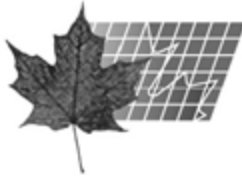


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C I P O

LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 86**

**Date of Decision: 2020-07-24**

**IN THE MATTER OF AN OPPOSITION**

**Louis Varoutsos**

**Opponent**

**and**

**Hebrew Strength-Power Corporation**

**Applicant**

**1,733,859 for WINGS BUFFALO BILL  
& Design**

**Application**

INTRODUCTION

[1] Louis Varoutsos (the Opponent) opposes registration of the trademark WINGS BUFFALO BILL & Design (the Mark), which is the subject of application No. 1,733,859, by Hebrew Strength-Power Corporation (the Applicant). The Mark is shown below and includes the following colour claim: Colour is claimed as a feature of the trademark. The words WINGS BUFFALO BILL and the outer border are in blue. The depiction of a man and the border around the words BUFFALO BILL are red.



[2] The application for the Mark is based upon proposed use in association with the following Goods and Services:

#### Goods

(1) Buffalo chicken wings, buffalo fried chicken, fried chicken, poultry and game, meat, prepared meat, sandwiches, burgers, poutine, hot sauces, spicy sauces, barbecue sauces, honey barbecue sauces, chicken wing sauces, chutney, salsa, mayonnaise, spicy mayonnaise, meat sauce, fish sauce, sauce mixes, edible spices, herbs, coleslaw, bottled water, non-alcoholic carbonated drinks, carbonated soft drinks, muffins, cookies, custard cakes, cakes

(2) Publications, namely TV shows, internet videos, books, newsletters, magazines, brochures and informational handouts in the fields of cooking, healthy nutrition and lifestyle

#### Services

(1) Operation of a restaurant; catering services; outside catering services

(2) Conducting live and on-line TV shows, pod casting, workshops, classes, conferences, seminars and healthy retreats in the fields of cooking, healthy nutrition and lifestyle

(3) Providing a website featuring information, electronic magazines, music, e-books, videos, blogs, podcast, webinars and downloadable publications in the fields of cooking, healthy nutrition and lifestyle

(4) Production of instructional and training films, videos and audio clips for others in the fields of cooking, healthy nutrition and lifestyle

[3] The opposition is primarily based on an allegation that the Mark is confusing with the Opponent's prior use and registration of its trademarks WINGS BUFFALO BILL & Design and AILES BUFFALO BILL & Design.

[4] For the reasons that follow, the application is refused.

#### THE RECORD

[5] The application for the Mark was filed on June 19, 2015.

[6] The application was advertised for opposition purposes in the *Trademarks Journal* of April 6, 2016.

[7] On September 6, 2016, the Opponent filed a statement of opposition under section 38 of the *Trademarks Act* (RSC 1985, c T-13) (the Act). The grounds of opposition pleaded by the Opponent include sections 30(i), 12(1)(d), 16(3)(a), 16(3)(b), and 2 of the Act, all of which turn on the issue of a likelihood of confusion between the Mark and the Opponent's trademarks WINGS BUFFALO BILL & Design and AILES BUFFALO BILL & Design.

[8] As the Act was amended on June 17, 2019, all references in this decision are to the Act as amended, with the exception of references to the grounds of opposition (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised before this date).

[9] The Applicant denied each of the grounds of opposition in its counter statement.

[10] The Opponent filed an affidavit in his name. The Applicant filed the affidavit of Maria Moniz. The Opponent alone filed a written argument. Neither party requested a hearing.

#### LEGAL ONUS AND EVIDENTIAL BURDEN


[11] Before considering the grounds of opposition, I will review the requirements of (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[12] With respect to (i) above, there is, in accordance with the usual rules of evidence, an evidential burden on an opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Limited v The Molson Companies Limited*, 1990 CanLII 11059 (FC), 30 CPR (3d) 293 at 298 (FCTD)]. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent in the statement of opposition (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, on a balance of probabilities standard, then the issue must be decided against an applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

**Section 12(1)(d) ground of opposition succeeds**

[13] I will first begin with a consideration of the section 12(1)(d) ground of opposition. The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent's registration set out below.

Registration No.	Trademark	Services
TMA411,356		(1) Business of operating a restaurant, for the provision of eat-in and take-out food and delivery services.  (2) Catering services; franchising services; operation of a training school for restaurant operations.

[14] The material date for considering this ground of opposition is the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)].

[15] I have exercised my discretion to check the Register and confirm that registration No. TMA411,356 is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its burden with respect to this ground of opposition.

Test to determine confusion

[16] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person, whether or not the goods or services are of the same general class or appear in the same Nice Class. In making such an assessment, I must consider all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trademarks and the

extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 (CanLII), [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

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] at a time when he or she has no more than an imperfect recollection of the [prior] trademarks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[17] The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 (CanLII), [2006] 1 SCR 772 (SCC) at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* 2011 SCC 27 at para 49, where the Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[18] Finally, section 6(2) does not concern the 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 section 6(2) is whether purchasers of the Applicant's Goods and Services, provided under the Mark, would believe that those Goods and Services were being provided by the Opponent, or that the Applicant was authorized or licensed by the Opponent.

#### Inherent distinctiveness of the trademarks

[19] This factor does not favour either party. The Mark and the Opponent's trademark AILES BUFFALO BILL & Design have a similar amount of inherent distinctiveness by virtue of the phrase BUFFALO BILL and the design features of each trademark as WINGS/AILES is descriptive of chicken wings. Given that the word BUFFALO appears to be suggestive of the goods and services offered by the parties (ie) buffalo style chicken and BILL is a given name, I consider the trademarks of the parties to have only a fair degree of inherent distinctiveness.

#### Extent known and the length of time the trademarks have been in use

[20] This factor does not favour either party.

[21] The Applicant has not filed any evidence of use of the Mark. Likewise, the Opponent has not filed any evidence of use of its registered trademark. While the Opponent provides evidence of use of another WINGS BUFFALO BILL & Design trademark (set out below) on magnets and menus distributed to customers as well as takeout boxes and signage (Exhibits B, C), for the purposes of this case, I do not consider this to be use of the Opponent's registered trademark. The Opponent's trademark as used has significant differences in its dominant features including the face designs and the stylization and font of the word portion of the mark [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].



#### Nature of the goods, services, or business, and trade

[22] The nature of the parties' goods and services and channel of trade are identical with respect to the bar and restaurant services and individual food and drink items applied-for. With respect to the remaining goods and services, I find that they all significantly overlap with the registered services as all are in the nature of providing information and entertainment with respect to food related topics.

#### Degree of resemblance

[23] The degree of resemblance between the trademarks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trademarks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trademark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra* at para 20].

[24] I find that the parties' trademarks resemble each other in appearance, sound and idea suggested. Both parties' trademarks feature BUFFALO BILL and a stylized depiction of a bearded man and suggest services offered by a man named BUFFALO BILL. Bilingual Canadians would further recognize WINGS BUFFALO BILL as the English equivalent of

AILES BUFFALO BILL. Accordingly, I find that the section 6(5)(e) factor favours the Opponent.

Surrounding circumstance – the Applicant’s evidence

[25] The Applicant filed as its evidence the affidavit of Ms. Moniz, its President and director. Ms. Moniz provides evidence of the following:

- that the Opponent’s registration No. TMA454,713 for WINGS BUFFALO BILL & Design was expunged in 2011 (para 2, Exhibit A);
- that the Opponent’s company BUFFALO BILL WINGS was cancelled ex officio on May 2004 from the Registre des Entreprises of Quebec (para 6, Exhibit B); and
- that a company 9346-0251 has changed its name multiple times, including to Ailes Buffalo Bill or BUFFALO BILL WINGS (paras 10-12; Exhibit D).

[26] In the absence of submissions, it is difficult to know how the Applicant intended this evidence to impact my assessment of the grounds of opposition. With respect to the section 12(1)(d) ground of opposition and in the absence of submissions, I do not find that this evidence forms a relevant surrounding circumstance for the following reasons:

- (a) An opponent is free to rely upon third party registrations in challenging the registrability of an applicant’s mark in relation to a section 12(1)(d) ground [*USV Pharmaceuticals of Canada Ltd v Sherman and Ulster Ltd* (1974), 15 CPR (2d) 79 (TMOB)].
- (b) Opposition proceedings are not the appropriate forum to challenge the validity of a registered trademark cited by an opponent in support of a ground of opposition based on section 12(1)(d) of the Act [*Magill v Taco Bell Corp.* (1990), 31 CPR (3d) 221 (TMOB)]. By not considering the pleaded registration it would be tantamount to a conclusion that the registration has no effect. Only the Federal Court of Canada has jurisdiction to order an entry in the Register to

be struck out on the basis that it has been abandoned or lost distinctiveness [see section 57 of the Act].

### Conclusion

[27] 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 trademark AILES BUFFALO BILL & Design used in association with the registered services [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra*]. Section 6(2) of the Act states that there is a likelihood of confusion if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold or leased by the same person. Confusion will also be found if consumers believe that the Applicant's Goods and Services are somehow approved, licensed or sponsored by the Opponent [*Big Apple Ltd v BAB Holdings Inc* (2000), 8 CPR (4th) 252 (TMOB) at para 13].

[28] Due to the similarity between the trademarks, the overlap in the nature of the goods and services and in the absence of evidence that BUFFALO BILL has been adopted by third parties, I find that a consumer upon seeing the Mark would be likely to infer that the Goods and Services associated with this Mark are approved, licensed or sponsored by the Opponent. I therefore find that the Applicant has failed to prove, on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trademark AILES BUFFALO BILL & Design. As the Applicant has not met its legal onus, the section 12(1)(d) ground of opposition succeeds.

### **Section 16(3)(a) ground of opposition succeeds**

[29] The Opponent pleads that the Applicant is not entitled to registration of the Mark as it is confusing with its use of the trademarks AILES BUFFALO BILL & Design and WINGS BUFFALO BILL & Design. The Opponent's WINGS BUFFALO BILL & Design trademark is set out below.





[30] In order to meet its initial burden with respect to its section 16(3)(a) ground of opposition, the Opponent must show that it had used its trademark WINGS BUFFALO BILL & Design as of June 19, 2015 (the filing date of the application) and had not abandoned such use as of April 6, 2016 (the advertisement date of the application) (see section 16(5) of the Act). I note that I have already found that the Opponent has not evidenced use of the AILES BUFFALO BILL & Design trademark. The Opponent's evidence summarized below is sufficient to meet its evidential burden with respect to use of the trademark WINGS BUFFALO BILL & Design in association with restaurant services selling a variety of food and drink products.

- (a) The Opponent opened the first restaurant bearing the trademarks WINGS BUFFALO BILL & Design in 1988 bringing two American fast foods, the Philadelphia cheese and steak sandwich and Buffalo chicken wings, to Canada (para 2).
- (b) The Opponent owns this trademarks and licenses the use of this trademark to Pony Express Investments Inc. (Pony Express) who in 2012 licensed 8124728 Canada Inc. to franchise these trademarks to others (para 4). The Opponent is the President and sole shareholder of Pony Express and personally supervises the trademark use of 8124728 Canada Inc. The Opponent explains in paragraph 5 of his affidavit:

I am responsible for overseeing the day to day operations of all entities that are licensed to use these trademarks. These responsibilities include franchising and licensing of these restaurants ... The character and quality of the services is under my control and is based on inspection of the premises and operations ...

- (c) The Opponent provides evidence of use of the WINGS BUFFALO BILL & Design trademark on menus, magnets and signage (Exhibit B) and menus delivered to mailboxes (Exhibit C).

- (d) Since its inception in 1988 until 2017, the publicity costs for all services associated with the WINGS BUFFALO BILL & Design and AILES BUFFALO BILL & Design trademarks are \$100,000 per year (para 14) and total revenue generated has been approximately \$20 million (para 15).

[31] While the Opponent's evidence could have been more specific (by providing yearly sales numbers and stating that the examples of use were representative), I find that the evidence provided by the Opponent is sufficient to find that he has met his evidential burden of proving use prior to the material date through his sworn statements. In this regard, I note that no cross-examination of the Opponent was conducted. Further, in the absence of submissions, I do not see how the evidence filed by the Applicant would impact whether the Opponent has met its evidential burden particularly given that the Opponent has confirmed that its trademarks have been licensed to others and there are multiple locations of the WINGS BUFFALO BILL restaurants.

[32] I find that the Applicant has failed to meet its legal onus of proving, on a balance of probabilities, that there is no reasonable likelihood of confusion. Specifically, a casual consumer with an imperfect recollection of the Opponent's trademark WINGS BUFFALO BILL & Design who encounters the Goods and Services in association with the Mark may think that the Goods and Services are sold by, sold under license or are otherwise affiliated with the Opponent. In finding this ground of opposition successful, I have had regard to all of the surrounding circumstances including that: (i) the Mark and the Opponent's trademark WINGS BUFFALO BILL & Design are virtually identical; (ii) both parties trademarks have some inherent distinctiveness; (iii) there is significant overlap between the services of the parties and (iv) there is no evidence that casual consumers are accustomed to seeing and having to distinguish between trademarks including the component BUFFALO BILL. My findings with respect to (ii)-(iii) for this ground of opposition are the same as with respect to the section 12(1)(d) ground of opposition and are discussed further in paragraphs 19 and 22 of this decision. Accordingly, this ground of opposition succeeds.

## **Remaining Grounds of Opposition**

[33] Having already refused the application under two grounds, I will not discuss the remaining grounds of opposition

### DISPOSITION

[34] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** No Hearing Held

**AGENT(S) OF RECORD**

SARIE. MOSCOWITZ

FOR THE OPPONENT

No Agent Appointed

FOR THE APPLICANT