



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

Citation: 2012 TMOB 52
Date of Decision: 2012-02-28

**IN THE MATTER OF AN OPPOSITION by
George V Eatertainment to application
No. 1,316,554 for the trade-mark BUDDHA
DOG in the name of Buddha Foodha Inc.**

[1] On September 14, 2006, Buddha Foodha Inc. (the Applicant) filed an application to register the trade-mark BUDDHA DOG (the Mark) based on use of the Mark in Canada since as early as July 1, 2005 in association with the following wares (2) and services, and proposed use of the Mark in association with the following wares (1) (as revised):

Wares (1): Hot dogs, Sauces and Condiments, namely Fruit, Vegetable, Herb, Honey, Maple Syrup, Smokey Ancho Ketchup, Ginger Maple Dijon, Red Pepper Jelly, Sweet Onion, Tomato Basil Balsamic, Indian Butter, Garlic Aioli, Beef Chili, Habanero Aioli, Spicy Jerk, Basil Pesto, Apple Butter, Lime Chil Mango, Raspberry Chipotle, Cherry Ketchup, Chipotle Pepper, Golden Habanero Jelly, Jalapeno Tequila Jelly, Drunken Blueberry, Laundry's Corn Relish, Maple Brandy Ginger Peach, Maple Dijon, Muffalate Mustard, Barley Days Mustard, Tomato Pear Chutney, Tomato Peach Chutney, Smooth Guacamole, Peach Mango Wasabi, Pumpkin Pie, Sun-Dried Tomato Tapenade, Olive 'Muffy' Tapenade, Lime Cilantro Aioli, Rosemary Chicken Gravy, Shallot Marmalade, Green Tomato Relish, Yellow Tomato Relish, Blueberry Julep, Asparagus Pear, Champagne Cassis Dijon, Spicy Peanut, Chocolate Mole, Ivy Ridge Honey Mustard, Hayloft Apple BBQ.

Wares (2): T-shirts.

Services: Dine-in and take-out food and drink services.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of September 5, 2007.

[3] On February 5, 2008, George V Restauration (later changed to George V Eatertainment) (the Opponent) filed a statement of opposition against the application claiming that the application does not conform to the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). The statement of opposition also claims that the Mark is not registrable pursuant to s. 12(1)(d) of the Act, that it is 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 Mark pursuant to s. 16 of the Act. The Opponent claims that the Mark is confusing with the Opponent's word mark BUDDHA-BAR that is the subject of the following trade-mark registration and application in Canada:

- 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).

- 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.

[4] The Applicant filed and served a counter statement denying the Opponent's allegations. The Applicant also requested that the Registrar issue an interlocutory ruling striking portions of

the Opponent's pleadings in the statement of opposition of record as being improper grounds and/or insufficiently pled. As the Opponent filed partial evidence subsequently to the Applicant's request, the Applicant was advised by Office letter dated December 1, 2008 that issues concerning the striking of all or any portion of the Opponent's pleadings would only be considered at the decision stage together with a consideration of the evidence filed.

[5] In support of its opposition, the Opponent filed certified copies of registration No. TMA662,480 and application No. 1,151,620 for its BUDDHA-BAR trade-mark. In support of its application, the Applicant filed the affidavit of Andrew Hunter, Secretary of the Applicant, sworn November 18, 2009.

[6] Only the Applicant filed a written argument. An oral hearing was requested 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 its application complies 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 case, the only grounds of opposition the Registrar must decide on are those based on non-entitlement pursuant to s. 16(1)(b) and (3)(b) of the Act, and non-registrability of the Mark 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 1.9) of the statement 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 at pages 20 and 21 of its written argument, the Opponent adduced no evidence in support of any of the s. 30 grounds that have been pled. There is no evidence whatsoever that puts into issue the correctness of the use and proposed use bases claimed in the Applicant's application or the correctness of the other statements made in the Applicant's application;

- The s. 16(1)(a) and (3)(a) grounds are dismissed as the Opponent has failed to show that as of the material dates stated in s. 16(1)(a) and (3)(a) of the Act respectively, 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 application [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 *Roxxs, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) (T.M.O.B.)]; and
- The non-distinctiveness ground of opposition is dismissed as the Opponent has failed to show that as of the filing date of the statement of opposition its BUDDHA-BAR trade-mark had become known to some extent at least to negate the distinctiveness of the Mark [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 grounds pursuant s. 16(1)(b) and (3)(b), I note that the Opponent has also pleaded under the introductory paragraphs of s. 16(1) and (3) of the Act that the application does not conform to the requirements of s. 30 of the Act, that the Mark is not registrable or does not function as a trade-mark, and that the application is not for a proposed trade-mark but a mark that is being used (or vice versa). I am of the view that such pleading does not raise valid grounds 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 grounds of opposition based on the introductory paragraphs of s. 16(1) and (3) of the Act are dismissed.

Section 12(1)(d) ground of opposition

[10] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of s. 12(1)(d) of the Act in that it is 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 Mark 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, although the inherent distinctiveness of the Opponent's mark is arguably less considering the descriptive character of the word "BAR" in the context of the Opponent's restaurant services. 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".

[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. By contrast, the Applicant's evidence establishes that the Mark has been used and become known to some extent in Canada in association with the applied-for services.

[18] More particularly, the Hunter affidavit establishes that since July 1, 2005, the Applicant has continuously advertised and carried on dine-in and take-out food and drink services in association with the Mark in Canada. Mr. Hunter states that advertising and promotion

expenditures of the Applicant in Canada since July 1, 2005, which are allocated to the advertising of dine-in and take-out food and drink services in association with the Mark are in excess of 50,000 Canadian dollars. He further states that net sales figures of dine-in and take-out food and drink services offered by the Applicant in association with the Mark since July 1, 2005 are in excess of 690,000 Canadian dollars. Among the specimens of advertising materials attached as Exhibit A to the Hunter affidavit, I note photographs of the Applicant's restaurant store front located at 163 Roncesvalles Avenue in Toronto, Ontario, displaying a BUDDHA DOG sign. I further note that the Applicant's restaurant services (which revolve around the sale of "gourmet" or "haute cuisine" hot dogs) have been the subject of numerous articles and restaurant reviews published over the years 2006 to 2009 (that is to the date of the Hunter affidavit) in various magazines and newspapers having circulation in Canada such as *The Globe and Mail*; *The Toronto Star*; *ReaderDigest.ca* magazine; *Edible Toronto* magazine; *The Journal of Porter Airlines*; etc.

[19] 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 favours the Applicant, particularly with respect to the applied-for services.

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

[20] In view of my comments above, this factor also favours the Applicant with respect to the applied-for services.

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

[21] As for the nature of the wares and the nature of the trade, I must compare the Applicant's statement of wares and services 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.)].

[22] As the Applicant's application covers "dine-in and take-out food and drink services" whereas the Opponent's registration covers "[TRANSLATION] restaurant services", I find there is an overlap between the parties' services. In the absence of evidence to the contrary, it is fair to assume that their associated channels of trade also overlap. However, there is no overlap between the parties' respective wares and their associated channels of trade.

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 in the context of the Opponent's services is that of a somewhat "Zen" restaurant encompassing a bar. By contrast, the combination of the words "BUDDHA" and "DOG" in the context of the Applicant's applied-for services evokes the fanciful idea of a purveyor of "holistic" hot dogs. Indeed, most, if not all of the restaurant reviews filed under Exhibit A to the Hunter affidavit discussed above, comment in flattering terms on the Applicant's restaurant concept, which reinvents hot dogs.

Conclusion regarding the likelihood of confusion

[25] Having considered all the surrounding circumstances, I find that there is not a reasonable likelihood of confusion between the parties' marks. While there is an overlap in the parties' services and associated channels of trade, I find that the differences existing between the marks in appearance, sound, and in the ideas suggested by them are sufficient enough to avoid a likelihood of confusion. My finding is reinforced by the fact that the Mark has become known to some extent in Canada, thus enhancing the distinctiveness of the Mark, especially when compared to the Opponent's mark.

[26] Accordingly, the s. 12(1)(d) ground of opposition is dismissed.

Section 16(1)(b) and (3)(b) grounds of opposition

[27] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(b) and (3)(b) of the Act on the basis that as of the material dates stated in s. 16(1)(b) and (3)(b) respectively, the Mark was confusing with the Opponent's BUDDHA-BAR trade-mark in respect of which an application for registration had been previously filed in Canada, namely application No. 1,151,620.

[28] The Opponent has met its initial evidentiary burden with respect to each of these grounds as its application was filed prior to both the date of first use claimed in the Applicant's application [s. 16(1)(b)] and the date of filing of the Applicant's application [s. 16(3)(b)], and was pending when the Applicant's application was advertised, as required by s. 16(4) of the Act.

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

[30] As the wares covered by application No. 1,151,620 are completely different from the wares and services covered by the Applicant's application, the Applicant's case is even stronger than it is under s. 12(1)(d) of the Act. In view of my analysis made above under the s. 12(1)(d) ground of opposition, I find that the Applicant has satisfied its burden to show that there was not a reasonable likelihood of confusion between the marks as of the material dates stated in s. 16(1)(b) and (3)(b) of the Act.

[31] Accordingly, the s. 16(1)(b) and (3)(b) grounds of opposition are also dismissed.

Disposition

[32] In view of the foregoing and 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.

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