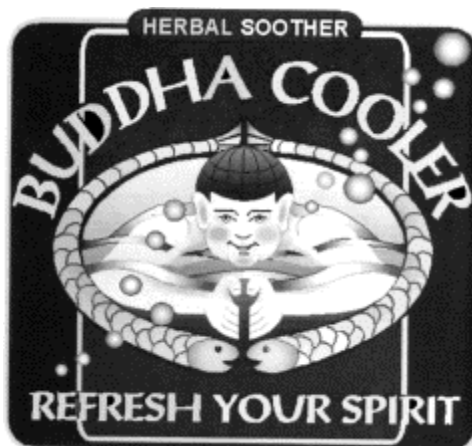


LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 51
Date of Decision: 2012-02-28

**IN THE MATTER OF OPPOSITIONS by
George V Eatertainment to application
Nos. 1,361,125 and 1,361,127 for the trade-
marks BUDDHA COOLER and BUDDHA
COOLER & Design respectively, in the name
of Randall S. West**

[1] On August 24, 2007, Randall S. West (the Applicant) filed applications to register the trade-marks BUDDHA COOLER and BUDDHA COOLER & Design (shown below) (hereinafter collectively referred to as the Marks) based on proposed use of the Marks in Canada in association with “non alcoholic beverages, namely, fruit-based soft drinks flavoured with tea”:



[2] The applications were advertised for opposition purposes in the *Trade-marks Journal* of August 6, 2008.

[3] On December 22, 2008, George V Eatertainment (the Opponent) filed identical statements of opposition against each application. The statements of opposition claim that the applications do not conform to the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act); that the Marks are not registrable pursuant to s. 12(1)(d) of the Act; that they are non-distinctive of the Applicant pursuant to s. 2 and 38(2)(d) of the Act; and that the Applicant is not the person entitled to registration of the Marks pursuant to s. 16 of the Act. The Opponent claims that the Marks are confusing with the Opponent's trade-marks that are the subject of the following trade-mark registration and applications in Canada:

- BUDDHA-BAR - TMA662,480 registered on April 11, 2006, based on use and registration of the BUDDHA-BAR trade-mark in France in association with the following wares and services:

(1) Parfums, savons, huiles essentielles, nommément parfums destinés à une utilisation personnelle, lotions pour les cheveux, dentifrices.

(2) Joaillerie, bijouterie, horlogerie, instruments chronométriques, nommément montres, chronomètres, pendules, réveils matins, vaisselle en métaux précieux; journaux, magazines, livres, papeterie, nommément cartes postales, photographie, stylos, crayons; ustensiles et récipients pour le ménage ou la cuisine, nommément spatules, fourchettes, couteaux, cuillères, casseroles, baguettes; vaisselle non en métaux précieux, nommément assiettes, plats, vases, seaux à champagne, verres à boire.

(1) Services de restauration (alimentation).

- BUDDHA-BAR - application No. 1,151,620 filed on September 3, 2002, based on use of the BUDDHA-BAR trade-mark in Canada since at least as early as June 30, 2000 in association with the following wares and services:

(1) Disques compacts, nommément séries de compilations de musique du monde, lounge et electro.

(1) Divertissement, nommément concerts de musique en direct, production et édition musicale, nommément enregistrement et production audio et production de disques, service de discothèque, services d'impresario, location d'enregistrements sonores, montage de programmes radiophoniques et de télévision, services d'orchestres, production de spectacle, nommément de concerts de musique, services de studio d'enregistrement.

- BUDDHA-BAR HOTEL - application No. 1,273,448 filed on September 26, 2005, based on proposed use of the BUDDHA-BAR HOTEL trade-mark in Canada in association with the following services:

Hotels; motels; restaurants; bar services; catering (food and drink); hotel reservations; reservation (temporary accommodation); seaside resorts (accommodation and restaurant); rental of temporary accommodation; temporary accommodation reservation and rooms of reception; accommodation bureaux (hotels, boarding houses).

- BUDDHA-BAR - application No. 1,282,207 filed on December 7, 2005, based on proposed use of the BUDDHA-BAR trade-mark in Canada in association with the following services:

Restaurants services, bars services, hotels services.

[4] The Applicant filed and served a counter statement in each case in which he denies the Opponent's allegations.

[5] As its evidence in each case, the Opponent filed certified copies of registration No. TMA662,480 and application Nos. 1,151,620; 1,273,448; and 1,282,207. In support of each of his applications, the Applicant filed the affidavit of Kristi Zychowka, a lawyer with the law firm representing the Applicant in the instant proceeding, sworn October 17, 2009.

[6] Only the Applicant filed a written argument in each case. An oral hearing was requested by the Opponent but ultimately was not held because both parties decided not to participate.

Onus

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that his applications comply with the requirements of the Act. However, there is an initial evidentiary 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[8] Applying these principles to the instant cases, the only grounds of opposition the Registrar must decide on are those based on non-entitlement pursuant to s. 16(3)(b) of the Act,

and non-registrability of the Marks pursuant to s. 12(1)(d) of the Act. The s. 30 grounds of opposition as well as the non-distinctiveness ground of opposition and the other s. 16 grounds of opposition can be summarily dismissed as follows:

- All of the s. 30 grounds of opposition as pleaded by the Opponent in Part C, Paragraph 1 (including subparagraphs 1.1 to 1.4.3) of each of the statements of opposition are dismissed as the Opponent has failed to meet its initial evidentiary burden in respect thereof. I do not wish to discuss in detail each and every of the specific s. 30 grounds of opposition as pleaded by the Opponent. Suffice it to say that as stressed by the Applicant, the Opponent adduced no evidence in support of any of the s. 30 grounds that have been pleaded. There is no evidence whatsoever that puts into issue the correctness of the proposed use basis claimed in each of the Applicant's applications or the correctness of the other statements made in the Applicant's applications;
- The s. 16(3)(a) ground of opposition as pleaded by the Opponent in each case is dismissed as the Opponent has failed to show that as of the date of filing of the Applicant's applications, its trade-mark BUDDHA-BAR had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant's applications [s. 16(5) of the Act]. The Opponent has not filed any evidence of use of its BUDDHA-BAR trade-mark. The mere existence of registration No. TMA662,480 can establish no more than *de minimis* use of the Opponent's trade-mark [see *Entre Computer Centers, Inc. v. Global Upholstery Co.* (1992), 40 C.P.R. (3d) 427 (T.M.O.B.)]. Such use does not meet the requirements of s. 16 of the Act [see *Rooxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) (T.M.O.B.)]; and
- The non-distinctiveness ground of opposition as pleaded by the Opponent in each case is dismissed as the Opponent has failed to show that as of the filing date of the statements of opposition its BUDDHA-BAR trade-mark had become known to some extent at least to negate the distinctiveness of the Marks [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. Again, the Opponent has not filed any evidence demonstrating the extent to which its BUDDHA-BAR trade-mark has become known in

Canada.

[9] Before turning to the non-registrability ground pursuant to s. 12(1)(d) and the non-entitlement ground pursuant s. 16(3)(b), I note that the Opponent has also pleaded under the introductory paragraph of s. 16(3) of the Act that the applications do not conform to the requirements of s. 30 of the Act, that the Marks are not registrable or do not function as trade-marks, and that each application is not for a proposed trade-mark but a mark that is being used. I am of the view that such pleading does not raise a valid ground of opposition. Such pleading would be more appropriately raised under s. 38(2)(a) (non-compliance with s. 30 of the Act) discussed above, or s. 38(2)(b) (non-registrability pursuant to s. 12(1)(d) of the Act) discussed below. Accordingly, the ground of opposition based on the introductory paragraph of s. 16(3) of the Act is dismissed in each case.

Section 12(1)(d) ground of opposition

[10] The Opponent has pleaded that the Marks are not registrable having regard to the provisions of s. 12(1)(d) of the Act in that they are confusing with the Opponent's trade-mark BUDDHA-BAR identified above, which was registered on April 11, 2006 under No. TMA662,480. I have exercised the Registrar's discretion to confirm that such registration is in good standing as of today's date.

[11] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Marks and the Opponent's BUDDHA-BAR trade-mark.

[12] 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.

[13] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have 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. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.)].

a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[14] The parties' marks are both made up of the word "BUDDHA" combined with another word.

[15] As I may refer myself to dictionaries to determine the meaning of a word, I have looked into the *Canadian Oxford Dictionary* and found the following definition for the word "BUDDHA": "*n.* a title given to successive teachers (past and future) of Buddhism, although it usually denotes the founder of Buddhism, Siddhartha Gautama."

[16] I assess the inherent distinctiveness of the parties' marks as about the same and relatively moderate considering the descriptive character of each of the words "COOLER" and "BAR" in the context of the Applicant's beverages and the Opponent's restaurant services respectively. Indeed, the definitions of the word "BAR" provided for in the *Canadian Oxford Dictionary* include the following: "a counter in a pub, restaurant, or home across which alcohol or refreshments are served"; "a room in a restaurant, hotel, etc., in which customers may sit and drink"; "an establishment serving alcoholic drinks; a pub". The definitions of the word "COOLER" include the following: "a mixture of wine or liquor and soda water, often with a fruit flavour".

[17] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. However, as indicated above, there is no evidence that the Opponent's BUDDHA-BAR trade-mark has been used or become known to any extent whatsoever in Canada. There is also no evidence that the Applicant's proposed Marks have been used or become known in Canada.

[18] In view of the foregoing, the overall consideration of the inherent distinctiveness of the parties' marks and the extent to which they have become known does not significantly favour either party.

b) the length of time the trade-marks have been in use

[19] In view of my comments above, this factor also does not significantly favour either party. As indicated above, the mere existence of registration No. TMA662,480 can establish no more than *de minimis* use of the Opponent's trade-mark.

c) the nature of the wares, services or business; and d) the nature of the trade

[20] As for the nature of the wares and the nature of the trade, I must compare the Applicant's statements of wares with the statement of wares and services in the Opponent's registration [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); and *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)].

[21] The Applicant's applications cover "non alcoholic beverages, namely, fruit-based soft drinks flavoured with tea" whereas the Opponent's registration covers:

[TRANSLATION taken from the *Trade-marks Journal*] (1) Perfumes, soaps, essential oils, namely perfumes for personal use, hair lotions, dentifrices. (2) Jewelry, jewels, timepieces, chronometric instruments, namely watches, stop watches, wall clocks, alarm clocks, dinnerware made of precious metals; newspapers, magazines, books, stationery, namely postcards, photography, pens, pencils; utensils and containers used in the household or the

kitchen, namely spatulas, forks, knives, spoons, pots and pans, sticks; dinnerware not made of precious metals, namely plates, dishes, vases, champagne buckets, drinking glasses. Catering services (food).

[22] Except arguably for the Opponent's wares and services identified as "*verres à boire*" (drinking glasses) and "*services de restauration (alimentation)*" (catering services (food) / restaurant services), the parties' marks cover completely different and unrelated wares. The only tenuous connection between the parties' respective wares and services is that the Opponent allegedly offers catering / restaurant services and sells drinking glasses, and that various beverages are served in restaurant establishments. Even then, the parties' channels of trade remain different. Indeed, in the absence of evidence to the contrary, it is fair to assume that the Applicant's non alcoholic beverages are to be sold in grocery stores and the like, whereas the Opponent's drinking glasses are likely to be sold within the Opponent's restaurant premises or in retail stores that sell dinnerware.

e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[23] There is some resemblance between the parties' marks owing to the common element "BUDDHA", which evokes the Buddhism philosophy. However, I find that when considered in their entirety, the parties' marks differ visually and orally as well as in the ideas suggested by them, as explained below.

[24] Indeed, as mentioned above, the word "BAR" in the context of the Opponent's services is descriptive. As such, the idea suggested by the Opponent's mark is that of a somewhat "Zen" restaurant encompassing a bar. By comparison, the combination of the words "BUDDHA" and "COOLER" in the context of the Applicant's non alcoholic beverages evokes the fanciful idea of "holistic" refreshing beverages, especially when the BUDDHA COOLER & Design mark is considered.

Additional surrounding circumstances

[25] As a surrounding circumstance, the Applicant argues that the use of "BUDDHA" and

variations of that name is ubiquitous in Canada, even in association with food products and restaurant services. This brings me to comment on the state of the register evidence and distinctiveness character search submitted by way of the Zychowka affidavit.

[26] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[27] Ms. Zychowka states in her affidavit that she conducted a search of the on-line Canadian Trade-marks Database to locate trade-marks registered or pending that include the word “BUDDHA” or variants of that word and that she narrowed that search down to find applications and registrations that cover wares or services including food items, beverages, restaurant services or night club services, excluding those of the Opponent. She attaches as Exhibits A to G to her affidavit the printouts of the seven search results that resulted. Upon review of these exhibits, I note that two of these registrations, namely SMILIN’ BUDDHA CABARET and SMILIN’ BUDDHA CABARET & Design are owned by the same entity. I also note that the application for the trade-mark BUDDHA DOG has not yet been allowed for registration. I further note that two of the registrations revealed by Ms. Zychowka’s search are for design marks that do not include the word BUDDHA *per se*, but rather a representation of a man seated or a religious figure. Considering the low number of pertinent allowed applications or registrations revealed (that is less than four), I find that little can be inferred from Ms. Zychowka’s state of the register search as to the state of the marketplace.

[28] Turning to the other searches conducted by Ms. Zychowka, Ms. Zychowka attaches as Exhibit H to her affidavit, the results of her search of the website of the Yellow Pages Group at www.yellowpages.ca. More particularly, Ms. Zychowka states that she searched for business

names that include the keyword “BUDDHA” in four large Canadian cities, namely Toronto, Edmonton, Calgary and Vancouver. She further attaches as Exhibits I, J and K respectively a copy of the websites found at *www.smilingbuddhabar.com*; *www.buddhasveggie.com*; *www.buddhasveggie.com/history.html*; *www.buddhasveggie.com/gallery.html*; and *http://buddhafooda.com*. Upon review of Exhibits H, I, J and K, I note that the word BUDDHA would appear to be found in numerous business names or trade-names. While a certain number of these business names or trade-names seem to be attached to restaurants or the like, namely “Bamboo Buddha Chinese Restaurant”; “Buddha’s Vegetarian Foods”; “Buddha’s Veggie Restaurant”; “Smiling Buddha” and “Buddha Dog” (these latter two trade-names would appear to correspond respectively to the SMILIN’ BUDDHA CABARET and SMILIN’ BUDDHA CABARET & Design trade-mark registrations and BUDDHA DOG trade-mark application revealed by Ms. Zychowka’s state of the register search discussed above), it is impossible to determine the extent to which these names have actually been used in Canada as trade-names or trade-marks. Furthermore, the low number of pertinent business names or trade-names revealed by Ms. Zychowska’s search does not enable me to infer that there are numerous restaurants in Canada operating under a trade-name or trade-mark that includes the word “BUDDHA”. In any event, I do not consider that additional circumstance necessary in order to find in the Applicant’s favour.

Conclusion regarding the likelihood of confusion

[29] Having considered all the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between the parties’ marks. Indeed, I find that the differences existing between the parties’ marks in appearance, sound, and in the ideas suggested by them combined with the differences existing in the exact nature of their associated wares and services and corresponding channels of trade are sufficient enough to avoid a likelihood of confusion.

[30] Accordingly, the s. 12(1)(d) ground of opposition is dismissed in each case.

Section 16(3)(b) ground of opposition

[31] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Marks pursuant to s. 16(3)(b) of the Act on the basis that as of the date of filing of the Applicant's applications, the Marks were confusing with the Opponent's BUDDHA-BAR and BUDDHA-BAR HOTEL trade-marks in respect of which applications for registration had been previously filed in Canada, namely application Nos. 1,273,448; 1,151,620; and 1,282,207.

[32] The Opponent has met its initial evidentiary burden with respect to this ground as its applications were filed prior to the date of filing of the Applicant's applications [s. 16(3)(b)], and were pending when the Applicant's applications were advertised, as required by s. 16(4) of the Act.

[33] As the Opponent's evidentiary burden has been satisfied, the Applicant has the legal onus to establish that there was no reasonable likelihood of confusion within the meaning of s. 6(2) of the Act between the marks at issue as of the filing date of his applications.

[34] The difference in relevant dates does not substantially affect my analysis above under the s. 12(1)(d) ground of opposition. As the wares and services covered by application No. 1,151,620 are completely different from and unrelated to the wares covered by the Applicant's applications, the Applicant's case is even stronger than it is under s. 12(1)(d) of the Act. The Applicant's case is also even stronger than it is under s. 12(1)(d) when the Opponent's BUDDHA-BAR HOTEL trade-mark covered by application No. 1,273,448 is considered given the more important differences existing between the marks in appearance, sound and the ideas suggested by them owing to the addition of the word HOTEL. As for the Opponent's BUDDHA-BAR trade-mark covered by application No. 1,282,207, I still find that the differences existing between the parties' marks and the nature of the parties' wares and services are sufficient to avoid a likelihood of confusion. Thus, I find that the Applicant has satisfied his burden to show that there was not a reasonable likelihood of confusion between the marks as of the filing date of the Applicant's applications.

[35] Accordingly, the s. 16(3)(b) ground of opposition is also dismissed in each case.

Disposition

[36] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the oppositions pursuant to s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office