

IN THE MATTER OF AN OPPOSITION by Restaurant Bar-B Inc.  
to application No. 600,443 for the trade-mark BAR-B-RIBS filed by  
Bernard Matthews P.L.C.

On February 8, 1988, Bernard Matthews P.L.C. filed an application to register the trade-mark BAR-B-RIBS based upon use and registration of the trade-mark in the United Kingdom in association with "pork products and beef products namely cuts of meat from or including a rib or being shaped similarly to such cuts of meat".

The present application was advertised for opposition purposes in the *Trade-marks Journal* of March 25, 1992 and the opponent, Restaurant Bar-B Inc., filed a statement of opposition which was amended February 26, 1993 in response to a letter of objection issued by the Opposition Board.

In its revised statement of opposition, the opponent alleged the following grounds:

(a) The application does not comply with Section 30 of the *Trade-marks Act* in that the statement in the present application that the applicant is satisfied that it is entitled to use the trade-mark BAR-B-RIBS in Canada in association with the wares covered in the application is false in that the applicant adopted the trade-mark knowing of prior use of THE BAR B BARN & Design as a trade-mark and the corporate name Restaurant Bar-B Inc. and Bar-B Foods Inc. as a trade-name by the opponent in association with "restaurant services generally";

(b) The applicant is not the person entitled to registration in view of the provisions of Sections 16(2)(a) and (c) of the *Trade-marks Act* in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-mark and trade-name THE BAR-B BARN & Design, registration No. 208,657, a representation of which is set out below, and Restaurant Bar-B Inc. and Bar-B Foods Inc., which had been previously used in Canada in association with "restaurant services generally" by the opponent;

Registration No. 208,657

(c) The applicant is not the person entitled to registration in view of the provisions of Sections 16(2) of the *Trade-marks Act* in that, as of the filing date of the present application, the applicant's trade-mark was confusing with the opponent's trade-mark THE BAR-B BARN & Design which had been previously used and made known in Canada by the opponent and with the opponent's trade-name Restaurant Bar-B Inc.

and Bar-B Foods Inc. for services associated with “restaurant services generally” since at least as early as September 1969;

(d) The applicant's trade-mark is not distinctive because it is confusing with the opponent's trade-mark THE BAR-B BARN & Design and the opponent's trade-name Restaurant Bar-B Inc. and Bar-B Foods Inc.

The opponent filed as its evidence the affidavit of Dalton Barnoff while the applicant submitted the affidavits of John D. Miller, Lisa Corbeil and Susan Martinez. Lisa Corbeil and Susan Martinez were cross-examined on their affidavits, the transcripts of the cross-examinations forming part of the opposition record. As evidence in reply, the opponent filed a second affidavit of Dalton Barnoff. I would note that paragraphs 3, 11 and 13 to 20 of the second Dalton affidavit are not strictly confined to matter in reply to the applicant's evidence and therefore are not proper reply evidence as contemplated by Section 43 of the *Trade-marks Regulations*. I have therefore ignored these paragraphs in determining the outcome of this opposition.

Both parties submitted written arguments and both parties were represented at an oral hearing.

Subsequent to the exchange of written arguments, the opponent requested leave on February 28, 1996 to amend its statement of opposition pursuant to Rule 40 of the *Trade-marks Regulations*. The amendments sought by the opponent included its reliance upon the trade-marks BAR-B BARN, BAR-B and BAR-B SPARERIBS which were registered by the opponent in November and December of 1995. However, as in its revised statement of opposition of February 26, 1993, the opponent did not allege a ground of opposition based on Section 12(1)(d) of the *Trade-marks Act* in view of its registered trade-marks. Rather, and for reasons best known to the opponent or its trade-mark agents, the opponent relied only upon its common law rights in the three trade-marks covered by its recently obtained registrations in challenging the applicant's compliance with Section 30 of the *Act* and its entitlement to registration, as well as the distinctiveness of the applicant's trade-mark. Consequently, the opponent's Rule 40 request for leave was refused by the Opposition Board by way of the Office letter dated March 12, 1996 as the grounds based on its common law rights in its trade-marks could have been alleged much earlier in the proceeding.

At the oral hearing, the agent for the opponent argued that, in the interest of maintaining the purity of the register, I should interpret the opponent's grounds of opposition broadly. However, while the Registrar has a public interest which he is responsible for overseeing under the *Trade-marks Act*, Section 38(3)(a) of the *Trade-marks Act* specifically requires an opponent to set forth its grounds of opposition in sufficient detail to enable the applicant to respond thereto. In order to meet the requirements of Section 38(3)(a), the opponent must identify the trade-marks or trade-names being relied upon by it in challenging the applicant's entitlement to registration or the distinctiveness of the applicant's trade-mark. I am therefore not prepared to interpret the opponent's statement of opposition as including within its scope trade-marks which the opponent failed to timely identify in these proceedings.

While the legal burden is upon the applicant to show that its application complies with Section 30(i) of the *Trade-marks Act*, there is an initial evidential burden on the opponent in respect of its Section 30 ground [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330]. As no evidence has been filed by the opponent in support of its allegation that the applicant adopted the trade-mark BAR-B-RIBS knowing of the opponent's prior use of the trade-mark THE BAR B BARN & Design and the trade-name(s) Restaurant Bar-B Inc. and Bar-B Foods Inc., it has failed to meet the evidential burden upon it in respect of the Section 30 ground. In any event, and even had the applicant been aware of the opponent's trade-mark and trade-name(s) prior to filing the present application, such a fact is not inconsistent with the statement in the application that the applicant was satisfied that it was entitled to use the trade-mark BAR-B-RIBS in Canada on the basis *inter alia* that its mark is not confusing with the trade-mark and trade-name(s) of the opponent. Thus, the success of this ground is contingent upon a finding that the trade-mark and the opponent's trade-mark and trade-name(s) are confusing [see *Consumer Distributing Co. Ltd. v. Toy World Ltd.*, 30 C.P.R. (3d) 191, at pg. 195; and *Sapodilla Co. Ltd. v. Bristol-Myers Co.*, 15 C.P.R. (2d) 152, at pg. 155].

Both the second and third grounds of opposition relate to the applicant's entitlement to registration and, in both instances, the opponent has alleged that the applicant is not the person entitled to registration in that the trade-mark BAR-B-RIBS was confusing as of the applicant's filing

date [February 8, 1988] with the opponent's trade-mark THE BAR-B BARN & Design as covered by registration No. 208,657 and with the opponent's trade-names, Restaurant Bar-B Inc. and Bar-B Foods Inc., which had been previously used in Canada in association with "restaurant services generally". I do not understand the distinction which the opponent is attempting to make, if any, between its second and third grounds in that the opponent is relying upon the same trade-mark and trade-names as applied to "restaurant services generally" in challenging the applicant's entitlement to registration. I will therefore treat these grounds as being essentially the same ground of opposition.

With respect to a Section 16 ground, there is an initial burden on the opponent in view of Sections 16(5) and 17(1) of the *Trade-marks Act* to establish its use of the trade-mark THE BAR B BARN & Design and trade-names Restaurant Bar-B Inc. and Bar-B Foods Inc. prior to the applicant's filing date [February 8, 1988], as well as to show that it had not abandoned its trade-mark and trade-names as of the date of advertisement of the present application in the *Trade-marks Journal* [March 25, 1992]. I would note that the representation of the opponent's design trade-mark appearing in the statement of opposition and as used by the opponent does not include a hyphen between the elements BAR and B. I will therefore consider the opponent's trade-mark as being THE BAR B BARN & Design.

Having regard to the first Dalton affidavit, I am satisfied that the opponent has established its prior use and non-abandonment of the trade-mark THE BAR B BARN & Design in Canada as applied to restaurant services. On the other hand, the first Dalton affidavit does not establish that the opponent has used its corporate name in either its English or French versions as a trade-name in Canada in relation to "restaurant services" prior to the applicant's filing date. Indeed, the only reference to either version of the opponent's name appearing in the exhibits to the first Dalton affidavit is in Exhibit O which relates to the purchase of a motor vehicle by the opponent and therefore does not show use of the trade-name as applied to "restaurant services". As the opponent has met the initial burden upon it as it relates to the trade-mark THE BAR B BARN & Design, the legal burden is upon the applicant to satisfy the Registrar that there would be no reasonable likelihood of confusion between its trade-mark BAR-B-RIBS as applied to the wares covered in the

present application and the opponent's trade-mark THE BAR B BARN & Design as applied to restaurant services. In assessing whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances including, but not limited to, those specifically enumerated in subsection 6(5) of the *Trade-marks Act*. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the filing date of the present application.

The applicant's trade-mark BAR-B-RIBS possesses some measure of inherent distinctiveness even though the mark is suggestive of spareribs that are suitable for barbecuing. On the other hand, the opponent's trade-mark THE BAR B BARN & Design is inherently distinctive when considered in its entirety as applied to restaurant services even though it might suggest to some consumers that the opponent's restaurant services are directed to barbecued food products. Having regard to the first Dalton affidavit and as no evidence of use of its trade-mark BAR-B-RIBS has been submitted by the applicant, it is clear that both the extent to which the trade-marks have become known in Canada and the length of use of the trade-marks at issue weigh in the opponent's favour. Indeed, from the first Dalton affidavit, it would appear that the opponent's trade-mark THE BAR B BARN & Design has become relatively well known in the Montreal area in association with restaurant services.

The applicant's "pork products and beef products namely cuts of meat from or including a rib or being shaped similarly to such cuts of meat" differ from the opponent's restaurant services although one element of the opponent's services is the free delivery of food products including spareribs or ribs which, according to Mr. Dalton, is a specialty of the opponent's two restaurants situated in the Montreal area. Further, the channels of trade associated with cuts of meat and restaurant services generally differ in that the applicant's food products bearing its trade-mark BAR-B-RIBS would normally be sold through grocery stores, supermarkets delicatessens or the like while the opponent's restaurant services would normally be offered to the public through the operation of a restaurant.

As for the degree of resemblance between the trade-marks at issue, I consider there to be some degree of similarity in appearance and in sounding between the trade-marks BAR-B-RIBS and

THE BAR B BARN & Design when considered in their entirety as a matter of immediate impression. Further, to the extent that there is a suggestion of barbecued food product associated with the marks, there is some similarity in the ideas suggested by the trade-marks at issue. However, from the state of the register evidence, I do not consider that the opponent is entitled to a monopoly in respect of such an idea as applied to either food products or restaurant services.

Having regard to the above, I have concluded that the applicant has met the legal burden upon it in respect of the issue of confusion, bearing in mind the differences in the channels of trade of the parties and the limited degree of similarity between the trade-marks at issue when considered in their entirety in appearance and sounding. As a result, the applicant is the person entitled to registration of the trade-mark BAR-B-RIBS.

The final ground relates to the alleged non-distinctiveness of the trade-mark BAR-B-RIBS. However, having concluded that there would be no reasonable likelihood of confusion between the trade-marks at issue and having found that the opponent has not established any use of its trade-names in relation to restaurant services, I have dismissed the final ground of opposition.

In passing, I would note that had the opponent properly pleaded its grounds of opposition in this proceeding or had it sought to amend its pleadings to rely upon Section 12(1)(d) of the *Trade-marks Act* as a ground of opposition subsequent to registering its trade-marks in November and December of 1995, it might well have been successful in this opposition.

Having been delegated by the Registrar of Trade-marks pursuant to Section 63(3) of the *Trade-marks Act*, I reject the opponent's opposition pursuant to Section 38(8) of the *Trade-marks Act*.

DATED AT HULL, QUEBEC, THIS 15<sup>th</sup> DAY OF JULY 1996.

G.W. Partington,  
Chairman,  
Trade Marks Opposition Board.