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Citation: 2021 TMOB 59

Date of Decision: 2021-03-30

IN THE MATTER OF AN OPPOSITION

**McSheep Investments Ltd. (formerly
Telpo Investments Inc.)**

Opponent

And

Hemingway Ltd.

Applicant

for 1,452,075(01)

Application

OVERVIEW

[1] Hemingway, Ltd. (the Applicant) is the family corporation of the estate of the late famous author Ernest Hemingway. It has filed an application to extend the statement of goods related to Registration No. TMA884,384 for the trademark HEMINGWAY for various items including printed materials, various types of drinking glasses, plates, trays, blankets and pillows.

[2] McSheep Investments Inc. (formerly Telpo Investments Inc.) (the Opponent) opposes the application on the basis that the Mark is confusing with the Opponent's registered trademark HEMINGWAY'S, previously used in Toronto, Ontario, in association with restaurant and bar services.

[3] The parties are also involved in the co-pending opposition involving the trademark ERNEST HEMINGWAY, application No. 1,653,460, the decision for which will be issued under separate cover.

[4] For the reasons that follow, the Applicant has not satisfied its legal burden to demonstrate that there is no reasonable likelihood of confusion with the Opponent's trademark with respect to the following goods: drinking glasses, shot glasses, flasks, high ball glasses, cocktail shakers, mugs, plates, trays. The opposition is otherwise rejected.

THE RECORD

[5] The application to extend the goods was filed November 23, 2015, and is based on use of the Mark in Canada in association with the Goods set out in the attached schedule A since at least as early as October 1, 2015.

[6] The application was advertised for opposition purposes in the *Trademarks Journal* on November 16, 2016. On March 2, 2017, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that 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 which refer to the Act as it read before it was amended (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 prior to that date).

[7] The Opponent raises grounds of opposition based on registrability, entitlement, distinctiveness, and non-compliance with sections 30(a), 30(b) and 30(i) of the Act, registrability under section 12(1)(d), entitlement under section 16(1)(a), and distinctiveness under section 2. With respect to the registrability, entitlement and distinctiveness ground, the Opponent relies on its use and registration of its HEMINGWAY'S trademark, registration No. TMA661,809, registered in association with restaurant and bar services.

[8] The Applicant responded by filing and serving a counter statement denying the grounds of opposition.

[9] The Opponent's evidence in chief consists of the affidavit of Martin McSkimming dated March 26, 2018 (McSkimming #1). The Applicant's evidence consists of two affidavits of D. Jill Roberts (Roberts #1 dated February 12, 2019, and Roberts #2 dated February 26, 2019), the affidavit of Scott Tremblay and the affidavit of Ahmed Bulbulia. As evidence in reply, the Opponent filed a second affidavit of Mr. McSkimming, dated June 25, 2019 (McSkimming #2). Mr. McSkimming was cross-examined on both of his affidavits and his transcripts and replies to undertakings form part of the record.

[10] The Opponent was granted leave to file an amended statement of opposition on November 12, 2020, to reflect a change in identity of the Opponent.

[11] Both parties filed a written argument and made submissions at a hearing.

LEGAL ONUS AND EVIDENTIAL BURDEN

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

PRELIMINARY ISSUE

Opponent's correspondence dated December 8, 2020

[13] On December 8, 2020, the Opponent submitted a letter to the Registrar and the Applicant in which it indicated that the Opposition may be treated as withdrawn in respect of the following goods:

Pens, journals, cards, printed materials, namely books, tour books, travel guidebooks, appointment books, brochures, diaries, daily planners, calendars, organizers, study guides, manuals, posters, magazines; ceramic jewelry trays; blankets, pillows.

[14] Accordingly, the only applied for goods at issue in this opposition are as follows:

Drinking glasses, shot glasses, flasks, high ball glasses, cocktail shakers, mugs, plates, trays (the Goods at issue)

Insufficiency of Pleadings

[15] The Opponent's section 16(1)(a) and section 38(2)(d) grounds of opposition have been pleaded as follows:

Pursuant to section 38(2)(c), the Applicant is not the person entitled to the registration of the trademark as applied for as required by section 16(1)(a) as its application is confusing with the trademark "HEMINGWAY'S" held by the Opponent and previously used in Canada.

Pursuant to section 38(2)(d) the trademark is not distinctive of the Applicant in that contrary to section 2 it does not actually distinguish the wares of the Applicant from the wares and services of others including the Opponent..

[16] The wording of both of these grounds lacks specificity in that they do not identify the food, beverages, barware and clothing goods which Mr. McSkimming claims the Opponent's mark has been used in association with.

[17] Relying on the decision in *Imperial Developments v Imperial Oil* (1984), 79 CPR (2d) 12 (FCTD), the Applicant submits that issues in an opposition are confined to those raised in the statement of opposition. It is therefore the Applicant's submission that since the Opponent only relied on its registered mark and did not identify other goods or services in association with which it was used, it can only rely on the services that are registered in association with its mark (*i.e.* restaurant and bar services).

[18] The Opponent, on the other hand, submits that the Applicant did not request an interlocutory ruling in order to better understand the case it had to meet under this ground. I also note that it has previously been held that in determining the scope of the pleadings, the evidence needs to be considered [*Novopharm v Astrazeneca*, 2002 FCA 387].

[19] In my view, this case can be distinguished from *Imperial Oil, supra*, because that case was about a ground not having been plead at all whereas in this case, the Opponent has raised both section 16(1)(a) and section 38(2)(d) as grounds in its statement of opposition. Further, the Opponent's evidence does purport to show use of its mark in association with food, beverages

and clothing. I therefore find that the deficiencies in the Opponent's section 16(1)(a) and distinctiveness grounds have been remedied by the Opponent's evidence. Accordingly, I find that any use of the Opponent's mark in association with food, beverages and clothing can be considered under both of these grounds [see also *Arc Teryx Equipment Inc v Kawasaki Jukogyo Kabushiki Kaisha (Kawasaki Heavy Industries, Ltd)*, 2015 TMOB 60].

GROUND OF OPPOSITION

Section 30(i) Ground of Opposition

[20] The Opponent pleads that the Applicant could not make the statement that it was satisfied that it was entitled to use the Mark in Canada because it knew of the Opponent's rights or interests in the HEMINGWAY'S mark, such knowledge based on a settlement agreement signed on May 1, 2009, between the parties.

[21] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of 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 the applicant [see *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 [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[22] In the related opposition proceeding against application No. 1,653,460, the Opponent attempted to introduce evidence of a May 1, 2009, settlement agreement, which concerned an application filed by the Applicant in a different proceeding. I found that such evidence was inadmissible as it constituted a breach of the settlement privilege as the settlement agreement did not address the trademark applied for under application No. 1,653,460.

[23] In this case, the Opponent has not filed any evidence to show that the Applicant's application was filed in bad faith. Further, as noted above, mere knowledge of the existence of the Opponent's trademark does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use the Mark. This ground is accordingly dismissed.

Section 30(a) and 30(b) Grounds of Opposition

[24] The Opponent pleads that the application does not comply with the requirements of section 30(a) in that the goods “cards” are not stated specifically in ordinary commercial terms. The Opponent further pleads that the application does not comply to the requirements of section 30(b) as the Applicant has not used the Mark in Canada since October 1, 2015.

[25] The Opponent did not, however, file any evidence nor make any submissions with respect to either of these grounds. These grounds can therefore be summarily dismissed on the basis that the Opponent has not met its initial evidentiary burden in respect thereof.

Section 12(1)(d) Ground of Opposition

[26] The Opponent pleads that the Mark is not registrable under section 12(1)(d) of the Act as it is confusing with the Opponent’s HEMINGWAY’S trademark, registered under No. TMA661,809, in association with restaurant and bar services.

[27] 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 CanLII 11769 (FCA)].

[28] I have exercised my discretion to check the Register and confirm that registration No. TMA661,809 is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. I therefore find that the Opponent has met its burden with respect to this ground of opposition.

Meaning of Confusion between Trademarks

[29] Trademarks are confusing when there is a reasonable likelihood of confusion within the meaning of section 6(2) of the Act:

The 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 . . . 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.

[30] Thus, section 6(2) does not concern mistaking one mark for the other, 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 Goods at issue, sold under the HEMINGWAY trademark, would believe that those goods were produced or authorized or licensed by the Opponent who sells its services under the HEMINGWAY'S trademark.

Test for Confusion

[31] The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are “all the surrounding circumstances including” those specifically mentioned in sections 6(5)(a) to 6(5)(e) of the Act: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the goods, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. While the weight to be given to each factor depends on the circumstances, the degree of resemblance is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion [*Gainers Inc v Tammy L. Marchildon and The Registrar of Trademarks* (1996), 66 CPR (3d) 308 (FCTD); *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Inherent distinctiveness and the extent to which the marks have become known.

[32] The Applicant submitted evidence regarding the fame of the author Ernest Hemingway [Tremblay Affidavit, Roberts Affidavit #2]. The evidence shows that the word Hemingway is defined in the *Canadian Oxford Dictionary* as follows:

Hemingway/Ernest (Miller) (1899-1961), U.S. novelist...He was awarded the Nobel Prize for literature in 1954.

[33] The Applicant submits that consumers would likely be able to recognize the parties' marks as comprising the last name of the famous novelist. I agree. However, I still find both marks to have a low degree of inherent distinctiveness because they each comprise a surname

[*Glaskoch B Koch Jr GmbH & Co KG v Anglo Canadian Mercantile Co* (2006), CanLII 80333 (TMOB); *Ricard v Molson Breweries, a Partnership* (1992), 44 CPR (3d) 359 (FCTD)].

[34] The distinctiveness of a trademark may be increased by its use or its making known in Canada. The evidence of the Opponent's affiant, Mr. McSkimming, provides that the Opponent, its predecessor by amalgamation Telpo Investments Inc.'s and/or its licensee McSheep Investments Ltd., have operated the restaurant and bar HEMINGWAY'S in Toronto, Ontario since at least as early as May 26, 1980 [McSkimming#1, para 1-4]. Since that date, the trademark HEMINGWAY'S has appeared on exterior signage, on menus, on other goods and elsewhere in the restaurant [McSkimming #1, paras 9, 13, 14, 17]. Annual sales of the restaurant between 1981 and 1998 ranged between \$893,666 and \$2,750,152, and were over \$6,000,000 at the date of swearing his affidavit [McSkimming#1, para 15, 23-24]. The Opponent's restaurant has also been promoted on the Opponent's website at <http://hemingways.to>, and referenced in the following publications: *Southern Skies*, the inflight magazine of Ansett New Zealand, the *Toronto Star*, the spring 2005 issue of "*hosting*", the official publication of the Ontario Restaurant and Hotel & Motel Association, *Toronto Today* and the Toronto publication *NOW* from December, 2017 [McSkimming #1, para. 20]. While I am prepared to take judicial notice of the fact that the *Toronto Star* has wide circulation in Canada, I do not consider this evidence sufficient to show that the Opponent's mark has become known outside of the Toronto area to any significant extent.

[35] I therefore find that the Opponent's mark has become known to a considerable extent in Toronto in association with bar and restaurant services. As the Applicant did not file any evidence of use, this factor overall favours the Opponent.

Length of time in use

[36] The Opponent's mark has been used in association with bar and restaurant services since 1980. Although the Applicant's application is based on use with the extended goods since at least as early as October 1, 2015, the Applicant has not provided any evidence of use of the Mark. This factor therefore favours the Opponent.

Nature of the goods, business and trade

[37] When considering the goods, services and trades of the parties, it is the statement of goods or services in the parties' trademark application or registration that governs in respect of the issue of confusion arising under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA.); *Mr. Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe Inc v Bohna*, 1994 CanLII 3534 (FCA)].

[38] As explained above, the applied for Goods at issue are: drinking glasses, shot glasses, flasks, high ball glasses, cocktail shakers, mugs, plates, trays. I find that these Goods at issue are related to the Opponent's business and offering of restaurant and bar services. This factor therefore favours the Opponent. In view that the Applicant has not restricted its goods to any particular channel of trade, and in the absence of evidence to the contrary, I find that the parties' channels of trade could also overlap, as further discussed in paragraph 45 of this decision.

Degree of resemblance between the marks

[39] In *Masterpiece*, the Supreme Court stated that the degree of resemblance between the marks is often likely to have the greatest effect on the confusion analysis [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145 (FCTD) at 149, affirmed 60 CPR (2d) 70].

[40] The Mark and the Opponent's mark are highly similar in appearance, sound and ideas suggested as the dominant component of each is the surname HEMINGWAY. While the "apostrophe" and the letter S in the Opponent's mark suggests the possessive form of the surname, it does not diminish the resemblance between the marks to any significant extent.

Surrounding circumstances – Use of the Opponent's mark with other goods

[41] Although the Opponent's mark is only registered for restaurant and bar services, the Opponent submits that it has also used its mark in association with food, beverages, clothing items and barware such as shot glasses and that it is typical in the trade to do so [McSkimming #2, paras 9-13; 17-25].

[42] Both parties submitted evidence on this issue, the most pertinent parts of which I summarize below. I will mention here that since the Applicant has not applied for any food, beverage or clothing goods, I will focus this discussion on the evidence provided with respect to barware and related goods and only discuss clothing where I consider it relevant to do so.

[43] Mr. Bulbulia, a barrister and solicitor practicing in Mississauga, was asked by the Applicant's agent to attend at the Opponent's HEMINGWAY'S restaurant to determine whether there were any goods for sale at the restaurant, and to determine whether there was any use of the HEMINGWAY'S trademark on clothing, glassware or alcoholic beverages. He also swore an affidavit dated June 22, 2018, in the opposition to application No. 1,653,460 for the trademark ERNEST HEMINGWAY, which he incorporates into his affidavit by reference. His evidence provides the following:

- Both of the Opponent's food and drink menus displayed the word HEMINGWAY'S and a Kiwi bird design;
- The Opponent's trademark did not appear on the glassware or the plates on his table, nor on the plates and glassware around him; and
- All of the drinking glasses he observed behind the bar were plain transparent glasses with no wording on them.

[44] In reply, the Opponent filed the affidavit of Mr. McSkimming #2, on which he was cross-examined. His evidence provides as follows:

- It is typical in the trade for bars and restaurants to sell branded goods such as t-shirts, sweatshirts, jackets, caps, toques, golf-shirts, ashtray and bar ware such as shot glasses; all of these goods have been sold at the Opponent's restaurant "over the past years";
- While the subject of normal commercial transactions, the sales of branded items are secondary to the Opponent's main business of selling food and drink; As such, the sales of these products are not tracked specifically nor does the Opponent's invoicing system allow it to tabulate sales;
- There has been an estimated \$1000 in annual sales representing 80-100 clothing items per year, over each of the five years prior to his affidavit;
- At the date of Mr. McSkimming's affidavit the Opponent was not offering branded barware because it is frequently stolen; Barware has been sold in the past and may be

offered again in the future as part of a promotion such as a branded glass with the purchase of a particular item;

- It is somewhat common in the restaurant and bar industry to use, sell and give away barware with a restaurant's brand applied to it;
- If a client were to request to purchase one of the Opponent's branded items such as a t-shirt, the item would not be visible within the restaurant, rather an employee would go and get the item which would be situated in the office or a storage facility; and
- While the Opponent also provides take-out and catering services, neither the containers nor the platters or trays through which the food is delivered display the HEMINGWAY'S trademark.

[45] While the evidence furnished shows use of the Opponent's mark in association with clothing items, it does not show use of the Opponent's mark in association with barware. What the evidence does show, however, is that it is common in the trade for restaurants and bars to sell or give away barware with the restaurant or bar's mark as part of a promotion. This factor therefore favours the Opponent as it suggests a potential for overlap in the parties' channels of trade for the Goods at issue.

Surrounding Circumstance – State of the Register Evidence

[46] As a further surrounding circumstance, the Applicant relies on the state of the register evidence of Ms. Roberts, a law clerk employed by the Applicant's agent [Roberts #1].

[47] State of the register evidence favours an applicant when it can be shown that the presence of a common element in marks would cause consumers to pay more attention to the other features of the marks, and to distinguish between them by those other features [*McDowell v Laverana GmbH & Co. KG*, 2017 FC 327 at para 42]. Inferences regarding the state of the marketplace may be drawn from such evidence in two situations: a large number of relevant third party registrations are located; and/or there is evidence of common use in the marketplace of relevant third party marks [*Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA); *McDowell v Laverana GmbH & Co KG*, 2017 FC 327 at paras 41-46; and *Cie Gervais Danone v Astro Dairy Products Ltd*, 1999 CanLII 7656 (FC)]. Relevant trademarks include those that (i) are registered; (ii) are for similar goods and services as the marks at issue, and (iii) include the component at issue in a material way [*Sobeys West Inc v Schwan's IP, LLC*,

2015 TMOB 197; *Allergan Inc v Lancôme Parfums & Beauté & Cie, société en nom collectif* (2007), 64 CPR (4th) 147 (TMOB) at 169].

[48] Ms. Roberts’ evidence shows that there are 9 active applications or registrations for trademarks which include the word HEMINGWAY, and 7 of these applications or registrations belong to the Applicant. Ms. Robert’s search therefore only identified two third party trademarks.

[49] As the Applicant has not provided any evidence to establish that either of these third party marks has been used in Canada, I am of the view that this limited number of registrations is not significant enough to allow me to draw any inferences from them in respect of the state of the marketplace. This factor therefore does not assist the Applicant.

Surrounding Circumstance - Applicant’s Ownership of Similar Registrations

[50] As noted above, Ms. Roberts’ search also identified 7 marks owned by the Applicant which include the word HEMINGWAY. Excluding the two applications which are currently in opposition proceedings, these marks include the following:

Application/ Registration No.	Trademark	Goods/Services
TMA533,943	ERNEST HEMINGWAY	(1) Living room, dining room, outdoor, and occasional furniture, namely end tables dining tables, coffee tables, serving tables, lamp tables, console tables, armchairs, lounge chairs, side chairs, dining room chairs, chaise lounges, bar stools, sofas, ottomans, entertainment cabinets, desks, bureau dressers, armoires, nightstands, chests, beds, mattresses, and mirrors. (2) Bronze busts; lamps, sconces, chandeliers and hurricane lamps; clocks, mantel clocks, grandfather clocks, silver serving trays, silver decorative african ornamental masks, silver sculpture, and silver busts; photo albums and bookends; framed art pictures; luggage, leather boxes, leather writing tablet covers; leather organizers, leather briefcases, leather pen cases, leather wine caddies, leather flasks, leather trays, leather mail holders, leather blotters, leather satchels, leather travel

		bars, leather travel desks, hat boxes for travel, canes, and stencilled and natural hides; frames for pictures and artwork, magazine stands, pillows, wooden sculpture, and wooden decorative african ornamental masks; candlesticks not of precious metal, non-metal decorative boxes, wooden baskets, bowls, beverage glassware, barware, namely, high ball glasses, old fashioned glasses, wine goblets, carafes, pitchers, ice buckets, vases, china plates, and serving trays; artificial flower arrangements; rugs.
TMA705,004	PAPA'S HIDEAWAY, A HEMINGWAY COLLECTION	Rugs
TMA780,495	ERNEST HEMINGWAY	(1) Electric fans and ceiling fans. (2) Indoor lighting fixtures, sconce lighting fixtures, and lamp shades
TMA884,384	HEMINGWAY	(1) Men's and women's outdoor clothing namely, underwear, swimwear, pajamas, nightgowns, robes, socks, shirts, t-shirts, sweatshirts, sweaters, pants, sweatpants, dresses, skirts, shorts, jumpsuits, jackets, raincoats, vests, hats, gloves, ties and scarves. (2) Footwear, namely, boots, shoes, athletic shoes, moccasins, sandals, slippers; hosiery; coats; suits; leather jackets; quilted vests; belts (clothing); bandanas; fishing vests; fishing waders; foul weather gear, namely waterproof and windproof coats, pants, jackets, anoraks, hoods and tuques. (3) Clothing for men, women and children, namely, polo shirts, underwear, sleepwear, namely nightshirts; boating shoes, waterproof footwear, fishing footwear; wallets, billfolds, passport cases, watches, eyeglasses, sunglasses, eyeglass cases, eyeglass frames and eyeglass chains; luggage, travel bags, duffel bags, satchels, messenger bags, tote bags, overnight bags. (4) Footwear, namely, boots, shoes, athletic shoes, moccasins, sandals and slippers.

1,894,438	HEMINGWAY Design (stylized)	<p>(1) Cosmetics; fragrances; bath and body lotions</p> <p>(2) Eyeglasses, eyeglass frames</p> <p>(3) Decorative items for the home namely, lamps namely floor lamps, table lamps, desk lamps, and wall lamps, sconces, chandeliers</p> <p>(4) Decorative items for the home namely, bronze and silver busts; silver and bronze sculptures</p> <p>(5) Wood flooring</p> <p>(6) Furniture namely, bedroom, living room, dining room, outdoor and occasional furniture namely beds, mattresses, bureaus, dressers, armoires, nightstands, chests, end tables, dining room tables, coffee tables, service tables, lamp tables, console tables, armchairs, lounge chairs, side chairs, dining room chairs, chaises longues, bar stools, sofas, ottomans, entertainment cabinets, and desks; decorative items for the home namely, non-metal decorative boxes, wooden baskets, wooden sculptures</p> <p>(7) Decorative items for the home namely, serving trays, candlesticks not of precious metal</p> <p>(8) Fishing equipment namely, nets</p> <p>(9) Towels, namely hand towels, bath towels, dish towels, beach towels; bed linens; bed sheets; blankets; comforters</p> <p>(10) Bath mats; rugs</p> <p>(11) Fishing equipment namely, rods, reels, flies and lures, boxes and fishing line; decorative items for the home namely, decorative ornamental masks</p> <p>(12) Beer</p> <p>(13) Alcoholic beverages, namely, whiskey, rum, vodka, liquors, namely, liqueurs, wine, sparkling wine, prepared alcoholic cocktails, wine coolers</p>
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[51] It is well established, however, that the existence of prior registrations owned by a party does not automatically entitle that party to register a similar trademark [see *Groupe Lavo Inc v Proctor & Gamble Inc* (1990), 32 CPR (3d) 533 (TMOB); see also *Highland Feather Inc v American Textile Co*, 2011 TMOB 16 at para 20]. Further, the Applicant did not provide any

evidence to establish that any of these marks had been previously used in Canada. This factor therefore does not assist the Applicant.

[52] I would like to add that had the Applicant provided evidence of use of these marks in Canada with relevant goods, this may have assisted in weakening the Opponent's claim that the presence of the word HEMINGWAY in the Applicant's Mark is sufficient to give rise to a likelihood of confusion [see *Caesarstone Sdot-Yam Ltd v Ceramiche Caesar SPA* 2016 FC 895 at paras 50-56].

Conclusion

[53] As noted above, section 6(2) does not concern mistaking one mark for the other, 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 Goods at issue, sold under the HEMINGWAY Mark would believe that those goods were produced or authorized or licensed by the Opponent who sells its services under the HEMINGWAY'S trademark.

[54] In this case, having considered all of the surrounding circumstances, and in particular the similarity between the parties' marks, the extent known of the Opponent's mark in association with restaurant and bar services in Toronto and the potential for overlap between the parties' channels of trade, I find that the Applicant has not met the legal onus on it to show that, on a balance of probabilities, there is no reasonable likelihood of confusion between the Mark and the Opponent's mark for the Goods at issue, namely drinking glasses, shot glasses, flasks, high ball glasses, cocktail shakers, mugs, plates, and trays. This ground is therefore successful in part.

Section 16(1)(a) Ground of Opposition

[55] The Opponent has also pleaded that the Applicant is not the person entitled to registration pursuant to section 16(1)(a) on the basis that the Mark is confusing with the Opponent's HEMINGWAY'S trademark.

[56] Under this ground the Opponent must show that it and/or its predecessor in title had used the trademark HEMINGWAY'S in Canada prior to the Applicant's date of first use

[section 16(1)(a) of the Act as well as non-abandonment of its trademark at the date of advertisement of the Mark, namely November 16, 2016 [section 16(5) of the Act].

[57] The parties both made submissions regarding whether the Opponent had met its burden under this ground with respect to other goods including food, beverages, clothing and barware. In view of my discussion above under the section 12(1)(d) ground, I do not consider it necessary to address this issue in detail. Suffice is to say that the Opponent has met its burden under this ground with respect to its bar and restaurant services and the difference in material dates between this ground and the section 12(1)(d) ground does not have a significant impact on this ground. I am therefore not satisfied that the Applicant has met the legal onus upon it to show that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark for the Goods at issue.

[58] Accordingly the section 16(1)(a) ground is also successful in part.

Section 38(2)(d) ground of opposition

[59] The Opponent alleges that the Mark is not distinctive. In order to satisfy its evidential burden, the Opponent must establish that as of the filing date of the opposition (*i.e.* Sept. 8, 2016), its HEMINGWAY'S trademark was known to such an extent it could negate the distinctiveness of the Mark [*Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657 (CanLII)].

[60] The parties both made submissions regarding whether the Opponent had met its burden under this ground with respect to other goods including food, beverages, clothing and barware. In view of my discussion above under the section 12(1)(d) ground, I do not consider it necessary to address this issue in detail.

[61] Again, suffice is to say that the Opponent has met its burden under this ground with respect to restaurant and bar services and the difference in material dates between this ground and the section 12(1)(d) ground does not have a significant impact on this ground. I am therefore not satisfied that the Applicant has met the legal onus upon it to show that there is no reasonable likelihood of confusion between the Mark and the Opponent's mark for the Goods at issue.

[62] Accordingly, the section 38(2) ground of opposition is also successful in part.

DISPOSITION

[63] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “drinking glasses, shot glasses, flasks, high ball glasses, cocktail shakers, mugs, plates, and trays” and I reject the opposition with respect to the remainder of the Goods pursuant to section 38(12) of the Act.

Cindy R. Folz
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Application No. 1452075 (1)

Pens, journals, cards, printed materials, namely books, tour books, travel guidebooks, appointment books, brochures, diaries, daily planners, calendars, organizers, study guides, manuals, posters, magazines; drinking glasses, shot glasses, flasks, high ball glasses, cocktail shakers, mugs, plates, trays; ceramic jewelry trays; blankets, pillows (the Goods)

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

HEARING DATE 2020-12-09

APPEARANCES

Coleen Morrison	For the Opponent
Adele Finlayson	For the Applicant

AGENTS OF RECORD

Perley Robertson, Hill & McDougall, LLP	For the Opponent
Macera & Jarzyna LLP	For the Applicant