



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

Citation: 2018 TMOB 62

Date of Decision: 2018-06-26

IN THE MATTER OF AN OPPOSITION

Good Earth Cafes Ltd.

Opponent

and

Urth Caffè Licensing, LLC

Applicant

1,587,204 for URTH CAFFÈ & Design

Applications

1,587,210 for URTH CAFFÈ

APPLICATION 1,587,210 for URTH CAFFÈ

FILE RECORD

[1] On July 23, 2012, Urth Caffè Licensing, LLC filed an application to register the trademark URTH CAFFÈ, based on use in Canada since November 1, 2007, in association with the following goods, as well as with the services of “online sales” of the listed goods:

coffee beans; tea; tea leaves; fruit tea; herbal tea; herbal tea blends; flavored tea; dessert gift packages consisting of pastries, cakes, and bakery goods; gift packages consisting of coffee, tea, bakery goods and cakes.

[2] A second basis for registration for the listed goods, and also for related “bakery shop” and “restaurant and coffee house” services, relies on the applicant’s registration (on September 21, 2004) and use of the mark in the United States in association with the listed goods and related services.

[3] A third basis for registration is proposed use of the mark in Canada for bakery, restaurant, and coffee house services.

[4] The Examination Section of the Canadian Intellectual Property Office (“CIPO,” under whose auspices this Board also operates) initially objected to the subject application (on January 30, 2013) on the basis that the applied-for mark U^RTH CAFF^E was confusing with a pending application (No. 1,473,289) for the mark EARTH COFFEE & Design covering the services of the sale of packaged coffee. The design feature of the mark consists of the word “coffee” appearing in small print vertically adjacent to, and to the right of, the letter H, as shown below:



[5] The applicant responded to the objection (on July 30, 2013) by arguing that the cited mark is visually very different from the applied-for mark. It appears that the argument succeeded (there is no explicit indication on file) as the applied-for mark was advertised for opposition purposes in the *Trade-marks Journal* issue dated November 19, 2014.

[6] The subject application was then opposed by Good Earth Cafes Ltd. on April 20, 2015. The opponent, in its statement of opposition, relies on several of its trademarks, comprised in part of the word components GOOD and EARTH, used in association with goods and services directly overlapping, or related to, the applicant’s goods and services.

[7] The Registrar forwarded a copy of the statement of opposition to the applicant on May 7, 2015, as required by s.38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[8] The opponent elected not to file any evidence in support of its opposition. The applicant's evidence (in respect of each opposition) consists of the affidavit of Corrine Viray; various certified copies of third party trademark registrations and applications comprised of the term "earth," or a phonetic equivalent, as a component of the marks; and the affidavit of Norman Milburn Cameron which provides, as exhibits, uncertified copies of the aforementioned third party registrations and applications. Both parties submitted written arguments and both were ably represented at an oral hearing held on March 8, 2018 (the hearing dealt with the oppositions to both applications).

STATEMENT OF OPPOSITION

[9] Various grounds of opposition, with supporting assertions of facts, are pleaded in the statement of opposition. However, only one ground was put in issue because the opponent, by failing to file evidence, failed to meet the evidential onus on it to establish the factual circumstances underlying the various grounds of opposition (except the one ground not requiring evidential support).

[10] The one remaining ground of opposition which does not require evidential support is pleaded in para. 1(d) of the statement of opposition, shown below:

The applicant's trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with a registered trade-mark, namely GOOD EARTH CAFES LTD & Design, registration number TMA 484,679 previously used or made known by the opponent in Canada in association with the wares of T-shirts and coffee mugs and the services of restaurant and food services.

[11] In this regard, the Board's policy is that it is in the public interest for the Board to exercise discretion to review the trademarks register to determine whether trademark registrations (or applications) relied on in a statement of opposition are extant at the relevant material date. If the registrations or applications are extant at the relevant material date then the Board will permit the opponent to rely on them: see *Quaker Oats Co. of Canada v. Menu Foods Ltd.* (1986) 11 CPR(3d) 410 at 411; *Royal Appliance Mfg. Co. v. Iona Appliance Inc.* (1990) 32

CPR(3d) 525 at 529. Further, an extant registration is all that is required to support a section 12(1)(d) ground of opposition; the opponent is not required to show that it has used its registered mark.

[12] The opponent's registered mark GOOD EARTH CAFES LTD & Design, relied on in quoted para. 1(d) above, is shown below:



DISPOSITION

[13] In reviewing the trademarks register, I have noted that the opponent's registered mark GOOD EARTH CAFES LTD & Design was expunged on February 1, 2018 (i.e., shortly before the oral hearing held on March 8, 2018), pursuant to a section 45 proceeding, for reasons of non-use of the mark. As the material date in respect of a ground of opposition pursuant to section 12(1)(d) is the date of my decision, and as the opponent's registered mark is no longer extant, there is no support for the last remaining ground of opposition.

[14] The opposition to application 1,587,210 is therefore rejected.

[15] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under section 63(3) of the *Trade-marks Act*.

[16] I would add that the outcome would likely have been the same had the opponent's mark been extant as of today. In this regard, the opponent's election not to file evidence would have made the resemblance between the parties' marks the most important factor in assessing the issue of confusion. I would have found the marks significantly more different than alike - leading to a finding of no confusion.

APPLICATION 1,587,204 for URTH CAFFÉ & Design

[17] The word and design mark application in issue is shown below:



[18] The opposition to URTH CAFFÉ & Design is in all respects analogous to the opposition to the word mark URTH CAFÉ. That is, the application for URTH CAFFÉ & Design has the same filing date as the application for URTH CAFFÉ, covers the same goods and services, and asserts the same bases for registration (see paras 1-3 above). The opponent did not file any evidence to support the various grounds of opposition pleaded in the statement of opposition. Again, the only ground in issue, which does not require evidential support, is based on section 12(1)(d) where the opponent relies on its expunged registration as discussed in para. 13 above. It follows that the opposition to application 1,587,204 is rejected.

[19] This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under section 63(3) of the *Trade-marks Act*.

[20] Again, I would add that the outcome would likely have been the same had the opponent's mark been extant as of today. In this regard, I would have found that the parties' marks are significantly more different than alike - leading to a finding of no confusion: see para. 16 above.

Myer Herzig
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2018-03-08

APPEARANCES

Rob McDonald

FOR THE OPPONENT

Nicholas Garner and Norman Cameron

FOR THE APPLICANT

AGENTS OF RECORD

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FOR THE OPPONENT

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