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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 182**

**Date of Decision: 2022-09-20**

**IN THE MATTER OF AN OPPOSITION**

**Maria Josephina Struik**

**Opponent**

**and**

**Churrasqueira Red Rooster B.B.Q.  
Grill Corp.**

**Applicant**

**1,870,921 for RED ROOSTER  
PORTUGUESE BBQ**

**Application**

INTRODUCTION

[1] Maria Josephina Struik (the Opponent) opposes registration of the trademark RED ROOSTER PORTUGUESE BBQ (the Mark) (depicted below), which is the subject of application No. 1,870,921 by Churrasqueira Red Rooster B.B.Q. Grill Corp. (the Applicant):



[2] The application is based on the Applicant's use of the Mark in association with restaurant services since at least as early as January 1, 2007.

THE RECORD

[3] The application was filed on December 1, 2017 and was advertised for opposition purposes in the *Trademarks Journal* of March 18, 2020.

[4] On September 18, 2020, the Opponent filed a statement of opposition. The grounds of opposition pleaded are based on sections 12(1)(d) (registrability), 16(1)(a) and 16(1)(c) (entitlement), and 2 (distinctiveness) of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read prior to June 17, 2019.

[5] The Opponent's 12(1)(d), 16(1)(a) and distinctiveness grounds of opposition are primarily based on an allegation of confusion between the Mark and the Opponent's trademarks RD ROOSTERS and RD ROOSTERS & Design, depicted below:



[6] Both parties submitted evidence. The Opponent submitted as her evidence the affidavit of Amanda Suzanne Gabrielle St-Amour, a legal assistant for the prior trademark agent of the Opponent, who attaches copies of the Opponent's registrations for the trademarks RD ROOSTERS and RD ROOSTERS & Design. The Applicant submitted as its evidence the affidavit of Solvera Gomes, "an agent of the Applicant" and the daughter of its founders. Ms. Gomes provides evidence regarding the Applicant's use of the Mark. The Applicant alone filed written representations. A hearing was not held.

#### LEGAL ONUS AND EVIDENTIAL BURDEN

[7] An applicant bears the legal onus of establishing, on a balance of probabilities, that the application complies with the requirements of the Act. However, an opponent must first 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; *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

## ANALYSIS OF THE GROUNDS OF OPPOSITION

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

[8] The Opponent has pleaded that the Mark is not registrable in that, pursuant to section 12(1)(d) of the Act, the Mark is confusing with the registered trademarks of the Opponent set out below:

- RD ROOSTERS (TMA959,709) for use in association with Shirts; Mugs; Hats; Key chains. and Restaurant services; Take-out restaurant services.
- RD ROOSTERS & Design set out at para 5 (TMA899,535) for use in association with Shirts; Mugs; Hats; Key chains. and Restaurant services; Take-out restaurant services.

[9] The material date for this ground of opposition is the date of this decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[10] As these registrations are extant, the Opponent has met her initial evidential burden with respect to this ground of opposition [see *Quaker Oats Co of Canada Ltd v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB) regarding the Registrar's discretion to check the register in the context of a section 12(1)(d) ground of opposition]. As a result, the Applicant must prove on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and each of these registrations.

### Test for Confusion

[11] The test for confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods and services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods and services are of the same general class or appear in the same class of the Nice Classification. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of

time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks including 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; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23].

[12] The test for confusion is assessed as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees an applicant's mark, at a time when he or she has no more than an imperfect recollection of an opponent's trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot, supra*, at para 20].

#### *Degree of Resemblance*

[13] In most instances, the degree of resemblance between the trademarks at issue is likely to have the greatest effect on the confusion analysis [*Masterpiece, supra* at para 49]. One must consider the degree of resemblance between the marks including with respect to their appearance, sound and ideas suggested. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [*Veuve Clicquot, supra*].

[14] I will first assess the degree of resemblance between the Mark and the Opponent's trademark RD ROOSTERS. In my view, there is a high degree of visual resemblance between the parties' trademarks insofar as the striking component of the Mark (RED ROOSTER) varies by only two letters from the Opponent's trademark. There is some resemblance in sound and in idea suggested as both trademarks include the word ROOSTER and therefore suggest a rooster. In the case of the Mark, a red rooster. In the case of the Opponent's trademark RD ROOSTER, it is not clear how the RD would be understood whether as "red", the initials "RD" or as "ROAD". With respect to the idea suggested by the Opponent's trademark RD ROOSTER, as a matter of first impression, I find that consumers would be unsure of what is suggested whether that be a red rooster, a road rooster, or a rooster with the initials RD. Overall, therefore I find that the marks have a fair degree of resemblance. In making this finding, I am mindful of case law

such as *Conde Nast Publications Inc. v Union des Editions Modernes* (1979), 46 CPR (2d) 183 at 188 (FCTD) which stands for the principle that the first portion of a trademark is the most important.

[15] In terms of the degree of resemblance between the Mark and the design trademark RD ROOSTERS & Design, there is a degree of resemblance in terms of idea suggested in that both trademarks suggest a rooster. The degree of resemblance in appearance or sound between the trademarks is mitigated by the word components of the Mark and the differing dominant features of their designs including the lack of silhouette and farm scene in the Mark.

#### *Inherent Distinctiveness of the Trademarks*

[16] The parties' trademarks have a similar degree of inherent distinctiveness. With respect to the Mark, it includes a distinctive rooster design and the words RED ROOSTER. The words PORTUGESE BBQ do not add any distinctiveness to the Mark as they are descriptive of restaurant services. With respect to the trademark RD ROOSTERS, this trademark is inherently distinctive as a RD ROOSTERS is not a term with any meaning. With respect to the RD ROOSTERS & Design trademark, this trademark is a distinctive design of a rooster silhouette over a farm scene.

#### *Extent Known*

[17] The strength of a trademark may be increased by means of it becoming known through promotion or use. This factor favours the Applicant who has shown use of the Mark in contrast with the Opponent who has not evidenced use of either of her registrations.

[18] While the Opponent's registrations are based on use, this only entitles me to assume *de minimis* use [*Entre Computer Centers Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB) at 430]. *De minimis* use does not support a conclusion that a trademark has become known to any significant extent, nor that a trademark has been used continuously.

[19] Ms. Gomes states that the Applicant has operated its RED ROOSTER PORTUGESE BBQ restaurants in association with the Mark in the Greater Toronto area since 2001 (paras 3-5; Exhibits A-B). The Mark has appeared in exterior signage, menus, and on the internet (Exhibits

A-C, E). Ms. Gomes reports that the Applicant's restaurants have served many thousands of customers (para 7).

#### *Length of Time in Use*

[20] This factor significantly favours the Applicant who has evidenced use of the Mark in association with restaurant services since 2001 (Gomes affidavit, para 5, Exhibit B). In *Pink Panther Beauty Corp v United Artists Corp*, [1998] 3 FC 534 (FCA), the Federal Court of Appeal confirms that the length of time a trademark has been in use is a factor which must be given weight in assessing confusion:

The length of time that a mark has been used is obviously a factor which will contribute to confusion on behalf of the consumer in determining the origin of wares or services. A mark that has been in use a long time, versus one newly arrived on the scene, is presumed to have made a certain impression which must be given some weight. It is important to remember that "use" is a term defined by the Act and, therefore, has a special meaning.

#### *Nature of the Goods, Services or Business; and the Nature of the Trade*

[21] There is direct overlap in the restaurant services of the Applicant and the Opponent. With respect to the channels of trade, as the services at issue are identical, it is reasonable to assume that their channels of trade would also overlap, particularly in the absence of evidence to the contrary. Accordingly, these factors favour the Opponent.

#### Conclusion


[22] The test to be applied is as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Mark when he or she has no more than an imperfect recollection of the Opponent's RD ROOSTERS or RD ROOSTERS & Design trademarks and does not pause to give the matter any detailed consideration or scrutiny.

[23] Having considered all the surrounding circumstances, in particular the degree of resemblance and the extent known and length of time in use of the Mark in contrast with the Opponent's trademarks, as a matter of first impression and imperfect recollection, I find that the Applicant has met the legal onus on it to show that the balance of probabilities weighs in its

favour on the issue of a reasonable likelihood of confusion. In reaching this conclusion, I note that pursuant to section 6(2) of the Act, the issue of confusion relates to the likelihood of confusion of services as from one source being from another source, not confusion between the trademarks themselves. Accordingly, the section 12(1)(d) ground of opposition is rejected.

**Sections 16(1)(a) and 16(1)(c) Grounds of Opposition**

[24] The Opponent alleges in the statement of opposition that the Applicant is not the person entitled to register the Mark in view of the Opponent’s use of her trademarks and trade names listed below.

Trademarks	Trade names
<p><b>RD ROOSTERS</b></p> <p><b>ROOSTERS DESIGN</b></p> 	<p><b>ROOSTERS DINER INC.</b></p> <p><b>ROOSTERS DINER</b></p> <p><b>ROOSTERS DINER SPANISH</b></p> <p><b>ROOSTER DINER DIXIE LEE</b></p>

[25] In order to meet her initial evidential burden in support of the non-entitlement grounds of opposition, the Opponent was required to show that she had used one of her trademarks (for the section 16(1)(a) ground) and one of her trade names (for the section 16(1)(c) ground) at the filing date of the application or 2001, the date of first use of the trademark in Canada as evidenced in Ms. Gomes’ affidavit. The Opponent has not done so. Further, while the Opponent’s trademark registrations are based on use, that is not sufficient for the Opponent to meet her burden with respect to a section 16(1)(a) ground of opposition [*Roosx, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB) at 268]. These grounds of opposition are therefore rejected.

## Section 2 Ground of Opposition

[26] The Opponent alleges in the statement of opposition that the Mark is not distinctive as it does not distinguish, nor is it adapted to distinguish, the restaurant services of the Applicant from the goods and services with which the Opponent has previously used and continues to use the trademarks and trade names set out with respect to the section 16 grounds of opposition.

[27] In order to meet her initial evidential burden in support of this ground of opposition, the Opponent was required to show that as of the date of filing the statement of opposition, September 18, 2020, that one or more of her trademarks or trade names were known to some extent at least and the reputation of one or more of these trademarks or trade names in Canada was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 1981 CanLII 2834 (FC), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd* (2006), 2006 FC 657 (CanLII), 48 CPR (4th) 427 (FC)]. The Opponent has not done so. This ground of opposition is therefore rejected.

### DISPOSITION

[28] In view of the above, 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



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

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**AGENTS OF RECORD**

No agent appointed

FOR THE OPPONENT

John H. Simpson

FOR THE APPLICANT