



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 67

Date of Decision: 2020-05-29

IN THE MATTER OF OPPOSITIONS

Bellagio Properties Inc.

Opponent

and

Mirage Resorts, Incorporated

Applicant

1,660,785 for BELLAGIO

Applications

1,660,786 for BELLAGIO Design

INTRODUCTION

[1] Mirage Resorts, Incorporated (the Applicant) has applied to register the trademarks BELLAGIO (the Word Mark) and BELLAGIO Design (the Design Mark), shown below, under application Nos. 1,660,785 and 1,660,786, respectively. The Applicant is the owner of the BELLAGIO hotel in Las Vegas, Nevada:

The logo for Bellagio, featuring the word "BELLAGIO" in a serif font. The letter "B" is significantly larger and more ornate, with a large, flowing flourish that extends upwards and to the right, partially overlapping the "E" and "L".

[2] In this decision, I refer to the BELLAGIO application as the “Word Mark Application”. I refer to the BELLAGIO Design application as the “Design Mark Application”. Collectively, I refer to the “Marks” and the “Applications”.

[3] The Word Mark Application is based on use and registration in the United States and is in association with the following goods and services:

Goods:

- (1) Wearing apparel, namely t-shirts, tank tops, collared golf shirts, sweaters, jackets, jogging suits, sweat shirts, sweat pants, short pants, swim wear, dress shirts, skirts, blouses, dress pants, caps, hats and bandannas.
- (2) Cologne; perfume; eau de toilette; body lotion; hand cream; bath and shower gels; massage oils; bath salts; bath soaps; hair shampoo; hair conditioner.
- (3) Mattresses.
- (4) Towels and washcloths; bed linen, namely bed sheets, duvet covers, blankets and pillow cases.
- (5) Glass beverageware; mugs; drinking steins; cups; plates; serving trays not of precious metal; cookie jars; water bottles sold empty; insulating sleeve holders for beverage cans; thermal insulated containers for beverages; vases; coasters not of paper and not being table linen; statues of china, crystal, earthenware, glass, porcelain and terra cotta; hair brushes; hair combs; non-metal piggy banks.

Services:

- (1) Casinos and live entertainment services in the nature of performances by singers, comedians, dancers, and musical groups.
- (2) Hotels, beauty salons and health spas.
- (3) Wedding chapel services.
- (4) Photography services.
- (5) Providing convention facilities and providing banquet and social function facilities for special occasions.
- (6) Retail store services, namely, retail apparel and clothing stores; retail shops featuring perfume, cologne, cosmetics, personal body care lotions, soaps, gels and body sprays; retail store services featuring handbags, purses, shoes and accessories; retail store services featuring convenience store items.
- (7) Operation of casinos; conducting and providing facilities for special events featuring casino and gaming contests and tournaments; botanical gardens; booking of theatre tickets; cabarets; night clubs; amusement arcades; beach and pool clubs, namely, providing fitness and exercise facilities featuring pools and bathing and showering facilities.

(8) Restaurant and bar services; cafes; cafeterias; snack bars; catering; providing facilities for exhibitions; travel agency services, namely making lodging, restaurant and meals reservation.

[4] The Design Mark Application, also based on use and registration in the United States, is in association with the following goods and services:

Goods

(1) Clothing, namely, t-shirts; tank tops; polo shirts; sweatshirts; jackets; shorts; sundresses; two-piece sets comprised of tops and bottoms; headwear; sleepwear; socks.

(2) Mattresses.

(3) Glass beverageware; mugs; drinking steins; cups; plates; serving trays not of precious metal; cookie jars; water bottles sold empty; insulating sleeve holders for beverage cans; thermal insulated containers for beverages; vases; coasters not of paper and not being table linen; statues of china, crystal, earthenware, glass, porcelain and terra cotta; hair brushes; hair combs; and non-metal piggy banks.

Services

(1) Hotel, beauty salons and health spas.

(2) Casino and entertainment services in the nature of live performances by singers.

(3) Photography services.

(4) Wedding chapel services.

(5) Art galleries; issuing gift certificates which may then be redeemed for goods or services; providing facilities for business meetings; providing information in the field of shopping via the internet.

(6) Conducting and providing facilities for special events featuring casino and gaming contests and tournaments; botanical gardens; health club services; booking of theatre tickets; special event planning; cabarets; night clubs; amusement arcades; beach and pool clubs, namely providing fitness and exercise facilities featuring pools and bathing and showering facilities; providing information in the field of gaming and entertainment via the internet.

(7) Restaurant services; bar and lounge services; providing convention facilities; providing banquet and social function facilities for special occasions; catering; providing travel lodging information services via the internet; providing information in the fields of dining, hospitality and exhibit facilities via the internet; travel agency services, namely making reservations and booking for temporary lodging, restaurants and meals.

(8) Retail store services, namely, retail apparel and clothing stores; retail shops featuring perfume, cologne, cosmetics, personal body care lotions, soaps, gels and body sprays; retail store services featuring handbags, purses, shoes and accessories; retail store services featuring convenience store items.

[5] Bellaggio Properties Inc. (the Opponent) has opposed the Applications, alleging non-entitlement and non-distinctiveness based on the Opponent's prior use of trademarks and trade names including Bellaggio and Bellaggio Café in association with restaurant, bar, and café services. The remaining grounds of opposition are based on technical challenges to the Applications.

THE RECORD

[6] The Applications for the Marks were filed on January 23, 2014, and both were advertised for opposition purposes in the *Trademarks Journal* of July 15, 2015.

[7] On December 14, 2015, the Opponent filed statements of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition pleaded by the Opponent are identical in both matters, and include sections 30, 16, and 2 of the Act. 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).

[8] The Applicant filed counter statements on February 23, 2016.

[9] In support of its oppositions, in each case, the Opponent filed the affidavit of Emil Malak. Mr. Malak was cross-examined on his affidavit and the transcript, as well as responses to undertakings, form part of the record.

[10] In support of its applications, in each case, the Applicant filed a certified copy of registration No. TMA540,882 for the trademark BELLAGGIO, and the affidavit of April Chaparian. The Applicant subsequently sought and was granted leave to file a further affidavit of April Chaparian. Ms. Chaparian was not cross-examined.

[11] Both parties filed a written argument and attended a hearing.

[12] Given that the Applications are for similar trademarks, and the grounds of opposition, evidence and written arguments are identical, both matters are addressed in this decision.

OVERVIEW OF THE EVIDENCE

[13] The evidence of record is briefly summarized below. Pertinent portions of the evidence are discussed further in the analysis of the grounds of opposition.

The Opponent's evidence – Affidavit of Emil Malak

[14] The Opponent filed the affidavit of Emil Malak (sworn June 3, 2016), the CEO and President of the Opponent. Mr. Malak has been actively involved in the day-to-day operations of the Opponent since its incorporation in January 1999 (Malak affidavit, para 2).

[15] Mr. Malak provides evidence relating to the establishment and operation of the Opponent's Vancouver-based restaurants, Bellaggio Café (in 1999) and Bellaggio Wine Bar (in 2011). The Malak affidavit also provides evidence relating to the Opponent's use of its Bellaggio trademarks and trade names, annual sales information, and some advertising information.

The Applicant's evidence – Affidavits of April Chaparian

[16] The Applicant filed a certified copy of its registration No. TMA540,882 for the trademark BELLAGIO in association with the services "promotional and guest relations services namely hotel and casino reservation and booking services". The Applicant also filed the affidavit of April Chaparian (sworn September 11, 2017). Ms. Chaparian is the Director of Intellectual Property of MGM Resorts International, of which the Applicant is a subsidiary. As part of her duties with MGM Resorts International, Ms. Chaparian manages the trademark portfolios of this company and related companies, including the Applicant (Chaparian affidavit, paras 1-3).

[17] Ms. Chaparian provides evidence relating to: the history and operation of the BELLAGIO hotel in Las Vegas; information about the website located at *www.bellagio.com*; samples of press coverage in Canadian publications for the BELLAGIO hotel over the years (para 23; Exhibit A); and information on the number of Canadians visiting Las Vegas and the BELLAGIO hotel (paras 24-29).

[18] The supplemental affidavit of April Chaparian (sworn October 26, 2017) provides additional samples of press coverage for the BELLAGIO hotel that appeared in Canadian based publications during the years 1998-1999 and which reference the BELLAGIO hotel (para 4).

[19] In reaching my decision I have considered all the evidence in the file. However, only those portions of the evidence that are directly relevant to my findings are discussed.

LEGAL ONUS AND EVIDENTIAL BURDEN

[20] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (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.

[21] With respect to (i) above, there is, in accordance with the usual rules of evidence, an evidential burden on the 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 the 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 the 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, then the issue must be decided against an applicant.

ANALYSIS OF THE GROUNDS OF OPPOSITION

Section 30 grounds of opposition

[22] The material date for considering a ground of opposition under section 30 of the Act is the date of filing of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475].

[23] With respect to the grounds of opposition pleaded under section 30 of the Act set out below, they have either been improperly pleaded, or the Opponent has not met its initial burden, with the result that they are summarily dismissed.

Section 30(d)

[24] The Opponent has pleaded that contrary to section 30(d) of the Act, the Applicant never used the Marks in association with each of the services listed in the Applications; the Applicant is not the owner of the foreign registrations; at the date of filing the Marks were not in use in the United States; and the Applicant failed to name its predecessors-in-title. I note that this ground includes no reference to the goods in the Applications.

[25] This ground of opposition is dismissed on the basis that the Opponent has failed to meet its initial evidential burden. There is no evidence that puts into issue the correctness of the use and registration abroad basis claimed in the Applicant's Applications. Similarly, there is no evidence suggesting that the Applicant is not the owner of the foreign registrations, nor that the Applicant has failed to name its predecessors-in-title.

Section 30(d) and (h)

[26] The Opponent has pleaded that contrary to sections 30(d) and 30(h) of the Act, the trademarks allegedly used are not the Marks. In the alternative, the Opponent has pleaded that contrary to section 30(d) of the Act, the use of the Marks has not been continuous for each of the services listed in the Applications. I note that these grounds include no reference to the goods in the Applications.

[27] Notwithstanding that this ground is improperly pleaded in respect of the Word Mark (as the requirements of section 30(h) do not apply), this ground is summarily dismissed on the basis that the Opponent has failed to meet its initial evidential burden. Similarly, the section 30(d) ground pleaded in the alternative is summarily dismissed on the basis that the Opponent has failed to meet its initial evidential burden. There is no evidence that puts into issue whether the Applicant's use of the Marks with any of their services has been continuous or not.

Section 30(e) and (h)

[28] The Opponent has pleaded that contrary to sections 30(e) and 30(h) of the Act, the trademarks proposed to be used are not the Marks. In addition or in the alternative, the Opponent has pleaded that contrary to section 30(e) of the Act, the Applicant never intended to use the Marks in Canada by itself, through a licensee or by itself and through a licensee in association with each of the services listed in the Applications. I note that these grounds include no reference to the goods in the Applications.

[29] These grounds of opposition are dismissed for having been improperly pleaded. Since the Applications are not based on proposed use in Canada, the requirements of section 30(e) do not apply. Further, the provisions of section 30(h) do not apply to the Word Mark Application as the Mark is a word not depicted in a special form.

Section 30(i)

[30] The Opponent has pleaded that contrary to sections 7(b) and 30(i) of the Act, the Applicant's statement as to its entitlement to the use of the Marks in Canada is false in view of the content of the statement of opposition, including the Applicant's knowledge of the Opponent's rights and the unlawfulness of said use. In particular, the Opponent alleges that the Applicant's use would be, was and is unlawful in that:

- i. it is encroaching upon the proprietary rights of the Opponent;
- ii. it is likely to have the effect of directing public attention to the Applicant's goods, services or business in such a way as to cause or be likely to cause confusion in Canada, at the time they commence to direct attention to them, between the Applicant's services and the services or business of the Opponent;

contrary to section 7(b) of the Act.

[31] Section 30(i) of the Act requires that an applicant include a statement in its application that it is satisfied that it is entitled to use the trademark in Canada (as the Applicant has done in this case). The Opponent has not filed any evidence that the Applicant may have been aware of the prior rights alleged by the Opponent, though in any event it has been established that mere awareness of prior rights alleged by an opponent does not preclude an applicant from truthfully

making the statement required by section 30(i) of the Act [4072430 *Canada Inc c Roberto Cavalli SpA*, 2015 TMOB 189; *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197]. As the Applications include the required statement and there is no evidence of bad faith, this part of the section 30(i) ground is rejected.

[32] With respect to the combination of section 30(i) with section 7 of the Act, as noted by the Registrar in the decision *InterCast Europe Srl v Next Retail Limited*, 2017 TMOB 12, "... it is far from certain that the combination of section 30(i) with any of sections 7(b), 20 and 22 of the Act constitutes a valid ground of opposition [*Euromed Restaurant Limited v Trilogy Properties Corporation*, 2012 TMOB 19 at para 13 citing *Parmalat Canada Inc v Sysco Corp* (2008), 69 CPR (4th) 349 (FC) at paras 3-42]..."

[33] That being said, even if I were to assume this comprises a valid ground of opposition, I would nonetheless find that the Opponent has not met its initial burden with respect to establishing all three elements required to show a violation of section 7(b) of the Act [as set out in *Ciba-Geigy Canada Ltd v Apotex Inc*, 1992 CanLII 33 (SCC), [1992] 3 SCR 120 at para 33 cited by *Pharmacommunications Holdings Inc v Avencia International Inc*, 2008 FC 828 at para 41].

[34] As an aside, I note that in its written representations, the Opponent further alleges that:

49... the Marks applied for on their face includes wares which are contrary to the *Criminal Code* unless licensed, namely:

- a. With respect to the 1,660,785 mark: (1) Casinos and live entertainment services in the nature of performances by singers, comedians, and musical groups and (7) Operation of casinos; conducting and providing facilities for special events featuring casino and gaming contests and tournaments; (...).
- b. And with respect to the 1,660,786 mark: (2) Casino and entertainment services in the nature of live performances by singers.

50. The Applicant has not established any regulatory approval or pending approval for these marks, despite being challenged to do so by Mr. Malak during his cross-examination.

[35] However, as established in *Le Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 2011 FC 118 (CanLII), the Registrar has no jurisdiction to adjudicate on a ground of

opposition not specifically pleaded in a statement of opposition. As a result, I have not considered this allegation, though I note that in any event, the Opponent would not have met its evidential burden for this ground [*Interprovincial Lottery Corp v Western Gaming Systems Inc*, 2002 CanLII 61461, (2002) 25 CPR (4th) 572 (T.M. Opp. Bd.); *Interprovincial Lottery Corp v Monetary Capital Corp*, 2006 CanLII 80348, (2006), 51 CPR (4th) 447 (T.M. Opp. Bd.)].

Section 16 grounds of opposition

[36] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Marks under section 16 as follows:

(a) Contrary to sections 16(2)(a) and 16(3)(a) of the Act, at the relevant time, the Mark was confusing with the Opponent's trademarks Bellaggio, *Bellaggio*, Bellaggio Café, Bellaggio Special, Bellaggio Appetizer, Bellaggio Sandwich, Bellaggio Pizza, Bellaggio Pasta, Bellaggio Breakfast, Full Bellaggio Breakfast, Bellaggio French Toast, Bellaggio Chicken Wings each of which was previously used or made known in Canada by the Opponent or its predecessors in title (or for their benefit by licensees) in association with restaurant, bar and café services.

(b) Contrary to sections 16(2)(c) and 16(3)(c) of the Act, at the relevant time, the Mark was confusing with the Opponent's trade names Bellaggio, Bellaggio Café, Bellaggio Wine Bar, Bellaggio Café Hornby, Bellaggio Café Convention, and Bellaggio Properties Inc. each of which was previously used in Canada by the Opponent or its predecessors in title (or for their benefit by licensees) in association with restaurant, bar and café services.

Section 16(2)(a) ground of opposition

The Opponent meets its initial evidential burden

[37] To meet its evidential burden under the section 16(2)(a) ground, the Opponent must show that as of the filing date of the application (January 23, 2014), one or more of its pleaded trademarks had been used in Canada and had not been abandoned at the date of advertisement of the application for the Marks, namely July 15, 2015 [section 16(5) of the Act].

[38] Based on my review of the Malak affidavit, and in particular, the portions summarized below, I find that the Opponent has met its initial burden and has demonstrated use of the trademarks Bellaggio and Bellaggio Café in association with restaurant, bar, and café services prior to January 23, 2014, and that these trademarks had not been abandoned as of July 15, 2015.

I have not considered the remainder of the alleged trademarks pleaded by the Opponent as I consider the Bellaggio and Bellaggio Café trademarks to represent the Opponent's best case:

- In 1999, the Opponent began operation of a restaurant located at 773 Hornby Street, Vancouver BC under the trade name Bellaggio Café, and has been operating as such continuously from that location since this time (para 5). The Opponent was issued a liquor license in 1999, after which the Opponent began to offer the sale of alcoholic beverages at the Hornby location (para 7).
- Exhibit F consists of photographs of the Hornby Street restaurant showing signage prominently displaying the trademarks Bellaggio Café and Bellaggio. Mr. Malak states that these signs have been present since 1999 (para 15). I note that shown in one of the photographs is a floor mat in front of the restaurant door bearing the stylized letters B and C. The stylized B on the mat as well as on the signage (the B in Bellaggio) resembles the stylized B element in the Applicant's Design Mark.
- On July 1, 2011, the Opponent opened a second location, Bellaggio Wine Bar (para 11). Bellaggio Wine Bar is also known as Bellaggio Convention location, due to its location at the Vancouver Convention Center (para 11). Exhibit G consists of photographs of this restaurant showing outdoor patio umbrellas prominently displaying the trademark Bellaggio. Mr. Malak states that this signage has been the same since opening (para 17).
- Mr. Malak describes Exhibit H as "a copy of the menu proof received by the Opponent on or about November 14, 2007 and two copies of the outside of the menus as used for the last several years" (para 20). Mr. Malak states that the Opponent has been using that menu or close variations since at least 2007... including the same logo and image" (para 21). I note that a composite mark featuring the words Bellaggio Café appears on the first page of the menu proof. I also consider this to constitute use of the trademark Bellaggio Café as I am of the view that these words stand out from the design elements of this mark, such that the public would perceive the word mark *per se* as being used [Nightingale Interloc Ltd v Prodesign Ltd (1984), 2 CPR (3d) 535 (TMOB); 88766 Canada Inc v National Cheese Co (2002), 24 CPR (4th) 410 (TMOB)]. I further note that

a stylized letter B (resembling the stylized B in the Applicant's Design Mark) appears to be embossed on the outside cover of the menus.

- Mr. Malak states that most of the Opponent's menu has also been online and available on its website at *www.bellaggiocafe.com* since at least October 2010 (para 22). Exhibit I is described as a copy of the site's homepage from September 23, 2013, as obtained from the Wayback Machine Internet Archive. Mr. Malak states that the homepage has remained similar since that time (para 22). I note that both the trademarks Bellaggio and Bellaggio Café appear on the homepage.
- Mr. Malak states that the Opponent has had over 25 million dollars in gross sales since 1999 and provides annual gross sales data from 2003 – 2016 (January – May) (para 23). These sales are almost exclusively of food and beverages through sales at the Hornby Location and from July 1, 2011, onwards, include sales made at the Convention Center location (para 24).
- Mr. Malak estimates that the Opponent has served over one million customers since it launched, and approximately 800,000 customers between launch and January 22, 2014 (para 25).

[39] During cross-examination, Mr. Malak advised that the Bellaggio Convention Location is operated through a separate corporate entity, "Bellaggio Convention Inc." (Q104). A sworn statement of control by the Opponent over this entity's use of the marks has not been provided, nor has a copy of a license agreement been provided. The Opponent in its written argument suggests that it can be inferred from the Malak affidavit as a whole that the use of the Opponent's trademarks are clearly under common control by the Opponent - in particular, reference is made to Mr. Malak's repeated use of "we" and "our" when referring to both restaurants, the inclusion of both locations on the Opponent's website, and the provision of joint sales data provided in the affidavit. Based on my review, and in the absence of any objection by the Applicant, I accept that it can be inferred from the evidence as a whole that the requisite control by the Opponent exists. However, if I am wrong in doing so, I note that this does not affect my conclusion on the issue of the Opponent showing prior use of its trademarks since the

Opponent's evidence unequivocally establishes that the first restaurant (Hornby location) is owned and operated by the Opponent.

[40] In addition to the services discussed above, Mr. Malak states that "we (the Opponent) also offer live entertainment, broadcasts of sporting events, and hosting of special events and parties, which further bring in customers and increase the awareness of our brand in the local community" (para 18). In support of this statement, the Opponent, in its written argument, cites Exhibit B, which is a copy of the Opponent's 1999 business license, and Exhibit I, an archived copy of the Opponent's website's homepage. In reviewing these documents, I note that included in the text of the business license is that "...All live entertainment, including DJs must cease operation between the hours of 12:00am to 9:00am daily..." The copy of the Opponent's website's homepage, which appears to be dated from September 23, 2013, describes the restaurant as "a perfect venue for a variety of events such as corporate meetings and parties, private dinners, informal meetings, weddings or drinks receptions..." It also includes the heading "Book for Parties", followed by the sentence "For more than 10 years, Bellaggio has been the venue of choice for spirited and sophisticated private events..." At the bottom of the page, there is another heading titled "Booking for parties", under which reference is included to features of the facility including "2 TV Games & Amplifier for DJ".

[41] Based on the foregoing, I am prepared to infer that the Opponent has offered services in the nature of hosting special events and parties prior to the material date. However, the Opponent's evidence does not persuade me that the Opponent was using its trademarks in association with the services "live entertainment and broadcasts of special events" prior to the material date.

Allegation that the Opponent's use of BELLAGGIO is unlawful

[42] The Applicant takes the position that to the extent that the Opponent's evidence shows prior use of its trademarks and trade names, that the Opponent should not be permitted to rely on such "unlawful use".

[43] In its written argument, the Applicant submits:

61. It is a recognized principle of Canadian trademark law that the Act should not be construed as providing support to unlawful use. “Lawful” means lawful in relation to trademark law (in addition to contractual rights with others and the general law, including other statutory criteria and criminal law).

McCabe v Yamamoto & Co. (America) Inc. (1989), 23 CPR (3d) 498 (Federal Court, Trial Division); *Lunettes Cartier Ltee v Carties, Inc.* (1990), 36 CPR (3d) 391 (Opposition Board); *Erva Pharmaceuticals Inc. v American Cyanamid Co.* 19 USPQ (2d) 1460 (DPR 1991).

62. In the present case, the Opponent has admitted under cross-examination that it adopted the BELLAGGIO trademarks and trade names being relied upon in these oppositions with full knowledge of the Applicant’s prior use of its BELLAGGIO trademark. Additionally, it is readily apparent that the Opponent took this action with the intention of capitalizing on the reputation that the Applicant had quickly achieved in Canada in association with the BELLAGGIO trademark.

63. Accordingly, whether the ground of opposition being considered is non-distinctiveness or entitlement, the Opponent should not be permitted to rely upon its unlawful use of its alleged trademarks and trade names.

[44] In support of this position, the Applicant has noted the following, emphasizing the chronology of these events:

- On October 17, 1997, the Applicant filed an application to register the trademark BELLAGGIO based on proposed use in Canada. On February 6, 2001, that application issued to registration under No. TMA540,882; the services covered under the registration are “hotel and casino reservation and booking services”.
- Construction of the BELLAGGIO hotel in Las Vegas was commenced by the Applicant in May 1996. The Applicant started taking reservations for the hotel on April 20, 1998 (First Chaparian affidavit, para 5), and the hotel opened on October 15, 1998 (First Chaparian affidavit, para 6).
- The opening of the BELLAGGIO hotel in 1998 received press in Canadian publications including *The Globe and Mail*, and the *National Post* (Second Chaparian affidavit, Exhibit A).
- On cross-examination, Mr. Malak admitted that he visited the Bellagio hotel when he went to Las Vegas in 1998 (Q68-72), and that while he does not recall, he may have had a meal at the Bellagio hotel (Q74). Mr. Malak also acknowledged that lots of people in

Vancouver go to the Bellagio [Hotel] Vegas (Q130), and “that some people said, oh, you own Bellagio...” (Q130).

[45] In response, the Opponent submitted that the Applicant had provided no evidence that the Opponent’s use of its Bellaggio trademark as of the material date of January 23, 2014 was unlawful or in any way questionable. The Opponent also submitted that there is no evidence to substantiate the Applicant’s claim that the Opponent’s adoption of the trademark Bellaggio in 1999 was somehow illegal, and that consideration of such an issue is not even within the jurisdiction of the Registrar.

[46] The Opponent further submitted that it is no more than speculation by the Applicant that it is the source of the Opponent’s selection of the trademark and trade name Bellaggio. In this regard, at the hearing, the Opponent referred to portions of the cross-examination transcript including statements by Mr. Malak:

- indicating he was not aware that the Applicant’s trademark Bellaggio, with one G, had a Canadian application that had been filed in 1997 in Canada (Q88);
- asking if the Applicant’s “Bellaggio 1997 ever got a trademark in Canada.” (Q90)
- indicating that he did not discuss with his brother (his business partner) that there was already a hotel and casino in Vegas called the Bellaggio because they were dealing in Canada at the time (Q123);
- further noting that “maybe I talked to him (his brother) about it, but I don’t really remember... we were at the time focused on getting various places in Italy... first we were going to call it Venetian; we were going to call it Milan. And then we looked at so many names and said, oh, Bellaggio is a good name. That’s what we were focused on. We weren’t focused on bloody Vegas because I hate gambling anyway” (Q124).
- denying that the Opponent had intentionally copied the B design or logo used by the Bellaggio Hotel and Casino (Q125).

[47] I find the following passage from *Sunbeam Products, Inc. v. Mister Coffee Services Inc.* (2001), 16 CPR (4th) 53 (FC) [*Sunbeam*] to be instructive in its approach to this issue:

In *McCabe*, the Federal Court had evidence of a finding by a U.S. Court that the respondent's use of the trade-mark was an infringement of the appellant's rights. In the *Lunettes Cartier* case, the Opposition Board had evidence that the respondent was subject to an injunction from the Federal Court enjoining the respondent's use of the trade-marks, the same trade-marks which the respondent was relying upon in support of its opposition.

In the case at bar, there is not clear evidence that the use of the trade-mark MISTER COFFEE by the respondent is unlawful. This question requires a proper hearing. ... The Registrar; in the course of opposition proceedings under s. 38 of the *Trade-marks Act*, does not have the jurisdiction to conduct a full hearing with *viva voce* evidence to determine the lawfulness of the respondent's use of the trade-mark. If the lawfulness issue was clear, then the Registrar has the jurisdiction to state that the respondent cannot rely upon its use of the trade-mark because its use is not lawful. In the case at bar, the Registrar cannot come to that clear conclusion in this opposition proceeding.

[48] As in *Sunbeam, supra*, I find that the issue of the lawfulness of the use of the trademarks Bellaggio and Bellaggio Café by the Opponent is not sufficiently clear. Unlike in the *McCabe* and *Lunettes Cartier* cases cited by *Sunbeam*, in the instant case there is no evidence of a finding of infringement by a court, nor is there evidence the Opponent is subject to an injunction. I would also add that I do not have any evidence that the Applicant has contested the Opponent's use of the trademarks Bellaggio and Bellaggio Café, despite the evidence suggesting those trademarks have been in use for many years. I would be reluctant to make any finding concerning whether or not the Opponent's use effectively constitutes a case of passing off in the absence of not only any finding of passing off and/or the depreciation of goodwill by a court, but also of any evidence of an action for same having been commenced by the Applicant against the Opponent [*The Blue Note Restaurant Inc v Bensusan Restaurant Corporation, 2000 CanLII 28646 (CA TMOB)*].

[49] Accordingly, I am satisfied that the Opponent can rely on the use of the trademarks Bellaggio and Bellaggio Café to support this ground of opposition.

Test to determine confusion

[50] The Opponent having met its initial burden of proof, I must now determine, on a balance of probabilities, if the Marks are likely to cause confusion with the Opponent's trademarks Bellaggio and Bellaggio Café.

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

[52] Thus the issue is not confusion between the trademarks themselves, but of confusion of goods and services from one source as being from another source. In the instant case, the question posed by section 6(2) of the Act is whether purchasers of the goods and services provided in association with the Marks would believe that those goods and services were produced, authorized or licensed by the Opponent.

[53] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks 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 trademarks in appearance or sound or in the ideas suggested by them. These criteria 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].

Inherent distinctiveness and extent known

[54] I find that the applied for word mark BELLAGGIO possesses a fair degree of inherent distinctiveness as the word has no meaning in the French or English language. To the extent that the word Bellaggio might hold geographical meaning (which has not been canvassed by the Applicant, and which has simply been asserted by Mr. Malak without any accompanying evidence (Malak affidavit, para 5)), I do not consider it to affect the inherent distinctiveness of

the Mark as there is no evidence that the Mark is suggestive of the place of origin of the listed goods or services. With respect to the Design Mark, I find that the design element comprised of the letter B in a special font superimposed over the word BELLAGIO does increase the overall inherent distinctiveness of the trademark, though not significantly.

[55] I find the Opponent's trademarks Bellaggio and Bellaggio Café also possess a fair degree of inherent distinctiveness. The word Bellaggio is identical to the Mark but for the addition of an extra 'g' which I do not consider a material difference, and the addition of the element Café does not increase the overall inherent distinctiveness of the trademark Bellaggio Café given its descriptive connotation.

[56] The strength of a trademark may be increased by means of it becoming known through promotion or use. The Opponent's evidence establishes that it has provided restaurant, bar and café services in association with the trademarks Bellaggio and Bellaggio Café for over a decade. The Bellaggio Café Hornby street location opened in 1999, is open for business daily, and can serve up to 120 guests (up from a seating capacity of 80 in 1999) (Malak affidavit, paras 5-10). The Bellaggio Wine Bar located at the Vancouver Convention Center opened in July 2011, is open daily, and has a seating capacity of 300 guests (Malak affidavit, paras 11,12). The Opponent's trademarks have appeared on signage, menus, and on the Opponent's website (Malak affidavit, paras 15-22; Exhibits F-I).

[57] The Opponent has had over 25 million dollars in gross sales since 1999, with annual sales in 2003-2015 between 1 and 2.2 million dollars annually (Malak affidavit, para 23). These sales are almost exclusively of food and beverages through sales made at the Hornby location and from July 1, 2011 onwards, include sales made from the Convention Center Location (para 24). Mr. Malak estimates that the Opponent has served over 1 million customers since it has launched, and approximately 800,000 customers between launch and January 22, 2014 (Malak affidavit, paras 24, 25). The Opponent has also done some direct advertising, incurring advertising expenses of over \$65,000 between 1999 to date (June 2016), of which over \$40,000 occurred prior to January 22, 2014 (para 26). However, without more information on the nature of these advertisements, this information is of limited assistance in the assessment (only one

sample ad (©2016) is provided at Exhibit J). The majority of the Opponent's customers are Canadians, with a mix of locals from the Vancouver region and those from elsewhere (para 28).

[58] Based on the foregoing, I find that the Opponent's trademarks Bellaggio and Bellagio Café have become known to some extent at least in the Vancouver area in association with restaurant, bar and café services.

[59] The Applicant's evidence provides information on the Applicant's BELLAGIO hotel and casino in Las Vegas, which opened on October 15, 1998 (First Chaparian affidavit, para 6).

Portions of the First Chaparian affidavit are summarized below:

- Ms. Chaparian explains that the hotel features many services and attractions, including a large casino, several restaurants, a broad range of entertainment including permanent and rotating shows, the large choreographed feature "Fountains of Bellagio", a conservatory and botanical gardens, and the Bellagio Gallery of Fine Art (paras 9-15).
- Ms. Chaparian states that "there are 14 restaurants inside the BELLAGIO hotel as well as private dining, in-room dining and poolside dining options. These restaurants include award-winning restaurants such as LE CIRQUE, PICASSO and MICHAEL MINA. There is also a restaurant named CAFÉ BELLAGIO that is open for breakfast, lunch and dinner" (para 10). However, no further information, such as dates of operation, sales and attendance information, and the way in which the Applicant's Marks have appeared (if at all) in association with these restaurants, is provided.
- Ms. Chaparian states that the BELLAGIO hotel has won many awards over the years, and lists some of these awards dating between 2001-2016, including the AAA Five Diamond Award, 2001-2016; *Celebrated Living* #1 Hotel in the US Readers Choice Platinum List, 2009; and *Condé Nast Traveler Magazine* Gold List of the World's Best Places to Stay, 2008-2012 (para 16). However, without further details, these awards are of limited weight as I am unable to conclude to what extent Canadian consumers would have been aware of them.

- Ms. Chaparian states that Mirage, for many years, has operated a website located at *www.bellagio.com* to promote the BELLAGIO hotel and its various amenities and services (para 18). Ms. Chaparian explains that “the website allows customers, including Canadians, to conduct a wide variety of transactions such as: (a) making reservations at the restaurants located at the BELLAGIO hotel; (b) booking hotel rooms; (c) buying tickets for shows and other entertainment at the hotel; and (d) obtaining information about events that we organize at the hotel such as wedding and other group events” (para 19). Information on the number of unique visitors to the website from Canada between 2014 -2017 is also provided (paras 20-22), though this information is not broken down any further (for example, by providing the number of restaurant reservations made through the site). More importantly however, I note that no evidence is provided showing the Marks as they appear or have appeared on the website.
- Ms. Chaparian states that the BELLAGIO hotel has, continually since its opening in 1998, received a great deal of attention in the press (para 23). Exhibit A is described as some of the many articles in Canadian publications that have mentioned this hotel over the years. I note that there are approximately 20 articles from Canadian publications including the *Calgary Herald*, *Toronto Sun*, *Vancouver Sun*, and *The Globe and Mail*. In these articles, most of which predate the material date, the references to BELLAGIO are not always prominent (but instead often present alongside references to other establishments).
- Ms. Chaparian provides information on the number of people who have visited Las Vegas from Canada between 2006 and 2015, based on reports from the Las Vegas Convention and Visitors Authority (para 24). Ms. Chaparian also provides information on the number of Canadian customers (defined as customers with Canadian addresses) who have visited the BELLAGIO hotel between 2012 and 2016. The information is further broken down to reflect the number of people who stayed or visited the BELLAGIO hotel (para 26). While data on the number of people conducting “some paying activity” is provided, this information is not further broken down to reflect the specific activity (for example, visiting a restaurant or a spa).

[60] The Second Chaparian affidavit includes copies of approximately 13 additional articles that appeared in Canadian-based publications during the years 1998-1999, and which reference the BELLAGIO hotel (Second Chaparian affidavit, para 4, Exhibit A).

[61] I am prepared to infer from the evidence of Applicant, in particular the articles referencing the Bellagio hotel in Canadian publications prior to the material date, and from the information on the number of Canadian visitors to the Bellagio Hotel in 2012 and 2013 (First Chaparian affidavit at paras 26-28) that the Applicant had acquired some distinctiveness in the trademark BELLAGIO in Canada for the operation of the BELLAGIO hotel in Las Vegas prior to the material date of January 23, 2014. However, I am not prepared to infer that this reputation would extend to restaurant, bar and café services, which I consider to constitute a different “niche” of services within the general class of hospitality services [see *4072430 Canada Inc c Roberto Cavalli SpA*, 2015 TMOB 189 at paras 52-53 citing *Euromed Restaurant Limited v Trilogy Properties Corporation* 2012 TMOB 19 at para 23].

[62] In view of the foregoing, I find that the first factor, which is a combination of inherent and acquired distinctiveness, favours the Opponent in respect of restaurant, bar and café services only.

Length of time in use

[63] The Opponent’s evidence shows that the Opponent has, for well over a decade, used its trademarks in Canada, whereas the Applicant has filed no evidence of use of the Marks in Canada. Accordingly, this factor favours the Opponent.

The nature of the goods, services or business; and the nature of the trade

[64] The Opponent’s services, as pleaded in the statement of opposition, are identified as “restaurant, bar and café services”.

[65] The Applicant’s goods and services as set out in the Word Mark and Design Mark Applications are listed above in paragraphs 3 and 4, respectively.

[66] The Opponent's written submissions on the nature of the parties' goods, services, and trade, are reproduced in part below. I note that the emphasis on specific services in paragraphs 29 and 30 of the Opponent's submissions was added by the Opponent:

Section 6(5)(c) – The nature of the goods, services or business

28. The Opponent provides food and beverages services, including liquor, as well as live entertainment, broadcasts of sporting events, and hosting of special events and parties, including the registration for same over the internet through its website.

29. The Applicant makes *inter alia* two claims for services with respect to Application No. 1,660,785 for BELLAGIO with significant overlap to the services offered by the Opponent, namely:

(5) providing convention facilities and **providing banquet and social function facilities for special occasions.**

(8) **Restaurant and bar services; cafes; cafeterias; snack bars; catering;** providing facilities for exhibitions; travel agency services, namely making lodging, **restaurant and meals reservation.**

30. The Applicant makes *inter alia* two claims for services with respect to Application No. 1,660,786 for BELLAGIO Design with significant overlap to the services offered by the Opponent, namely:

(2) Casino and **entertainment services in the nature of live performances by singers.**

(7) **Restaurant services; bar and lounge services; providing convention facilities; providing banquet and social function facilities for special occasions; catering;** providing travel lodging information services via the internet; **providing information in the fields of dining, hospitality and exhibition facilities via the internet;** travel agency services, namely, making reservations and booking for temporary lodging, restaurants and meals.

31. This high degree of overlap between these services and that of the Opponent strongly supports a finding of confusion.

Section 6(d) – The nature of the trade

32. There is significant overlap between the services applied for by the Applicant and those offered by the Opponent prior to these applications.

33. The evidence of the Applicant is that their hotel hosts numerous restaurants. The Applicant's services include claims to convention hosting. The evidence of the Opponent is that it offers restaurant services and hosting of special events, including a 300-person capacity restaurant located at the Vancouver Convention Center.

34. It is noted that the confusion between the Opponent's services and those applied for by the Applicant are particularly acute with respect to entertainment and restaurant services, and not hotel services generally. The reason for this is that provision of

restaurant and café services are generally considered distinct from hotel services, regardless of whether the hotel offers restaurant services, due to the different in clientele...

[67] Notwithstanding its allegation of “unlawful use” by the Opponent, the Applicant, in its written argument, submits:

68. The only potential overlap between the Opponent’s services and the services listed in the Applications would be in respect of the following services listed in the Applications:

- (1) Restaurant and bar services; cafes; cafeterias; snack bars; catering.
- (2) Travel agency services, namely making restaurant and meals reservations.”

[68] I find there is direct overlap between the Opponent’s restaurant, bar and café services, and the restaurant, café and bar services listed in the Applications. I also find there to be overlap with those services listed in the Applications that are related to restaurant, bar and café services, albeit in an ancillary capacity, such as catering, cafeterias, snack bars, the making of restaurant and meal reservations, providing information in the field of dining facilities via the internet, and providing banquet and social function facilities for special occasions.

[69] While the Opponent has highlighted that it offers restaurant services through its Bellaggio Convention location, I do not consider the mere fact of its physical location at the Vancouver Convention Center to constitute the provision of convention facilities, and so do not consider there to be overlap in this regard.

[70] Regarding the ‘live entertainment’ and ‘broadcasts of sporting events’ services referenced by the Opponent, I do not find that the Opponent’s evidence shows use of the Opponent’s trademarks in association with these services, and therefore I find there is no overlap with the entertainment services of the Applicant. In addition, I note that the Opponent has not pleaded use of its trademarks in association with these services.

[71] Finally, I do not consider there to be any overlap in respect of the Opponent’s “restaurant, bar and café services” with any of the remaining services in the Applicant’s Applications, or with any of the goods listed in the Applications.

[72] Accordingly, with respect to application No. 1,660,785, I find that the Opponent’s restaurant, café and bar services directly overlap with the Applicant’s “restaurant and bar services; cafés”. I also find there to be overlap with respect to the applied for services “cafeterias; snack bars; catering; travel agency services, namely making restaurant and meal reservation” and “providing banquet and social function facilities for special occasions” because they also pertain to restaurant and bar services, albeit in an ancillary capacity. In the absence of evidence to the contrary, I am prepared to assume that the parties’ channels of trade for these services would also overlap.

[73] With respect to application No. 1,660,786 for BELLAGIO & Design, I find that the Opponent’s restaurant, café and bar services directly overlap with the Applicant’s services “restaurant services; bar and lounge services”. I also find there to be overlap with respect to the services “providing banquet and social function facilities for special occasions; catering; providing information in the field of dining facilities via the internet; travel agency services, namely making reservations and booking for restaurants and meals” because they also pertain to restaurant and bar services, albeit in an ancillary capacity. Further, in the absence of evidence to the contrary, I am prepared to assume that the parties’ channels of trade for these services would also overlap.

Degree of Resemblance

[74] In most instances, the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [*Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2) 145, conf. 60 CPR (2d) 70 (FCTD)]. This principle was upheld by the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361.

[75] When considering the degree of resemblance between the trademarks, the law is clear that the marks must be considered in their totality; it is not correct to lay the trademarks side by side and compare and observe similarities or differences among the elements or components of the marks [*Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée*, (2006), 2006 SCC 23 (CanLII), 49 CPR (4th) 401 at para 20]. In the present case, given they all contain the near identical and

dominant component BELLAGIO or BELLAGGIO, the Opponent's Bellaggio trademark and the Applicant's Marks have a significant degree of resemblance in appearance and sound. In terms of ideas suggested, as noted above in the analysis of the inherent distinctiveness of the marks (paragraphs 54-55 of this decision), the parties' marks are also similar.

[76] There is also a significant degree of resemblance between the Opponent's trademark Bellaggio Café and the Applicant's Marks. The word CAFÉ does not diminish the resemblance between the parties' marks as it is descriptive of the Opponent's services [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 2010 TMOB 11 (CanLII), 84 CPR (4th) 58 (TMOB) at para 58].

[77] Overall, this factor strongly favours the Opponent.

Surrounding circumstance – evidence of actual confusion

[78] During cross-examination, Mr. Malak indicated that there had been some instances of confusion where “some people even thought I owned it (the Bellagio Hotel and Casino in Las Vegas)” (Q130). However, without further details, I am unable to consider this evidence, particularly as it is unclear whether these instances occurred prior to the filing date of January 23, 2014 [*Servicemaster Co v 385229 Ontario Ltd* 2015 FCA 114 (CanLII) at paras 21-22].

Surrounding circumstance – Applicant's prior registration for BELLAGIO

[79] The Applicant has provided a certified copy of its registration No. TMA540,882 for the trademark BELLAGIO. However, it is well-established that section 19 of the Act does not give the owner of a registration an automatic right to obtain a further registration no matter how closely it is related to the prior registration [*Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 at 538 (TMOB)]. Accordingly, I do not consider this to be a surrounding circumstance assisting the Applicant.

Conclusion

[80] 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 Marks when he or she has no more than an imperfect

recollection of the Opponent's Bellaggio and Bellaggio Café trademarks and does not pause to give the matter any detailed consideration or scrutiny [*Veuve Clicquot, supra*, at para 20].

[81] Having considered all of the surrounding circumstances, in particular, the high degree of resemblance between the trademarks, the overlap in various of the parties' services, and the extent known and length of time in use of the Opponent's trademarks with restaurant, bar and café services, I find that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Word Mark is not confusing with the Opponent's trademarks in respect of the following of the applied for services: "providing banquet and social function facilities for special occasions; restaurant and bar services; cafes; cafeterias; snack bars; catering; travel agency services, namely making restaurant and meals reservation".

[82] I also find that the Applicant has not discharged its burden of establishing, on a balance of probabilities, that the Design Mark is not confusing with the Opponent's trademarks in respect of the following of the applied for services: "restaurant services; bar and lounge services; providing banquet and social function facilities for special occasions; catering; providing information in the field of dining facilities via the internet; travel agency services, namely making reservations and booking for restaurants and meals".

[83] I make these findings recognizing that the Applicant possesses some reputation in Canada in association with the operation of a hotel in Las Vegas, but that this reputation does not necessarily extend to restaurant services in Canada.

[84] Accordingly, for the application for the Word Mark, the section 16(2)(a) ground of opposition is therefore successful only with respect to "restaurant and bar services; cafes; cafeterias; snack bars; catering; providing banquet and social function facilities for special occasions; travel agency services, namely making restaurant and meals reservation". The 16(2)(a) ground is rejected with respect to the remaining services, and all the goods.

[85] Regarding the application for the Design Mark, the section 16(2)(a) ground of opposition is therefore successful only with respect to "restaurant services; bar and lounge services; providing banquet and social function facilities for special occasions; catering; providing information in the field of dining facilities via the internet; travel agency services, namely

making reservations and booking for restaurants and meals”. The 16(2)(a) ground is rejected with respect to the remaining services, and all the goods.

Section 16(2)(c) ground of opposition

[86] To the extent that I may be incorrect in categorizing the Opponent’s use of Bellaggio and Bellaggio Café as trademark use, and that such use (either additionally or alternatively) constituted trade name use, I find that with respect to the application for the Word Mark, the section 16(2)(c) ground would have succeeded for “restaurant and bar services; cafes; cafeterias; snack bars; catering; providing banquet and social function facilities for special occasions; travel agency services, namely making restaurant and meals reservation” for the reasons above. The 16(2)(c) ground would have been rejected with respect to the remaining services, and all the goods.

[87] Similarly, with respect to the application for the Design Mark, the 16(2)(c) ground would have succeeded for “restaurant services; bar and lounge services; providing banquet and social function facilities for special occasions; catering; providing information in the field of dining facilities via the internet; travel agency services, namely making reservations and booking for restaurants and meals” for the reasons above. The 16(2)(c) ground would have been rejected with respect to the remaining services, and all the goods.

Section 16(3)(a) and 16(3)(c) grounds of opposition – summarily dismissed

[88] Since the Applications are based on use and registration in the United States, I find the grounds of opposition based on sections 16(3)(a) and 16(3)(c) have been improperly pleaded as they relate to a proposed use trademark. Accordingly, these grounds of opposition are dismissed.

Section 2 ground of opposition

[89] The Opponent has pleaded that the Marks are not distinctive since the Marks do “not actually distinguish the services in association with which it is used or proposed to be used by the Applicant from the services of the Opponent, nor is it adapted to so distinguish them”. I note that no reference is made to the goods used or proposed to be used by the Applicant in this ground of opposition.

[90] The material date with respect to distinctiveness is the date of filing the opposition, namely December 14, 2015 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

[91] To meet its evidential burden, the Opponent must show that its Bellaggio and/or Bellaggio Café trademarks or trade names had become sufficiently known to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 at paras 33-34]. When an opponent's reputation is restricted to a specific area of Canada, an opponent's evidential burden may be satisfied if its trademark is well known in a specific area [*Bojangles, supra; CEG License Inc v Joey Tomato's (Canada) Inc.* (2011), 97 CPR (4th) 436 (TMOB) aff'd (2012), 110 CPR (4th) 398 (TMOB)].

[92] I find that the Opponent's evidence as discussed above is sufficient to meet the Opponent's burden. The Applicant is therefore required to show that its Marks are adapted to distinguish or actually distinguish the services from the restaurant, bar and café services of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[93] I consider that the difference in material dates does not materially affect my conclusion under the section 16(2)(a) ground of opposition discussed above. Accordingly, for reasons similar to those expressed in the above analysis, I reach the same conclusion regarding the likelihood of confusion as under the section 16(2)(a) ground of opposition. Accordingly, for the application for the Word Mark, this ground of opposition is successful only with respect to "restaurant and bar services; cafes; cafeterias; snack bars; catering; providing banquet and social function facilities for special occasions; travel agency services, namely making restaurant and meals reservation". This ground of opposition is rejected with respect to the remaining services, and all the goods.

[94] For the application for the Design Mark, this ground of opposition is successful only with respect to "restaurant services; bar and lounge services; providing banquet and social function facilities for special occasions; catering; providing information in the field of dining facilities via the internet; travel agency services, namely making reservations and booking for restaurants and

meals”. This ground of opposition is rejected with respect to the remaining services, and all the goods.

DISPOSITION

[95] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,660,785 with respect to the services “providing banquet and social function facilities for special occasions; restaurant and bar services; cafes; cafeterias; snack bars; catering; travel agency services, namely making restaurant and meals reservation”, and I reject the opposition with respect to the remaining services and with all the goods listed in the application, pursuant to section 38(12) of the Act.

[96] I refuse application No. 1,660,786 with respect to the services “restaurant services; bar and lounge services; providing banquet and social function facilities for special occasions; catering; providing information in the field of dining facilities via the internet; travel agency services, namely making reservations and booking for restaurants and meals”, and I reject the opposition with respect to the remaining services and with all the goods listed in the application, pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2020-02-17

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