



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

Citation: 2012 TMOB 109
Date of Decision: 2012-05-29

**IN THE MATTER OF AN OPPOSITION
by George V Entertainment to application
No 1,357,749 for the trade-mark
BUDDAKAN filed by Costar Partners LP**

File Record

[1] On July 30, 2007 Costar Partners LP (the Applicant) filed application No 1,357,749 to register the trade-mark BUDDAKAN (the Mark) based on use and registration abroad and on proposed use in Canada. It covers restaurant services (the Services).

[2] The application was advertised on July 16, 2008 in the *Trade-marks Journal* for opposition purposes. George V Entertainment (the Opponent) filed a statement of opposition on December 15, 2008 which was forwarded by the Registrar on January 14, 2009 to the Applicant.

[3] The Applicant denied all grounds of opposition in a counter statement filed on March 13, 2009.

[4] The Opponent filed as its evidence certificates of authenticity for registration No TMA662,480 for the trade-mark BUDDHA-BAR, application No 1,151,620 for the trade-mark BUDDHA-BAR, application No 1,273,448 for the trade-mark BUDDHA-BAR HOTEL and application No 1,282,207 for the trade-mark BUDDHA-BAR. The Applicant filed the affidavits of Stephen Starr and Russell Paul Latham.

[5] Neither party filed a written argument. A hearing was scheduled but cancelled after both parties expressed their intention not to participate.

The Grounds of Opposition

[6] The grounds of opposition pleaded by the Opponent can be summarized as follow:

1. The Application does not satisfy the requirements of section 30 of the *Trade-marks Act* RSC 1985, c T-13, (the “Act”) in that:
 - a) At the filing date of the application, the Applicant was already using the Mark in Canada in association with the Services;
 - b) The trade-mark that is proposed to be used is not the Mark;
 - c) Alternatively or cumulatively, the Applicant never intended to use the Mark in Canada in association with the Services;
 - d) It is falsely that the Applicant declared itself satisfied that it is entitled to use the Mark in Canada in view of the content of the present opposition, including the Applicant’s knowledge of the Opponent’s rights as herein alleged and the unlawfulness of said use, if any;
 - e) It is falsely that the Applicant declared itself satisfied that it is entitled to use the Mark in Canada in view of the Applicant’s knowledge of the Opponent’s rights and the illegality of such use as it would depreciate the value of the goodwill attached to the Opponent’s trade-marks contrary to section 22 of the Act;
 - f) It is falsely that the Applicant declared itself satisfied that it is entitled to use the Mark in Canada in view of the Applicant’s knowledge of the Opponent’s rights and the illegality of such use as it would direct the public attention to its wares, services or business in such a way as to cause or be likely to cause confusion in Canada between its wares, services or business and those of the Opponent, the whole contrary to section 7(b) of the Act.
2. The Mark is not registrable pursuant to section 12(1)(d) of the Act as it is confusing with the Opponent’s registered trade-mark BUDDHA-BAR, certificate of registration No TMA662,480 for amongst other, restaurant services.
3. The Applicant is not entitled to the registration of the Mark pursuant to section 16 of the Act in that:
 - a) At the filing date of the application the Mark was confusing with the Opponent’s trade-mark BUDDHA-BAR which has been previously used or made known in Canada by the Opponent or its predecessors in title in association with Compact discs, namely series of world music, lounge music and electronic music compilations; Entertainment, namely live music concerts, music production and publishing, namely audio recording

and production and disc production, discotheque services, artist agent services, rental of sound recordings, editing of radio and television programs, orchestra services, production of performances, namely music concerts, recording studio services the whole contrary to section 16(3)(a) of the Act;

- b) At the filing date of the application the Mark was confusing with the Opponent's trade-mark applications:
 - i) No 1,273,448 for the trade-mark BUDDHA-BAR HOTEL in association with hotel, bar and restaurant services;
 - ii) No 1,151,620 for the trade-mark BUDDHA-BAR in association with compact discs, namely series of world music, lounge music and electronic music compilations; entertainment, namely live music concerts, music production and publishing, namely audio recording and production and disc production, discotheque services, artist agent services, rental of sound recordings, editing of radio and television programs, orchestra services, production of performances, namely music concerts, recording studio services; and
 - iii) No 1,282,207 for the trade-mark BUDDHA-BAR in association with hotel, bar and restaurant services;all of which were previously filed in Canada the whole contrary to the provisions of section 16(3)(b) of the Act;
- c) For the reasons previously mentioned, the application does not comply with the requirements of section 30 of the Act; the Mark is not a proposed one but rather a used one and the Mark is not registrable or does not function as a trade-mark the whole contrary to the introductory paragraph of section 16(3) of the Act.

- 4. Pursuant to section 38(2)(d), the Applicant's Mark is not distinctive of the Applicant's Services nor can it be because the Mark does not actually distinguish the services in association with which the Mark is proposed to be used by the Applicant from the wares and services of others, including those of the Opponent.

Legal Onus and Burden of Proof in Trade-marks Opposition Proceedings

[7] The legal onus is upon the Applicant to show that the Application complies with the provisions of the Act, but there is however 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. Once this initial burden is met, the Applicant has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd et al v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325

(TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) and *Wrangler Apparel Corp v The Timberland Company* [2005] FC 722].

Grounds of Opposition Summarily Dismissed

[8] The Opponent has not filed any evidence that could support its grounds of opposition 1, 3 a) and 4 described above. Therefore those grounds of opposition are dismissed for failure by the Opponent to meet its initial burden of proof.

[9] Section 16 of the Act defines the non-entitlement grounds of opposition and its introductory paragraph by itself does not define a ground of opposition by which non-compliance and registrability issues could be raised. Those grounds of opposition are covered specifically in other sections of the Act. The ground of opposition 3c) as described above is not a valid ground of opposition. It is dismissed.

Entitlement under section 16(3)(b) of the Act

[10] In order to meet its initial burden under this ground of opposition, the Opponent must show that the cited applications were filed prior to the filing date of the present application and that they were still pending at the advertising date (July 16, 2008) [see section 16(4) of the Act].

[11] I checked the register and applications Nos 1,273,448; 1,151,620 and 1,282,207 were all pending at the advertisement date. Consequently the Opponent has met its initial burden. Therefore the Applicant has the legal onus to prove, on a balance of probabilities, that the use of the Mark in association with the Services is not likely to cause confusion with the Opponent's aforesaid trade-marks. I consider the Opponent to have the best chances to succeed with application No 1,282,207 for the trade-mark BUDDHA-BAR in association with hotel, bar and restaurant services. If the Opponent is not successful with this cited application, it would not achieve a more favourable result with the other two applications.

[12] The test to determine the issue of likelihood of confusion is set out in section 6(2) of the Act. I must take into consideration all the relevant surrounding circumstances,

including those listed in section 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, 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.

[13] Those criteria are not exhaustive and it is not necessary to give each one of them equal weight. In its recent judgment in *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 96 CPR (4th) 361 (SCC), the Supreme Court of Canada has clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

The inherent distinctiveness of the marks and the extent that they have become known

[14] The Mark is inherently distinctive as it is a coined word. The trade-mark BUDDHA-BAR is less distinctive. The first component is the word “Buddha” defined in *The Canadian Oxford Dictionary* as: “a title given to successive teachers (past and future) of Buddhism, although it usually denotes the founder of Buddhism, Siddhartha Gautama (c. 563 – c. 480 BC)”. It has no suggestive meaning when used in association with the services covered by such application. However the addition of the word “bar” tends to suggest the type of services offered or to be offered in association with that mark.

[15] The relevant date is the filing date of the application [see section 16(3) of the Act]. There has been no evidence of use or promotion of the parties’ trade-marks in Canada prior to the relevant date. Consequently neither mark was known at such date.

Length of time the marks have been used

[16] This factor does not favour either party as there is no evidence of use of the parties’ respective trade-marks prior to the relevant date. Mr. Starr, the Chief Executive Officer of the Opponent states in his affidavit that the Mark has not yet been used in Canada in association with the Services. He does make allegations of use in the United States but this is not relevant in the analysis of this factor.

Nature of the services and their channels of trade

[17] The Services are identical to those covered by the Opponent's application No 1,282,207. In the absence of evidence of the parties' respective channels of trade, I have to presume that they will be similar since the parties' services offered or to be offered to Canadian consumers are or will be similar if not identical in nature. These factors favour the Opponent.

Degree of resemblance

[18] The first portion of the parties' marks is phonetically identical. However as stated earlier "Buddha" is a common English word and thus does not possess much inherent distinctiveness.

[19] Mr. Starr does explain the origin of the Mark. He states that he was inspired by the title of an album recorded by the rock group Cheap Trick entitled "Cheap Trick at Budokan". Mr. Starr has provided information about "Budokan" being the name of a stadium located in Tokyo, Japan. However I doubt that the average Canadian consumer would associate the Mark to that stadium. It is more likely that the average Canadian consumer would view the Mark as a coined word. In any event, when viewed as a whole, the marks are different visually and in the ideas suggested.

[20] This factor favours the Applicant.

Additional surrounding circumstances

[21] Mr. Latham was a lawyer at the Applicant's agent firm when he signed his affidavit. On June 24, 2010 he conducted a search of the Canadian Trade-marks register to locate pending applications or registrations for trade-marks consisting or incorporating the term BUDDHA or a visually or phonetically similar term, for use in association with food and beverage related wares and services. He filed the results of such search as Exhibit A to his affidavit.

[22] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD)]. Inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]. The search results reveal only 7 pertinent citations as I had to eliminate the applications filed subsequent to the relevant date. This number is insufficient to draw any inferences about the state of the marketplace.

Conclusion

[23] Since the most important factor is the degree of resemblance, I conclude that the Applicant has met its burden to prove, at the filing date of the application and on a balance of probabilities, that the Mark was not likely to cause confusion with the Opponent's trade-mark BUDDHA-BAR when the Mark is used in association with the Services. The Mark is more inherently distinctive than the Opponent's trade-mark BUDDHA-BAR and is different visually and in the ideas suggested.

[24] Consequently the ground of opposition 3b) described above is dismissed.

Registrability under section 12(1)(d) of the Act

[25] In order to meet its initial burden under this ground of opposition, the Opponent needs to establish the existence of the registration cited under this ground of opposition.

[26] As stated above the Opponent has filed a certificate of authenticity for registration No TMA662,480. I checked the register and such registration is extant [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats Ltée v Manu Foods Ltd*, 11 CPR (3d) 410]. The Opponent has met its initial burden of proof. Consequently the Applicant has the legal onus to prove, on a balance of probabilities, that the use of the Mark in association with the Services is not likely to cause confusion with the Opponent's registered trade-mark BUDDHA-BAR.

[27] The relevant date is the date of the Registrar's decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413 at 424 (FCA)]. The test to determine this issue is the same as the one described earlier under entitlement.

[28] Registration No TMA662,480 for the trade-mark BUDDHA-BAR covers amongst other, restaurant services.

[29] The later relevant date, when compared to the one associated with the ground of opposition of entitlement, enables me to take into consideration the content of Mr. Starr's affidavit. However, as mentioned previously the allegations of use described in his affidavit relate to use of the Mark in the United States.

[30] Mr. Starr also alleges that there has been concurrent use of the parties' marks in association with restaurant services in New York City from 2006 to 2010 without any instances of confusion that he is aware of. We have no information on the extent of both parties' use of their respective trade-marks in the United States. Moreover we have no information as to the inquiries made by Mr. Starr to make such a statement. Finally we have no information about the US marketplace.

[31] The Applicant argues that both parties' trade-marks have co-existed on the register in the United States. Additionally the Applicant submits that the Opponent opposed before the Japanese Patent Office its application to register the Mark without success. No further details were provided as to the reasons why such decision was reached. In *Vivat Holdings Ltd v. Levi Strauss & Co* (2005), 41 CPR (4th) 8 (FCTD) Layden-Stevenson J. made the following ruling:

The "consideration of foreign applications and registrations" can be summarily determined. There is no dispute that there was no evidence regarding foreign law. Neither Mr. Richards (nor Mr. Gerety) professed to have knowledge of such matters. Mr. Justice Marceau in *Haw Par Brothers International Ltd. v. Canada (Registrar of Trade Marks)* (1979), 48 C.P.R. (2d) 65 (Fed. T.D.) determined that little can be drawn from the fact that the trade marks at issue coexist in other jurisdictions, for the Registrar's decision must be based on Canadian standards, having regard to the situation in Canada. Similarly, in *Sun-Maid Growers of California v. Williams & Humbert*

Ltd. (1981), 54 C.P.R. (2d) 41 (Fed. T.D.) Associate Chief Justice Thurlow opined that registrations in other jurisdictions are irrelevant since they have their basis entirely in foreign law and procedure. I am inclined to agree with Levi that evidence of mere coexistence of marks on foreign registers is not relevant and evidence of foreign opposition on unproven records under foreign law is not probative. Moreover, Vivat has not been successful with respect to all of its applications.

[32] Consequently, given that the relevant evidence is substantially the same as the evidence reviewed under the ground of opposition of entitlement under section 16(3)(b), I come to the same conclusion reached under such ground of opposition.

[33] The second ground of opposition is therefore dismissed.

Disposition

[34] Having been delegated authority by the Registrar of Trade-marks by virtue of section 63(3) of the Act, I reject the opposition, the whole in accordance with section 38(8) of the Act.

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