



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

**Citation: 2017 TMOB 49**  
**Date of Decision: 2017-04-28**

**IN THE MATTER OF OPPOSITIONS**

**Shefa Franchises, Ltd.**

**Opponent**

**and**

**SilverBirch Hotels and Resorts Limited  
Partnership**

**Applicant**

**1,566,222 for AROMA RESTO BAR &  
Design**

**Applications**

**1,566,223 for AROMA RESTO BAR**

[1] SilverBirch Management Ltd. (the Applicant) has applied-for registration of the trade-marks AROMA RESTO BAR and AROMA RESTO BAR & Design below. On April 19, 2017, the assignment of these trade-marks to SilverBirch Hotels and Resorts Limited Partnership was recorded.

The applications for these trade-marks are for use in association with the following Goods and Services:

Goods:

- (1) Printed matter, namely restaurant menus.
- (2) All related food establishment merchandising products namely, take-out bags, all-purpose food and beverage containers, menu sign, pylon signs, place mats, disposable plates, plastic and stationary labels, souvenir shirts, chinaware, silverware, cups, and memorabilia products, namely, spoons, mugs, pens, pencils, key chains, stuffed toys, hats, aprons, decals, coasters, and tablecloths.

Services:

- (1) Restaurant services, operation of a restaurant.
- (2) Full serve restaurant services, namely breakfast, lunch and dinner.
- (3) Cocktail lounge services.
- (4) Catering services, namely provision of food and beverage services offered at general purpose facilities for meetings, conferences and exhibitions namely banquet and social function facilities.

The Applicant's applications are based on use of these trade-marks in association with Services (1)-(4) and Goods (1) since January 2005 and proposed use of these trade-marks in association with Goods (2).

[2] Shefa Franchises, Ltd. (the Opponent) alleges that the trade-marks AROMA RESTO BAR and AROMA RESTO BAR & Design are confusing with its trade-mark registrations, including two registrations for AROMA ESPRESSO BAR. The Opponent also alleges that the applied-for trade-marks are not distinctive of the Applicant in view of the Opponent's extensive and longstanding use of its trade-marks AROMA, AROMA EXPRESS and AROMA ESPRESSO BAR in Canada in association with the operation of cafés, restaurants and the sale of coffee, tea and a wide range of food products. The Opponent also raises two other challenges to the applications: (i) that the trade-marks have not been used by the Applicant from the first use date claimed and (ii) that the trade-marks AROMA RESTO BAR and AROMA RESTO BAR & Design are not distinctive as parties other than the Applicant have used these trade-marks without such use being properly licensed.

[3] For the reasons that follow, I find that these applications should be refused.

Application No. 1,566,223

[4] I will first consider the Opponent's opposition to application No. 1,566,223.

Background

[5] On February 28, 2012, the Applicant filed an application for the trade-mark AROMA RESTO BAR (the Mark) in association with the Goods and Services as amended.

[6] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 5, 2013. The Opponent filed a statement of opposition on November 5, 2013 and shortly thereafter was granted leave to file an amended statement of opposition to correct a typographical error. The grounds of opposition pleaded are as follows:

- (a) The application does not comply with section 30(b) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) since the Mark has not been used by the Applicant in association with the Goods and Services listed in the application from the date of first use claimed or at all.
- (b) The Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with one or more of the following registered trade-marks owned by the Opponent for use in association with goods and services such as café services, retail store services featuring coffee, tea, baked goods, breads and sandwiches and as an informal restaurant featuring coffee, tea, cocoa, chocolate and espresso beverages.

Reg. No.	Trade-mark
TMA733,102	AROMA ESPRESSO BAR
TMA693,683	AROMA ESPRESSO BAR
TMA762,080	Aroma Espresso Bar Design

TMA790,546	AROMA EXPRESS
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(c) The Mark is not distinctive having regard to section 2 of the Act in that it does not distinguish, nor is it adapted to distinguish the Goods and Services of the Applicant from those of the Opponent because of the use and promotion by the Opponent of its trade-marks in Canada and abroad with spillover into Canada.

(d) The Mark is not distinctive because of its use by those other than the Applicant without such use being properly licensed in accordance with the requirements of section 50 of the Act.

[7] The Applicant filed and served a counter statement, in which it denies the Opponent's allegations.

[8] The Opponent filed as its evidence the affidavits of Jennifer Leah Stecyk and Nicole McDonald. The Applicant filed as its evidence the affidavits of Paula Stenzel and Jean Mai. The Opponent alone filed a written argument. A hearing was not requested.

#### Onus and Material Dates

[9] The Applicant bears the legal onus of establishing, on a balance of probabilities that its application complies with the requirements of the Act. 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 [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[10] The material dates that apply to the grounds of opposition are as follows:

- sections 38(2)(a)/30(b) - the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- sections 38(2)(b)/12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 at 422 (FCA)]; and

- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

## **Grounds of Opposition**

### *Section 30(b) Ground of Opposition*

[11] The Opponent alleges that the application does not comply with section 30(b) of the Act as the Mark was not being used by the Applicant as of the date claimed in the application. Such a ground of opposition is necessarily restricted to Goods (1) and Services (1)-(4) which are based on use.

[12] The evidential burden on an opponent respecting the issue of an applicant's non-compliance with this section of the Act is a light one and can be met by reference not only to its evidence, but also to an applicant's evidence [*Labatt Brewing Co Ltd v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD) at 230; *Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 33-38]. To meet its burden, an opponent must show that an applicant's evidence is clearly inconsistent with the claimed date of first use or raises doubt as to the veracity of the claimed date of first use [*Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), at 565 -6, aff'd (2001), 11 CPR (4th) 489 (FCTD); *Corporativo de Marcas, supra*; *Reitmans (Canada) Limited v Atlantic Engraving Ltd*, 2005 CanLII 78234 (TMOB)]. If an opponent meets its evidential burden, an applicant must prove that it has used the Mark as of the date claimed.

[13] The evidence of both the Opponent and the Applicant raises a real doubt as to whether the Applicant was the person using the Mark as of the January 2005 date claimed in the application with respect to Goods (1) and Services (1)-(4).

[14] The evidence of Ms. Stecyk, a trade-mark searcher employed by the agent for the Opponent, includes webpages for "AROMA Mediterranean Resto-Bar" in the Radisson Hotel. These webpages include the copyright notice "© 2014 Radisson. All rights reserved." (Stecyck affidavit, para 6, Exhibit E). The Site Usage Terms & Conditions for this website include the following notice "All trademarks, service marks, trade names and trade dress are proprietary to

Carlson Hotels or its subsidiaries or affiliated companies and/or third party licensors.” (Stecyk affidavit, para 6, Exhibit E).

[15] The evidence of Ms. Stenzel, the Manager, Customer Experience and Social Media for SilverBirch Hotels & Resorts, sets out that “Aroma Resto Bar is a restaurant located ... in the Radisson Hotel Saskatoon, one of the hotels operated by SilverBirch” and opened in 2004 (Stenzel affidavit, para 2). Ms. Stenzel also provides printouts from the Facebook pages of the Aroma Resto Bar which feature the Mark and the AROMA RESTO BAR & Design trade-mark prominently and include the following “Copyright ©2012 Aroma Mediterranean Resto Bar” (Exhibit A). Nowhere in the text of her affidavit does Ms. Stenzel name the Applicant, nor confirm that use of the Mark was by the Applicant or a licensee of the Applicant.

[16] Given the identification of multiple entities whose webpages advertise the Mark and the failure of Ms. Stenzel to indicate that the Mark is licensed by the Applicant, the Opponent has met its evidential burden. I consider the evidence to raise a real doubt as to whether the Applicant was the person using the Mark. As the Applicant has not evidenced that it has used the Mark in association with these goods and services since the date claimed, this ground of opposition is successful with respect to Goods (1) and Services (1)-(4).

#### *Section 12(1)(d) Ground of Opposition*

[17] My analysis will focus on the Opponent’s trade-mark registrations for AROMA ESPRESSO BAR as I consider that these registrations represent the Opponent’s best chance of success.

[18] With respect to a section 12(1)(d) ground of opposition, an opponent’s initial evidential burden is met if a registration relied upon in the statement of opposition is in good standing as of the date of the decision. The Registrar has discretion to check the register in order to confirm the existence of a registration relied upon by an opponent [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. In this case, I have exercised that discretion and confirm that the Opponent’s registration Nos. TMA693,693 and TMA733,102 for AROMA ESPRESSO BAR for use in association with the goods and services set out below are in good standing.

Registration No.      Opponent's Goods and Services

TMA693,683      Goods

(1) Coffee, tea, cocoa, chocolate and espresso beverages and non-alcoholic beverages made with a base of coffee, cocoa, chocolate, espresso and/or milk; sodas and soft drinks, fruit juices, vegetable juices; muffins, cookies, cakes, pastries, breads and sandwiches

Services

(1) Retail store services featuring coffee, tea, cocoa, chocolate and espresso beverages and non-alcoholic beverages made with a base of coffee, cocoa, chocolate, espresso and/or milk; sodas and soft drinks, juices, baked goods, muffins, cookies, cakes, pastries, breads and sandwiches.

TMA733,102      Café services.

[19] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[20] In applying the test for confusion, the Registrar must have regard to all of the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time each has been in use; (c) the nature of the goods, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

[21] These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22 and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 96 CPR (4th) 361 (SCC)].

### *Inherent Distinctiveness*

[22] Neither trade-mark is inherently distinctive because the word “aroma” may mean a fragrance; a distinctive and pleasing smell, often of food; and may suggest a pleasing smell from the foods served at either the Applicant’s restaurant or the Opponent’s café or retail store [see definition of “aroma” in the *Canadian Oxford Dictionary*, 2<sup>nd</sup> ed; see *Tradall SA v Devil's Martini Inc* 2011 TMOB 65 at para 29]. Further, the other components in each of the trade-marks “ESPRESSO BAR” and “RESTAURANT BAR” appear to be descriptive of the associated services.

### *Extent to Which Marks Have Become Known and Length of Time in Use*

[23] This factor does not favour either party. The evidence of Nicole McDonald, a summer student employed by the Opponent’s agent, is that she visited two Aroma Espresso Bar locations and took pictures of the trade-mark AROMA ESPRESSO BAR appearing on cups, bags, receipts and on signage (Exhibits E-G and Exhibits I-L). While this evidence may show that the Opponent’s trade-mark AROMA ESPRESSO BAR was in use on the particular day she visited, this does not allow me to conclude to what extent this trade-mark is known, nor the length of time in use. While the printouts of the Opponent’s website *www.aroma.ca* attached as Exhibit B reference longstanding use of the Opponent’s AROMA ESPRESSO BAR trade-mark and explain that the Opponent licenses the use of its trade-marks in Canada, this evidence is hearsay and not admissible for the truth of its contents [see *Kocsis Transport Ltd v “K” Line America Inc*, 2008 TMOB 37]. The Applicant’s evidence in the affidavit of Ms. Stenzel does not allow me to conclude that any use of the Mark has enured to it because the Applicant is not referenced in the text, nor in any of the Exhibits attached to Ms. Stenzel’s affidavit.

### *Nature of Goods, Business and Trade*

[24] When considering the nature of the goods and services in respect of the issue of confusion, it is the statements of goods and services in the subject application and registrations that govern [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna*, 1994 CanLII 3534 (FCA), [1995] 1 FCR 614]. However, those statements must be read with a view to determining the probable type of business or trade



intended by the parties rather than all possible trades that might be encompassed by the wording. In this regard, evidence of the actual trades of the parties is useful, particularly where there is an ambiguity as to the goods and services set out in the subject application or registrations [*McDonald's Corp v Coffee Hut Stores Ltd*, 1996 CanLII 3963 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[25] While it appears from the evidence that the parties' goods and services may target different consumers (ie) coffee shop patrons vs upscale restaurant dining patrons (see, for example, the menu board at Exhibit E of the McDonald affidavit; the About Aroma Resto Bar page in Exhibit A and pictures of dishes in Exhibit E of the Stenzel affidavit), they still appear to significantly overlap because the Goods such as take-out bags, disposable plates and all-purpose food and beverage containers seem to suggest restaurant and catering services more similar to the Opponent's Registered Goods and Services than different from it. In this regard, I note that the application does not include any type of restriction to the type of restaurant services provided.

#### *Degree of Resemblance*

[26] As stated earlier, the degree of resemblance between the trade-marks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. The preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64]. I find that the Mark and the Opponent's trade-mark AROMA ESPRESSO BAR have a high degree of resemblance in appearance and as sounded due to the shared striking component AROMA and the last component of each trade-mark BAR. With respect to the ideas suggested, the parties' trade-marks suggest slightly different types of restaurants (ie) one being a restaurant bar focusing on food and one suggesting an espresso bar.

#### *Surrounding Circumstance: State of the Register and State of the Marketplace*

[27] The Applicant has filed the affidavit of Jean Mai, an employee of the Applicant's agent, who submits the following evidence:

- The results of a trade-mark search of the CIPO website for "Aroma" (Exhibit F) and copies of the trade-mark information for the trade-marks including AROMA and being used in association with coffee-related goods and services (Exhibit G).
- The first page of print-outs for searches from Google Canada of "aroma restaurant canada", "aroma restaurant", and "aroma bistro canada" (Exhibit A-C); and
- The website for the "Aroma Mediterranean Restaurant" located in London Ontario (Exhibit D) and the Facebook page for "Aroma Gourmet Pasta & Pizza" located in Lake Cowichan, British Columbia (Exhibit E).

[28] I do not find that the state of the Register evidence of the word "aroma" with coffee related goods and services to be a significant surrounding circumstance. State of the register evidence can be used to make inferences about the state of the marketplace, but only where large numbers of relevant trade-marks are located [*Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432; *Del Monte Corporation v Welch Foods Inc* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)]. Relevant trade-marks include those that (i) are registered or are allowed and based on use; (ii) are for similar goods and services as the marks at issue and (iii) those that include the component at issue in a material way.

[29] Ms. Mai's trade-mark searches for trade-marks containing AROMA for use in association with coffee goods and related services only identified three relevant trade-marks: registration Nos. TMA510,253 for AROMA & Design; TMA609,774 for AROMASEAL; and TMA682,788 for AROMASWIRL. I find the remaining third party applications and registrations submitted in Exhibit G to not be relevant for the following reasons:

- Application Nos. 1,615,111 for AROMA CUP; 1,615,112 for AROMACUP; 1,649,960 for AROMA KUP; 1,649,959 for AROMAKUP; 1,664,666 for AROMA T-CUP; 1,664,106 for Aroma Maya – are not yet allowed [*Kellogg Salada Canada, Inc, supra*];
- Application No. 1,600,920 for KRUPS Aroma Temp System & Design – while this application is allowed, it is not based on use [*Kraft Canada Inc v Happy Planet Foods Inc*, 2005 CarswellNat 2772 (TMOB) at para 21]; and

- Registration Nos. TMA883,588 for INTENSO AROMA DI CAFFÈ & Design; TMA368,120 for LAVAZZA CREMA E AROMA & Design; and TMA661,155 for CARAAROMA - while these trade-marks include the component AROMA, it does not form a prominent component of the trade-marks [see, for example, *RPM, A Partnership v American Biltrite Intellectual Properties, Inc* (2011), 92 CPR (4th) 329 (TMOB) at para 44].

In my view, the existence of the three registrations for AROMA & Design, AROMASEAL, and AROMASWIRL is insufficient in number to make any inferences about the state of the marketplace.

[30] Furthermore, the GOOGLE searches and website for "Aroma Mediterranean Restaurant" located in London Ontario (Exhibit D) and the Facebook page for "Aroma Gourmet Pasta & Pizza" (Exhibit E) do not assist the Applicant in demonstrating that there has been widespread use of the word AROMA as a trade-mark in the café and restaurant sphere. In this regard, these GOOGLE searches and website print-outs can at most be relied upon only as proof of the existence of the search results and website pages, not as proof of the truth of their contents [*Kocsis Transport, supra*]. They are therefore not sufficient to permit me to make the inference that Canadian customers are accustomed to seeing numerous trade-marks consisting of or including AROMA in the restaurant and café sectors such that they can distinguish them.

### *Conclusion*

[31] The test to be applied is a matter of first impression in the mind of a casual consumer "somewhat in a hurry" who sees the Mark in association with the Goods and Services at a time when he or she has no more than an imperfect recollection of the Opponent's AROMA ESPRESSO BAR trade-mark and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot, 2006 SCC 23* at para 20]. Having considered all of the surrounding circumstances, and in particular, the degree of resemblance between the trade-marks and the overlap in the nature of the services, I am not satisfied that the Applicant has discharged its burden of showing, on a balance of probabilities, that there is no reasonable likelihood of

confusion between the Mark and either of the Opponent's trade-mark registrations for AROMA ESPRESSO BAR. As such, the section 12(1)(d) ground of opposition is successful.

*Remaining Grounds of Opposition*

[32] Having already refused all of the Services and Goods (1) under two grounds of opposition, I will not discuss the remaining grounds of opposition with respect to this application.

Application No. 1,566,222 for AROMA RESTO BAR & Design

[33] Application No. 1,566,222 for the trade-mark AROMA RESTO BAR & Design was also filed on February 28, 2012. The issues, material dates and evidence are entirely analogous to those discussed with respect to application No.1,566,223. In this regard, I note that the design elements consist solely of the stylization of the letters and would not have a significant impact on my findings with respect to inherent distinctiveness or the degree of resemblance between the trade-marks. Accordingly, I make the same findings with respect to the first application, and the same conclusion follows, the section 30(b) and section 12(1)(d) grounds of opposition are successful.

Disposition

[34] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse both applications.

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

**TRADE-MARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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No Hearing Held

Agents of Record

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For the Opponent

Goodmans LLP

For the Applicant