



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

**Citation: 2010 TMOB 187**  
**Date of Decision: 2010-11-12**

**IN THE MATTER OF AN OPPOSITION**  
**by Red Robin International, Inc. to**  
**application No. 1,282,133 for the trade-**  
**mark JAUNTY ROBIN AND FLY-**  
**THRU & Design in the name of Robin's**  
**Foods (2006) Ltd.**

[1] On December 6, 2005, Robin's Foods Inc. filed an application to register the trade-mark (the Mark) that is shown below:



[2] I note that the Canadian Intellectual Property Office's records refer to the Mark as JAUNTY ROBIN AND FLY-THRU & Design, although perhaps a better description would have been ROBIN'S FLY-THRU & Bird Design.

[3] The application claims use of the Mark in Canada since at least November 1, 2005 in association with:

- (1) Operation of a drive-thru prepared food and beverage service.
- (2) Restaurant services; namely, food kiosk services and take-out restaurant services.
- (3) Restaurant franchising; namely, offering technical assistance in the establishment and/or operation of restaurants featuring drive-thru prepared food and beverage service and home delivery food services.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 20, 2006.

[5] On February 20, 2007, Red Robin International, Inc. (the Opponent) filed a statement of opposition, which pleaded the following grounds of opposition, pursuant to the indicated sections of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act):

1. s. 38(2)(a)/30(b): the application is not in compliance with the Act because the Applicant has not used the Mark in Canada since the date of first use claimed;
2. s. 38(2)(b)/12(1)(d): the Mark is not registrable because it is confusing with the trade-mark R & Robin Design registered by the Opponent under No. TMA271,699;
3. s. 38(2)(c)/16(1)(a) and (c): the Applicant is not the person entitled to registration of the Mark because at the date of first use claimed in the application (which date is denied) the Mark was confusing with the Opponent's R & Robin Design mark which had been previously "used in Canada in association with restaurant services and in combination with one or more of the Opponent's various trade-marks and trade-name containing or comprised of the words RED ROBIN";
4. s. 38(2)(d)/2: the Mark is not distinctive in that it does not distinguish nor is it adapted to distinguish the services of the Applicant from those of the Opponent.

[6] The Applicant filed and served a counter statement in which it denied the Opponent's allegations. In addition, the counter statement alleged that the Opponent did not have status to oppose the application, that the Opponent has abandoned its mark, and that the Applicant owns a registration for ROBINS FLY-THRU.

[7] On January 21, 2008, an assignment of the application was recorded in favour of Robin's Foods (2006) Ltd. The term "Applicant" will hereafter be used to refer to Robin's Foods (2006) Ltd. and its predecessor-in-title Robin's Foods Inc. collectively.

[8] In support of its opposition, the Opponent filed a certified copy of the registration that forms the basis of the s. 12(1)(d) ground of opposition. The Applicant elected to not file any evidence.

[9] Both parties filed a written argument. In its written argument, the Opponent took the position that the Registrar should exercise her discretion to check the register to confirm the existence of two other registrations owned by the Applicant. The Opponent submitted that the fact that the Applicant referred in its counter statement to a third registration that it owns supported the exercising of discretion. However, the Registrar will only exercise her discretion to check the register in order to confirm the existence of a registration or application relied upon by an opponent in support of a s. 12(1)(d) or s. 16 ground of opposition [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.) and *Royal Appliance Mfg. Co. v. Iona Appliances Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.)]. Therefore I will not exercise the Registrar's discretion and I am disregarding those portions of the written arguments that refer to any registration other than TMA271,699. I am also disregarding those portions of the Applicant's argument directed to the issue of the Opponent's abandonment of its registered trade-mark, because the validity of an Opponent's registration is not at issue in an opposition proceeding [see *Sunshine Biscuits, Inc. v. Corporate Foods Ltd.* (1982), 61 C.P.R. (2d) 53 (F.C.T.D.)].

[10] An oral hearing was held in which only the Applicant participated.

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[11] 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].

[12] The certified copy filed by the Opponent only satisfies its initial burden in respect of its s. 12(1)(d) ground of opposition. There is no evidence that the Applicant did not use the Mark as of the date claimed and the mere filing of a certified copy of the Opponent's registration will not support the Opponent's evidential burden with respect to grounds of opposition based on allegations of non-entitlement or non-distinctiveness [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.)] Accordingly, the s. 38(2)(a), (c) and (d) grounds of opposition are dismissed.

## Section 12(1)(d) Ground of Opposition

[13] The material date with respect to the surviving ground of opposition is the date of my decision [*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.)].

[14] The mark of the Opponent that forms the basis of this ground is shown below:



[15] The Opponent's mark was registered on August 13, 1982 for restaurant services based solely on use and registration of the mark in the United States of America.

[16] 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.

[17] In applying the test for confusion, I 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.).]

[18] Both marks are inherently distinctive. There is no evidence that shows that either of them has become known in Canada through use or promotion.

[19] Based on the claims in the Opponent's registration and in the Applicant's application, the Opponent has not used its mark in Canada whereas the Applicant has used its Mark in Canada since November 1, 2005.

[20] The parties' marks are both for use in association with restaurant services and for the purpose of this analysis one should assume that their channels of trade would be similar if not identical.

[21] To the extent that both parties' marks comprise a caricature of the upper half of a bird, they are similar. However, it is not evident that the Opponent's bird is a robin (it is only the word ROBIN in the Applicant's Mark that leads me to believe that its bird is suppose to be a robin) and the two birds have different features, for example: the Opponent's bird is wearing a baseball cap whereas the Applicant's bird is wearing a chef's hat; the Opponent's bird is carrying a beer

and a burger whereas the Applicant's bird is carrying a cup of coffee. While it is true that both are looking straight at the camera and are only shown from the waist up, I find that the differences between the two marks are greater than are their similarities. One must not forget that a dominant portion of the Applicant's Mark are the words ROBIN'S FLY-THRU, which also serve to distinguish the Applicant's Mark from the Opponent's mark. With respect to the degree of resemblance in appearance, sound or ideas under s. 6(5)(e), the trade-marks at issue must be considered in their totality.

[22] Having considered all of the surrounding circumstances, I find that, on a balance of probabilities, confusion is not likely between the Applicant's Mark and the Opponent's registered mark. The s. 12(1)(d) ground of opposition is therefore dismissed.

#### Disposition

[23] 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.

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