

**IN THE MATTER OF AN OPPOSITION
by Wing Nuts Café Inc. to application No.
1,181,959 for the trade-mark WING NUTS
filed by Justin Joyce**

On June 18, 2003, Justin Joyce (the “Applicant”) filed an application to register the trade-mark WING NUTS (the “Mark”) based upon proposed use of the Mark in Canada in association with “sit-in and carry-out restaurant services”.

The application was advertised for opposition purposes in the Trade-marks Journal of March 24, 2004.

On April 8, 2004, Wing Nuts Café Inc. (the “Opponent”) filed a statement of opposition against the application. There is only one ground of opposition, namely that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) because, at the date of filing of the application, the Mark was confusing with the Opponent’s trade-mark WING NUTS which the Opponent has used in Canada since at least as early as February 2003 in association with “sit-in and carry-out restaurant services” and “chicken wings”.

The Applicant filed and served a counter statement in which it denied the Opponent’s allegations.

As rule 41 evidence, the Opponent filed the affidavit of Stephen Klette. The Applicant obtained an order for the cross-examination of Mr. Klette but did not conduct a cross-examination

As rule 42 evidence, the Applicant filed the affidavits of Sara Urbauer, Justin Joyce and David Takagawa.

As rule 43 evidence, the Opponent filed the affidavit of Mark Nowakowski. [The Applicant has submitted that this evidence is not proper reply evidence but, as will become clear below, I need

not deal with those submissions in order to conclude these proceedings.]

Each party filed a written argument, but an oral hearing was not requested.

Material Date

The material date for assessment of the likelihood of confusion in this case is the filing date of the Applicant's application. [See s. 16(3)]

Onus

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial 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*, 30 C.P.R. (3d) 293 at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)] In addition, s. 16(5) and 17(1) of the Act place a burden on the Opponent to establish non-abandonment of its mark as of the date of advertisement of the Applicant's application.

The Opponent alleges that it used WING NUTS in Canada prior to June 18, 2003. I summarize below the evidence relating to such claim:

- Wing Nuts Café Inc. was incorporated on June 25, 2003; “such incorporation followed upon several months of activities related to establishing the said business, which activities commenced at least as early as February, 2003, when the said Mark Nowakosky [sic] and [Stephen Klette] agreed to move forward with the establishment of our business.” [Klette affidavit, paragraphs 2 and 3]
- The activities that Mr. Klette says predated June 18, 2003 were:
 - a) an analysis of the market;
 - b) the development of a business name and image;
 - c) a lease of premises;
 - d) the development of the menu, signage, etc.;
 - e) promotion of the said business, including formal advertising and informal marketing through word of mouth. [Klette affidavit, paragraph 3]
- Mr. Klette provides the following exhibits in support of his claims:
 - Exhibits “A”, “B” and “C”: telephone directory listings (bearing no dates) which he

says resulted from an order placed in advance of the May 31, 2003 deadline for advertisement in the 2003/2004 Telephone Directory for the City of Saskatoon

- Exhibit "D": an e-mail of April 25, 2003 with a potential supplier

- Exhibits "E" and "F": e-mails from the Mr. Klette's wife to a friend and a graphic design business which referred to the WING NUTS trade-mark, dated March 11, 2003 and June 17, 2003 respectively

- Exhibit "G": correspondence dated June 13, 2003 from the Saskatchewan Corporations Branch confirming the reservation "of the business name and corporate name 'Wing Nuts Café'"

I have carefully considered the Opponent's evidence and concluded that it does not show use of the WING NUTS trade-mark in association with either "sit-in and carry-out restaurant services" or "chicken wings" prior to June 18, 2003, for the following reasons.

Section 4 of the Act sets out what qualifies as use of a trade-mark as follows:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

Considering first the Opponent's chicken wings, there is no evidence that such wares were ever sold prior to June 18, 2003.

Regarding the Opponent's services, while there clearly was activity in advance of June 18, 2003 aimed at advertising the Opponent's mark, there is no evidence that any advertisement occurred before that date. Delivering an advertisement order to a publisher does not constitute advertising, nor does discussing a concept with friends, suppliers or graphic designers. In addition, registering or reserving a name with a provincial government does not constitute use of such name as a trade-mark. [See *Pharmx Rexall Drugs Stores Inc. v. Vitabin Investments Inc.* (1995),

62 C.P.R. (3d) 108 (T.M.O.B.); *Opus Building Corp. v. Opus Corp.* (1995), 60 C.P.R. (3d) 100 (F.C.T.D.) at 106]

Thus there is no evidence that the Opponent was performing or advertising “sit-in and carry-out restaurant services” in association with WING NUTS prior to June 18, 2003 and the Opponent has not satisfied its initial burden. Consequently the ground of opposition pleaded under s. 16 is dismissed.

As the failure of the Opponent to satisfy its initial burden with respect to its s. 16 ground of opposition effectively concludes these proceedings, I consider it unnecessary to discuss the Applicant’s evidence.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, pursuant to s. 38(8) I reject the opposition.

DATED AT TORONTO, ONTARIO, THIS 17th DAY OF JULY 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board