



MADRID PROTOCOL

Total Provisional Refusal of Protection

(Rule 17(1) of the Regulations under the Protocol)

I. Name of the Office:

Canadian Intellectual Property Office

II. International registration number:

1793070

III. Name of the holder:

Sandro Bottega

IV. Information concerning the type of provisional refusal:

Total provisional refusal based on an ex officio examination.

V. Information concerning the scope of the provisional refusal:

The provisional refusal affects all the goods and services.

VI. Grounds for refusal (where applicable, see item VII):

This examiner's report concerns the above identified Protocol application. To avoid abandonment proceedings, a proper response must be received by this office by January 15, 2026. All correspondence respecting this Protocol application must indicate the file number.

Registrability:

Paragraph 37(1)(d) - Not Inherently Distinctive

The trademark is not distinctive pursuant to paragraph 37(1)(d) of the *Trademarks Act*.

As the trademark consists exclusively or primarily of a three-dimensional shape of any of the goods specified in the Protocol application, or of an integral part or the packaging of any of those goods, the applicant is required to submit evidence establishing that the trademark was distinctive at the filing date of the Protocol application pursuant to paragraph 32(1)(d) of the *Trademarks Act*.

The Registrar shall, having regard to the evidence adduced, restrict the registration to the goods or services in association with which, and to the defined territorial area in Canada in which, the trademark is shown to be distinctive pursuant to subsection 32(2) of the *Trademarks Act*.

For more information on distinctiveness and paragraph 37(1)(d) of the *Trademarks Act*, please see sections 4.9.2 and 4.10 of the *Trademarks Examination Manual* at

Paragraph 12(1)(d) - Confusion with a Registered Trademark

The trademark is not registrable pursuant to paragraph 12(1)(d) of the *Trademarks Act*.

The trademark is confusing with registered trademark no(s). TMA894,316; TMA894,315 and TMA560,995, the particulars of which are attached.

Please be advised that the objection pertains to all the goods presently designated in the subject Protocol application.

Paragraph 37(1)(c) - Confusion with a co-pending application

The applicant is not the person entitled to registration of the trademark because it is confusing with another trademark for the registration of which an application is pending pursuant to paragraph 37(1)(c) of the *Trademarks Act*.

Specifically, the entitlement date January 23, 2024 of the Protocol application is later than the entitlement date(s) March 6, 2023 of co-pending and confusing application no(s). 2,243,426, the particulars of which are attached.

Please be advised that the objection pertains to all the goods presently designated in the subject Protocol application.

In assessing whether there is a reasonable likelihood of confusion, the Registrar must have regard to the provisions of subsection 6(2) of the *Trademarks Act*, which 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.

The Registrar must consider all the surrounding circumstances including those stated in subsection 6(5) of the *Trademarks Act*:

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

Confusion is tested in terms of the average consumer's first impression of the one trademark and imperfect recollection of the other mark(s), and not by a side-by-side scrutiny. The "average consumer" is a likely buyer of the associated goods or services who has an average education in English and/or French.

For more information on trademarks that are confusing, please see sections 3.2, 3.3 and 3.5 of the *Trademarks Examination Manual* at www.cipo.gc.ca.

Any comments the applicant may wish to submit in writing will receive consideration.

Requirements:

Representation of the Trademark

Please amend the description of the trademark to be clear and concise pursuant to paragraph 30(g) of the *Trademarks Regulations*. In the present case, the description included in the Protocol application is not considered clear since the trademark contains multiple images, but the description does not contain a statement that the visual representation is comprised of different views of the same trademark.

The following description would be considered acceptable: The trademark consists in a bottle with a particular oval section shape with the word BOTTEGA, which is the owner's patronymic, written in block letters and placed vertically near the neck of the bottle. The visual representation depicts different views of the same trademark.

Goods and services:

The following underlined goods are not considered to be specific pursuant to section 29 of the *Trademarks Regulations*, nor are they considered to be in ordinary commercial terms pursuant to paragraph 30(2)(a) of the *Trademarks Act*:

33: **Spirits; liquors, spirits** and liqueurs; alcoholic bitters; anise liqueur; aperitifs; **alcoholic beverages except beers; alcoholic beverages containing fruit; pre-mixed alcoholic beverages, other than beer-based; distilled alcoholic beverages**; alcoholic cocktails; digestifs; **alcoholic essences; alcoholic extracts**; fruit extracts, alcoholic; gin; liqueurs; rum; piquette; wine; vodka; whisky.

For further guidance on redefining the statements of goods or services, please refer to the *Goods and Services Manual* available on our website. This searchable tool is not an exhaustive list of acceptable terms, but it may be used as a guide to the specificity and ordinary commercial term requirements of the *Trademarks Act* and its Regulations.

The applicant is required to file an amended Protocol application, using the e-service on the CIPO website at www.cipo.gc.ca, by fax at 819-953-2476 or by mail at the following address:

Registrar of Trademarks
Place du Portage I
50 Victoria Street, room C-114
Gatineau, QC K1A 0C9

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised Protocol application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,

Benjamin Welchner

VII. Information relating to an earlier mark:

1645026 TMA894,316
1645025 TMA894,315
1052456 TMA560,995
2243426

(i) Filing date and number, and, if any, priority date:

2013-09-25, **1645026**, 2013-04-19

(ii) Registration date and number (if available):

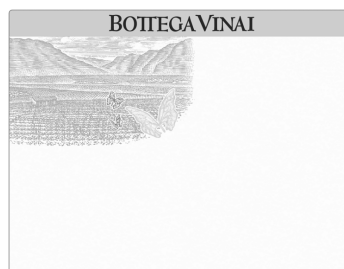
2015-01-19, TMA894,316

(iii) Name and address of the owner:

CAVIT CANTINA VITICOLTORI CONSORZIO CANTINE SOCIALI DEL TRENTINO Società
Cooperativa, an Italian company
Via del Ponte 31
38123 TRENTO
ITALY

(iv) Reproduction of the mark:

BOTTEGA VINAI (& GOLD DESIGN)



(v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):

Wines, sparkling wines

(i) Filing date and number, and, if any, priority date:

2013-09-25, **1645025**, 2013-04-19

(ii) Registration date and number (if available):

2015-01-19, TMA894,315

(iii) Name and address of the owner:

CAVIT CANTINA VITICOLTORI CONSORZIO CANTINE SOCIALI DEL TRENTINO Società
Cooperativa, an Italian company

Via del Ponte 31
38123 TRENTO
ITALY

- (iv) Reproduction of the mark:
BOTTEGA VINAI (& SILVER DESIGN)



- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):
Wines, sparkling wines

-
- (i) Filing date and number, and, if any, priority date:

2000-03-29, **1052456**

- (ii) Registration date and number (if available):

2002-04-29, TMA560,995

- (iii) Name and address of the owner:

CAVIT CANTINA VITICOLTORI CONSORZIO CANTINE SOCIALI del TRENTO SOCIETA
COOPERATIVA
Via del Ponte 31
I-38123 Trento
ITALY

- (iv) Reproduction of the mark:

BOTTEGA VINAI

- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):

Wines, sparkling wines, distilled spirits and liqueurs

-
- (i) Filing date and number, and, if any, priority date:

2023-03-06, **2243426**

- (ii) Registration date and number (if available):

Not applicable

- (iii) Name and address of the owner:

Seven Directions Wine Ltd.
665 Beacroft Avenue
Cawston

CANADA

- (iv) Reproduction of the mark:
Bottega Wine Studio
- (v) List of the relevant goods and services (this list may be in the language of the earlier application or registration):
 - (Class 33) Wine; wine-based beverages;
 - (Class 35) Operation of a winery, namely retail sale of wine and wine-based beverages;
 - (Class 39) Operation of a winery, namely offering winery tours for travel tourism purposes;
 - (Class 41) Operation of a winery, namely offering winery tours for educational purposes and conducting wine tasting;

VIII. Provisions of the applicable law:

Paragraph 12(1)(d) of the *Trademarks Act*

Paragraph 30(2)(a) of the *Trademarks Act*

Paragraph 32(1)(d) of the *Trademarks Act*

Section 37 of the *Trademarks Act*

Paragraph 37(1)(c) of the *Trademarks Act*

Paragraph 37(1)(d) of the *Trademarks Act*

Section 29 of the *Trademarks Regulations*

Paragraph 30(g) of the *Trademarks Regulations*

IX. Information relating to the possibility to request a review, file an appeal or otherwise respond to the refusal:

- (i) Time limit to request a review, file an appeal or otherwise respond to the refusal:

A complete response is required within 6 months from the date of issuance of the provisional refusal.

- (ii) Calculation of time limit (the time limit runs from):

(a) The time limit starts on: 2025-07-15

(b) The time limit ends on: 2026-01-15

- (iii) Whether the time limit can be extended:

Yes

- (iv) Authority to which such request for review, appeal or response should be made:
Registrar of Trademarks
- (v) Whether the request for review, appeal or response has to be filed in a specific language or through a local representative:
Correspondence must be in French or English
- (vi) Other requirements, if any:
Not applicable

X. Date and signature of the Office:

Registrar of Trademarks

2025-07-15

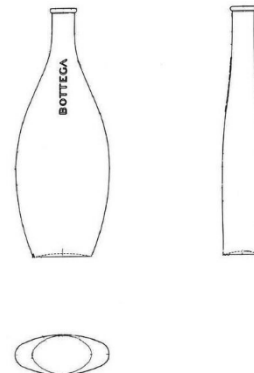


15 juil/Jul 2025
Votre référence Your File

Notre référence Our File
2331308
Numéro EI IR Number
1793070

Sandro Bottega
Via Moranda Alta,
15 P.S. 1T1
I-31020 San Fior (TV)
ITALY

RE: Trademark: BOTTEGA
Applicant: Sandro Bottega



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Benjamin Welchner
Examination Section
819-360-9549
fax: 819-953-2476