



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 294

Date of Decision: 2021-12-31

IN THE MATTER OF AN OPPOSITION

Saizeriya Co., Ltd.

Opponent

and

Wei Meng

Applicant

**1,843,215 for
SAIZERIYA&Design**

Application

FILE HISTORY

[1] On June 19, 2017, Wei Meng (the Applicant) filed an application to register the trademark SAIZERIYA&Design set out below (the Mark) based on the Applicant's proposed use in Canada.



[2] The Services are restaurant services; take-out restaurant services.

[3] The application was advertised for opposition purposes in the *Trademarks Journal* of October 31, 2018.

[4] On December 27, 2018, Saizeriya Co., Ltd. (the Opponent) filed a statement of opposition pleading the grounds summarized below:

- (a) Contrary to section 30(e) of the *Trademarks Act*, RSC 1985, c T-13 (the Act), the Applicant did not intend, by itself or through a licensee, or by itself and through a licensee to use the Mark;
- (b) Contrary to section 30(i) of the Act, the Applicant could not have been satisfied of his or her entitlement to use the Mark;
- (c) Contrary to section 16(3)(a) of the Act, the Applicant is not the person entitled to registration of the Mark because, at the date of filing, it was confusing with the Opponent's SAIZERIYA design trademark which had been previously made known in Canada;
- (d) The Mark is not distinctive within the meaning of section 2 of the Act.

[5] The Applicant filed and served a counter statement denying the Opponent's allegations.

[6] In support of its opposition, the Opponent filed the affidavits of Mr. Tomoatsu Takahashi, the Manager of Corporate Planning Division and an employee of the Opponent and Mr. Michael Duchesneau, a law clerk employed by the agents for the Opponent.

[7] The Opponent and the Applicant each filed a written argument. A hearing was not held.

ONUS AND MATERIAL DATES

[8] 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[9] The material dates with respect to the grounds of opposition are:

- (a) Sections 38(2)(a)/30 of the Act - the date of filing the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- (b) Sections 38(2)(c)/16(3) of the Act - the date of filing the application; and
- (c) Sections 38(2)(d)/2 of the Act - the date of filing the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

GROUNDS OF OPPOSITION

Section 30(e) Ground of Opposition

[10] To meet its evidential burden with respect to this ground of opposition, the Opponent must adduce sufficient evidence from which it could reasonably be concluded that the facts alleged to support this issue exist. The evidential burden with respect to section 30(e) is relatively light as the facts at issue may be exclusively in the possession of the Applicant [*Canada National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 (TMOB) at 94-96]. I do not find that the evidence of the Opponent supports the allegation that the Applicant did not intend to use the Mark in Canada. Accordingly, the Opponent has failed to meet its evidential burden and this ground of opposition is rejected.

Section 30(i) Ground of Opposition

[11] The Opponent's section 30(i) ground of opposition includes the following allegations:

- (a) At the filing date of the application, namely June 19, 2017, the Applicant must have been aware of the publication of the Opponent's Saizeriya design trademark in Japan and elsewhere in the world and must have known that the Applicant did not have the Opponent's authorization to reproduce the Opponent's Saizeriya design trademark, in whole, contrary to Section 27 of the *Copyright Act*, RSC, 1985, c C-42;

- (b) The application was filed in bad faith given that the Mark is an identical copy of the Opponent's Saizeriya design trademark; and
- (c) The application was filed in bad faith given that the Applicant has a demonstrated history of filing Canadian trademark applications for the design logos of well-known restaurants in Japan and elsewhere in Asia.

[12] Mr. Takahashi's evidence set out below is sufficient to meet the Opponent's evidential burden with respect to a prima facie case of copyright infringement. Specifically, the Opponent's evidence is that copyright exists in the Opponent's SAIZERIYA Design Trademark owned by the Opponent, the Opponent has evidenced use of that design in green pre-dating the filing date of the subject application and the Mark is virtually identical.

- (a) The Opponent operates a large chain of casual and affordable Italian-inspired restaurants which sell Italian-style food and related goods under the name "Saizeriya" and the logo below (the Opponent's SAIZERIYA Design Trademark) (para 4). Currently, the Opponent operates over 1400 restaurants (para 8).



- (b) The Opponent operates Saizeriya restaurants in Japan, China, Hong Kong, Taiwan and Singapore (para 6).
- (c) The Opponent's SAIZERIYA Design Trademark is an original work created by the Opponent's founder and is now owned by the Opponent (para 11).
- (d) The Opponent's SAIZERIYA Design Trademark was first published in Japan in 1992 (para 12) and appeared on its website as of 2016 (Exhibit A-3) and its Facebook page as of 2014 (Exhibit A-5).

- (e) The Opponent has never authorized the Applicant to make copies of the Opponent's SAIZERIYA Design Trademark or file an application for its registration as a trademark in Canada (para 12).

[13] I adopt the Registrar's comments from the *E Remy Martin & Co SA v Magnet Trading Corp (HK)* (1988), 23 CPR (3d) 242 (TMOB) at 246 case:

Given that copyright in the opponent's design of a centaur exists in Canada, that the opponent has evidenced fairly extensive use of that design on its labels and otherwise and that the design portion of the applicant's mark is virtually identical to the opponent's design, it would appear that the opponent has made out a 'prima facie' case of copyright infringement. ... That is not to say that the applicant has, in fact, infringed the opponent's copyright. However, the applicant has done nothing to evidence the contrary such as, for example, providing evidence of independent creation. If, in fact, the applicant has infringed the opponent's copyright, then it could not have been satisfied that it was the person entitled to registration of its two applied for marks incorporating the virtually identical design as a dominant feature thereof. Since the onus or legal burden is on the applicant to show its compliance with Section 29(i) of the Act, I must find that the opponent's first ground in each opposition is successful.

[14] The Applicant has filed no evidence. In the Applicant's submissions, the Applicant states that the Opponent did not own any SAIZERIYA restaurants in Canada, nor filed any trademark applications within six months of the earliest foreign filing. However, this is not determinative of the issue of copyright. As such, I find that the Applicant has not met the legal onus of demonstrating that he or she was satisfied he or she had the right to use the Mark in Canada. This ground of opposition is therefore successful. Having decided that this ground succeeds on the basis of the Opponent's allegation of a *prima facie* case of copyright infringement, it is unnecessary for me to discuss Mr. Duchesneau's evidence of the three other applications of the Applicant filed for trademarks which appear to be in use in Asia.

Sections 16(3)(a) and 2 Grounds of Opposition

[15] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(3)(a) of the Act because it is confusing with the Opponent's

SAIZERIYA Design Trademark which had been previously made known in Canada by the Opponent in association with restaurant and take-out services.

[16] The Opponent also pleads that the Mark is not distinctive for the same reasons.

[17] With respect to the ground of opposition based on section 16(3)(a) of the Act, the material date is June 19, 2017. In order to meet its initial evidential burden with respect to this ground, the Opponent must show that it had made known its trademark in accordance with section 5 of the Act. The making known requirements set out in section 5 require a finding that a trademark has become well known in Canada by reason of the distribution or advertising of an opponent's goods and services in Canada such that a substantial area in Canada knows its trademark [*Marineland Inc v Marine Wonderland and Animal Park Ltd* (1974), 16 CPR (2d) 97 (FCTD)]. Even though the Opponent has demonstrated that its SAIZERIYA brand has been referenced on the travel website TripAdvisor Canada, this evidence fails to show that its mark was made known by virtue of advertising as required by section 5 [*Williams Companies Inc et al v William Tel Ltd* (2000), 4 CPR (4th) 253 (TMOB)].

[18] In order to meet its evidential burden in support of the non-distinctiveness ground of opposition, the Opponent must show that as of December 27, 2018 its trademark was known to some extent at least and its reputation in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FCTD)]. The Opponent's evidence fails to show that its trademark is known to some extent in Canada and has a reputation sufficient to negate the distinctiveness of the Mark.

[19] As such, the Opponent fails to meet its evidential burden with respect to these grounds of opposition and both are rejected.

DISPOSITION

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

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

No hearing held.

Agents of record

Smart & Biggar LLP

For the Opponent

No agent appointed

For the Applicant