



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

Citation: 2011 TMOB 41
Date of Decision: 2011-03-07

**IN THE MATTER OF AN OPPOSITION
by Memphis Blues Barbeque House Ltd.
to application No. 1,301,859 for the trade-
mark MEMPHIS BBQ & WICKED
WINGS in the name of T.J.C. Rombos
Investments Inc.**

[1] On May 16, 2006, 405379 Ontario Limited, a legal entity, t.a. Memphis BBQ & Wicked Wings (the Original Applicant) filed an application to register the trade-mark MEMPHIS BBQ & WICKED WINGS (the Mark). The application is based on proposed use of the Mark in Canada in association with headwear, namely, toques, baseball caps; clothing, namely, t-shirts, sweatshirts. The application is also based on use of the Mark in Canada in association with restaurant services since at least as early as March 1, 2006. The right to the exclusive use of the words MEMPHIS BBQ and WINGS has been disclaimed with respect to the services only, apart from the Mark.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 13, 2007.

[3] On November 9, 2007, Memphis Blues Barbeque House Ltd. (the Opponent) filed a statement of opposition. The Original Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[4] In support of its opposition, the Opponent filed the affidavit of George Siu, sworn December 12, 2008 (Siu Affidavit #1).

[5] On May 12, 2009, an assignment of the application was recorded in favour of T.J.C. Rombos Investments Inc. (Rombos Investments). The Original Applicant and its successor-in-title, Rombos Investments, will be referred to collectively as the Applicant.

[6] In support of its application, the Applicant filed the affidavits of Carla Edwards and Chris Rombos, sworn June 29, 2009 and July 9, 2009 respectively.

[7] As reply evidence, the Opponent filed a second affidavit of George Siu (Siu Affidavit #2) and the affidavit of Megan Sargent, both sworn August 10, 2009.

[8] No cross-examinations were conducted.

[9] Each party filed a written argument. An oral hearing was not requested.

Summary of Grounds of Opposition and Applicable Material Dates

[10] The Opponent has pleaded nine grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), which are summarized below:

1. pursuant to s. 38(2)(a), the application does not comply with s. 30(b) in that the Applicant has not used the Mark for the claimed services since the date stated in the application;
2. pursuant to s. 38(2)(a), the application does not comply with s. 30(i) in that the Applicant cannot be satisfied that it is entitled to use the Mark in association with the services listed in the application because the Mark “is confusingly similar with the Opponent’s trade-mark registration for MEMPHIS BLUES BARBEQUE HOUSE and the services of the Opponent are sold in the same field of use as those of the applicant, namely restaurant services”;
3. pursuant to s. 38(2)(b), the Mark is not registrable because, contrary to s. 12(1)(d), it is confusing with the trade-mark MEMPHIS BLUES BARBEQUE HOUSE, registered and used in Canada by the Opponent in association with identical services sold through identical channels of trade;
4. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, in view of s. 16(1)(a), at the time the Applicant first used its Mark, the Mark was confusing with the trade-mark MEMPHIS BLUES

BARBEQUE HOUSE, which had been previously used in Canada by the Opponent for restaurant services;

5. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, in view of s. 16(1)(b), at the time the Applicant first used its Mark, the Mark was confusing with the trade-mark MEMPHIS BLUES BARBEQUE HOUSE, for which an application for registration had been previously filed in Canada by the Opponent for restaurant services;
6. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, in view of s. 16(1)(c), at the time the Applicant first used its trade-name [*sic*], the Mark was confusing with the trade-name MEMPHIS BLUES BARBEQUE HOUSE, which had been previously used in Canada by the Opponent for restaurant services;
7. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, in view of s. 16(3)(a), at the date of filing of the application, the Mark was confusing with the trade-mark MEMPHIS BLUES BARBEQUE HOUSE, which had been previously used in Canada by the Opponent for clothing;
8. pursuant to s. 38(2)(c), the Applicant is not the person entitled to registration of the Mark because, in view of s. 16(3)(c), at the date of filing of the application, the Mark was confusing with the well known trade-name MEMPHIS BLUES BARBEQUE HOUSE that had been previously used in Canada by the Opponent;
9. pursuant to s. 38(2)(d), the Mark is not distinctive of the Applicant because it does not actually distinguish, nor is it adapted so to distinguish the wares and services of the Applicant from the wares or services of the Opponent as used in association with its trade-mark and trade-name MEMPHIS BLUES BARBEQUE HOUSE.

[11] The material dates with respect to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [*Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 12(1)(d) - 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.)];
- s. 16(1) - the Applicant's claimed date of first use;
- s. 16(3) - the filing date of the application;

- s. 2 - the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Onus

[12] 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].

Summary of Evidence

Siu Affidavit (#1)

[13] Mr. Siu, the Opponent's President, provides the following information in his first affidavit:

- The Opponent, based in Vancouver, provides restaurant and catering services.
- The Opponent owns registration No. TMA599,073 for MEMPHIS BLUES BARBEQUE HOUSE (see Exhibit "A"); the registration claims use in association with restaurant and catering services since at least as early as August 31, 2001 and disclaims the right to the exclusive use of BARBEQUE apart from the mark.
- "MEMPHIS BLUES BARBEQUE HOUSE is the primary brand for [the Opponent] and has been used with restaurant and catering services since at least as early as August 31, 2001." (Mr. Siu simply makes this bald statement, without providing any evidence of use as of that date.)
- The Opponent operates a website at www.memphisbluesbbq.com which is accessible across Canada and which prominently displays the MEMPHIS BLUES BARBEQUE HOUSE trade-mark (see Exhibit "B", which consists of one page and is undated except for a design date of 2008).

- The Opponent provides customers with takeaway menus that display its mark, to advertise its services (see Exhibit “C”, which is undated).
- The Opponent distributes advertising leaflets that display its mark (see Exhibit “D”, which consists of one page and is undated).
- The Opponent sells a book of its recipes “at the counter of each restaurant to make consumers aware of its restaurant and catering business” (see Exhibit “E”, which consists of two undated pages).

Rombos Affidavit

[14] Mr. Rombos, the President of Rombos Investments, provides the following information:

- The Applicant has used the Mark in Canada since March 1, 2006 in association with restaurant services, take-out services and catering services. (Mr. Rombos simply makes this bald statement, without providing any evidence of use as of that date.)
- Rombos Investments owns and licenses the Mark and in accordance with a licence agreement it maintains care and control over the nature and quality of the wares and services performed by its licensee at the property using the Mark; this has been so since Rombos Investments licensed its property on April 1, 2009. (Mr. Rombos has not provided the name of the licensee.)
- From March 1, 2006 to July 9, 2009, restaurant sales in Canada in association with MEMPHIS BBQ & WICKED WINGS have been at least 1.4 million dollars (annual figures also provided).
- A photograph showing the Mark displayed on the exterior of a restaurant located in Woodbridge, Ontario has been provided as Exhibit “A” (the signage includes a reference to 2007).
- A take-out menu displaying the Mark, representative of those offered by the Applicant since March 1, 2006, has been provided as Exhibit “B”.

- “Write-ups” about the Applicant’s business, that refer to its Mark, have appeared in 2007 in the *Toronto Life* magazine and the *National Post* newspaper (see Exhibit “C”).
- An on-line blog, dated 2009, concerning the Applicant’s Mark and services has been provided as Exhibit “D”.
- Continuous since prior to opening its restaurant, the Applicant has advertised in regional newspapers; four invoices dated 3/3/06, 3/26/06, 3/10/06 and 4/30/06 for advertising expenditures for advertisements in regional newspapers for the MEMPHIS BBQ & WICKED WINGS restaurant have been provided (see Exhibit “E”).
- An Internet ad, from 2009, featuring the Applicant’s Mark has been provided as Exhibit “F”.
- From March 1, 2006 to July 9, 2009, advertising expenditures in Canada in association with the MEMPHIS BBQ & WICKED WINGS restaurant have exceeded \$12,000 (annual figures also provided).

Edwards Affidavit

[15] Ms. Edwards, a secretary employed by the Applicant’s agents, provides the following information:

- Information about “Memphis-style barbecue” obtained from the Internet (see Exhibits “A”, “C” and “D”); these pages indicate that Memphis, Tennessee is known for a particular style of barbeque and is the home to a world championship barbecue cooking contest.
- Information about “Memphis blues” obtained from the Internet (see Exhibit “B”); these pages indicate that Memphis blues is a style of blues music that originated in the Memphis area.

- Listings from www.canada411.ca from June 24, 2009 for telephone numbers for “Memphis Mike’s BBQ” caterer and “Memphis Smoke House” restaurant (see Exhibits “E” and “F”).

Sargent Affidavit

[16] Ms. Sargent, a legal assistant at the Opponent’s agency firm, in reply to the Edwards affidavit provides the following information, all of which she obtained on August 10, 2009:

- Results of a search conducted of the Canadian Intellectual Property Office’s online trade-marks database for the word MEMPHIS in the TM Lookup and ‘restaurant’ for services (see Exhibit “A”); only two active marks were located, namely those of the parties.
- Results of a Google search for the term ‘memphis barbeque’ limited to ‘pages from Canada’ (see Exhibit “B”); only the first 10 of about 25,600 results were provided – the first is a long list of businesses specializing in barbeque near Memphis, Tennessee; the second, third, and fifth through tenth are listings related to the Opponent’s MEMPHIS BLUES BARBEQUE HOUSE; the fourth is a listing for the Applicant’s MEMPHIS BBQ & WICKED WINGS.
- Results of a Google search for the term ‘memphis barbeque Canada’ (see Exhibit “C”); only the first 10 of about 17,300 results were provided – the first is a listing for MEMPHIS BLUES BARBEQUE HOUSE; the second is a listing for MEMPHIS BBQ & WICKED WINGS; the third is an article from www.foodtv.ca entitled The Memphis Barbecue Tour, which refers to Memphis as one of America’s greatest barbecue towns; the fourth is a list of businesses near Memphis, Tennessee; the next four refer to the Opponent’s MEMPHIS BLUES BARBEQUE HOUSE; the penultimate record, which concerns a BBQ caterer in Kelowna, explains the term Memphis barbecue; the last is a recipe for Easy Memphis-style Barbecued Pork Spareribs.
- Results of a Canada411.ca search for ‘Memphis’ under ‘business name’ and ‘Canada’ under ‘location’ (see Exhibit “D”); although the search produced 21 results,

only the first 13 have been provided – in addition to multiple listings for Memphis Blues Barbeque House, there are listings for a tavern called Little Memphis Cabaret, a restaurant called Memphis Belle, another restaurant called Memphis Belles, another restaurant called Memphis BBQ, and another restaurant called Memphis Blues Bbq.

- Results of a Canada411.ca search for ‘Memphis barbeque’ under ‘business name’ and ‘Canada’ under ‘location’ (see Exhibit “E”); nine listings were reported for businesses serving Canada – five for Memphis Blues Barbeque House; one for Memphis BBQ; two for Memphis Blues Bbq; and one for Memphis Mike’s BBQ (the last is identified as a caterer, the rest as restaurants).

Siu Affidavit (#2)

[17] Mr. Siu begins his second affidavit by stating that it is in reply to Mr. Rombos` affidavit. However, I agree with the Applicant’s submission that this affidavit is not proper reply evidence. The second Siu affidavit provides i) copies of a cease and desist letter and follow-up letter sent by the Opponent to the Applicant and ii) information and exhibits concerning the use or reputation of the Opponent’s mark. The evidence contained in the second Siu affidavit ought to have been introduced as evidence-in-chief or pursuant to leave obtained under r. 44(1) of the *Trade-marks Regulations*, SOR/96-195. I am therefore disregarding the second Siu affidavit in its entirety because the manner in which it was introduced makes it inadmissible. [See *London Life Insurance Co. v. Manufacturers Life Insurance Co.* (1996), 67 C.P.R. (3d) 563 (T.M.O.B.), affd 87 C.P.R. (3d) 229 (F.C.T.D.).]

Grounds to be Dismissed on the Basis that the Opponent has not Met its Initial Burden

[18] In its written argument, the Opponent has only made submissions concerning its s. 12(1)(d) and 30(b) grounds of opposition. While it is not clear that the Opponent is withdrawing the remainder of its grounds, they can all be dismissed on the basis that the Opponent has not met its initial burden in respect thereof. In particular:

- the s. 30(i) ground fails because there is no evidence of bad faith on the part of the Applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155];
- the s. 16(1)(a) ground fails because there is no admissible evidence showing use of the Opponent's trade-mark prior to March 1, 2006;
- the s. 16(1)(b) ground fails because there is no evidence that an application was pending for the Opponent's trade-mark as of March 1, 2006 (if the Opponent intended to rely on the application that issued to registration as TMA599,073, that application was not pending as of the material date as it issued to registration on January 12, 2004: see s. 16(4) and *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528);
- the s. 16(1)(c) ground fails because there is no admissible evidence showing use of the Opponent's trade-name prior to March 1, 2006;
- the s. 16(3)(a) ground fails because there is no admissible evidence showing use of the Opponent's trade-mark prior to May 16, 2006;
- the s. 16(3)(c) ground fails because there is no admissible evidence showing use of the Opponent's trade-name prior to May 16, 2006;
- the distinctiveness ground fails because the Opponent's admissible evidence does not show that its trade-mark or trade-name had a substantial, significant or sufficient reputation in Canada as of November 9, 2007 [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

I note that the statement of use in the Opponent's registration is not sufficient to meet the initial onus on the Opponent under the grounds of opposition of entitlement and distinctiveness [see *Roxxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.)].

Section 12(1)(d) Ground of Opposition

[19] The Opponent has met its initial burden with respect to this ground because its registration for MEMPHIS BLUES BARBEQUE HOUSE is extant.

[20] 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.

[21] 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.).]

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

[22] Neither mark is inherently strong. Geographic designations, such as MEMPHIS, are not inherently distinctive [see *California Fashion Industries Inc. v. Reitmans (Canada) Ltd.* (1991), 38 C.P.R. (3d) 439 (F.C.T.D.) at para. 13]. Words that describe the type of food served at the parties' restaurants, such as BARBEQUE, BBQ, and WINGS, are also not inherently distinctive. The most distinctive portion of the Opponent's mark is the word BLUES. The most distinctive portion of the Applicant's Mark is the word WICKED. Overall, I consider the parties' marks to possess an equal degree of inherent distinctiveness.

[23] In addition to the geographic meaning of MEMPHIS, there is also some evidence before me that there is a style of barbequing associated with the word Memphis. The Opponent has not

contested this – instead the Opponent has submitted that there is no evidence that Canadians are aware of this meaning.

[24] A trade-mark may acquire distinctiveness through use or promotion. Although Mr. Siu's evidence-in-chief indicates that the Opponent's mark has been used and promoted, the extent to which this has occurred was not provided. On the other hand, Mr. Rombos' evidence enables me to conclude that the Applicant's Mark has acquired a certain degree of distinctiveness. Based on the evidence that has been properly adduced before me, I find that the extent to which the marks have become known favours the Applicant.

length of time each trade-mark has been in use

[25] Based solely on the dates of first use claimed by the parties, a consideration of the length of time that each mark has been in use favours the Opponent. However, in the absence of evidence of continuous use of the Opponent's mark since its claimed date of first use, this is not a particularly significant circumstance.

nature of the wares, services, business or trade

[26] The parties provide the same type of services and there is nothing in their statements of services to indicate that their channels of trade would be restricted in any manner. The nature of the services, business and trade therefore favours the Opponent.

[27] I note however that there is no evidence that the Opponent sells any clothing.

degree of resemblance between the trade-marks

[28] It is a well accepted principle that the first portion of a trade-mark is the most relevant for the purposes of distinction. However, when a word is a common, descriptive or suggestive word, the significance of the first component decreases [see *Conde Nast Publications Inc. v. Union des Editions Modernes* (1979), 46 C.P.R. (2d) 183 (F.C.T.D.); *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.); *Phantom Industries Inc. v. Sara Lee Corp.* (2000), 8 C.P.R. (4th) 109 (T.M.O.B.)].

[29] Since MEMPHIS is a geographic designation, the significance of this shared word is diminished. The main idea suggested by the Applicant's Mark is the type of food one might expect to receive at the associated restaurant. The Opponent's mark also suggests the type of food that one might expect to receive, but the addition of the word BLUES, as part of the term MEMPHIS BLUES, also suggests the ambience of that type of music or, as the Applicant puts it, a barbeque house which features Memphis blues music.

additional surrounding circumstances

i) state of the register and marketplace evidence

[30] The state of the register evidence indicates that no other parties have registered marks that incorporate MEMPHIS within the parties' field. However, the Applicant's evidence has shown that two other entities exist in Canada that use MEMPHIS in the names of businesses that operate within the parties' field (see Edwards affidavit). Moreover, the Opponent's own evidence not only confirms the existence of one of those two businesses but also evidences the existence of at least three other MEMPHIS businesses in Canada that operate within the parties' field (see Sargent affidavit).

conclusion

[31] In the circumstances of this case, I am satisfied that the differences between the marks in appearance, sound and idea suggested are sufficient that confusion between the marks as a whole is not likely. I note that in the case of weak marks, small differences may suffice to distinguish one mark from the other [see for example: *GSW Ltd. v. Great West Steel Industries Ltd. et al.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.); *Associated Brands Inc. v. Scott Paper Ltd.* (2004), 43 C.P.R. (4th) 361 (T.M.O.B.)].

[32] The s. 12(1)(d) ground is therefore dismissed.

Section 30(b) Ground of Opposition

[33] The Opponent submits that the Applicant has not used the Mark since the date claimed for two reasons: i) Ms. Sargent's Canada 411 search found a listing for "Memphis BBQ", not for

“Memphis BBQ & Wicked Wings”; and ii) Exhibits “A” and “B” to Mr. Rombos’ affidavit emphasize the words MEMPHIS BBQ over the words & WICKED WINGS and incorporate design features. However, such evidence does not satisfy the Opponent’s initial burden under s. 30(b). First, the Sargent evidence concerns what appeared (or did not appear) in 2009, whereas the material date is March 1, 2006. Second, the Applicant has applied to register MEMPHIS BBQ & WICKED WINGS without restriction to any specific presentation and the use shown in Mr. Rombos’ Exhibits “A” and “B” qualifies as use of the applied-for trade-mark [in general see *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 and *Registrar of Trade Marks v. Compagnie Internationale Pour L’Informatique CII Honeywell Bull Societe Anonyme et al.* (1985), 4 C.P.R. (3d) 523 (F.C.A.)].

[34] The s. 30(b) ground is accordingly dismissed.

Disposition

[35] 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.

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