



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

Citation: 2012 TMOB 8
Date of Decision: 2012-01-18

**IN THE MATTER OF AN OPPOSITION
by Liverton Hotels International Inc. to
application No. 1,238,970 for the trade-
mark FOOD DIVA in the name of
Maribel Linfield**

[1] On November 29, 2004, Maribel Linfield (the Applicant) filed an application to register the trade-mark FOOD DIVA (the Mark) in association with the following wares and services (the Wares and Services) based on use in Canada or proposed use as set out below:

Wares:

- (1) Jewelry, namely, earrings. Used in Canada since at least as early as June 2004.
- (2) Men's & ladies clothing and apparel, namely, tank tops, blouses, pullovers, coats, sweaters, T-shirts, underwear, lingerie, chef pants, chef coats, socks, hankerchiefs, sweatsuits, loungewear, beachwear, aprons, slippers; fake tattoos; cookware, namely, pots and pans; kitchen equipment, namely, baking sheets, knives; kitchen utensils, namely, wooden spoons, whisks, spatulas, tongs, ceramic spoons and spatulas; pitchers, bowls, platters, glasses, pottery, serving trays, serving plates, serving bowls, cutlery, plate chargers, picnic wares bakeware, namely, ceramic, metal, plastic or glass plates; food containers, namely, lunch pails, plastic glass, or metal food holders, food tongs, forks knives and spoons; gift certificates, printed matter, namely, fridge magnets, bumper stickers, labels, posters, brochures, cookbooks; stationery, namely, grocery lists, gift cards, letterhead, calendars, books, recipes, recipe cards, documents, awards, cards; bathware, namely, towels, scented soaps, air fresheners, candles, bath salts, bath oils, linens, namely, tea towels, dishtowels, wash rags, napkins, pot holders, table cloths; textile designs for clothing and table fashions, decorations, namely, picture frames; decorative items, namely, sculptures, paintings and pictures, pillows, couch throws; jewelry, namely, pendants, broaches, rings, toe rings, bracelets; accessory buttons, key chains; artwork, namely, etchings, engravings, stampings, embossings, brandings and

moldings; handbags, purses, knapsacks, carrying totes; candles, cosmetics, namely, lipstick, eye makeup, face makeup, gloss, tattoos, body stickers, skin creams and spritzes; pre-recorded instructional videos, compact disks, DVD's, MP3's, videogames and disks relating to food and/or cooking. Based on proposed use.

(3) Cookware, namely, ceramics and ramekins. Used in Canada since at least as early as October 2004.

Services

Teaching cooking, providing cooking lessons, providing cooking courses, conducting cooking classes, catering services, event planning relating to food, food consulting. Used in Canada since at least as early as January 2004.

[2] The Applicant disclaimed the right to the exclusive use of the word FOOD apart from the Mark.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 26, 2006.

[4] On March 22, 2007, Liverton Hotels International Inc. (the Opponent) filed a statement of opposition.

[5] The grounds of opposition can be summarized as follows:

- Non-compliance with s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) on the basis that the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Wares and Services since at the date of filing the application for the Mark, the Applicant was or should have been aware of the Opponent's trade-marks, DIVA and DIVA AT THE MET, previously used in Canada in association with restaurant services.
- The Mark is not registrable as it is confusing with the Opponent's registrations for the following trade-marks: DIVA (TMA480,444) and DIVA AT THE MET (TMA480,443) (the DIVA marks).
- Pursuant to s. 16(1)(a) of the Act, the Applicant is not entitled to registration of the Mark on the ground that as at the date of filing the application for the Mark, the Mark was confusing with the DIVA marks that had been previously used and made known in Canada by the Opponent in association with restaurant services.
- Pursuant to s. 16(1)(b) of the Act, the Applicant is not entitled to registration of the Mark on the ground that at the date of filing the application for the Mark, the Mark was confusing with the Opponent's DIVA marks in respect of which applications for

registration had previously been filed in Canada by the Opponent, in association with restaurant services.

- The Mark is not distinctive of the Wares in that the Mark does not distinguish, nor was it adapted to distinguish, the Wares and Services from the wares and services of others, namely restaurant services offered in association with the Opponent's DIVA marks.

[6] The Applicant served and filed a counter statement in which it denied the Opponent's allegations and put the Opponent to the strict proof thereof.

[7] In support of its opposition, the Opponent filed affidavits of Henry Wu, the Opponent's President, sworn December 7, 2007 and Karin McCaig, a student-at-law for the Opponent's agent, sworn December 10, 2007 as its evidence pursuant to r. 41 of the *Trade-marks Regulations* SOR/96-195 (the Regulations). An order for cross-examination issued but no cross-examinations were conducted. The Opponent also filed the affidavit of Gary Daniel, an associate with the Opponent's agent, sworn July 21, 2009 in reply to the Applicant's evidence pursuant to r. 43 of the Regulations.

[8] In support of its application, the Applicant filed her own affidavit sworn November 28, 2008 and the affidavit of David J. Schnurr, an associate with the Applicant's agent, sworn November 28, 2008. An order for cross-examination issued but no cross-examinations were conducted.

[9] Both parties filed written arguments and were represented at an oral hearing.

Onus and Material Dates

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298].

[11] The material dates that apply to the grounds of opposition are as follows:

- s. 38(2)(a)/30(i) - the date of filing the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 at 475 (T.M.O.B.) and *Tower Conference Management Co. v. Canadian Exhibition Management Inc.* (1990), 28 C.P.R. (3d) 428 at 432 (T.M.O.B.)].
- s. 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)].
- s. 38(2)(c)/16(1)(a) and (b) - the claimed dates of first use [see s. 16(1) of the Act].
- s. 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Section 30(i) Ground

[12] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. The Applicant has provided the necessary statement and this is not an exceptional case; the s. 30(i) ground is accordingly dismissed.

Non-registrability Ground – s. 12(1)(d) of the Act

[13] An opponent's initial onus is met with respect to a s. 12(1)(d) ground of opposition if the registrations relied upon are in good standing as of the date of the opposition decision. The Registrar has discretion to check the register in order to confirm the existence of the registration(s) relied upon by an opponent [see *Quaker Oats of Canada Ltd./La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. I have exercised that discretion and confirm that the registrations for the Opponent's DIVA marks remain valid and therefore the Opponent has satisfied its evidential burden. I must now assess whether the Applicant has met its legal burden.

[14] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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 wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[15] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight. [See, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.) and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.).]

[16] As a preliminary matter, I note that, in its written argument and at the oral hearing, the Opponent conceded that there is no overlap in the nature of the parties' wares with respect to the following wares in the application for the Mark, none of which have any connection to food or cooking (the Non-Food Wares):

Wares (1): Jewellery, namely, earrings.

Wares (2): Men's & ladies clothing and apparel, namely, tank tops, blouses, pullovers, coats, sweaters, T-shirts, underwear, lingerie, . . . , socks, handkerchiefs, sweatsuits, loungewear, beachwear, aprons, slippers; fake tattoos; . . . stationery, namely, grocery lists, gift cards, letterhead, calendars, books, . . . , documents, awards, cards; bathware, namely, towels, scented soaps, air fresheners, candles, bath salts, bath oils, linens, namely, tea towels, dish towels, wash rags, napkins, pot holders, table cloths; textile designs for clothing and table fashions, decorations, namely, picture frames; decorative items, namely, sculptures, paintings and pictures, pillows, couch throws; jewellery, namely, pendants, broaches, rings, toe rings, bracelets; accessory buttons, key chains; artwork, namely, etchings, engravings, stampings, embossings, brandings and moldings; handbags, purses, knapsacks, carrying totes; candles, cosmetics, namely, lipstick, eye makeup, face makeup, gloss, tattoos, body stickers, skin creams and spritzes;

...

[17] Furthermore, as an alternative remedy, the Opponent has sought to have the application for the Mark refused for only the food and cooking related wares and services, excluding the Non-Food Wares. In the absence of evidence or submissions supporting a likelihood of confusion with respect to the Non-Food Wares, I am dismissing the s. 12(1)(d) ground of opposition summarily with respect to the Non-Food Wares.

Section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which they have become known

[18] The parties' marks share the word DIVA, which, while a common dictionary word, has no meaning with respect to the parties' wares and thus is the most distinctive element of the parties' marks. In fact, it makes up the whole of the Opponent's trade-mark DIVA.

[19] The Mark also features the word FOOD, which has been disclaimed apart from the Mark on account of its descriptiveness.

[20] In light of the descriptive nature of the FOOD element of the Mark, I find that the Opponent's DIVA mark possesses a somewhat higher degree of inherent distinctiveness.

[21] The strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use. I will now turn to the extent to which the trade-marks have become known in Canada.

[22] The Applicant began offering her services in the Kitchener/Waterloo area in 2004. Specifically, in her affidavit, Ms. Linfield states that she has used the Mark since at least as early as January 2004 in association with "teaching cooking, providing cooking classes, providing cooking courses, conducting cooking classes, catering services, event planning related to food/food consulting". In her affidavit, Ms. Linfield states that she offers most of her cooking classes from her home, but that she will also conduct them in offsite locations including at Zehrs Markets Community Rooms.

[23] In her affidavit, Ms. Linfield states that she has operated a website at *fooddiva.com* since January 2004 through which she has offered educational services in the form of online cooking classes. The Applicant submits that, while the Applicant physically operates in the Kitchener/Waterloo area, the Applicant's website, and by corollary the online services offered thereon, have no geographical boundaries, such that the Applicant's reputation would extend beyond the Kitchener/Waterloo area. Ms. Linfield attaches to her affidavit materials printed from the *fooddiva.com* website displaying the Mark and advertising the Applicant's various services.

[24] In her affidavit, Ms. Linfield states that she also offers catering services. Specifically, Ms. Linfield indicates that she generally caters about six events per year. Ms. Linfield states that

over the years she has catered weddings, funerals and business functions, mostly to small groups of approximately 40 people. I note that the promotional materials attached to Ms. Linfield's affidavit do not make reference to catering services (Exhibits B-H).

[25] In support of her use claims, Ms. Linfield attaches to her affidavit a brochure advertising her services which includes a price list for her cooking classes as well as a list of the corporate services offered by the Applicant in addition to the cooking classes (e.g. television appearances, recipe writing, menu consulting, public speaking, cooking demos, food styling, on site cooking assistance, kitchen reorganization, food journalist, product development, staff training) (Exhibit G). The brochure displays the Mark in the following format, which I accept as use of the Mark:



[26] The brochure features a copyright date of 2005 and as a result I am willing to accept that it could have been used by the Applicant since as early as 2005. I accept the brochure as evidence of use of the Mark in advertising for “teaching cooking, providing cooking lessons, providing cooking courses, conducting cooking classes, ... food consulting” pursuant to s. 4(2) of the Act. I am not satisfied that the brochure evidences use of the Mark in association with “catering services” or “event planning relating to food”.

[27] Ms. Linfield also attaches to her affidavit copies of business cards she uses to promote her services, both of which display the logo set out above in paragraph 25 (Exhibit H). I note that the business card is not dated and as a result I consider it to be current to the date Ms. Linfield's affidavit was sworn, namely November 28, 2008.

[28] In her affidavit Ms. Linfield states that she has also used the Mark since at least as early as October 2004 in association with “cookware, namely, ceramics and ramekins”.

[29] I note that the Applicant has not provided any evidence suggesting that the Mark is applied to any of the Wares or their packaging or in any other way so associated to satisfy s. 4(1) of the Act. As a result, I am not satisfied that the Applicant has established any reputation for the Mark in association with any of the Wares.

[30] With respect to the Applicant's Services, the Opponent submits that there is no affirmative evidence of record suggesting that the Mark has acquired any significant reputation in Canada.

[31] I agree with the Opponent that the Applicant has not provided any sales figures or invoices and that this makes it difficult to establish the extent to which the Mark has become known in association with the Services. Furthermore, I note that the Applicant has not provided any data on the number of hits to the *fooddiva.com* website. As a result, I am unable to determine the extent to which the Mark has become known except that it must have become known to some extent in light of my finding that the Mark has been used in Canada since at least 2005 in association with some of the Services.

[32] At the oral hearing the Opponent submitted that it was not in dispute that the Opponent's primary use of its marks, and therefore its reputation, is with respect to its restaurant in Vancouver. The Applicant conceded that the Opponent's DIVA marks have likely become known in the Vancouver area for restaurant services.

[33] In addition, the Opponent submitted that separate and apart from the reputation in association with restaurant services, the Opponent has developed a reputation for its marks that extends beyond the Opponent's restaurant in its Vancouver hotel. Specifically, the Opponent submits that its DIVA marks have been used at the Opponent's Hemispheres restaurant located at its hotel in Toronto.

[34] Firstly, with respect to the Opponent's reputation in the DIVA marks in association with restaurant services, the Opponent submits that the evidence shows that the Opponent has served tens of thousands of meals per year; has been the subject of a significant amount of solicited and unsolicited publicity; and has operated a website which has received many hits. More specifically, Mr. Wu states that the Opponent has been operating a restaurant named DIVA in its

Vancouver Metropolitan hotel since 1996. Mr. Wu states that the restaurant is sometimes referred to as DIVA AT THE MET. The Applicant objects to Mr. Wu's interpretation of the evidence. Specifically, the Applicant submits that the materials attached to Mr. Wu's affidavit show that both the Opponent itself and third parties more often refer to the Opponent's DIVA restaurant as DIVA AT THE MET. Having reviewed the evidence as a whole, I find that the Applicant's objection has merit. In fact, I note that most often, the Opponent refers to the DIVA restaurant using a design mark, shown below, featuring the word elements DIVA AT THE MET (the Diva Logo).



[35] That said, I find that the Diva Logo qualifies as use of the trade-mark DIVA, since the word DIVA is set apart from the other parts of the logo through the use of a significantly different size font [see *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.) at 538-9].

[36] Mr. Wu states that in any given year the Opponent's restaurant serves over 40,000 guests per year. Mr. Wu states that in the year 2005 the Opponent served approximately 50,000 meals in its restaurant.

[37] Mr. Wu also provides sales figures for the Opponent's restaurant services. Specifically, Mr. Wu states that gross revenues for 2006 amounted to over \$2 million and that for several years preceding the year 2007 (the date of swearing his affidavit) revenues amounted to over \$1 million/year.

[38] Mr. Wu also provides evidence of advertising and promotion for the Opponent's DIVA marks. Firstly, Mr. Wu attaches to his affidavit copies of magazine and newspaper articles which he states constitute favourable publicity for the Opponent's DIVA restaurant (Exhibit A). I note that circulation figures have not been provided for the publications. However, I am able to take judicial notice of the general circulation of major Canadian daily newspapers [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 at 543 (T.M.O.B.); *R.*

Griggs Group Ltd. v. 359603 Canada Inc. (2005), 47 C.P.R. (4th) 215 at 227 (T.M.O.B.)]. Furthermore, I am willing to take judicial notice that *The Vancouver Sun* and *The Toronto Sun*, circulate at least in the Vancouver and Toronto area respectively [see *Milliken & Co. v. Keystone Industries (1970) Ltd.* (1986), 12 C.P.R. (3d) 166 (T.M.O.B.), at 168 and *Carling O'Keefe Breweries of Canada Ltd. v. Anheuser-Busch, Inc.* (1985), 4 C.P.R. (3d) 216 (T.M.O.B.), at 224]. I note, however, that newspaper and magazine articles do not constitute advertising. However, in light of the volume of articles, and the range of publications in which they are found, I am willing to accept that the existence of these articles suggests that Vancouver and Toronto residents would have been informed of the Opponent's DIVA restaurant.

[39] In his affidavit, Mr. Wu states that the Opponent spent over \$150,000 “over the last several years” to promote its restaurant services. Mr. Wu also provides samples of materials used by the Opponent to promote its restaurant services in association with the Opponent's DIVA marks (Exhibit B). He states that over 25,000 copies of the brochures found in Exhibit B were printed and sent to customers and potential customers in Canada. I note that, as mentioned previously, most of these documents display the Diva Logo.

[40] Mr. Wu also attaches to his affidavit materials from the Opponent's website, which he states gets over 30,000 hits per month on average.

[41] Mr. Wu attaches to his affidavit examples of what he calls indirect or unsolicited publicity (Exhibit D). Specifically, Mr. Wu attaches to his affidavit photos of chefs from the Opponent's DIVA restaurant participating in the “Bocuse d'Or” culinary competition in France in 2001 and 2003. The photographs show the chefs wearing jackets displaying the Diva Logo. I note that this photograph relates to an event which took place in France, not in Canada. As a result, this photograph does not form relevant evidence establishing a reputation for the Opponent's DIVA marks in Canada.

[42] With respect to the Opponent's alleged reputation outside of the DIVA restaurant, the Opponent submits the following evidence:

- in his affidavit Mr. Wu states that the Opponent makes available recipes for certain foods served at the Diva Restaurant (Exhibit H);

- and Mr. Wu also states that the Opponent has used the DIVA Marks in at least one of its other restaurants, namely Hemispheres in Toronto. Mr. Wu attaches to his affidavit a copy of the menu from Hemispheres offering “Diva’s Onion Dip – Vancouver’s Diva at the Met onion dip served with root vegetable chips” from 2006.

[43] Based on the foregoing, I am satisfied that the Opponent has established a significant reputation for the DIVA marks in Vancouver, British Columbia, and some degree of reputation in other parts of Canada, more particularly in Toronto.

Section 6(5)(b) – the length of time each has been in use

[44] As set out in more detail above in the analysis of the s. 6(5)(a) factor, the Applicant has established use of the Mark since at least as early as 2005 in association with “teaching cooking, providing cooking classes, providing cooking courses, conducting cooking classes ... food consulting”. The Applicant has not, however, established any use of the Mark in association with any of the claimed Wares or with “catering services” or “event planning related to food”.

[45] As set out in more detail above in the analysis of the s. 6(5)(a) factor, the Opponent has evidenced use of the Opponent’s DIVA marks. I note that Mr. Wu makes the sworn statement that the Opponent has offered restaurant services in association with the Opponent’s DIVA marks since 1996 but the supporting documentary evidence dates back only to 2001. This factor favours the Opponent regardless of whether the Opponent has succeeded in evidencing use of its DIVA marks since 1996 or 2001, since both dates predate the Applicant’s date of 2005.

Sections 6(5)(c) and (d) – the nature of the wares, services, trade and business

[46] It is the Applicant’s statement of wares and services as defined in its application versus the Opponent’s registered services that govern my determination of this factor [see *Esprit International v. Alcohol Countermeasure Systems Corp.* (1997), 84 C.P.R. (3d) 89 (T.M.O.B.)].

[47] Ms. Linfield states that in her cooking classes she teaches proper cookery methods and food theory. The classes are generally offered in her kitchen studio and are geared towards 8-10 adult students per three-hour class.

[48] Ms. Linfield states that her website, *fooddiva.com* is an instructional cooking video website “where anyone can learn to cook from the comfort of the home”. Ms. Linfield states that the online cooking school is a series of pre-filmed, pre-edited how to videos about cooking. Ms. Linfield states that visitors to the website can purchase individual videos for online viewing or a subscription to view all of the videos. Ms. Linfield states that there are also free videos on her website. Ms. Linfield states that she also provides an email based newsletter.

[49] With respect to the remaining Wares, I find that the simple fact that they relate to food and cooking is not sufficient to find any significant degree of similarity with the Opponent’s restaurant services.

[50] The analysis is more complicated with respect to the Services.

[51] In its written argument the Applicant submitted that the distinction between catering services and restaurant services is supported by virtue of the fact that the Nice Classification System classifies them in different categories. At the oral hearing the Opponent submitted that there is no authority for the proposition that this is relevant to the present confusion analysis. I agree with the Opponent’s submissions and I am not placing any weight on the Applicant’s submissions based on the Nice Classification system.

[52] The Applicant submits that the crux of her business is to provide instructional cooking classes, online tutorials and some catering (approximately six events per year). In her affidavit, Ms. Linfield makes it clear that she does not intend now, or in the future, to offer restaurant services. This is supported by the fact that the application does not include restaurant services.

[53] The Opponent’s registrations cover only restaurant services. The Applicant submits that catering services and restaurant services are distinct from each other and relies on the Schnurr affidavit. By contrast, the Opponent submits that catering services and/or cooking classes are frequently offered by restaurants and relies on the McCaig affidavit.

[54] More specifically, the Applicant relies upon Exhibits F and G to the Schnurr affidavit to support its submission that the Trade-marks Office has previously treated restaurant services and catering services and/or cooking classes as being distinct types of services. Specifically,

- Mr. Schnurr conducted a search for trade-marks which include catering services but not restaurant services (602 found); restaurant services but not catering services (6781 found); both restaurant and catering services (1236 found) (Exhibit F).
- Mr. Schnurr conducted a search for trade-marks which include cook* but not restaurant services (647 found); restaurant services but not cook* (7917 found); both cook* and restaurant services (100 found) (Exhibit G).

[55] By contrast, the Opponent relies on the McCaig affidavit in support of its allegation that restaurants frequently offer catering services or cooking classes in addition to the traditional restaurant services. Ms. McCaig attaches to her affidavit results from searches she conducted using the Google search engine. Specifically,

- Ms. McCaig searched the Google search engine for restaurants in Toronto and Vancouver which offer catering services in addition to restaurant services. Ms. McCaig's search revealed seven restaurants in Toronto and three in Vancouver which offer catering services in addition to restaurant services. Ms. McCaig telephoned each of these restaurants and confirmed that they do indeed offer catering services.
- Ms. McCaig also searched the Google search engine for restaurants that offer cooking classes in addition to restaurant searches. Ms. McCaig's search revealed three such restaurants in Toronto and one in Vancouver. Ms. McCaig followed up with telephone calls and was only able to confirm that two of the three restaurants found in Toronto in fact offered cooking classes.

[56] The Opponent also relies on Mr. Wu's evidence wherein he stated that a number of restaurants in Canada offer catering services and cooking classes in addition to restaurant services and attaches printouts from third party websites in support of this statement (Exhibit F). I note that these are the same entities referred to in the McCaig affidavit.

[57] In his affidavit, Mr. Schnurr searched *www.canada411.ca* for restaurants in Toronto and Vancouver (Exhibit I). The search revealed 4951 restaurants in Toronto and 4344 in Vancouver.

[58] I note that there are hearsay deficiencies with both Ms. McCaig and Mr. Schnurr's evidence. In particular, I note that, as submitted by the Applicant at the oral hearing, the evidence adduced by Ms. McCaig relating to the telephone calls she made confirming that these restaurants in fact offered the catering or cooking class services constitutes hearsay.

[59] In any event, I do not find the submissions based on Ms. McCaig and Mr. Schnurr's evidence determinative. Rather, based on a review of the evidence as a whole, I am satisfied that the fact that restaurant services and catering services both relate to the service of food is sufficient to find an overlap in the nature of these services. The same is not true for cooking classes, event planning relating to food or food consulting. I am not satisfied that the mere fact that these services, like restaurant services, have a connection to food is sufficient to create an overlap in the nature of those services.

[60] Based on the foregoing, I find an area of overlap between the parties' services but only with respect to "catering services".

Section 6(5)(e) – the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[61] Both of the Opponent's marks feature the word DIVA which is the only element of the Opponent's DIVA marks that shares any resemblance with the Mark. As a result, I consider registration No. TMA480,444 for the trade-mark DIVA registered for "restaurant services" to present the Opponent's strongest case. I will therefore address the s. 6(5)(e) analysis by focusing on the trade-mark DIVA of registration No. TMA480,444 and the Mark.

[62] In most instances, the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Beverly Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2) 145, conf. 60 C.P.R. (2d) 70 (F.C.T.D.)]. This principle was recently upheld by the Supreme Court of Canada in *Masterpiece, supra*.

[63] The Applicant submits that the first portion of a mark is the most important for the purpose of distinguishing [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.) at 188]. By contrast, the Supreme Court in *Masterpiece* recently advised that the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece, supra* at para 64]. The word DIVA, while a dictionary word, has no meaning with respect to the parties' wares and services and as a result it forms the most striking or unique element of the parties' marks.

[64] The DIVA element makes up the entirety of the Opponent's trade-mark DIVA, and is the dominant portion of the Mark. This creates similarities in sound, appearance, and ideas suggested by the parties' marks. The Opponent submits that both parties' marks suggest the idea of a diva. The Opponent submits that the addition of the word FOOD in the Mark is merely a descriptive reference to food but it does not serve to decrease the degree of resemblance between the parties' marks.

[65] I agree with the Opponent that the parties' marks share similarities in sound and appearance by virtue of the fact the Mark incorporates the whole of the trade-mark DIVA. Furthermore, I agree that both parties' marks suggest the idea of a "diva". However, for the reasons that follow I find that there is some nuance to the idea suggested by each mark such that there is not a significant overlap in the ideas suggested by the parties' marks.

[66] Based on a review of the evidence as a whole, I am of the view that the Applicant herself is the "food diva" and that this forms the basis for the way in which the Applicant uses the Mark. I base this on the fact that the Applicant is an individual who offers the Services herself, largely out of her own home. Furthermore, I note that the promotional materials adduced by Ms. Linfield show a cartoon image of what appears to be Ms. Linfield herself, further suggesting that Ms. Linfield is the "food diva" in question. By virtue of the fact that the Opponent, a corporation, uses the trade-mark DIVA in association with its restaurant located in a hotel, the idea suggested by the Opponent's trade-mark DIVA necessarily differs.

Additional Surrounding Circumstance – State of the Register and Marketplace

[67] Both parties filed evidence of the state of the register and marketplace with respect to the word DIVA in Canada.

[68] The Applicant provides state of the register evidence filed by Mr. Schnurr. Mr. Schnurr provides results from various searches he conducted of the Canadian Intellectual Property Office Trade-marks Database. Specifically, Mr. Schnurr conducted a search for DIVA-formative marks in association with the following types of wares and/or services:

- restaurants, food products, beverages and related wares and services (Exhibit A). Mr. Schnurr's search reveals nine relevant marks.

- clothing and related wares (Exhibit B). Mr. Schnurr's search reveals 13 relevant marks.
- jewellery, watches and related wares (Exhibit C). Mr. Schnurr's search reveals five relevant marks.
- lighting products (Exhibit D). Mr. Schnurr's search reveals two relevant marks.

[69] When analyzing state of the register evidence, it must be noted that such evidence will only be relevant insofar as one can make inferences from it about the state of the marketplace. Inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[70] The Opponent submits that at best I could only draw an inference that some of these marks may have been in use to a limited extent. I agree. I am not satisfied that the numbers of relevant registrations set out in the Schnurr affidavit are sufficient to enable me to make any inferences regarding the state of the marketplace. As a result, I am not placing any weight on Mr. Schnurr's state of the register evidence.

[71] Mr. Schnurr also conducted a search of the database *www.canada411.ca* for restaurants or related businesses which include the word DIVA in the business name. Mr. Schnurr's search located seven such businesses, three of which he was able to confirm by telephone were currently in operation (Exhibit H). Firstly, Mr. Schnurr's search results do not constitute evidence of use of these business names in Canada, and secondly, I am not satisfied that seven references are significant enough to support drawing an inference regarding the state of the marketplace.

[72] Mr. Schnurr also provides results of a search for similar marks registered separately for restaurant and catering services. Mr. Schnurr's search generated eight examples. The fact that third party "restaurant" marks are able to coexist with other third party "catering" marks is not relevant to a determination of the likelihood of confusion between the Mark and the Opponent's DIVA marks. Each case must be determined on the facts of the particular case. As a result, I am not placing any weight on this portion of Mr. Schnurr's affidavit.

[73] The Opponent filed the affidavit of Mr. Daniel in reply to Mr. Schnurr's affidavit. Mr. Daniel states that over the years, several of the third parties identified in Mr. Schnurr's search results have entered into agreements with the Opponent whereby they have agreed to certain limitations on their use of their DIVA marks. Mr. Daniel also discusses a business referred to in paragraph 11 of the Schnurr affidavit, specifically the business using the trade name "Diva Classic Indian Cuisine" which it forced to change its name to "Diwa Classic Indian Cuisine".

[74] The Applicant submits that Mr. Daniel's evidence is not relevant to a determination of confusion as between the Mark and the Opponent's DIVA marks. I agree. As a result, I am not placing any weight on Mr. Daniel's evidence.

[75] Based on the foregoing, I am not satisfied that either party has provided state of the register or marketplace evidence sufficient to create a relevant surrounding circumstance in determining the likelihood of confusion between the parties' marks.

Additional Surrounding Circumstance – Opponent's Catering and Cooking Class Services

[76] The Opponent's DIVA marks are only registered for use in association with restaurant services. However, the Opponent files evidence which it alleges supports a finding that in addition to offering the registered restaurant services, the Opponent also offers catering services and cooking classes in association with the Opponent's DIVA marks.

[77] I have already found that catering services and restaurant services are related and thus I need not consider this additional circumstance in order to find in favour of the Opponent with respect to catering services.

[78] Mr. Wu states that the Opponent has also offered cooking classes. Specifically, Mr. Wu states in his affidavit that the Opponent's former executive chef has offered private cooking classes at the Opponent's restaurant followed by a six-course tasting menu. In support of this Mr. Wu attaches a press release dated November 23, 2006 which provides details of this package. I note that the press release indicates that these services would be offered in January and February 2007. Mr. Wu states that plans were underway for the Opponent's current chef to offer cooking classes. This statement suggests that as of the date Mr. Wu swore his affidavit, the Opponent was

no longer offering cooking classes. Based on the foregoing, I am not satisfied that the Opponent has provided sufficient evidence to support a finding that at the relevant date the Opponent had developed any reputation for the Opponent's DIVA marks in association with cooking classes. I am thus unable to consider this as an additional circumstance supporting the Opponent's position.

Additional Surrounding Circumstance – No evidence of actual confusion

[79] At the oral hearing the Applicant submitted that it is relevant to note that the parties' marks have been coexisting in Canada since the Applicant commenced use of the Mark in 2004. The Applicant submits that this forms a relevant surrounding circumstance in support of the Applicant's position.

[80] While the Opponent is not under an obligation to file evidence of actual confusion, the failure to file any such evidence in the face of an extensive period of coexistence may result in a negative inference being drawn. In the present case, however, I note that the fact that the parties have offered their services on opposite sides of the country is a mitigating factor which could explain the lack of instances of actual confusion.

[81] As a result, I am not satisfied that the lack of evidence of actual confusion in the marketplace in Canada constitutes a factor which supports the Applicant's position.

Conclusion

[82] Having considered all of the surrounding circumstances, in particular similarity in the nature of "catering services" and "restaurant services", I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's DIVA mark with respect to "catering services". Having regard to the foregoing, I allow the ground of opposition based on s. 12(1)(d) with respect to catering services, only.

[83] With respect to the remainder of the Wares and Services, the difference in the nature of the wares and services serves to shift the balance of probabilities in favour of the Applicant and I

reject the ground of opposition based on s. 12(1)(d) of the Act with respect to the remainder of the Wares and Services.

Non-entitlement Grounds

Section 16(1)(a) of the Act

[84] Despite the onus of proof on the Applicant to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's DIVA marks, the Opponent has the initial onus of proving that one or more of the trade-marks alleged in support of its ground of opposition based on s. 16(1) of the Act was used in Canada prior to the claimed date of first use (June 2004 for Wares 1, October 2004 for Wares 3 and January 2004 for the Services) and had not been abandoned at the date of advertisement of the application for the Mark (July 26, 2006) [s. 16(5) of the Act].

[85] I note that, despite filing evidence of alleged use of the Opponent's DIVA marks in association with catering services and cooking classes, the Opponent did not base its non-entitlement pleading on use with these services. The non-entitlement pleading is limited to use of the Opponent's DIVA marks in association with restaurant services only. As a result, I am restrained from considering the Opponent's use in association with these additional services.

[86] This ground of opposition features three different material dates depending on the Wares and Services of issue. That said I do not find that the circumstances were particularly different at any of the material dates as compared to the circumstances at the material date for the s. 12(1)(d) ground of opposition and as a result, my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue with respect to "catering services". Having regard to the foregoing, I allow the ground of opposition based on s. 16(1)(a) of the Act with respect to catering services, only.

[87] With respect to Wares 1, Wares 3 and the remainder of the Services, the difference in the nature of the wares and services serves to shift the balance of probabilities in favour of the

Applicant and I reject the ground of opposition based on s. 16(1)(a) of the Act with respect to Wares 1, Wares 3 and the remainder of the Services.

Section 16(1)(b) of the Act

[88] The Opponent has not specified the application numbers for the pending applications it is relying on for this ground of opposition. The only trade-marks referred to in the statement of opposition are the Opponent's DIVA marks, both registered in 1997. The Opponent's DIVA marks were therefore not pending as of the date of advertisement for the application for the Mark [see s. 16(4) of the Act] and thus the Opponent has failed to meet its evidential burden. The ground of opposition based on s. 16(1)(b) of the Act is dismissed accordingly.

Non-distinctiveness Ground – s. 38(2)(d) of the Act

[89] In order to meet its initial burden with respect to this ground, the Opponent must establish that one or more of the Opponent's DIVA marks was known at least to some extent in Canada as of March 22, 2007 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.) and *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)].

[90] As discussed more fully in the analysis of the registrability and non-entitlement grounds of opposition, I am satisfied that the Opponent's evidence supports a finding that the Opponent's DIVA marks had developed a reputation in Canada as of the material date and thus the Opponent has met its evidential burden. I note that, as with the non-entitlement grounds of opposition, the Opponent has based this ground only on its restaurant services.

[91] I must now assess whether the Applicant has met its legal burden. Specifically, the onus is on the Applicant to establish on a balance of probabilities that there is no likelihood of confusion between the parties' marks.

[92] The difference in material dates is not significant and as a result my findings under the ground of opposition based on s. 12(1)(d) of the Act are equally applicable here. As a result, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion between the marks at issue with

respect to “catering services”. Having regard to the foregoing, I allow the ground of opposition based on non-distinctiveness with respect to catering services, only.

[93] With respect to the remainder of the Wares and Services, the difference in the nature of the wares and services serves to shift the balance of probabilities in favour of the Applicant and I reject the ground of opposition based on non-distinctiveness with respect to the remainder of the Wares and Services.

Disposition

[94] Pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application for the Mark with respect to the services “...catering services...” and I reject the opposition with respect to the Wares and the remainder of the Services pursuant to s. 38(8) of the Act [see *Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 C.P.R. (3d) 492 (F.C.T.D.) as authority for a split decision].

Andrea Flewelling
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Trade-marks Opposition Board
Canadian Intellectual Property Office