



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

Citation: 2012 TMOB 19
Date of Decision: 2012-02-06

**IN THE MATTER OF OPPOSITIONS by
Euromed Restaurant Limited to
application Nos. 1,214,099 and 1,214,100
for the trade-marks OPUS and OPUS
HOTEL in the name of Trilogy Properties
Corporation**

Application No. 1,214,099

[1] On April 21, 2004, Trilogy Properties Corporation (the Applicant) filed an application to register the trade-mark OPUS (the OPUS Mark). The application was filed on the basis of use in Canada since September 2002 in association with the following services (as amended):

The provision of hotel services; lodging and accommodation services; conference room services; exercise facility services; entertainment services, namely, live shows and piano playing; facsimile services, typing services; Internet and computer services, namely providing guests with access to the Internet and computers for their personal and business use (the Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 7, 2008.

[3] On June 25, 2008, Euromed Restaurant Limited (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) contrary to s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant could not have been satisfied of its entitlement to use the OPUS Mark since its use is contrary to s. 22 of the Act;
- (b) contrary to s. 12(1)(d) of the Act, the OPUS Mark is not registrable because it is confusing with the Opponent's trade-mark registered under No. TMA713,104;
- (c) contrary to s. 16(1)(a) and 16(1)(c) of the Act, the Applicant is not the person entitled to registration of the OPUS Mark because, at the date of first use alleged, the OPUS Mark was confusing with the Opponent's trade-marks and trade-names OPUS, OPUS RESTAURANT ON PRINCE ARTHUR & design, and OPUS RESTAURANT ON PRINCE ARTHUR used in Canada in association with restaurant, bar, catering services, food delivery services, wine tastings and operation of an Internet website in the field of restaurant services;
- (d) contrary to s. 16(1)(b) of the Act, the Applicant is not the person entitled to registration of the OPUS Mark because, at the date of first use alleged, the application was confusing with application No. 1,122,771; and
- (e) contrary to s. 2 of the Act, the OPUS Mark is not and cannot be distinctive of the Services in that the OPUS Mark was not and is not adapted to distinguish and does not actually distinguish the Services of the Applicant from the services of the Opponent.

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

[5] In support of its opposition, the Opponent filed an affidavit of Antonio Amaro. In support of its application, the Applicant filed affidavits of John deCoursey Evans and Vilayphet (Sarah) Gallvitz. No cross-examinations were conducted.

[6] The Applicant filed a written argument. A hearing was not requested.

Onus and Material Dates

[7] 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].

[8] 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.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];

- s. 38(2)(c)/16(1) of the Act - the date of first use alleged in 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.)].

Section 30(i) Ground of Opposition

[9] The first ground of opposition is set out below:

The application does not comply with the provisions of Section 30(i) of the Act in that the Applicant could not have been satisfied that it is entitled to use the trade-mark in Canada in association with the [Services]. The use of such trade-mark is contrary to the provisions of Section 22 of the *Trade-marks Act*, in that use of the Applicant's trade-mark is likely to have the effect of depreciating the value of the goodwill attaching to the Opponent's aforesaid trade-marks and trade-names. As such use is prohibited under the *Trade-marks Act*, the Applicant could not have been satisfied that it is entitled to lawfully use the subject trade-mark in Canada. The Applicant filed the application with knowledge at the time of filing of the previous use by the Opponent of the trade-marks and trade-names OPUS, OPUS & Design and OPUS RESTAURANT ON PRINCE ARTHUR.

[10] Section 22(1) of the Act states:

No person shall use a trade-mark registered by another person in a manner that is likely to have the effect of depreciating the value of the goodwill attaching thereto.

[11] This section of the Act concerns registered trade-marks. As the Opponent only has a registration for the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark, this is the only mark that could arguably support this section.

[12] Section 30(i) of the Act requires that an applicant declare itself satisfied that it is entitled to use the applied-for mark. The jurisprudence suggests that non-compliance with s. 30(i) can be found in one of two circumstances. The first circumstance is where there are exceptional circumstances such as bad faith which render the applicant's statement that it is satisfied that it is entitled to use the applied-for mark untrue [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155; *Cerverceria Modelo, S.A. de C.V. v. Marcon* (2008), 70 C.P.R. (4th) 355 (T.M.O.B.) at 369]. In this case, there is no evidence of bad faith on the part of the Applicant. The second circumstance is where there is a *prima facie* case of non-compliance with a federal statute such as the *Copyright Act* R.S.C. 1985, c. C-42, *Food and Drugs Act*, R.S.C. 1985, c. F-27 or *Canada Post Corporation Act*, R.S.C. 1985, c. C-10 [see *Interactiv Design Pty Ltd. v. Grafton-Fraser Inc.* (1998), 87 C.P.R. (3d) 537 (T.M.O.B.) at 542-543].

[13] Neither the Registrar, nor the Federal Court has ruled on whether a s. 30(i) ground of opposition based on the violation of s. 22 is a valid ground of opposition [*Parmalat Canada Inc. v. Sysco Corp.* (2008), 69 C.P.R. (4th) 349 (F.C.) at paras. 38-42]. Even if I found this to be a valid ground of opposition, as the Opponent has failed to adduce any evidence supporting a likelihood of depreciation of goodwill which would support a violation of s. 22 [see *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401 (S.C.C.) at paras. 46, 63-68], it would have no chance of success. Accordingly, this ground of opposition is dismissed.

Section 12(1)(d) Ground of Opposition

[14] I have exercised my discretion and checked the register to confirm that registration No. TMA713,104 for the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark set out below 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.



Services: Operation of restaurant, bar, catering services, food delivery services, wine tastings operation of an Internet website in the field of restaurant services.

[15] 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 an 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.

[16] 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), 92 C.P.R. (4th) 361 (S.C.C.) 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.

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

[17] The OPUS Mark and the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark have a similar degree of inherent distinctiveness with the latter being slightly more distinctive due to its design elements.

[18] The distinctiveness of a trade-mark may be increased by its use or if it has become known in Canada. The evidence of the Opponent's affiant, Mr. Amaro, officer, director and owner of the Opponent, provides the following:

- Since June 26, 1992, the Opponent has displayed the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark on the front of the Opponent's restaurant

located on Prince Arthur Avenue, in Toronto, Ontario and on its menus (Amaro affidavit, paras. 11-12; Exhibits B-C).

- From June 26, 1992 until August 31, 2002, the Opponent has served over 200,000 people (Amaro affidavit, para. 15).
- From 1992-2009, the Opponent spent \$30,000 on advertising its services in association with the OPUS and the OPUS RESTAURANT ON PRINCE ARTHUR & design trademarks (Amaro affidavit, para. 14).
- The Opponent has been recognized in articles appearing in the following publications: Wine Spectator, Toronto's 50 Best Restaurants, Dine, Toronto Star, Financial Post, The Toronto Sunday Sun, National Post, New York Times and American Way (Amaro affidavit, paras. 17, 21, Exhibits H1-4, I-M). No circulation figures have been provided. I am, however, prepared to take judicial notice of the fact that the Toronto Star and National Post have wide circulation in Canada, the New York Times has some circulation in Canada and The Toronto Sunday Sun has some circulation in Toronto, Ontario and the surrounding area [*Milliken & Co. v. Keystone Industries (1970) Ltd.*, (1986), 12 C.P.R. (3d) 166 (T.M.O.B.) at 168-169].

[19] The evidence of the Applicant's affiant, Mr. Evans, President and Chief Executive Officer of the Applicant, provides the following:

- In September 2002, the Applicant began offering Services in association with the OPUS Mark (Evans affidavit, para. 2).
- Mr. Evans provides examples of the OPUS Mark appearing on signage, brochures, maps and business cards (Evans affidavit, Exhibits B, D).
- Since opening in 2002, the Opus Vancouver hotel has sold more than 175,000 nights accommodation (Evans affidavit, para. 11).
- The OPUS Mark and Services have been advertised in the En Route, Playback, Zink, and M & IT Meetings and Incentive Travel magazines (Evans affidavit, Exhibits E-F)

and referenced in the following publications: Orange Coast, San Diego Magazine, Small Luxury Hotels, New York Times, Toronto Star, Alberta Oil Lifestyle, Shape, Fortune, Condé Nast Traveller, up! and The Vancouver Sun (Evans affidavit, Exhibits F,Q,R). No circulation figures have been provided. As above, I am prepared to take judicial notice of the fact that the Toronto Star has wide circulation in Canada, that the New York Times has some circulation in Canada and that The Vancouver Sun has some circulation in Vancouver, British Columbia and the surrounding area.

[20] Based on the foregoing information, the parties' marks appear to be known to a similar degree. As such, this factor favours neither party.

length of time each trade-mark has been in use

[21] This factor favours the Opponent since use of its trade-mark began in 1992 (Amaro affidavit, para. 11), whereas use of the OPUS Mark began in September 2002 (Evans affidavit, para. 2).

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] In his affidavit, Mr. Amaro states that he is not "aware of a Hotel in Canada that does not have a restaurant or a bar or room service providing food" (Amaro affidavit, para. 32) and that hotels in Canada are recognized as having restaurants and bars on their premises as part of the hotel services provided (Amaro affidavit, para. 31). I do not agree that services related to the provision of food and drink are understood to be part of hotel services. Similar to the *Courtyard Restaurant Inc. v. Marriott Worldwide Corp.*; 2006 CarswellNat 5371 (T.M.O.B.) at para. 56 case, I find that these services occupy different niches as one is primarily concerned with the

hotel business and the other with the bar and restaurant business [*Sim & McBurney v. Decore Holdings Inc.* (2011), 94 C.P.R. (4th) 399 (T.M.O.B.) at para. 16]. The mere fact that the parties' services all belong to the general class of hospitality services does not lead to a finding that the parties' services themselves are similar. Furthermore, the parties' services would be targeted at different parties (those interested in lodging versus those interested in dining).

[24] The Applicant's evidence supports the fact that hotel services and bar and restaurant services are different. With the exception of some promotional material relating to packages including both hotel and restaurant services, the Applicant's restaurant services appear to be promoted generally and do not appear to be targeted to hotel guests (Evans affidavit, Exhibits G, M, P). The Opponent's own evidence shows that restaurant and hotel services are not typically offered in association with the same trade-mark which further supports a distinction between hotel and restaurant services. Mr. Amaro provides four examples of hotels in Toronto which include restaurants each having a different name than the hotels they are associated with. No evidence of a restaurant operating within a hotel with the same name was provided by Mr. Amaro.

degree of resemblance between the trade-marks

[25] Overall, there is only some degree of resemblance between the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark and the OPUS Mark. While there is a high degree of resemblance visually due to the emphasis on the OPUS component in the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark, the marks are somewhat different sounding due to the additional components. Finally, the parties' marks do not suggest the same idea. The Opponent's OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark suggests a restaurant located on Prince Arthur street or avenue. The OPUS Mark gives no such impression [*Starbucks Corp. v. Food Steps International Inc.*; 2009 CarswellNat 4097 (T.M.O.B.) at para. 22]. The degree of resemblance is not sufficient to overcome the difference in the services of each party.

surrounding circumstances

[26] The Applicant filed an affidavit of Ms. Gallvitz, a trade-mark agent employed by its agent, attaching state of the register evidence which is of limited relevance. In view of my findings above, it is not necessary to discuss this evidence further.

conclusion

[27] Section 6(2) of the Act does not concern confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by s. 6(2) is whether there would be confusion of the Services sold under the Mark such that they are thought to be provided by the Opponent. I conclude that, on a balance of probabilities, given all the surrounding circumstances there is not a reasonable likelihood of confusion. The differences between the marks and their associated services are sufficient to make confusion unlikely. This ground of opposition is therefore dismissed.

Section 16(1)(a) Ground of Opposition

[28] The Opponent has pleaded that the Applicant is not the person entitled to register the OPUS Mark as it is confusing with its OPUS, OPUS RESTAURANT ON PRINCE ARTHUR and OPUS RESTAURANT ON PRINCE ARTHUR & design trade-marks used in association with the operation of restaurant, bar, catering services, food delivery services, wine tastings and operation of an Internet website in the field of restaurant services.

[29] For the reasons set out above in the discussion of the s. 12(1)(d) ground, I do not find that the Mark was confusing with either the OPUS RESTAURANT ON PRINCE ARTHUR & design or OPUS RESTAURANT ON PRINCE ARTHUR trade-marks as of the relevant date (September 2002).

[30] I note that the Opponent does not allege in its statement of opposition that the Mark is confusing with the prior use of its OPUS RESTAURANT ON PRINCE ARTHUR & design or OPUS ON PRINCE ARTHUR trade-marks in association with conference room services or entertainment services, namely, live shows and piano playing even though Mr. Amaro states in his affidavit the Opponent has used its trade-mark in association with these services (Amaro

affidavit, para. 33). Even if it had, I would not have found that it had met its burden in adducing evidence in respect of these particular services since we only have Mr. Amaro's bald statements of use with no supporting evidence showing use [*Payless ShoeSource Worldwide Inc. v. Timberland Co*; 2010 CarswellNat 3489 (T.M.O.B.) at para. 15].

[31] I will now consider the likelihood of confusion with the Opponent's OPUS trade-mark as of September 2002. Despite the fact that the marks are identical, the difference in the parties' services (restaurant vs. hotel services), is sufficient to conclude, on a balance of probabilities, that there is not a likelihood of confusion. Accordingly, this ground of opposition is dismissed.

Section 16(1)(b) Ground of Opposition

[32] The Opponent has pleaded that the Applicant is not the person entitled to register the Mark as it is confusing with application No. 1,122,771 for the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark which subsequently registered under No. TMA713,104.

[33] I have used my discretion to confirm that this application was pending as of September 2002 and May 7, 2008, the date of first use alleged and date of advertisement respectively of the subject application [*Royal Appliance Manufacturing Co. v. Iona Appliances 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.

[34] Given the differences in the marks and their associated services as set out in the s. 12(1)(d) ground of opposition, I do not find that the OPUS Mark was confusing with the OPUS RESTAURANT ON PRINCE ARTHUR & design trade-mark as of the relevant date (September 2002). Accordingly, this ground of opposition is dismissed.

Section 16(1)(c) Ground of Opposition

[35] The Opponent has alleged that the Applicant is not the person entitled to register the Mark as it is confusing with the use of the trade-names OPUS and OPUS RESTAURANT ON PRINCE ARTHUR.

[36] I find the Opponent has only met its burden with respect to the use of the trade-name OPUS RESTAURANT ON PRINCE ARTHUR as of September 2002. OPUS *per se* has not been used as a trade-name since the evidence shows only use of the trade-name OPUS RESTAURANT ON PRINCE ARTHUR (Amaro affidavit, Exhibits B-D). My findings with respect to confusion regarding the s. 16(1)(a) and s. 12(1)(d) grounds are for the most part applicable with respect to this ground of opposition, accordingly, it is dismissed.

Section 2 Ground of Opposition

[37] The Opponent has pleaded that the Mark is not distinctive of the Services of the Applicant. The Opponent must prove that its trade-marks OPUS, OPUS RESTAURANT ON PRINCE ARTHUR and OPUS RESTAURANT ON PRINCE ARTHUR & design and its trade-names had become sufficiently known as of June 25, 2008 to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D) at 58; *Bojangles' International, LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 at para. 34]. The conclusion reached on the issue of likelihood of confusion between the Mark and the Opponent's trade-marks and trade-names under the other grounds of opposition are equally applicable to this ground of opposition. Consequently the Mark is adapted to distinguish and actually distinguishes the Services from the Opponent's services. Accordingly, this ground of opposition is also dismissed.

Appl. No. 1,214,100

[38] Application No. 1,214,100 for the mark OPUS HOTEL (the OPUS HOTEL Mark) was filed on April 21, 2004 based on use in Canada in association with the Services (as amended). The OPUS HOTEL Mark was advertised for opposition purposes on May 7, 2008 and was opposed by the Opponent on June 25, 2008. With the exception of the degree of resemblance, the issues for decision, material dates and the evidence of record are largely the same as in the opposition to application No. 1,214,099.

[39] As compared to the OPUS Mark, the OPUS Hotel Mark has less of a degree of resemblance to the Opponent's OPUS RESTAURANT ON PRINCE ARTHUR word and design trade-marks, OPUS trade-mark and OPUS and OPUS RESTAURANT ON PRINCE ARTHUR

trade-names. The presence of the HOTEL component assists in distinguishing the mark visually and aurally. Finally, the OPUS HOTEL Mark suggests a hotel. Neither the Opponent's marks, nor its trade-names suggest a similar idea.

[40] Given the differences between the parties' services as discussed with respect to application No. 1,214,099, I do not find that there is a likelihood of confusion. As such, the grounds of opposition based on s. 12(1)(d), s. 16(1)(a), (b) and (c) and 2 are dismissed.

Disposition

[41] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the oppositions to application Nos. 1,214,099 and 1,214,100 pursuant to s. 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office