



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

Citation: 2012 TMOB 50
Date of Decision: 2012-02-28

**IN THE MATTER OF AN OPPOSITION by
Buddha Foodha Inc. to application
No. 1,282,207 for the trade-mark BUDDHA-
BAR in the name of George V Eatertainment**

[1] On December 7, 2005, George V Restauration, une société anonyme (later changed to George V Eatertainment) (the Applicant) filed an application to register the trade-mark BUDDHA-BAR (the Mark) based on proposed use of the Mark in Canada in association with the following services: “restaurants services, bars services, hotels services”.

[2] The application, as originally filed, was also based on use of the Mark in France and registration to issue from trade-mark application No. 4739281 filed on November 23, 2005 in the Office for Harmonization in the Internal Market (OHIM) in the European Union. It further claimed priority of the said trade-mark application No. 4739281.

[3] On July 17, 2007, the Applicant filed a revised application wherein the use and registration abroad basis was amended so as to rely on registration of the Mark in France under No. 053395625 instead of registration to issue from OHIM application No. 4739281. The Applicant also filed a certified copy of French registration No. 053395625.

[4] This revised application was advertised for opposition purposes in the *Trade-marks Journal* of November 7, 2007.

[5] On August 29, 2008, Buddha Foodha Inc. (the Opponent) filed a statement of opposition against the application. The grounds of opposition can be summarized as follows (I am not listing each and every of the specific s. 30(d) grounds of opposition as pleaded by the Opponent but only some of them):

1. The application for the Mark does not comply with the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in that:

(a) the application does not comply with s. 30(a) of the Act in that the application does not contain a statement in ordinary commercial terms of the specific services in association with which the Mark is proposed to be used;

(b) the application does not comply with s. 30(d) of the Act in that the Applicant was not using and has not used the Mark at all relevant dates in France in association with the services as set out in the application;

(c) the application does not comply with s. 30(d) of the Act in that the Applicant was not entitled to base the instant application on OHIM application No. 4739281 as the services set out in OHIM application No. 4739281 are:

Services de restauration (alimentation), services de bars, services de cafés, services hôteliers, hébergement temporaire; services de thermalisme, soins du visage, enveloppements corporels, massages, cirages, services de manicure, maquillage, réflexologie, gommages corporels au sel, assistance en nutrition, aromathérapie, soins balnéaires, services d'esthétique, services de remise en forme, fitness, méditation

whereas the instant application claiming priority from OHIM application No. 4739281 covers the following services :

Restaurants services, bars services, hotels services (English)
Services de restaurant, services de bars, services hôteliers (French)

(d) the application does not comply with s. 30(d) of the Act in that the Applicant was not entitled to base the instant application on OHIM application No. 4739281 and claim priority under s. 34 of the Act based on OHIM application No. 4739281 as it was not the earliest filed application filed in any country of the Union other than Canada by the Applicant for the registration of the same or substantially the same

trade-mark for use in association with the same kind of services as those listed in the instant application, contrary to s. 34 of the Act. Earlier applications were filed for the registration of the same kind of services by the Applicant including but not limited to:

(i) French registration No. 99804764 for BUDDHA-BAR, registered in France on July 26, 1999 by the Applicant for the services: *services de restauration (alimentation)*; and

(ii) French registration No. 053395625 for BUDDHA-BAR, registered in France on November 24, 2005 by the Applicant for the following wares and services:

Services de restauration (alimentation), services de bars, services de cafés, services hôteliers, hébergement temporaire

Services de thermalisme, soins du visage, enveloppements corporels, massages, cirages, services de manicure, maquillage, réflexologie, gommages corporels au sel, assistance en nutrition, aromathérapie, soins balnéaires, services d'esthétique, services de remise en forme (service de santé)

Services de remise en forme physique (activités sportives), méditation

(e) the application does not comply with s. 30(d) of the Act in that the Applicant was not entitled to base the instant application on OHIM application No. 4739281 and claim priority under s. 34 of the Act based on OHIM application No. 4739281 as the six-month time period in which to claim priority from the filing date of the earliest application for the same or substantially the same trade-mark for use in association with the same kind of services has and had expired in view of French registration Nos. 99804764 and 053395625 owned by the Applicant, contrary to s. 31(1)(a) of the Act;

(f) the application does not comply with s. 30(e) of the Act in that as of December 7, 2005 the Applicant had actually commenced use of the Mark in Canada in association with the applied-for services;

- (g) the application does not comply with s. 30(e) of the Act in that as of December 7, 2005, the Applicant had no intention of commencing use of the Mark in Canada in association with the applied-for services;
- (h) the application does not comply with s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark given the use of the alleged trade-mark by others, including the Opponent;
2. the Mark is not distinctive within the meaning of s. 2 of the Act in view of the following:
- (a) the Mark is neither adapted to distinguish nor does it actually distinguish the services of the Applicant from the wares and services of others in the trade of similar trade-names and trade-marks, namely:
- BUDDHA DOG - used by the Opponent;
 - BUDDA BOOM BUDDA BING - used by PRC TradeMarks Inc.;
 - SMILIN' BUDDHA CABARET - used by Robert Ravinder Paul Jir;
 - BUDDHA'S VEGGIE RESTAURANT – 5802 Macleod Trail SW, Calgary, AB;
 - Bamboo Buddha Chinese Restaurant – 752 King Street West, Toronto, ON;
 - Buddha House Restaurant – 282 Jane Street, Toronto, ON;
 - Buddha's Vegetarian Foods – 666 Dundas Street, Toronto, ON;
 - The Smokin' Buddha – 265 King St., Port Colborne, ON;
 - The Organic Buddha Café – 443 Danforth Ave., Toronto, ON;
 - Laughing Buddha – 194 Elgin St., Sudbury, ON;
 - House Of Buddha – 53 Main Street South, Georgetown, ON;
 - Buddha's – Commercial Drive, Vancouver, BC;
 - Buddha Belly Deli – 459 304th Street, Kimberley, BC;
 - Buddha Village Restaurant – 3018 Dewdney Avenue, Regina, SK
- (b) the Applicant has permitted licensees or others to use the Mark such that the Mark is not distinctive contrary to s. 50 of the Act; and
- (c) that as a result of a transfer of the Mark, rights subsisted in two or more persons to the use of the Mark and the rights were exercised by those persons such that the Mark is not distinctive of the Applicant according to s. 48(2) of the Act.

[6] The Applicant filed and served a counter statement denying the Opponent's allegations.

[7] In support of its opposition, the Opponent filed the affidavits of Martin Boyd, a Spanish Language Translator at Multi-Languages Corporation, sworn October 27, 2009; and Carolyn Hewitt, a law clerk with the law firm representing the Opponent in the instant proceeding, also sworn October 27, 2009. Mr. Boyd's affidavit purports to provide a true and exact translation from Spanish into English of OHIM trade-mark registration No. 4739281. Ms. Hewitt's affidavit purports to provide certified copies of various trade-mark prosecution file histories, applications and registrations, as well as printouts of various searches conducted over the Internet. The Applicant elected not to file evidence.

[8] Only the Opponent filed a written argument. Only the Applicant was represented at an oral hearing.

[9] At the hearing, the Applicant voluntarily withdrew verbally the use and registration abroad basis and priority claim included in its application. I indicated to the Applicant that I would reserve my ruling as to the acceptability of such amendment to the decision stage and requested that the Applicant file a proposed revised application to this effect, with a copy to the Opponent, which the Applicant did on the same day. I shall therefore address this issue first.

Preliminary issue: the proposed revised application of December 6, 2011

[10] I will address first the withdrawal of the use and registration abroad basis.

[11] Amendments of applications are governed by s. 30 to 32 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations). More particularly, s. 30 states that:

30. Except as provided in sections 31 and 32, an application for the registration of a trade-mark may be amended either before or after the application is advertised pursuant to subsection 37(1) of the Act.

Whereas s. 32(d) of the Regulations states that:

32. No application for the registration of a trade-mark may be amended, after it has been advertised in the *Journal*, to change:

[...]

(d) the application from one that does not allege that the trade-mark has been used and registered in or for a country of the Union to one that does so allege;

[12] Thus, an application may be amended, after it has been advertised in the *Journal*, to withdraw a use and registration abroad basis. This reasoning is in line with decisions rendered by this Board in opposition files wherein it was stated that while an opponent had been able to successfully defeat a basis of use and registration of the mark abroad, the application could still proceed on the basis of proposed use of the mark in Canada, depending on the outcome of the remaining grounds of opposition [see *Reitmans (Canada) Ltd. v. Thymes Ltd.*, 2011 TMOB 100 at para. 37; *Canada Dry Mott's Inc. v. Krush Global Ltd.*, 2011 TMOB 86 at para. 17].

[13] Accordingly, I hereby confirm that such amendment has been accepted by the Registrar. As the instant application is now based on the sole basis of proposed use of the Mark in Canada, all of the s. 30(d) grounds of opposition revolving around the basis of use and registration of the Mark abroad have become moot and are dismissed summarily.

[14] Turning to the withdrawal of the priority claim, s. 31 and 32 of the Regulations do not contain any provisions expressly prohibiting such amendment. I have duly noted the Opponent's argument made at pp. 20-21 of its written argument concerning the validity of the Applicant's priority claim, according to which:

[A] false declaration regarding a priority claim is equivalent to including a statement in an application that an application in [sic] based upon proposed use when in fact the trade-mark has been used, or including a date of first use in an application where in fact the actual date of first use is later than the date claimed.

However, I note that the case scenarios argued by the Opponent are expressly governed by s. 32(b) and (c) of the Regulations, which provide that no application for registration of a trade-mark may be amended, after it has been advertised in the *Journal*, to change the date of first use

or making known in Canada of the trade-mark [s. 32(b)]; or the application from one alleging use or making known to one for a proposed trade-mark [s. 32(c)]. Again, s. 31 and 32 of the Regulations are silent as to the withdrawal of a priority claim. I would also observe that such amendment does not appear to be contrary to any provisions of the Act. Therefore, while I sympathize with the Opponent's argument, I must conclude that such amendment is permitted under s. 30 of the Regulations. (I note in passing that the Opponent has not objected to the Applicant's proposed revised application *per se*)

[15] Accordingly, I hereby confirm that the withdrawal of the priority claim has been accepted by the Registrar. All of the s. 30(d) grounds of opposition revolving around the issue of validity of the Applicant's priority claim, as pleaded by the Opponent, have therefore become moot and are dismissed summarily.

[16] In closing, I note that the revised application filed on December 6, 2011, incorrectly refers to the Applicant as George V Restauration, une société anonyme instead of George V Eatertainment, whereas the name change from George V Restauration, une société anonyme to George V Eatertainment was recorded by the Registrar on July 18, 2008. I find it fair to assume that such error is the result of an oversight.

Analysis

[17] 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 evidentiary 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 Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[18] Applying these principles to the instant case, the other s. 30 grounds of opposition can also be summarily dismissed as follows:

- The s. 30(a) ground of opposition, as pleaded, does not raise a proper ground of opposition in that the Opponent has not pleaded any material facts in respect thereof;
- The s. 30(e) grounds of opposition fail on the basis that the Opponent has not met its initial evidentiary burden in respect thereof. There is no evidence that puts into issue the correctness of the proposed use basis claimed in the Applicant's application; and
- The s. 30(i) ground of opposition, as pleaded, does not raise a proper ground of opposition. The mere fact that the Applicant may have been aware of the existence of similar trade-names and trade-marks used by others, including the Opponent, does not preclude it from making the statement in its application required by s. 30(i) of the Act.

Even if the ground had been properly pleaded, where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional circumstances such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.)]. There is no such evidence in the instant case. Indeed, the mere fact that the Applicant already owns an existing trade-mark registration for the same mark in respect of various wares and services, including “*services de restauration (alimentation)*” [catering services (food)], based on use and registration abroad, with no use or proposed use in Canada claims made in the registration [see copy of Registration No. TMA662,480 included in the certified copy of the prosecution file history for Canadian trade-mark application No. 1,148,691 filed as Exhibit 2 to the Hewitt affidavit] cannot lead to an inference of bad faith.

[19] There remains the ground of opposition based on non-distinctiveness of the Mark.

The non-distinctiveness ground of opposition

[20] As indicated above, the non-distinctiveness ground, as pleaded by the Opponent, has three prongs. The second and third prongs can be summarily dismissed on the basis that the

Opponent has not met its initial evidentiary burden in respect thereof. There is no evidence whatsoever revolving around the use of the Mark, be it by the Applicant itself or its predecessor(s)-in-title, if any, that puts into issue the distinctiveness of the Mark pursuant to s. 48(2) or 50 of the Act. This leaves the first prong of the non-distinctiveness ground of opposition.

[21] In order to meet its evidentiary burden with respect to this particular ground of opposition, the Opponent must show that as of the filing date of the opposition, in this case August 29, 2008, the trade-names and trade-marks alleged in its statement of opposition had become known to some extent at least to negate the distinctiveness of the Mark [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)]. Transposing the comments of Board Member de Paulsen in *Whole Foods Market IP, L.P. v. Salba Corp. N.A.*, 2012 TMOB 5, an attack based on non-distinctiveness is not restricted to the actual performance of services or sales of goods in Canada. It may also be based on evidence of knowledge or reputation of the Opponent's or third parties' trade-marks or trade-names spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [*Motel 6*, at 58-59]. This brings me to review the Opponent's evidence on this point submitted by way of the Hewitt affidavit.

[22] Ms. Hewitt states in her affidavit that she was instructed by a solicitor at her firm to go to the on-line Canadian Trade-marks Database and search for active trade-marks containing the word "BUDDHA". She attaches to her affidavit as Exhibit 12 a printout of the search results. She also attaches as Exhibits 13 to 35 printouts of the 23 search results that resulted, which include the Opponent's trade-mark application Serial No. 1,316,554 for the trade-mark BUDDHA DOG based, among others, on use of the mark in association with "dine-in and take-out food and drink services" since at least as early as July 1, 2005. Upon review of these exhibits, I note that most of the trade-marks revealed by Ms. Hewitt's state of the register search have not yet been allowed for registration or registered. Considering the low number of pertinent allowed applications or registrations revealed (that is less than four), I find that little can be inferred from Ms. Hewitt's state of the register search as to the state of the marketplace [see *Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432 (T.M.O.B.); *Welch Foods Inc. v. Del Monte Corp.*

(1992), 44 C.P.R. (3d) 205 (F.C.T.D.); and *Maximum Nutrition Ltd. v. Kellogg Salada Canada Inc.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)].

[23] Concerning more particularly the Opponent's use or making known of the BUDDHA DOG trade-mark in Canada, Ms. Hewitt states that she was instructed to go to the Opponent's website *www.buddhafoodha.com* and print off pages from the website and associated links. She attaches as Exhibits 36 to 57 the web pages she personally caused to be printed. She also attaches as Exhibits 58 and 59 a list of search results and the associated links relating to the Opponent's use of BUDDHA DOG. She further attaches as Exhibits 60 to 63 articles and an interview relating to the Opponent's use or making known of BUDDHA DOG in Canada.

[24] Ms. Hewitt states that on June 26, 2008, she personally visited the BUDDHA DOG restaurant located at 163 Roncesvalles Avenue in Toronto, Ontario. She states that the restaurant store front contained a BUDDHA DOG sign. Dine in and take out services were offered. She personally dined in at the BUDDHA DOG store during her visit.

[25] Turning to the third party uses of the "BUDDHA" trade-marks or trade-names listed above in the statement of opposition, Ms. Hewitt states that she was instructed to conduct a Google search of each of them and to print off the first page of the search results and the associated web pages related to the third party. She states that where a website existed for the third party or it was possible through another website advertising the third party use, she was instructed to go to the archive.org website and conduct a search of that website and print the search results. She attaches as Exhibits 64 to 84 such search results.

[26] I do not wish to comment in detail on each and every piece of evidence included in the voluminous evidence introduced by Ms. Hewitt concerning the use or making known of BUDDHA DOG by the Opponent and each of the third party "BUDDHA" trade-marks or trade-names referred to in the statement of opposition. Suffice it to say that I am satisfied from my review of the various exhibits attached to Ms. Hewitt's affidavit that the Opponent has shown fairly substantial evidence of knowledge or reputation of the Opponent's BUDDHA DOG trade-mark as well as that of all the alleged third party "BUDDHA" trade-marks or trade-names prior

to the filing of the statement of opposition, except for BUDDA BOOM BUDDA BING; Buddha Belly Deli; and Buddha Village Restaurant. This brings me to discuss the Applicant's argument made at the oral hearing that the existence of other "BUDDHA" trade-marks or trade-names, be it in the marketplace or on the register of trade-marks, does not annihilate the distinctiveness of the Applicant's Mark.

[27] The very fact that the Opponent's BUDDHA DOG trade-mark itself coexists in the Canadian marketplace with ten or so third party "BUDDHA" trade-marks or trade-names associated with restaurant services or the like as put forward by the Opponent leads me to infer that consumers are accustomed to making fine distinctions between trade-marks or trade-names incorporating the word "BUDDHA" in association with restaurant services in the marketplace. I agree with the Applicant that the differences existing between the Applicant's Mark and the Opponent's BUDDHA DOG trade-mark as well as the third party "BUDDHA" trade-marks or trade-names should be sufficient, in the circumstances, to preclude a likelihood of confusion. It is not necessary to discuss in detail the other circumstances enumerated in s. 6(5) of the Act as I find that none of them is significant enough to find a likelihood of confusion in the instant case [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (S.C.C.); *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.); and *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 92 C.P.R. (4th) 361 (S.C.C.) for a thorough discussion of the general principles that govern the test for confusion].

[28] Accordingly, I find that the Applicant has satisfied its burden to show that there was not a reasonable likelihood of confusion between the marks at issue as of the material date of August 29, 2008. Thus, the first prong of the non-distinctiveness ground of opposition is also dismissed.

Disposition

[29] In view of the foregoing and 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.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office