

IN THE MATTER OF AN OPPOSITION
by Mr. Grumpps Restaurant and
Emporium Limited to application
No. 509,234 for the trade-mark
MR. GRUMPPS filed by
Mr. Greenjeans Corporation

On September 9, 1983, the applicant, Mr. Greenjeans Corporation, filed an application to register the trade-mark MR. GRUMPPS based on proposed use in Canada for "retail department store services and restaurant and bar services." The application was advertised for opposition purposes on February 15, 1984.

The opponent, Mr. Grumpps Restaurant and Emporium Limited, filed a statement of opposition on March 14, 1984 and subsequently filed a revised statement of opposition. A copy of the revised statement was forwarded to the applicant on October 9, 1984. The first ground of opposition is that the applied for trade-mark is not distinctive. The second ground is that the applicant is not the person entitled to registration pursuant to Section 16(3) of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-marks and trade-names MR. GRUMPPS and MR. GRUMPPS RESTAURANT AND EMPORIUM LIMITED previously used and made known in Canada by the opponent.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Jules Chatoff and Bruce A. Preston. The applicant filed the affidavit of Maury Kalen. Only the opponent filed a written argument and no oral hearing was conducted.

As for the opponent's second ground of opposition, there was a burden on the opponent to evidence use or making known of its trade-marks or use of its trade-names prior to the applicant's filing date. The opponent has failed to adduce any evidence directed to establishing making known of its trade-marks within the terms of Section 5 of the Act. Furthermore, the opponent has failed to evidence prior use of its trade-marks in Canada. Mr. Chatoff describes the activities of the opponent in 1983 which led to the construction and operation of a MR. GRUMPPS restaurant in Toronto. However, since the restaurant did not commence business until the summer of 1984, there was no use of the opponent's trade-marks in association with restaurant services until after the applicant's filing date.

There was prior use, however, of the opponent's trade-names Mr. Grumpps and Mr. Grumpps Restaurant and Emporium Limited. As stated by Mr. Chatoff in his affidavit, the opponent was incorporated in 1981 and in early 1983 negotiations were conducted regarding a lease for a restaurant location in Toronto. A lease was entered into in June of 1983. An agreement was entered into between the opponent and a firm of architects (see Exhibit M to the Chatoff affidavit). An exterior sign was placed at the restaurant site in the summer of 1983 announcing the future opening of a MR. GRUMPPS restaurant. An advertising display contract was entered into in August of 1983. All of these activities comprised the carrying on of a business in association with the opponent's trade-names Mr. Grumpps and Mr. Grumpps Restaurant and Emporium Limited: see the opposition decision in Heritage Life Assurance Co. v. Heritage Life Insurance Co. (1978), 43 C.P.R.(2d) 203 at 210-211. The subsequent activities of the opponent establish that the opponent had not abandoned its trade-names as of the applicant's advertisement date as required by Section 17(1) of the Act.

In view of the above, the second ground of opposition remains to be decided on the issue of confusion between the applicant's mark and the opponent's trade-names. The material time for considering the circumstances is as of the applicant's filing date in

accordance with the wording of Section 16(3) of the Act. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion set forth in Section 6(3) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The applicant's mark and the opponent's trade-names are all inherently distinctive. There is no evidence of use of the applicant's mark as of the material time. Thus, I must conclude that it had not become known at all in Canada as of that time. As discussed, the opponent's business activities conducted in association with its trade-names were minimal prior to the applicant's filing date. The opponent sought to rely on a possible Canadian reputation in view of restaurant activities in Florida by the opponent's American licensor Mr. Grumpps Restaurant and Emporium Inc. However, the opponent's evidence is insufficient to establish any such reputation. Thus, based on the opponent's own activities, I can only ascribe a very limited reputation for its trade-names in Toronto as of the material time.

The length of time the mark and names have been in use is not a significant factor in the present case. The opponent's business activities were directed to the establishment of a restaurant, that being one of the very services for which the applicant is seeking registration. Thus, there would presumably be an overlap in the trades of the parties. The applicant's mark and the opponent's trade-name Mr. Grumpps are identical in all respects. The applicant's mark and the opponent's trade-name Mr. Grumpps Restaurant and Emporium Limited bear a high degree of resemblance.

I have considered that the test for confusion is to be applied as a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the services and trades of the parties and the similarities between the mark and the names, I find that the applicant has failed to satisfy the onus on it to show that its proposed trade-mark MR. GRUMPPS is not confusing with the opponent's trade-names. The second ground of opposition is therefore successful and the first ground need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 31st DAY OF January, 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.