



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

Citation: 2011 TMOB 183
Date of Decision: 2011-09-29

**IN THE MATTER OF AN OPPOSITION
by 2028274 Ontario Limited c/o/b/a B
Espresso Bar to application No. 1,314,209
for the trade-mark B STORE Stylized in
the name of B Store Limited**

[1] On August 24, 2006, B Store Limited (the Applicant) filed an application to register the B STORE Stylized trade-mark shown below (the Mark).



The application was filed on the basis of the Applicant's use and registration abroad and proposed use in Canada in association with clothing; footwear; headgear and the following services:

retail services in the field of clothing, footwear and headgear; retail services connected with the sale of clothing, footwear and headgear, bags, rucksacks and backpacks, jewellery, imitation jewellery, perfumes, cosmetics and toilet articles; chronometric and horological instruments, by Internet, mail order, catalogue and other media including by means of telecommunications; provision of information to customers and advice or assistance in the selection of goods brought together as above; retail services connected with clothing, footwear and headgear in order to

make it possible for others to conveniently view and purchase such goods (the Services).

[2] The wares were subsequently amended to:

clothing, namely athletic clothing, baby clothing, beachwear, business attire, casual clothing, children's clothing, exercise clothing, formal wear, gym clothing, loungewear, outdoor winter clothing, rainwear, sleepwear, sportswear and undergarments; footwear, namely athletic footwear, baby footwear, beach footwear, casual footwear, children's footwear, evening footwear, exercise footwear, orthopaedic footwear, outdoor footwear, winter footwear, rain footwear, sports footwear and lounge footwear; headgear, namely berets, earmuffs, hats, caps, toques, turbans, balaclavas and cagoules (the Wares).

[3] The Applicant disclaimed the right to the exclusive use of the word STORE apart from the trade-mark in respect of the Services.

[4] The application was advertised for opposition purposes in the *Trade-marks Journal* of November 28, 2007.

[5] On July 8, 2008, 2028274 Ontario Limited c/o/b/a B Espresso Bar (the Opponent) filed a statement of opposition pleading the grounds summarized below:

(a) contrary to s. 30(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant has not used the Mark in association with all of the Wares and Services at the date of filing, publication or opposition and at the date of filing did not have a real and effective industrial or commercial establishment in the United Kingdom;

(b) contrary to s. 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark as it knew or ought to have known of the Opponent's use, registration and notoriety of its marks and trade-names prior to the filing date;

(c) contrary to s. 12(1)(d) of the Act, the Mark is not registrable because it is confusing with registration No. TMA713,109 for the B & SOLID CIRCLE Design trade-mark shown below (B & Design Trade-mark);



(d) contrary to s. 16(2)(a), (b) and (c) and 16(3)(a), (b) and (c) of the Act, the Applicant is not the person entitled to registration of the Mark because at the filing date it was confusing with the Opponent's application Nos. 1,197,656 and 1,197,657 for the B & Design Trade-mark and B EXPRESSO BAR trade-mark and the use of these trade-marks and the trade-names *b Espresso* and *b Espresso Bar* by the Opponent; and

(e) contrary to s. 2 of the Act, the Mark is not distinctive of the Applicant.

[6] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[7] In support of its opposition, the Opponent filed an affidavit of Elenita Anastacio. In support of its application, the Applicant filed an affidavit of Michelle Andersen. No cross-examinations were conducted.

[8] No written arguments were filed and an oral hearing was not requested.

[9] On June 1, 2009, the application was amended to delete the use and registration abroad filing basis.

Onus and Material Dates

[10] 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].

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

- s. 38(2)(a)/30 of the Act - 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. 38(2)(b)/12(1)(d) of the Act - 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. 38(2)(c)/16(2)/16(3) of the Act - the filing date of the application;

- s. 38(2)(d) of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

Grounds of Opposition that Can be Summarily Dismissed

[12] As the Applicant has amended the application to delete the use and registration abroad basis, the s. 16(2)(a), 16(2)(b), 16(2)(c) and s. 30(d) grounds of opposition are moot [*Balenciaga v. Balega International LLC*; 2010 CarswellNat 5650 (T.M.O.B.) at para. 12]. Accordingly, these grounds are dismissed.

[13] The s. 30(i) ground alleges that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as the Applicant knew or ought to have known of the Opponent's use, registration and notoriety of its trade-marks and trade-names. Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As the application includes the required statement and there is no allegation or evidence of bad faith or other exceptional circumstances, the s. 30(i) ground is dismissed.

[14] The s. 16(3)(a) and (c) and s. 2 grounds are dismissed because the Opponent has not met its initial burden for these grounds. The Opponent has not evidenced that its marks or trade-names were used or known in Canada as of the applicable material dates. Although the Opponent's registration for the B & Design Trade-mark and application for the B ESPRESSO

BAR trade-mark both refer to use, that is not sufficient to meet the initial onus on the Opponent under these grounds of opposition [*Roos, Inc. v. Edit-SRL* (2002), 23 C.P.R. (4th) 265 (T.M.O.B.) at para. 4].

Section 12(1)(d) Ground of Opposition

[15] I have exercised my discretion and checked the register to confirm that registration No. TMA713,109 for the B & Design Trade-mark is extant [*Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Therefore, the Opponent has met its initial burden with respect to this ground. The particulars for the B & Design Trade-mark are set out below:

b Operation of an espresso bar, serving food and beverages in a retail environment; catering of business lunches and hosting and/or catering private functions.

[16] The test to determine the issue of confusion is set out in s. 6(2) of the Act where it is stipulated that the use of a trade-mark causes confusion with another trade-mark 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, whether or not the wares and services are of the same general class. In making such assessment I must take into consideration all the relevant surrounding circumstances, including those listed in s. 6(5): 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.

[17] These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [see *Mattel, Inc. v. 3894207 Canada Inc.*, [2006] 1 S.C.R. 772 (S.C.C.) at para. 54]. I also refer to *Masterpiece Inc. v. Alavida Lifestyles Inc.*, 2011 SCC 27 (unreported) at para. 49, where the Supreme Court of Canada states that s. 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis. While I have examined the criteria in the order in which they appear in the Act in considering the

s. 12(1)(d) ground of opposition, I have taken into account the Supreme Court's comments with respect to the importance of s. 6(5)(e).

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

[18] Neither mark has a large degree of inherent distinctiveness as the dominant element of each is the letter b [*GSW Ltd. v. Great West Steel Industries Ltd.* (1975), 22 C.P.R. (2d) 154 (F.C.T.D.)]. Both parties' marks owe their inherent distinctiveness to the other elements in the marks and their respective stylizations of the letter b [*General Motors Corp. v. Gunn & Moore Ltd.* (1998), 84 C.P.R. (3d) 114 (T.M.O.B.) at para. 13].

[19] A trade-mark may acquire distinctiveness through use or promotion, but neither party has filed evidence showing this. While the Opponent's registration for the B & Design Trade-mark issued on the basis of use of the mark in Canada since at least as early as October 19, 2003, this only entitles me to assume *de minimis* use [see *Entre Computer Centers Inc. v. Global Upholstery Co.* (1991), 40 C.P.R. (3d) 427 (T.M.O.B.) at 430]. *De minimis* use does not support a conclusion that the mark has become known to any significant extent.

[20] As such, this factor favours neither party.

length of time each trade-mark has been in use

[21] The Opponent's registration indicates that the B & Design Trade-mark has been used in Canada since at least as early as October 19, 2003. The subject application was filed on August 24, 2006 on the basis of proposed use in Canada. While the Opponent's affiant, Elenita Anastacio, a trade-mark searcher employed by its Agent, filed print-outs of the website *www.bstorelondon.com* featuring the Mark there is no indication that this is the Applicant's website, nor that Canadians have accessed it (Anastacio Affidavit, Exhibit B). It, therefore, appears that the Opponent's mark has been in use longer than the Mark and this factor favours the Opponent. However, not much weight can be placed on this factor since there is no evidence of the extent of use of the B & Design Trade-mark, nor that it has been used continuously.

nature of the wares, services, business or trade

[22] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application or registration that govern in respect of the issue of confusion arising under s. 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[23] Neither party filed evidence relating to the nature of its wares, services or channels of trade. Given the statement of wares and/or services in each case there is no basis for finding that there is any overlap between the food and beverage related services of the Opponent and the Wares and Services. This factor favours the Applicant.

degree of resemblance between the trade-marks

[24] There is some degree of resemblance between the Mark and the B & Design Trade-mark. Insofar as there is visual similarity, it solely resides in the use of the lower case letter b by each party [*Anamet, Inc. v. Acklands Ltd.* (1996), 67 C.P.R. (3d) 478 (F.C.T.D.) at 483-484]. The marks, however, do differ visually in the following respects: the B & Design Trade-mark includes a coffee bean and minimal stylization whereas the Mark includes the word STORE and is highly stylized with the letter b including flourishes and an elaborate outline. The marks also differ aurally due to the presence of STORE in the Mark. Finally, due to the presence of a coffee bean in the B & Design Trade-mark and the word STORE in the Mark, I find that there is a low degree of resemblance in the ideas suggested by each mark. The B & Design Trade-mark suggests a place where coffee is served whereas the Mark suggests a store where goods can be purchased. This factor favours the Applicant.

additional surrounding circumstances - state of the register evidence

[25] The Applicant filed an affidavit of Michelle Andersen, a legal assistant and trade-mark searcher employed by its Agent. Ms. Andersen attached the particulars of allowed applications and registrations featuring what she describes as "a prominent B Design" in relation to clothing,

headwear and/or footwear. The results of Ms. Andersen's search are, for the most part, irrelevant since most of the marks located bear little resemblance to the designs used by the Applicant and Opponent [*Anheuser-Busch Inc. v. Guangdong Cannery Guangzhon* (1996), 76 C.P.R. (3d) 406 (T.M.O.B.) at para. 14].

Conclusion

[26] I conclude that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the marks. The Opponent's B & Design Trade-mark, being comprised primarily of one letter, has a low degree of inherent distinctiveness and there is no evidence that it has acquired any distinctiveness. Accordingly, the differences between the marks and their associated wares and services is sufficient to make confusion unlikely. This ground of opposition is therefore dismissed.

Section 16(3)(b) Ground of Opposition

[27] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with application No. 1,197,656 for the B & Design Trade-mark and application No. 1,197,657 for the B ESPRESSO BAR trade-mark.

[28] I have used my discretion to confirm that both these applications were pending as of August 24, 2006 and November 28, 2007, the filing and advertisement dates respectively of the subject application [*Royal Appliance Manufacturing Co. v. Iona Appliances Inc./Appareils Iona Inc.* (1990), 32 C.P.R. (3d) 525 (T.M.O.B.) at 529]. As such, the Opponent has met its burden with respect to this ground.

[29] For the reasons set out above with respect to the s. 12(1)(d) ground, I do not find that the Mark was confusing with the B & Design Trade-mark as of the relevant date (August 24, 2006). In so deciding, I have taken account of the statement of wares and services in application No. 1,197,656 as of this date:

Wares: Coffee, and coffee related beverages namely made with coffee namely cappucino, espresso, latte's and café au lait; teas, juices, soft drinks, alcoholic beverages namely beer, wine and spirits namely liqueurs and distilled beverages, namely, rye, scotch, gin, rum, vodka, bourbon, aperitifs, brandy, cognac, port and juices mixed with afore-mentioned distilled beverages; lunch foods namely Italian panini sandwiches, gourmet salads and soups, desserts, pastries, muffins, cakes. Retail items namely coffee beans, ground coffee, designer cups, small home espresso machines, chocolates and gift baskets.

Services: Operation of an espresso bar, serving food and beverages in a retail environment; catering of business lunches and hosting and/or catering private functions.

[30] I will now consider the likelihood of confusion with the B ESPRESSO BAR trade-mark as of August 24, 2006. The statement of wares and services in this application as of this date is set out below:

Wares: Coffee, and coffee related beverages, teas, juices, soft drinks, alcoholic beverages namely beer, wine and spirits; lunch foods namely Italian panini sandwiches, gourmet salads and soups, desserts, pastries, muffins, cakes. Retail items namely coffee beans, ground coffee, designer cups, small home espresso machines, chocolates and gift baskets.

Services: Operation of an espresso bar, serving food and beverages in a retail environment; catering of business lunches and hosting and/or catering private functions.

[31] I am of the view that with respect to the B ESPRESSO BAR trade-mark it is appropriate to consider the resemblance between the Applicant's and Opponent's marks as the first step in the confusion analysis (*Masterpiece, supra* at para. 49). The inclusion of ESPRESSO BAR in the Opponent's mark results in a very different sounding and looking mark due to the differences between the second component of each mark (ESPRESSO BAR and STORE) which share no

resemblance. Furthermore, I consider that the Mark and the B ESPRESSO BAR trade-mark have a very different commercial impression as espresso bars and stores are very different types of locations. Given these differences, the marks do not resemble each other.

[32] In *Masterpiece*, Rothstein J. stated that:

... if the marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar...

My comments with respect to the remaining s. 6(5) factors in the section entitled “Section 12(1)(d) Ground of Opposition” also apply with respect to the B ESPRESSO BAR trade-mark. I note that the lack of inherent distinctiveness and evidence of use of this trade-mark and the different channels of trade, all support a lack of confusion. Accordingly, this ground of opposition is dismissed.

Disposition

[33] 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.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office