

**IN THE MATTER OF TWO OPPOSITIONS  
by Shark Clubs of Canada Inc. to applications  
nos. 1044263 and 1033636 for the trade-marks  
SHARX POOL BAR and SHARX POOL BAR  
RESTO & Design filed by 2764296 Canada Inc.**  
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On January 24, 2000, the applicant 2764296 Canada Inc. filed an application (no. 1,044,263) to register the trade-mark SHARX POOL BAR based on use of the mark in Canada since at least as early as 1992 in association with

wares  
T-shirts, pens, pencils and key chains

services  
operation of lounges and sports bars which offer billiards, snooker and games of chance.

The application disclaims the right to the exclusive use of the phrase POOL BAR apart from the trade-mark as a whole.

The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated March 26, 2003 and was opposed by Shark Club Sports Grill Ltd. on April 9, 2003. The Registrar forwarded a copy of the statement of opposition to the applicant on April 29, 2003. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition. At the time of filing its counter statement, the applicant also requested an interlocutory ruling concerning paragraphs (b) and (f) of the statement of opposition (summarized below) which the applicant characterized as deficient. Inexplicably, the Board failed to respond to the applicant and the applicant never followed up on

its request. In any event, the disposition of this proceeding would not be affected if paragraphs (b) and (f) were struck from the opponent's pleadings as initially requested by the applicant.

The grounds of opposition pleaded by the opponent may be summarized as follows.

(a) Pursuant to Section 30(b) of the *Trade-marks Act*, the applicant has not used the mark since 1992 or has subsequently abandoned the mark.

(b) Pursuant to Section 30(i), at the date of filing the application the applicant could not have been satisfied that it was entitled to use the applied for mark.

(c) Pursuant to Section 12(1)(d), the applied for mark is not registrable because it is confusing with the opponent's registered word mark SHARK CLUB BAR & GRILL and two registered design trade-marks, shown below, all used in association with restaurant and bar services:



(d) and (e) Pursuant to Sections 16(1)(a) and (c), the applicant is not entitled to register the applied for mark because it is confusing with the opponent's above mentioned marks and with the opponent's trade-name Shark Club Sports Grill Ltd. previously used in Canada by the opponent.

(f) Pursuant to Section 2, the applied for mark is not distinctive of the applicant's wares and services in view of the opponent's use of its marks and trade-name.

During the course of the proceeding the statement of opposition was amended to reflect a transfer of trade-mark and trade-name rights from the initial opponent Shark Club Sports Grill Ltd. to the present opponent Shark Clubs of Canada Inc.: see the Board ruling dated November 23, 2005.

The opponent's evidence consists of the affidavit of Roger Gibson, President of the opponent company. The applicant's evidence consists of the affidavit of Rahman Ismaili, President, Director and majority shareholder of the applicant company. Only the opponent submitted a written argument and only the opponent was represented at an oral hearing.

Mr. Gibson's evidence may be summarized as follows. The opponent is a British Columbia corporation which was incorporated in 1991. The opponent is in the business of operating bars and grills featuring sports entertainment and parlour games such as billiards and darts. The opponent operates in British Columbia, Alberta and Saskatchewan. By 2004, the opponent was operating eight establishments. The opponent's marks, most noticeably the word mark SHARK CLUB BAR & GRILL, appear prominently in signage above the entrance to the opponent's establishments and on menu jackets, on the opponent's website, on gift certificates, on various souvenir items such as shirts, lighters and pocket knives, and on the opponent's stationery. Expenses for print and radio advertising totalled about \$13,000 in 1993 gradually rising to about \$345,000 in 2003. The opponent's Vancouver establishment achieved recognition as "best bar" in polls conducted by various local magazines in 1996, 1998 and 1999. The opponent's concern with the present trade-mark application is voiced at paragraph 21 of Mr.

Gibson's affidavit, shown below:

Mr. Ismaili's evidence, filed on behalf of the applicant, may be summarised as follows. The applicant is a Canadian corporation headquartered in Montreal, Quebec where the applicant operates a bar and restaurant, pool room and bowling alley establishment. The facility has 37 professional pool tables and ten bowling lanes as well as a meeting and party room. The restaurant's sales figures (not disclosed by Mr. Ismaili) represents less than 5% of the pool bar's total sales (also not disclosed). Exhibits to Mr. Ismaili's affidavit show that the establishment is decorated with unique and stylish architectural features. The component SHARX in the applied for mark is intended to refer to a "pool shark," that is, a person who is an expert or excellent player of pool or billiards.

The substantive issue for decision is whether the applied for mark SHARX POOL BAR is confusing with the opponent's mark SHARK CLUB BAR & GRILL. The material date to consider the issue of confusion arising pursuant to Section 12(1)(d) is the date of my decision, while the material date arising from the allegation of non-distinctiveness (ground (f) above) is the

date of opposition namely, April 9, 2003. The issue of confusion is also determinative of the grounds of opposition alleging non-entitlement, pleaded in paragraphs (d) and (e) above. The material time to consider the issue of non-entitlement is the date of first use of the applied for mark namely, December 31, 1992. As the opponent has not established any use of its marks or trade-name prior to 1993, grounds (d) and (e) above must be rejected. For a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark SHARX POOL BAR and the opponent's mark SHARK CLUB BAR & GRILL. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308

(F.C.T.D.).

The opponent's mark SHARK CLUB BAR & GRILL derives its inherent distinctiveness for the most part from the first component SHARK as the remaining components are apt to describe the opponent's services. Similarly, the component SHARX contributes most to the inherent distinctiveness of the applied for mark SHARX POOL BAR. Given that the term "pool shark" is a colloquialism for an expert pool or billiards player, the parties' marks possess a fairly low degree of inherent distinctiveness as the consumer might expect that the parties' establishments provide pool or billiards play as entertainment in addition to restaurant and bar services. On the basis of the more complete evidence filed by the opponent and the limited evidence filed by the applicant, I conclude that the opponent's mark had acquired a greater reputation in western Canada than the applied for mark had acquired in Quebec (specifically Montreal), at least by the later material date which is the date of this decision. The length of time that the marks in issue have been in use is a minor factor as the applicant claims use of its mark since 1992 while the opponent claims use of its mark since 1993. The nature of the parties' businesses and services are essentially the same or overlapping as both parties provide restaurant and bar services in an environment which offers pool and billiards play as entertainment. Lastly, there is a high degree of resemblance between the marks SHARK CLUB BAR & GRILL and SHARX POOL BAR in ideas suggested and in sounding although slightly less so in appearance, keeping in mind that it is the first portion of a mark that is the most relevant for purposes of distinction: see *Pernod Ricard v. Molson Breweries* (1992), 44 C.P.R. (3d) 359 at 370 (F.C.T.D.), *Conde Nast Publications Inc. v. Union Des Editions Modernes* (1979) 46 C.P.R.(2d)

183 at 188 (F.C.T.D.).

Having regard to the above, I find that the applicant has not met the onus on it to show, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark and the opponent's mark SHARK CLUB BAR & GRILL. Had the applicant been able to demonstrate that the component SHARK, or variations thereof, was common to restaurant and bar services, such evidence may have tipped the balance of probabilities in favour of the applicant.

Application no. 1,033,636 for the mark SHARX POOL BAR RESTO & Design, shown below, was filed on October 25, 1999. The design mark application covers the same services as application no. 1,044,263 (but is based on use since October 25, 1999) and covers the wares " T-shirts, caps, hats, mugs, drinking glasses and pens," based on proposed use in Canada.



The above mentioned application was opposed on March 19, 2003. In this proceeding, the applicant also requested an interlocutory ruling on the sufficiency of the statement of opposition, however, the matter was resolved by the opponent amending its pleadings. Only the opponent

submitted a written argument and only the opponent was represented at an oral hearing. The issues raised by the pleadings and the evidence filed by the parties in respect of the design mark application are essentially the same as those considered in respect of application no. 1,044,263 and the same result follows.

In view of the above, application nos. 1,033,636 and 1,044,263 are refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 30th DAY OF MAY, 2006.

Myer Herzig,  
Member,  
Trade-marks Opposition Board