibles” products by food critics). The Registrar found that:

[47] [TRANSLATION] In light of the sales and the advertising carried out through millions of flyers distributed every week in Quebec and Ontario, submitted into evidence by Mr. Cournoyer, I find it reasonable to conclude that the Opponent’s IRRESISTIBLES mark is very well established in Canada and has become known substantially, at the very least in Quebec and Ontario. As a result, this recognition strengthens the distinctiveness of the Opponent’s IRRESISTIBLES mark.

[48] [TRANSLATION] Consequently, my overall assessment of this first factor, which is a combination of the acquired and inherent distinctiveness of the marks at issue, clearly favours the Opponent.

[37] Given the evidence in the record, it was therefore not unreasonable for the Registrar to find that the respondent’s mark had acquired distinctiveness.

(ii) The parties' products

[38] The applicant points out that there are still major distinctions to be made between various food products when the likelihood of confusion is assessed in this regard; the Registrar allegedly failed to take this into account in her analysis.

[39] According to the applicant, the respondent's "Irresistibles" mark is associated with various food products that differ from wines. To support its argument, it cites *Boulangerie Canada Bread, Ltée v. Beverages Brands (UK) Ltd.*, [2012] TMOB No. 5011, in which the Registrar differentiated a vodka-based alcoholic beverage containing the word "POM" from the well-known "POM" cereal products in Canada. The applicant also disputes the applicability of the Registrar's decisions in *Evian*, *Heineken* and *Dom Pérignon* because in each of these cases, the mark at issue was world famous in the beverage industry. The concept of the natural extension of the mark was therefore appropriate in those cases. However, the "Irresistibles" mark is not that famous for beverages in Canada.

[40] In my view, the applicant is unduly limiting the concept of natural extension by failing to acknowledge a very important fact: the respondent's private label extends to over 1000 products of all kinds, including juices, sparkling water, sparkling juices, wine vinegars, and so on. Although it was unreasonable to consider that a mark like "POM," solely limited to all types of breads, could suddenly extend to alcoholic beverages, the same is not true for the respondent's mark, which the evidence shows has rapidly expanded into all types of food products. The respondent's private label covers a range of products so wide that its extension to a range of

wines is reasonably conceivable. The respondent's predecessor, Metro Richelieu, also marketed a beer under the "Irresistibles" mark, which clearly illustrates the concept of natural extension, as stated by the Registrar. To maintain that discontinuing this product shows a lack of interest in the alcoholic beverages industry on the respondent's part is purely speculative and not supported by the evidence in the record.

[41] In addition, I note, as the Registrar did, that the concept of natural extension or connection has often been retained despite the products' not sharing the same intrinsic nature (*Evian, Heineken, Dom Pérignon, Sobeyes Capital Inc. v. Julia Wine Inc.*, [2014] TMOB No. 5034).

[42] The Registrar's finding on this issue is reasonable because it falls within a range of possible, acceptable outcomes which are defensible in respect of the facts and the law (*Dunsmuir*).

(iii) Distribution channels

[43] According to the applicant, the Registrar should have considered that the specific distribution channels for the respondent's products consisted in its own food stores, which should have eliminated any likelihood of confusion. It maintains that the Registrar's failure to take this circumstance into account is unreasonable. The applicant bases its arguments largely on *Hayabusa*. In this case, de Montigny J. ruled that the Registrar's decision was not reasonable because "the fact that it is virtually impossible to find these wares in the same channels of trade

should have been determinative.” (at paragraph 51). The absence of overlap between the channels of trade used by the parties in this case made it difficult to imagine that there could be a likelihood of confusion between the marks at issue.

[44] However, in *Hayabusa*, Hayabusa’s wares were available only through trade fairs, combat schools, and retailers specialized in mixed martial arts accessories and clothing, whereas Hayabusa products from Suzuki were available only at its authorized retailers. Those were therefore two very specific markets that targeted different consumers.

[45] However, the facts of this case are totally different. First, as the Registrar noted, although the respondent does not sell wines under its “Irresistibles” private label, the respondent’s evidence clearly establishes that wines are sold in its supermarkets. In addition, several flyers promote “Irresistibles” products and wines on the same page. Without evidence to the contrary, the fact that the applicant’s wines could be sold in the same types of supermarkets as the respondent’s cannot be excluded.

[46] It is telling that the president of the applicant approached the respondent in 2010 to discuss the possibility of distributing its products bearing the Mark at issue in Metro and Metro Plus stores; this confirms the applicant’s intention for its products to share the same distribution channels.

[47] The average consumer who is familiar with the respondent’s private label could also see the applicant’s wines bearing the Mark in convenience stores or in big-box stores such as Costco.

The consumer could believe that it is one of the respondent's products, and that the respondent has entered into an agreement with these independent third parties. Although the parties are well aware that the "Irresistibles" mark is one of the respondent's private labels that is sold only in Metro and Metro Plus supermarkets, this is not necessarily the case for the consumer in a hurry (*T. Eaton Co. Ltd. v. Viking Umwelttechnik Gesellschaft m.B.H.*, [1998] TMOB No. 77, at paragraph 9).

[48] In my view, there are no other reasons for the applicant to want to use the Mark except to benefit from the reputation acquired by the respondent's "Irresistibles" private label over the years.

[49] The Registrar determined that the respondent's "Irresistibles" mark has become known substantially in Quebec and Ontario. This recognition, combined with the fact that it is used with over 1000 varied products sold in grocery stores, could lead the consumer to make a mental connection between the applicant's wines and the respondent's products.

[50] It was based on her expertise and her experience in the field that the Registrar found that the applicant did not discharge its ultimate burden of establishing, on a balance of probabilities, that there was no risk of confusion between the applicant's and the respondent's respective marks.

[51] In the circumstances, nothing indicates that the Registrar's decision on this issue does not fall within a range of possible, acceptable outcomes which are defensible in respect of the facts and the law.

C. *Did the Registrar err in allowing the ground of opposition based on paragraph 30(i) of the Act?*

[52] Paragraph 30(i) of the Act requires that an applicant for the registration of a trade-mark file with the Registrar a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application. Both parties acknowledge that a ground of opposition based on this paragraph should only succeed in exceptional cases, such as when there is evidence of bad faith on the part of the applicant (*Cerverceria Modelo*).

[53] In support of its position, the respondent submitted three affidavits: from Mr. Cournoyer, Director of Design and Packaging at Metro; Ms. Patenaude, Director of National Procurement at Metro Richelieu; and Mr. Charron, Vice-President of National Procurement, Grocery and Corporate Brands at Metro Richelieu. Mr. Cournoyer's affidavit describes the food market in Quebec and Ontario and notes that there are only three major chains: that of the respondent, Loblaws and Sobeys. Each one markets its products under its own private label: "Irresistibles," "President's Choice" and "Compliments," respectively. Ms. Patenaude's and Mr. Charron's affidavits discuss their meetings with the applicant's representative, who suggested marketing "Irresistibles" wine solely in the respondent's stores to potentially assign it the Mark and to allow it to take advantage of an alleged loophole in Quebec legislation regarding the sale of wine

in grocery stores. The applicant's representative also told Ms. Patenaude that he had made the same proposal to the Loblaws and Sobeys representatives.

[54] The respondent also submitted into evidence three applications for registration filed on August 19, 2009, by the applicant for the "Irresistibles," "President's Choice" and "Compliments" marks.

[55] The Registrar determined that the respondent had discharged its initial burden as set out in paragraph 30(i) and that it was up to the applicant to prove that it believed that it was entitled to register the Mark. Yet the applicant submitted no evidence and provided no explanations before the Registrar. However, it was in the best position to defend its actions because it had personal knowledge of its state of mind when it filed its application for registration (*Cerverceria Modelo*).

[56] It was therefore reasonable for the Registrar to find it difficult to explain that the applicant had, on the same day, filed applications to register—in connection with wine—marks identical to three well-known private labels used in connection with a wide range of food products. I also note that, contrary to what the applicant stated at the hearing, this case is similar to the cases involving Mr. Marcon. Although the number of applications for registration was not as high as in the Marcon cases, that is simply because there are only three major grocery store chains in the region targeted by the applicant. It tried to register the marks owned by the three chains in question.

[57] The applicant also makes much of the fact that the respondent's "Irresistibles" mark is not registered, contrary to what was stated in the Registrar's decision. It maintains that because the respondent does not own the word "irresistibles," the applicant had the right to file an application for registration in connection with a product that differs from those sold by the respondent.

[58] In my view, the applicant misunderstands the distinction made by the Federal Court of Appeal and the Supreme Court of Canada between a registered mark and an unregistered mark in *Marlboro Canada Ltd. v. Philip Morris Products S.A.*, 2012 FCA 201 [*Marlboro*] and in *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27. In *Marlboro*, Madam Justice Gauthier notes the following:

[55] Justice Marshall Rothstein, writing for the Court made it very clear that, when considering the degree of resemblance between marks, the approach differed depending on whether they were registered or not.

[56] For unregistered marks, a court should only consider the manner in which they have actually been used. However, for registered marks, a court must consider the trade-mark registration according to its terms to reflect the entire scope of the rights granted under the latter.

[59] This in no way supports the applicant's position because the respondent showed that it used its mark on a wide range of food products and beverages. It is difficult to imagine that the applicant was not aware of the use that the respondent was making of its mark, given its establishment and its broad circulation. In this regard, I echo the words of the Registrar in *Cerverceria Modelo*:

[TRANSLATION]

I do not know of any decisions that describe the concept of “bad faith” in the context of paragraph 30(i). Although I am not sure whether this concept applies in this case, I wonder how a reasonable person would be satisfied that he or she was entitled to file applications to register more than 18 undoubtedly well-known trademarks in connection with apparently related goods and/or services. I also wonder about the intention that prompts an applicant to do so. In my view, an applicant’s attempt to benefit from the established reputation of a significant number of well-known marks should be the type of situation that paragraph 30(i) aims to prevent.

[Emphasis added.]

[60] Consequently, I am satisfied that the Registrar’s decision based on paragraph 30(i) of the Act is reasonable.

### VIII. Conclusion

[61] As stated previously, the Registrar has specific expertise in trademarks.

[62] In this case, her analysis is meticulous and detailed and her reasoning is supported by knowledge of the case law that is relevant to the issues raised in this case. The findings on confusion between the marks and on compliance of the application for registration with paragraph 30(i) of the Act are based on the evidence and fall within a range of possible, acceptable outcomes. The Court cannot intervene if there are no errors in fact or in law because her decision meets all of the reasonableness criteria defined in the case law.

[63] I conclude by reiterating the following passage from the Supreme Court's finding in

*Dunsmuir*:

[49] Deference in the context of the reasonableness standard therefore implies that courts will give due consideration to the determinations of decision makers. As Mullan explains, a policy of deference “recognizes the reality that, in many instances, those working day to day in the implementation of frequently complex administrative schemes have or will develop a considerable degree of expertise or field sensitivity to the imperatives and nuances of the legislative regime”: D. J. Mullan, “Establishing the Standard of Review: The Struggle for Complexity?” (2004), 17 *C.J.A.L.P.* 59, at p. 93. . . .

[64] The appeal is therefore dismissed with costs.

**JUDGMENT**

**THE COURT ORDERS** that the appeal is dismissed with costs.

“Danièle Tremblay-Lamer”

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Judge

## APPENDIX

*Trade-marks Act, RSC 1985, c T-13*

6(2) The use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

...

6(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

(a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;

(b) the length of time the trade-marks or trade-names have been in use;

(c) the nature of the goods, services or business;

(d) the nature of the trade; and

6(2) L'emploi d'une marque de commerce crée de la confusion avec une autre marque de commerce lorsque l'emploi des deux marques de commerce dans la même région serait susceptible de faire conclure que les produits liés à ces marques de commerce sont fabriqués, vendus, donnés à bail ou loués, ou que les services liés à ces marques sont loués ou exécutés, par la même personne, que ces produits ou ces services soient ou non de la même catégorie générale.

[...]

6(5) En décidant si des marques de commerce ou des noms commerciaux créent de la confusion, le tribunal ou le registraire, selon le cas, tient compte de toutes les circonstances de l'espèce, y compris :

a) le caractère distinctif inhérent des marques de commerce ou noms commerciaux, et la mesure dans laquelle ils sont devenus connus;

b) la période pendant laquelle les marques de commerce ou noms commerciaux ont été en usage;

c) le genre de produits, services ou entreprises;

d) la nature du commerce;

(e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them.

...

30 An applicant for the registration of a trade-mark shall file with the Registrar an application containing

...

(i) a statement that the applicant is satisfied that he is entitled to use the trade-mark in Canada in association with the goods or services described in the application.

e) le degré de ressemblance entre les marques de commerce ou les noms commerciaux dans la présentation ou le son, ou dans les idées qu'ils suggèrent.

[...]

30 Quiconque sollicite l'enregistrement d'une marque de commerce produit au bureau du registraire une demande renfermant :

[...]

i) une déclaration portant que le requérant est convaincu qu'il a droit d'employer la marque de commerce au Canada en liaison avec les produits ou services décrits dans la demande.

**FEDERAL COURT**  
**SOLICITORS OF RECORD**

**DOCKET:** T-2-15

**STYLE OF CAUSE:** JULIA WINE INC. v. LES MARQUES METRO,  
S.E.N.C., ALSO KNOWN AS LES MARQUES  
METRO/METRO BRANDS S.E.N.C.

**PLACE OF HEARING:** MONTRÉAL, QUEBEC

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