



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 203
Date of Decision: 2011-10-20

**IN THE MATTER OF AN OPPOSITION
by CEG License Inc. to application
No. 1,412,784 for the trade-mark LOCAL
in the name of Joey Tomato's (Canada)
Inc.**

[1] On September 30, 2008, Joey Tomato's (Canada) Inc. (the Applicant) filed an application to register the trade-mark LOCAL (the Mark). The application is based upon proposed use in association with the following wares and services:

wares

- (1) Beverageware including wine glasses and other glasses, cups and mugs; beverage coasters; wine cranks.
 - (2) Promotional items, namely key chains, flags, novelty buttons, greeting cards, note cards, pencils, pens, coffee mugs, and magnets, namely fridge magnets.
- (collectively the Wares)

services

- (1) Restaurant, bar and lounge services; food take-out services including online ordering services for take-out food; catering services.

(collectively the Services)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 22, 2009.

[3] On September 21, 2009, CEG License Inc. (the Opponent) filed a statement of opposition. The Applicant filed and served a counter statement, denying the Opponent's allegations.

[4] An affidavit of Brian Lee, the Opponent's Vice-President, was filed in support of the opposition. No evidence was filed in support of the application and Mr. Lee was not cross-examined.

[5] Both parties filed a written argument. An oral hearing was not held.

Grounds of Opposition

[6] The statement of opposition pleads four grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). However, in its written argument, the Opponent "disclaims" the first three grounds of opposition and therefore I am treating those grounds as withdrawn. (I also agree with the Applicant's submissions that the Opponent did not meet its initial burden with respect to the first three grounds of opposition.)

[7] The surviving ground of opposition reads:

The trademark applied for is not distinctive, having regard to the provisions of Sections 38(2)(d) and 2 of the *Trade-marks Act* because it is not capable of distinguishing the Applicant's services from the services of others, particularly the services provided by the Opponent under the trade-names LOCAL 522 and LOCAL 510, nor is it adapted to so distinguish the Opponent's trade-names.

[8] The last phrase of the above pleading makes no sense and will be disregarded. Regarding the remainder of the pleading, I note that the Opponent has not referred to the Applicant's Wares, with the result that this ground of opposition can at best succeed with respect to the Applicant's Services.

Material Date re Distinctiveness Ground

[9] The material date for assessing the issue of distinctiveness is the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Initial Onus re Distinctiveness Ground

[10] There is an initial burden on the Opponent to establish that, as of September 21, 2009, one or both of the pleaded trade-names was known to at least some extent to negate the distinctiveness of the Mark, and the trade-name's reputation should be substantial, significant or sufficient [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[11] I therefore turn now to the Opponent's evidence to see if it has met its initial evidential burden. The evidence of the use or reputation of the pleaded trade-names as of September 21, 2009 can be summarized as follows.

[12] Mr. Lee states that the Opponent has used the trade-names LOCAL 510 and LOCAL 522 in association with nightclub, bar, tavern, restaurant and lounge services since at least May 31, 2009. Although Mr. Lee provides various exhibits, the only ones identified as being prior to the material date of September 21, 2009 are:

1. "a copy of a poster advertised in the Beatroute magazine of the Calgary Herald in April 2009 advertising the opening of LOCAL 510 and LOCAL 522" (Exhibit "J") – however, I do not see either LOCAL 510 or LOCAL 522 displayed in such advertisement
2. "copies of the posters advertised in the Beatroute magazine of the Calgary Herald in June, July, August, September ... of 2009 respectively advertising LOCAL 510" – I do see LOCAL 510 displayed in these advertisements (Exhibits "K" through "N")
3. "a copy of the online review for LOCAL 510 from Fast Forward Weekly Magazine dated July 30, 2009" (Exhibit "S").

[13] Mr. Lee has provided sales figures associated with each trade-name in 2009 (Exhibit "T") but these figures are of no assistance because they have not been broken down to show the sales prior to September 21, 2009.

[14] From the above, it is clear that the Opponent has not met its initial onus insofar as the trade-name LOCAL 522 is concerned. The question remains whether it has met its onus insofar as the trade-name LOCAL 510 is concerned. There is some evidence that such trade-name was promoted prior to September 21, 2009 so the question becomes whether the reputation evidenced is sufficient to negate the distinctiveness of the Mark.

[15] In the absence of evidence of Canadian viewership of the July 20, 2009 online review, I can accord only *de minimus* weight to it. That leaves the evidence of four ads that appeared shortly before the material date in a magazine of the *Calgary Herald*. Mr. Lee has provided the average daily 2009 circulation figures for the *Calgary Herald* newspaper, namely 124,607 copies (Exhibit “R”). In the absence of such evidence, I would still be able to take judicial notice of the general circulation of the *Calgary Herald* as a major Canadian newspaper [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.)]. However, as pointed out by the Applicant, there is “no information as to how the daily circulation figures of the *Calgary Herald* is related to circulation of the Beatroute magazine.” (paragraph 15, Applicant’s written argument)

[16] I am not satisfied that four advertisements in a magazine of the *Calgary Herald* suffice to affect the distinctiveness of the Applicant’s proposed use Mark. In this regard, I refer to the first part of paragraph 33 of *Bojangles’ International LLC*, as reproduced below:

[33] The following propositions summarize the relevant jurisprudence on distinctiveness were there is an allegation that a mark’s reputation negates another mark’s distinctiveness, as per s. 2 and para. 38(2)(d) of the Act :

- The evidential burden lies on the party claiming that the reputation of its mark prevents the other party’s mark from being distinctive;
- However, a burden remains on the applicant for the registration of the trade-mark to prove that its mark is distinctive;
- A mark should be known in Canada to some extent at least to negate another mark’s distinctiveness;
- Alternatively, a mark could negate another mark’s distinctiveness if it is well known in a specific area of Canada;
- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect;
- The reputation of the mark can be proven by any means, and is not restricted to the specific means listed in section 5 of the Act, and it is for the decision-maker to weigh the evidence on a case-by-case basis.

...

[17] As noted in the fourth bullet above, when an opponent's reputation is restricted to a specific area of Canada, the opponent's initial onus will be satisfied if its trade-mark (or trade-name) is well known in that specific area. However, the evidence before me does not enable me to conclude either that the Opponent's trade-name was well known in the Calgary area or that it had a reputation in Canada that was substantial, significant or sufficient to negate the distinctiveness of the Applicant's Mark. Accordingly, I find that the Opponent has not met its initial onus, with the result that the distinctiveness ground of opposition is dismissed.

Disposition

[18] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office