

**IN THE MATTER OF AN OPPOSITION  
by White Spot Limited to application  
no. 1226098 for the trade-mark THE V  
SPOT & Design filed by 635839 Ontario Inc.**

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On August 5, 2004, the entity 635839 Ontario Inc. filed an application to register the trade-mark THE V SPOT & Design, illustrated below:

The logo for 'the V spot' is displayed in a bold, lowercase, sans-serif font. The word 'the' is in a smaller size than 'V spot'. The letter 'V' is significantly larger and more prominent than the other letters. The word 'spot' is in the same size as 'the'. The 'o' in 'spot' is filled with a dark grey color, while the other letters are black.

The application is based on proposed use of the mark in Canada in association with numerous wares and services including:

wares

(1) publications such as magazines, (2) on-line publications, (3) printed matter such as greeting cards, (4) clothing such as shirts, (5) textile articles such as tablecloths, (6) gardening supplies such as gardening tools, (7) novelty items such as shot glasses, (8) other items such as backpacks,

services

(1) restaurant services, namely the operation of restaurants engaging exclusively in the sale of vegetarian food, (2) consulting services for vegetarian food, (3) catering services, (4) entertainment services such as shows about cooking, (5) operation of an Internet website providing on-line chat, (6) on-line magazine concerning vegetarian cuisine, (7) retail services selling vegetarian food, (7) cooking demonstrations.

The application disclaims the exclusive right to the use of the word SPOT apart from the mark as a

whole.

The application was advertised for opposition purposes in the *Trade-marks Journal* issue dated April 6, 2005, and was opposed by White Spot Limited on July 15, 2005. A copy of the statement of opposition was forwarded by the Registrar of Trade-marks to the applicant, on August 11, 2005, as required by Section 38(5) of the *Trade-marks Act*. The applicant responded by filing and serving a counter statement.

The opponent's evidence in chief consists of the affidavit of Alan Howie, Vice President of Operations for the opponent company. The applicant elected not to file any evidence. The opponent was subsequently granted leave to file and serve additional evidence namely, the affidavit of Paul Rohrwasser. Both parties filed written arguments, however, only the opponent attended at an oral hearing.

#### OPPONENT'S EVIDENCE

Mr. Howie's evidence may be summarized as follows. The opponent is headquartered in Vancouver, British Columbia and has been in the restaurant business for over 75 years. The opponent is the owner of 17 trade-mark registrations including two registrations for the word mark WHITE SPOT and several registrations wherein the words WHITE SPOT comprise a dominant feature of the mark, as shown below:



The opponent presently operates restaurants at over 60 locations in Canada. More than 13 million persons dine each year at a WHITE SPOT restaurant. The opponent operates fifty eight full service restaurants in Canada under the mark WHITE SPOT LEGENDARY RESTAURANT & Design (illustrated above) and also operates fast food take-out outlets under the mark TRIPLE O'S BY WHITE SPOT & Design (illustrated above).

Sales under the opponent's marks amounted to \$125 million for the fiscal year 2002, increasing steadily to \$155 million for the fiscal year 2006. The opponent has expended about \$9 million in marketing and advertising its WHITE SPOT restaurant services. Exhibit material attached to Mr. Howie's affidavit show representative examples of advertisements in Vancouver newspapers for the opponent's WHITE SPOT restaurants. Other marketing is done via a website, on television, and sponsoring the 2006 World Junior Hockey Championship.

Mr. Rohrwasser testifies that the opponent has been catering to vegetarian customers for many years by offering vegetarian pastas, salads and veggie burgers. In excess of 330,000

Chargrilled Vegetarian Burgers were sold in the years 2004-2006.

MAIN ISSUE

Various grounds of opposition are pleaded in the statement of opposition, however, the main issue is whether the applied for mark THE V SPOT & Design is confusing with the opponent's mark WHITE SPOT registered for use in association with, among other things, restaurant services. The material date to assess the issue of confusion is the date of my decision with respect to the ground of opposition pursuant to Section 12(1)(d) of the *Trade-marks Act* alleging non-registrability: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.).

The legal onus is on the applicant to show that there would be no reasonable likelihood of confusion, within the meaning of Section 6(2) of the *Trade-marks Act*, between the applied for mark THE V SPOT & Design and the opponent's mark THE WHITE SPOT. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Trade-marks Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade;

the degree of resemblance in appearance or the sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

#### SECTION 6(5) FACTORS

The opponent's mark WHITE SPOT possesses a fair degree of inherent distinctiveness as the mark is not descriptive or suggestive of restaurant services. Similarly, the applied for mark THE V SPOT & Design possesses a fair degree of inherent distinctiveness. Based on the evidence of record, I am able to conclude that the opponent's mark has acquired a significant reputation in the province of British Columbia. There is no evidence that the applied for mark has acquired any reputation anywhere in Canada. The length of time that the marks in issue have been in use clearly favours the opponent. With respect to the nature of the parties' services and trades, the opponent submits at paragraph 19 of its written argument that "As is evident from the description of the wares and services in the Application, White Spot and the Applicant are both in the restaurant services businesses and, it is submitted, they are clearly potential competitors in the Canadian market." I agree with the opponent's above submission.

In my view, there is an overall resemblance between the parties' marks visually, aurally and in ideas suggested given that the first component of the applied for mark namely, the term THE, and the second component namely, the letter V, are fairly non-distinctive. That is, I find that

the parties' marks in their entireties resemble each other at least as much as they differ from each other.

DISPOSITION

Having regard to the above, I find that the applicant has not shown, on a balance of probabilities, that there is no reasonable likelihood of confusion between the applied for mark THE V SPOT & Design and the opponent's mark WHITE SPOT at the material date which is the date of my decision. Accordingly, the application is refused.

DATED AT VILLE DE GATINEAU, QUEBEC, THIS 13th DAY OF JANUARY, 2009.

Myer Herzig,  
Member,  
Trade-marks Opposition Board