



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

Citation: 2014 TMOB 9
Date of Decision: 2014-01-20

**IN THE MATTER OF AN OPPOSITION
by Prime Restaurants Inc. to application
No. 1,459,918 for the trade-mark TIR NA
N'OG in the name of Pacific Vision
Proprietary Ltd.**

[1] Pacific Vision Proprietary Ltd. (the Applicant) has applied-for the trade-mark TIR NA N'OG for use in association with distilled spirits, namely, whiskey, scotch, gin, vodka, and wine. Prime Restaurants Inc. (the Opponent) is an operator and franchisor of restaurants and bars across Canada. It has primarily opposed this application on the basis that the TIR NA N'OG trade-mark is confusing with its registration for and previous use and/or making known of the trade-mark TIR NAN OG in association with the operation of a restaurant and bar.

[2] For the reasons that follow, I find that this application should be refused.

Background

[3] On November 20, 2009, the Applicant filed an application for the trade-mark TIR NA N'OG (the Mark) based on proposed use in association with distilled spirits. The wares were subsequently amended to distilled spirits, namely, whiskey, scotch, gin, vodka, and wine (the Wares). The application was advertised for opposition purposes in the *Trade-marks Journal* of November 2, 2011.

[4] On April 2, 2012, the Opponent opposed the application on several grounds. The Opponent has pleaded non-compliance with section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) as the basis of two of its grounds of opposition. The remaining grounds turn on the determination of the likelihood of confusion between the Opponent's registration No. TMA496,236 for TIR NAN OG for use in association with sweatshirts, t-shirts, hats, jackets, shirts and shorts and operation of a restaurant and bar and its use and/or making known of this trade-mark (see sections 2 and 16 of the Act). The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[5] The Opponent filed as its evidence the affidavit of Jack Gardner, the Vice President of Sales and Marketing for CASEY'S Restaurant and the Pubs Division of the Opponent. The Applicant did not file evidence. Only the Opponent filed a written argument. No hearing was held.

Material Dates and Onus

[6] While various grounds of opposition are pleaded, the determinative issue for decision is whether the applied-for trade-mark TIR NA N'OG is confusing with the opponent's trade-mark TIR NAN OG. The earliest material date to assess the issue of confusion is the date the application was filed, November 20, 2009, while the latest material date is the date of my decision: for a review of material dates in opposition proceedings see *American Assn of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206 - 208 (FCTD).

[7] Before considering the issue of confusion between the parties' marks, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on the opponent to support the allegations in the statement of opposition and (ii) the legal onus on the applicant to prove its case.

[8] With respect to (i) above, there is an evidential burden on the opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on the opponent with respect to a particular issue means that in order for the issue to be

considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on the applicant to show that the application does not contravene the provisions of the Act as alleged by the opponent (for those allegations for which the opponent has met its evidential burden). The presence of a legal 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.

Section 30(e) Ground of Opposition

[9] The section 30(e) ground of opposition alleges that the Applicant never intended to use the Mark in Canada with the Wares. There is no evidence that supports this ground of opposition. Consequently, it is dismissed on the basis that the Opponent has not satisfied its initial burden.

Section 30(i) Ground of Opposition

[10] The section 30(i) ground of opposition alleges in part that the Applicant could not have been satisfied that it was entitled to use the Mark because the Applicant must have been aware of the Opponent's trade-mark. Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. As this application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, this part of the section 30(i) ground is dismissed.

[11] The section 30(i) ground of opposition further alleges that the Applicant could not have been satisfied it was entitled to use the Mark because such use would have the effect of depreciating the goodwill of the Opponent's TIR NAN OG registration in violation of section 22 of the Act. Neither the Registrar, nor the Federal Court has ruled on whether a section 30(i) ground of opposition based on the violation of section 22 is a valid ground of opposition [*Parmalat Canada Inc v Sysco Corp* 2008 FC 1104, (2008), 69 CPR (4th) 349 (FC) at paras 38-42]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce evidence supporting a likelihood of depreciation of goodwill [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* 2006 SCC 23, (2006), 49 CPR (4th) 401 (SCC) at paras. 46, 63-68], it

would have no chance of success. Accordingly, this part of the section 30(i) ground of opposition is dismissed.

Grounds of Opposition Premised on Confusion

[12] The Opponent has also pleaded grounds of opposition pursuant to sections 38(2)(b)/12(1)(d), 38(2)(c)/16(3)(a) and 38(2)(d)/2 of the Act. Each of these grounds is based on the allegation that there is a likelihood of confusion between the Mark and the Opponent's TIR NAN OG trade-mark.

Section 12(1)(d) Ground of Opposition

[13] The Opponent has pleaded that the Mark is not registrable because it is confusing with registration No. TMA496,236 for the Opponent's TIR NAN OG trade-mark. I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date and, as such, the Opponent has met its burden [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 at 411-412 (TMOB)].

[14] There is a likelihood of confusion if the use of both trade-marks in the same area would likely lead to the inference that the wares and services associated with those trade-marks are manufactured, sold or leased by the same person (section 6(2) of the Act). In assessing confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the wares and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them.

[15] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc*, (2011), 92 CPR (4th) 361 (SCC) at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

inherent distinctiveness

[16] The marks of each party are inherently distinctive. The Applicant states in its application that the Mark is a foreign word meaning “land of eternal youth”. Mr. Gardner explains in his affidavit that:

TIR NAN OG also spelled TIR NA N’OG was a mythical Irish land or “otherworld” populated by supernatural beings ... In English, TIR NAN OG or TIR NA N’OG means “land of eternal health” or “land of eternal youth” (paragraph 21).

There is no evidence that the average Canadian would know the meaning of TIR NAN OG or TIR NA N’OG. Therefore, the marks of each party are inherently distinctive [*Thai Agri Foods Public Co v Choy Foong Int’l Trading Co Inc*, 2012 TMOB 61 at para 11].

extent of use

[17] This factor favours the Opponent. The Opponent’s TIR NAN OG trade-mark is known to some extent in Canada whereas there is no evidence that the Mark has become known. Mr. Gardner’s evidence is that the Opponent or its predecessors in title:

- first opened the TIR NAN OG pub in Kingston, Ontario in May 1997 (paragraph 14 of the Gardner affidavit);
- between 1999 and 2012, total sales at the TIR NAN OG pub were over \$30 million (paragraph 15); and
- the TIR NAN OG trade-mark has appeared on such things as exterior signage (Exhibit 5); posters and postcards (Exhibit 6), food and beverage menus and promotions (Exhibits 2, 3, and 9), and sales receipt (Exhibit 4).

nature of the wares, services, business or trade

[18] This factor favours the Opponent. The evidence shows that the trades of the parties somewhat overlap. The applied-for wares distilled spirits, namely, whiskey, scotch, gin, vodka, and wine are sold in restaurants and bars including the Opponent’s pub TIR NAN OG.

Therefore, the Wares could be sold at the Opponent’s pub with an almost identical trade-mark. Furthermore, the Applicant’s wares and the Opponent’s services appear to be targeted at the same people – those interested in consuming alcoholic beverages. In this regards, Mr. Gardner

has provided evidence that Tir Nan Og's advertising including posters and postcards and pictures appearing on its Facebook page prominently feature beer (Exhibit 6) and spirits (Exhibit 8). Furthermore, its food menus feature pictures of beer, wine, spirits and cocktails (Exhibit 2).

[19] Finally, Mr. Gardner has provided evidence from third party web-sites that there are restaurants which sell wine or beer under the same trade-mark as their restaurant services are offered (see, for example, Exhibits 13, 14, 16, 20, 25, 27, 28 and 31). While excerpts of third party websites are generally considered hearsay and cannot be relied upon as evidence of the truth of their contents, I am satisfied that some weight may be placed on the Gardner affidavit due to the number of Canadian restaurant web-sites located. In previous cases, the nature of trade of alcoholic beverages has been found to be different from restaurant services (see *Hotel La Sapiniere Ltee v S Coorsh & Sons* (1982), 78 CPR (2d) 216 (TMOB) at 222; *Calona Wines Ltd v Bay-Charles Restaurant Ltd* (1980), 51 CPR (2d) 19 (FCTD) at 22; *437832 Ontario Ltd v John Labatt Ltd/John Labatt Ltee* (1987), 16 CPR (3d) 345 (TMOB) at 349). However, in each of these cases it was found that restaurant patrons would not expect a restaurant to brew beer or make wine. Mr. Gardner's evidence appears to contradict this finding. Therefore, I cannot make the same finding with respect to the Wares in this case. As such, this factor favours the Opponent.

degree of resemblance between the trade-marks

[20] This factor significantly favours the Opponent as the marks of the parties are almost identical in appearance and have the same sound and meaning.

Conclusion re likelihood of confusion

[21] For the reasons explained above, and in particular the similarity between the parties' marks and the overlap in the nature of trade between the Wares and the registered services operation of a restaurant and bar, I conclude that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Mark is not confusing with the Opponent's TIR NAN OG trade-mark. This ground of opposition is successful.

Remaining Grounds of Opposition

[22] Although the material dates for the section 16 and distinctiveness grounds of opposition fall earlier than today's date, the different dates do not result in a different outcome. While I do not have evidence before me at these earlier material dates showing restaurants offering wine or beer under the same trade-mark, the overwhelming similarity of the marks along with the potential overlap in the Wares with the Opponent's restaurant and bar services is sufficient for me to find that there is a likelihood of confusion. Therefore, the section 16(3)(a) and distinctiveness grounds succeed.

Disposition

[23] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office