



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

**Citation: 2021 TMOB 61**  
**Date of Decision: 2021-03-31**

**Buca, Inc.** **Opponent**

**and**

**King Street Company Inc.** **Applicant**

**1,674,269 for BUCA** **Application**

[1] On April 25, 2014, King Street Company Inc. (the Applicant) filed an application to register the trademark BUCA (the Mark). The application is based on the Applicant's proposed use of the Mark in Canada in association with goods (1) and services (2) and the Applicant's use of the Mark in Canada since 2009 in association with services (1).

Goods

(1) Food products, namely, olive oil, tomato sauce, canned tomatoes, pasta sauce, pasta, whole bean and ground coffee; beverages, namely, bottled water; wine.

Services

(1) Restaurant services; Bar and lounge services; Take out restaurant services.

(2) Catering services.

[2] Buca, Inc. (the Opponent) filed a statement of opposition on January 28, 2016. The Opponent has pleaded grounds of opposition pursuant to sections 30, 12(1)(d), 16, and 2 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). These grounds of opposition refer to the sections of the Act as they were before the Act was amended June 19, 2019 (see section 70). The Opponent filed as its evidence a certified copy of its trademark registration for BUCA DI BEPPO (registration No. TMA843,560). Both parties filed written submissions and attended a hearing.

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[3] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

### Analysis of the Grounds of Opposition

#### *Section 30(b) and Section 30(e) Grounds of Opposition*

[4] The Opponent withdrew these grounds at the hearing.

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

[5] The Opponent pleads that the Mark is confusing with its registration for BUCA DI BEPPO under No. TMA843,560 for the goods below. This trademark registration was expunged on July 17, 2019 following a section 45 expungement proceeding [*Gowling WLG (Canada) LLP v Buca, Inc.*, 2019 TMOB 15; see also *Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 at 412 (TMOB) which confirms that the Registrar will exercise its discretion to check the status of a registration pleaded in a statement of opposition].

Frozen gelato, sorbet and ice cream and frozen desserts made from gelato, sorbet and ice cream, namely, cakes, pies, ice cream cones, gelato cones, frozen dairy desserts, frozen confections, for consumption on or off the premises.

[6] At the hearing, the Opponent submitted that a registration forming the basis of a section 12(1)(d) ground of opposition must be extant as of the date the statement of opposition is filed, even though confusion is assessed as of the date of the decision citing *Quaker Oats Co of Canada, supra*. This case, however, was decided before *Park Avenue Furniture Corp. v Wickes/Simmons Bedding Ltd.* (1991), 37 CPR (3d) 413 where the Federal Court of Appeal held:

The Trademarks Act contains provisions which indicate the date at which certain situations are to be assessed. For instance, s. 16(1) of the Act refers to the date the mark was first used or was made known in relation to wares or services as the date where confusion is to be assessed. Section 16(3) of the Act refers to the date of filing of the application as the date where confusion is to be assessed. Section 6(5) of the Act, however, contains no indication as to the material date for determining whether trade marks or trade names are confusing. In such circumstances, the rule generally applicable in adjudicating matters should prevail, that is the date where the matter is disposed of on the evidence adduced.

...

... I find no fallacy in the possibility of an update of the situation by the parties when the issue is whether statutory recognition should be given to a mark. It is important, it would seem to me, that the decision of the Registrar or the court be taken on an accurate state of the record. Registrability should be decided at the date of registration or at the date of refusal of registration.

Following this decision, the Registrar has assessed grounds of opposition based on section 12(1)(d) on the basis of whether a registration was in good standing as of the date of the decision [see, for example, *Canadian Tire Corporation, Limited v The Pep Boys Manny, Moe & Jack*, 2000 CanLII 28611 (TMOB); *Kenner Parker Toys, Inc v Peter Pan Playthings Limited*, 1991 CanLII 6776 (TMOB)]. Accordingly, the Opponent has not met its evidential burden and this ground of opposition is rejected.

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

[7] The Opponent alleges in its statement of opposition that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada as it had previous knowledge of the

Opponent's BUCA DI BEPPO trademark. The material date for this ground of opposition is the date of filing the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)].

[8] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to use its trademark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of an applicant [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trademark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the mark [*Axa Assurances Inc v Charles Schwab & Co* (2005), 49 CPR (4th) 47 (TMOB); *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[9] In the present case, the Applicant has provided the necessary statement and there is no evidence of bad faith or exceptional circumstances. This ground of opposition is therefore rejected.

#### *Sections 16(1), 16(3) and 2 Grounds of Opposition*

[10] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark because it was confusing with the trademark BUCA DI BEPPO and trade name Buca, Inc., previously used or made known in Canada by the Opponent (the sections 16(1)(a), 16(3)(a), 16(1)(c) and 16(3)(c) grounds of opposition). The Opponent also pleads that the Mark is not distinctive because it does not and is not adapted to distinguish the goods of the Applicant from the goods and services of the Opponent (section 2 ground of opposition).

[11] With respect to the grounds of opposition based on sections 16(1) and 16(3) of the Act, the material dates are December 31, 2009 for the services based on use and the applicant's filing date (April 25, 2014) for the goods and services based on proposed use. The material date for assessing the non-distinctiveness ground is the date of opposition (January 28, 2016). The Opponent's sections 16(1)(a) and 16(3)(a) grounds of opposition rely on the use and making known of the trademark BUCA DI BEPPO. The Opponent's section 16(1)(c) and 16(3)(c)

grounds of opposition rely on use of the trade name Buca, Inc. The Opponent's section 2 ground of opposition relies on the Opponent's use of its trademark and trade name.

[12] The sections 16(1)(a), 16(3)(a), 16(1)(c), 16(3)(c) and section 2 grounds are rejected because the Opponent has not met its initial evidential burden. The Opponent has not evidenced that its trademark or trade name was used or made known or had any reputation in Canada as of the applicable material dates.

[13] At the hearing, the Opponent submitted that the fact that it had opposed this application and had been involved in the section 45 proceeding (as well as oppositions to other related applications of the Applicant, although this is not in evidence) was sufficient to meet its burden with respect to trade name use. The Opponent submitted because it was engaged in these proceedings that I could infer that it was also using its trade name in association with the goods in its registration.

[14] I find that the Opponent fails to meet its evidentiary burden with respect to the grounds of opposition based on sections 16(1)(c) and 16(3)(c). The use of a corporate name in a proceeding before the Trademarks Opposition Board does not constitute use of the Buca, Inc. trade name as use must be in the normal course of trade and in relation to class or classes of persons with whom such trade is conducted [*Professional Publishing Associates Ltd. v Toronto Parent Magazine Inc.* (1986), 9 CPR (3d) 207]. Further, I do not find that I can infer just because a party is involved in proceedings before the Trademarks Opposition Board that the trade name of that party has been used in Canada. Inferring use of the Buca, Inc. trade name in the normal course of trade is not a reasonably probable, logical deduction from the Opponent's opposition to the Mark or involvement in the section 45 decision with respect to the BUCA DI BEPPO registration.

Disposition

[15] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(12) of the Act.

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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

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

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**HEARING DATE** 2021-02-24

**APPEARANCES**

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