

**IN THE MATTER OF AN OPPOSITION  
by Francesco Martins carrying on business  
as Hooters Restaurant to application No.  
720,855 for the trade-mark HOOTERS &  
Design filed by Hooters of America, Inc. and  
subsequently assigned to Hooters, Inc.**

**On January 21, 1993, Hooters of America, Inc. filed an application based on proposed use in Canada to register the trade-mark HOOTERS & Design (illustrated below) for the following wares:**

plastic key chains, disc toss toys; cigarette lighters; calendars, posters, photographs, magazines of general interest; clothing: namely, sweatbands, shirts, pants, jackets, socks, shorts, baby bibs; hats, billed caps, sun visors; food, namely breading mix; video cassette tapes featuring entertainment programming

**and for the following services:**

operating restaurant and cocktail lounges; providing entertainment in the nature of a television program.

**The application was advertised for opposition purposes on August 25, 1993 and was subsequently assigned to the current applicant of record, Hooters, Inc.**

**The opponent, Francesco Martins carrying on business as Hooters Restaurant, filed a statement of opposition on October 1, 1993, a copy of which was forwarded to the applicant on December 14, 1993. The first ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(3)(a) of the Trade-marks Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the trade-mark HOOTERS & Design (illustrated below) previously used in Canada by the opponent in association with shirts, t-shirts and sweatshirts and with the operation of a restaurant and cocktail lounge since October of 1991. The second ground is one of prior entitlement pursuant**

to Section 16(3)(c) based on the opponent's prior use of his trade-name Hooters. The third ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As his evidence, the opponent filed an affidavit of Acilio Martins. Mr. Martins was cross-examined on his affidavit and the transcript of that cross-examination and the replies to undertakings form part of the record of this proceeding. The applicant did not file evidence. Only the opponent filed a written argument and no oral hearing was conducted.

The Martins affidavit evidences use of the opponent's trade-mark (or minor variations of that mark) and his trade-name prior to the applicant's filing date. Thus, all three grounds of opposition effectively turn on the issue of confusion between the applicant's proposed mark and the opponent's previously used trade-mark and trade-name. The material time for considering the first two grounds is the applicant's filing date and the material time respecting the third ground is the filing of the opposition. In the present case, nothing turns on which material time is used. Thus, a consideration of the issue of confusion as of the applicant's filing date will effectively decide all three grounds.

In applying the tests for confusion set forth in Sections 6(2) and 6(3) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion between its proposed mark and the opponent's previously used trade-mark and trade-name.

**The trade-marks and trade-name at issue are all inherently distinctive, none having any meaning associated with the related wares or services. There being no evidence from the applicant, I must conclude that its mark had not become known at all in Canada as of the applicant's filing date. The opponent's evidence shows that its mark had become known to some extent in the Toronto region in association with restaurant services as of the material time.**

**The length of time the marks have been in use favors the opponent. The restaurant and cocktail lounge services of the parties are the same. There is also some overlap in the wares of the parties since the opponent has shown use of its trade-mark for certain clothing items. On the other hand, the applicant's proposed service of "providing entertainment in the nature of a television program" differs substantially from the opponent's wares and services. The trades of the parties would presumably be the same in respect of the wares and the restaurant and cocktail lounge service but would differ in respect of the applicant's additional service. There is a high degree of resemblance between the applicant's mark and the opponent's trade-mark and trade-name.**

**In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares and the restaurant and cocktail lounge services of the parties and the resemblance between the marks and names of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's trade-mark and trade-name in respect of the wares listed in the application and the service "operating restaurant and cocktail lounges." Given the wide disparity between the opponent's wares and services and the applicant's service "providing entertainment in the nature of a television program", I find that the applicant's mark is not confusing with the opponent's trade-mark and trade-name in respect of that particular service. Thus, all three grounds of opposition are successful in part.**

**In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I refuse the applicant's application in respect of the wares and in respect of the service “operating restaurant and cocktail lounges.” I otherwise reject the opponent’s opposition. Authority for such a divided result may be found in Produits Menagers Coronet Inc. v. Coronet-Werke Heinrich Schlerf GmbH (1986), 10 C.P.R.(3d) 482 at 492 (F.C.T.D.).**

**DATED AT HULL, QUEBEC, THIS 12th DAY OF MARCH, 1997.**

**David J. Martin,  
Member,  
Trade Marks Opposition Board.**