



## Canadian Intellectual Property Office

### **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 072

**Date of Decision:** 2023-04-18

### **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Boulangerie Andalos Inc.

**Applicant:** Knead (Holding) S.A.L.

**Application:** 1,849,282 for ZAATAR W ZEIT & Design

### **INTRODUCTION**

[1] Boulangerie Andalos Inc. (the Opponent) opposes registration of the trademark ZAATAR W ZEIT & Design (the Mark), which is the subject of application No. 1,849,282 by Knead (Holding) S.A.L. (the Applicant). The Mark is shown below:



[2] The Mark is applied for in association with the following:

### **Goods**

Nice Class 29 (1) Prepared meals, namely prepared meat and packaged meat; preserved foods, namely dried and frozen fruits and vegetables; dairy products; eatable oils and edible fats; meat; fish; poultry; game; meat extracts; fruit preserves; jellies; jams; compotes; eggs; salads;

Nice Class 30 (2) Flour; sugar based confections; bread; biscuits; pastries; desserts, namely custard, brownie squares, cheesecakes, chocolate mousses, pancakes; sugar; honey; molasses; spices; syrups, namely maple syrup, chocolate syrup; products for making beverages, namely beverage flavourings, frozen yogurt for beverages; coffee; tea; cocoa; artificial coffee; rice; tapioca; sago; preparations made from cereals, namely dough, cake dough, brownie dough; edible ices; treacle; yeast, baking-powder; salt; vinegar; sauces, namely mayonnaise, tomato sauce; condiments, namely ketchup, mustard, relish, horseradish, hot sauce, and chili sauce; spices; ice;

Nice Class 32 (3) Syrups for beverages, namely coffee flavoured syrup, powdered starch syrup; alcoholic beverages, namely beer; non-alcoholic beverages, namely coffee, tea, non-alcoholic fruit juice beverages, energy drinks, carbonated soft drinks; drinking water; mineral and aerated waters; fruit beverages and fruit juices;

Nice Class 33 (4) Alcoholic beverages, namely wine;

### **Services**

Nice Class 39 (1) Delivery services, namely delivery of food by restaurants;

Nice Class 41 (2) Nightclub services;

Nice Class 43 (3) Restaurant services; bar services; catering services; take-out restaurant services; self service restaurants.

[3] The Applicant stated in its application that the English translation of ZAATAR W ZEIT in the Mark is THYME AND OLIVE OIL.

### **THE RECORD**

[4] The application for the Mark was filed on July 25, 2017 and advertised for opposition purposes on January 29, 2020. Since the Mark was advertised after the coming into force of the numerous amendments to the *Trademarks Act*, RSC 1985,

c T-13, (the Act), on June 17, 2019, under section 69.1 it is the Act as amended that applies to this proceeding.

[5] On March 30, 2020, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act.

[6] The grounds of opposition are the following:

- Non-entitlement under section 16(1)(a) of the Act,
- Non-distinctiveness under section 2 of the Act,
- Some services are not specified in ordinary commercial terms under section 30(2)(a) of the Act,
- The Applicant did not use or did not propose to use the Mark in Canada in association with the goods and services under section 38(2)(e) of the Act,
- The Applicant is not entitled to use the Mark in Canada in association with the goods and services as the use of the Mark would constitute common-law tort of passing off under sections 38(2)(f) and 7(b) of the Act.

[7] The Applicant filed a counter statement denying all the grounds of opposition.

[8] In support of its opposition, the Opponent filed the affidavits of Fathi Sfairy and Mohamad Ibrahim, both dated December 29, 2020.

[9] In support of its application, the Applicant filed the affidavits of Gerard Daccache and Jason Choi, both dated April 30, 2021.

[10] Only the Applicant submitted written representations and was represented at an oral hearing.

### **EVIDENTIAL BURDEN AND LEGAL ONUS**

[11] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CanLII 11059 (FC), 1990 CarswellNat 1053 (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.

[12] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

### **GROUND OF OPPOSITION SUMMARILY DISMISSED**

#### ***Section 30(2)(a) Ground – Goods Specified In Ordinary Commercial Terms***

[13] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not conform to the requirements of section 30(2)(a) of the Act because the applied-for service *Nightclub services* is not specified in ordinary commercial terms. The Opponent did not elaborate further.

[14] The material date for this ground is the filing date of the application.

[15] The initial burden on an opponent under a section 30(2)(a) ground is a light one and it can succeed through argument alone, i.e., the Registrar may take judicial notice of facts in support of the Opponent's pleading [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd*, 1984 CarswellNat 1074 (TMOB) and *Pro Image Sportswear Inc v Pro Image Inc*, 1992 CarswellNat 1487 (TMOB)].

[16] However, in the absence of representations from the Opponent and as none of the Opponent's evidence appears to be directed towards this ground, I find that the Opponent has not met its initial evidential burden.

[17] Accordingly, the ground of opposition based on section 30(2)(a) of the Act is rejected.

**Section 38(2)(e) Ground – No Use or Proposed Use by the Applicant**

[18] The Opponent pleads that the Applicant was not using, or did not propose to use, the Mark as of the filing date of the application. Again, no evidence of record supports this ground.

[19] Accordingly, the ground of opposition based on section 38(2)(e) of the Act is rejected.

**Section 38(2)(f) Ground – Unlawful use of the Trademark**

[20] In its statement of opposition, the Opponent submits that “the Applicant was not entitled to use the [Mark] in Canada in association with the goods and services applied for because it would constitute common-law tort of passing off and the statutory tort of passing-off, as codified by section 7(b) of the Act, because the [Mark] was confusing with the ZAATAR W ZEIT Marks”.

[21] Assuming that the ground as pleaded is a valid ground of opposition, the Opponent has failed to adduce evidence of at least one of the elements required to show a violation of section 7(b) of the Act: deception of the public due to a misrepresentation [see the three elements set forth in *Ciba-Geigy Canada Ltd v Apotex Inc*, [1992] 3 SCR 120 at para 33 cited by *Pharmacommunications Holdings Inc v Avencia International Inc*, 2008 FC 828 at para 41]. As such, this ground of opposition is rejected.

**REMAINING GROUNDS OF OPPOSITION**

**Section 16(1)(a) Ground – Non-Entitlement**

[22] The Opponent alleges that the Applicant is not the person entitled to registration because the Mark is confusing with the Opponent's applied-for trademark ZAATAR W ZEIT, pending application number 1,988,095, and its design form, both trademarks previously used or made known in Canada by the Opponent in association with spices, pita bread, pizza, snack bar services, restaurants services, café services, and catering services, since as early as 2008 and were not abandoned since then. Although the Opponent does reference to only section 16(1)(a) of the Act, its pleading refers to both

sections (ie) confusion with a trademark previously used or made known and confusion with a filed application

[23] I wish to point out that application 1,988,095 cannot form the basis of a ground of opposition as it was filed subsequent to the present application. The ground of opposition will therefore be assessed solely on the basis of prior use of the Opponent's ZAATAR W ZEIT and ZATAAR W ZEIT & Design trademarks under section 16(1)(a) of the Act.

[24] The Opponent has an initial burden of establishing that its trademarks alleged in support of this ground of opposition were used or made known prior to the earlier of the date of filing of the Application or the date of first use of the Mark in Canada, and were not abandoned at the date of advertisement of the Application for the registration of the Mark [section 16(3) of the Act].

[25] In order to determine the material date under this ground of opposition, I will summarize first the Applicant's evidence.

#### Evidence of the Applicant

[26] The Applicant filed two affidavits.

[27] Mr. Choi, an articling student, executed an affidavit. Since its content refers to facts related to the ground of opposition based on section 30(2)(a) of the Act, which has been summarily dismissed, there is no need to summarize it.

[28] In the second affidavit, Mr. Daccache states the following:

- He is the Market Operations Manager at Zaatara w Zeit Foods Canada Inc., a wholly owned British Columbia subsidiary (the BC Company) of the Applicant [para 1].
- The Applicant operates restaurants under the trademark ZATAAR W ZEIT serving healthy, fresh Lebanese food and beverages, including snacks, appetizers, sides, prepared meals, and desserts for dine in, take-

out, delivery, and catering. Some of these restaurants are open 24 hours per day and operate more in the nature of a bar or nightclub than a casual restaurant during the evening and overnight hours. These restaurants are located in six countries, but most of them are in Lebanon [para 4]. There is no reference to one of them being located in Canada.

- The Applicant created an Instagram profile in March 2017 to promote its goods and services in Canada in association with its registered word trademark ZAATAR W ZEIT (Canadian registration TMA886,584) and the Mark [para 12].
- In April 2019, the Applicant granted a licence for its trademarks, including the Mark, to Knead Food and Beverages Trading DWC – LLC (the Dubai Company). In the same month, the Dubai Company granted a sub-license of these same trademarks to the BC Company. Both the Dubai Company and the BC Company are affiliated with the Applicant [para 13].
- Through the licence, the Applicant maintains full control over the use of its trademarks, including control over the character and quality of all goods sold and services performed by the licensees [para 13].
- The Applicant, through the BC Company, opened a restaurant in Vancouver, British Columbia in November 2019. This location was leased a few years prior the opening and the Mark was affixed on a sign on the storefront of the restaurant since September 2017 [para 14].
- Since the opening of the Vancouver restaurant, the BC Company provided restaurant services, catering services, take-out restaurant services, and self-service services and sold prepared meals [paras 16 and 17].

- Since September 2017, the BC Company operated a website with the domain name *http://www.zaatarwzeit.net/CA* to promote its food and beverages and restaurant and catering services online [para 18].
- Since January 2020, the BC Company offered delivery services for its goods from the Vancouver restaurant [para 19].

[29] The Applicant also filed the following relevant exhibits to the Daccache Affidavit:

- A screen print of the Applicant's Instagram account [Exhibit B]. The Mark appears as the profile picture of the account.
- Copies of license agreements between the Applicant and the Dubai Company and between the Dubai Company and the BC Company [Exhibits C and D].
- A photograph of the front of the Vancouver restaurant in September 2017 [Exhibit E]. The Mark appears on the storefront of the restaurant along with the sign "opening our doors soon".
- A photograph of the Vancouver restaurant front doors the night of the opening ceremony on November 29, 2019 [Exhibit F]. The Mark and a slight variation of it appear above the restaurant's doors.
- Photographs of the Vancouver restaurant, including signs displayed outside the restaurant, self-service section, advertisements, disposable packaging, placemats, menus, and seating areas [Exhibits G through L]. The Mark appears on multiple of these photographs.
- Copies of the restaurant menu, online ordering form, and a screenshot of the Applicant's webpage showing an online ordering form for pick-up or delivery of goods [Exhibit N]. The Mark appears on the menu and on the screenshot.



- Photographs of different goods, including prepared meals, beverages, spices, sauces, desserts, and yogurts sold by the BC Company [Exhibits M, and O through S]. The Mark appears on most of the packages shown in these photographs.

[30] The Applicant has demonstrated use of the Mark in Canada in association with some of the Services, namely restaurant services, bar services, catering services, take-out restaurant services, and self service restaurants but only since November 2019, and for delivery services, namely delivery of food by restaurants since January 2020. As for the Goods, there is no evidence of use of the Mark within the meaning of section 4(1) of the Act prior to the filing date of the application.

[31] Accordingly, the material date for this ground of opposition is the filing date of the application namely July 25, 2017.

[32] Therefore the Opponent had the burden to prove use of its trademarks in Canada prior to July 25, 2017.

#### Evidence of the Opponent

[33] The Opponent's evidence consists of two affidavits. I will summarize the relevant portions of those affidavits.

[34] In the first affidavit, Mr. Sfairy states the following:

- He is the Financial Controller of the Opponent since March 2019, and is employed by the Opponent since December 2008 [para 1].
- The Opponent operates a Middle-Eastern grocery store, bakery, and restaurant in Montreal, Quebec that offers a wide range of baked goods, pastries and ready-to-eat food [para 4].
- In addition of operating the grocery store, bakery, and restaurant in Montreal, the Opponent also distributes and sells its products to stores and distributors, mainly in Canada but also in the United States [para 5 and Exhibit 1].

- The Opponent used its ZAATAR W ZEIT and design trademark since at least 2008 in association with “spices, pita bread, pizza, snack bar services, restaurants, cafe services and catering services”.
- Sales of the Opponent’s products are made through Produits Andalos Inc., a company affiliated to the Opponent, pursuant to a licence agreement, under which the Opponent maintains full control “over the use by Produits Andalos Inc. of the ZATAAR W ZEIT trademark [i.e., the ZAATAR W ZEIT and design trademark]” [para 11].
- The ZAATAR W ZEIT and design trademark appears on the packages of the Opponent’s goods [para 6].
- Sales figures of the goods and services in association with the ZAATAR W ZEIT and design trademark were in excess of \$149 000 in 2019 and \$165 000 in 2020 [para 10]. However there is no breakdown per goods and services.

[35] In the second affidavit, Mr. Ibrahim states the following:

- He was the Financial Controller of the Opponent from May 2000 to February 2009 [para 1].
- Since 2008, the Opponent continuously sold products namely, spices, pita bread, pizza, and provided services namely, snack bar services, restaurant services, café services and catering services under the ZAATAR W ZEIT and design trademark in Canada [para 9].
- Sales figures of the goods and services in association with the ZAATAR W ZEIT and design trademark were in excess of \$20 000 in 2015, \$175 000 in 2016, \$169 000 in 2017, and \$140 000 in 2018 [para 11]. Again, those figures are not broken down by goods and services identified above.

[36] The Opponent also attached the following relevant exhibits to the affidavits:

- A list of the Opponent’s retailers and distributors located in Canada and the United States to whom the goods were sold [Exhibits 1 to both affidavits].

- Photographs of “Pita Pizzas” and “Thyme Mix” in packaging bearing the following variations of the ZAATAR W ZEIT and design trademark [Exhibits 2 to both affidavits]:



- Invoices from Produits Andalous Inc. to different third party retailers dated between December 4, 2015 to May 27, 2020. In those invoices, multiple products were sold, but the only one that appeared to be sold in association with a ZAATAR W ZEIT trademark is “PITA PIZZA ZAATAR W ZEIT THYM REG x 6” [Exhibit 4 to the Sfairy Affidavit and Exhibit 5 to the Ibrahim Affidavit].

[37] I am satisfied that the Opponent has met its burden to show use of its trademarks ZAATAR W ZEIT and ZATAAE W ZEIT & Design prior to July 25, 2017 in association with pita bread. The evidence demonstrates that the Opponent’s ZAATAR W ZEIT and ZATAAR W ZEIT and design trademarks were associated with pita bread as the trademarks clearly appear on the packaging of the products sold by the Opponent [as seen on the photographs filed as Exhibits 2 to both affidavits]. The Opponent also provided invoices proving the sale of pita bread in Canada, as early as 2015.

[38] I do not find that the Opponent has evidenced use of its trademarks in association with any of the services. While the Opponent asserts that it had used its marks in association with snack bar services, restaurant services, café services and catering services, in the absence of any supporting documentary evidence, I do not find that it has met its burden with respect to these services.

[39] Given that the Opponent has met its initial burden in so far pita bread is concerned, I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with the Opponent's ZAATAR W ZEIT trademarks.

#### The Test for Confusion

[40] 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 the applicant's mark, at a time when he or she has no more than an imperfect recollection of the 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 Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[41] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at 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 the trade-marks have 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, including in appearance or sound or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered, and are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc* 2006 SCC 22; *Veuve Clicquot, supra*; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

#### Opponent's Trademark ZAATAR W ZEIT

[42] For the purpose of this analysis, I consider the use of the trademark ZAATAR W ZEIT and Design by the Opponent, as illustrated above, as use of its word mark

ZAATAR W ZEIT [see *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. The design portion does not create the impression that the ZATAR W ZEIT & Design mark is a distinctive trademark such that in the mind of an average consumer the pita bread sold in association with such trademark would originate from an entity different than the one selling pita bread in association with ZATAAR W ZEIT. I consider the combination of the words ZATTAR, W and ZEIT to be the dominant feature of both marks.

[43] Consequently, the analysis of the relevant criteria under section 6(5) of the Act, will equally apply to the Opponent's trademarks ZAATAR W ZEIT and ZAATAR W ZEIT & Design, except for the inherent distinctiveness of the marks and degree of resemblance as discuss below.

*Section 6(5)(a) – the inherent distinctiveness of the trademarks and the extent to which they have become known*

[44] Both parties' trademarks integrate the words ZAATAR W ZEIT. These words have no meaning in French or English, and therefore are inherently distinctive. While the words ZAATAR W ZEIT mean THYME AND OLIVE OIL, there is no evidence that the average Canadian consumer is aware of this meaning.

[45] Overall, the Mark has a degree of inherent distinctiveness higher than the Opponent's word mark ZAATAR W ZEIT due to its design portion.

[46] The strength of a trademark may be increased by means of it becoming known in Canada through promotion or use.

[47] The Opponent has demonstrated some use of its ZAATAR W ZEIT trademark through use of its ZAATAR W ZEIT & Design trademark, in Canada since at least 2015 in association with pita bread. I accept that the Opponent's trademark ZAATAR W ZEIT has acquired some distinctiveness in Canada in association with pita bread, such that this factor favours the Opponent in respect of this good. As for the services, no evidence, with the exception of a bare assertion by the affiants, was put forward by the

Opponent that it performed or promoted in Canada services in association with its ZAATAR W ZEIT trademark.

[48] With respect to the Applicant, as the material date is the date of the filing of the application, there is no evidence that the Applicant had used the Mark as of this date.

[49] Overall, this factor favours the Opponent.

*Section 6(5)(b) – the length of time of use*

[50] The evidence demonstrates that the Opponent used its trademark ZAATAR W ZEIT from at least 2015 in Canada in association with pita bread.

[51] The Applicant's evidence demonstrates that it has used the Mark in Canada since 2019 in association with some of the Services, which is after the material date.

[52] This factor favours the Opponent.

*Sections 6(5)(c) and (d) – the nature of the goods and channels of trade*

[53] It is the Applicant's statement of goods and services as defined in its application versus the Opponent's goods and services that govern my determination of this factor.

[54] In the present case, the Applicant's goods below in bold (Overlapping Goods) fall within the nature of the Opponent's pita bread:

(2) **Flour**; sugar based confections; **bread**; **biscuits**; pastries; desserts, namely custard, brownie squares, cheesecakes, chocolate mousses, pancakes; sugar; honey; molasses; spices; syrups, namely maple syrup, chocolate syrup; products for making beverages, namely beverage flavourings, frozen yogurt for beverages; coffee; tea; cocoa; artificial coffee; rice; tapioca; sago; **preparations made from cereals, namely dough**, cake dough, brownie dough; edible ices; treacle; **yeast, baking-powder**; salt; vinegar; sauces, namely mayonnaise, tomato sauce; condiments, namely ketchup, mustard, relish, horseradish, hot sauce, and chili sauce; spices; ice;

[55] Given the absence of evidence from the Opponent regarding the services it allegedly performed in Canada in association with its ZAATAR W ZEIT trademarks and sales of the other goods referred to in the Opponent's affidavits, I cannot conclude to

potential overlap in the nature of the Opponent's goods or services with the Applicant's Goods and Services other than for pita bread and the Overlapping Goods.

[56] As for the channels of trade, given that the Overlapping Goods are related to the Opponent's pita bread, and since there are other food products as part of the Goods, I conclude that the parties' channels of trade would also overlap when considering the food products part of the Goods.

[57] However, even though the channels of trade would potentially overlap for the majority of the Goods, I assume that given the different nature of the applied-for Goods and the Opponent's pita bread, the parties' respective goods would not be offered for sale or in display in proximity to each other. Therefore, I consider that this factor does not favour the Opponent for the entirety of the applied-for Goods, but only for the Overlapping Goods.

*Section 6(5)(e) – the degree of resemblance*

[58] When considering the degree of resemblance between trademarks, they must be considered in their totality; it is not correct to lay them side by side and compare and observe similarities or differences among the elements or components of the trademarks [*Veuve Clicquot, supra*, at para 20].

[59] In *Masterpiece, supra* at paragraph 64, the Court further advised that the preferable approach when considering resemblance "is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique".

[60] In my view, the subject trademarks (the Mark and the Opponent's word mark ZAATAR W ZEIT) have a high degree of resemblance in appearance, sound and in ideas suggested, given they shared a dominant element consisting of the three words ZAATAR, W and ZEIT.

[61] Accordingly, this factor favours the Opponent.

### *Conclusion on Confusion*

[62] Having considered all of the surrounding circumstances, and bearing in mind that the test for confusion is a matter of first impression and imperfect recollection, I find that the Applicant has not established, on a balance of probabilities, the absence of any likelihood of confusion with respect to the Overlapping Goods.

### Opponent's Trademark ZAATAR W ZEIT and Design

[63] This analysis is essentially the same as the one above, except for the sections 6(5)(a) and 6(5)(e) factors, namely the degree of inherent distinctiveness and the degree of resemblance.

[64] The degree of inherent distinctiveness would be the same when comparing the Mark to the Opponent's ZAATAR W ZEIT & design trademark. Even though the design portion of these marks is different, the marks, in their entirety, have relatively the same degree of inherent distinctiveness.

[65] As mentioned above, both marks shared the dominant element consisting of the three words ZAATAR W ZEIT. The Opponent's design mark incorporate what seems to be a leaf and a drop, the same elements that are incorporated in the Mark. Unless the design is so original or unique, which is not the present case, a consumer is likely to remember the mark by its word portion.

[66] Therefore, the inherent distinctiveness does not favour either party.

[67] However, in view of the Opponent's evidence of use of its mark ZAATAR W ZEIT & Design, the factor under section 6(5)(a) still favours the Opponent.

[68] As for degree of resemblance, the marks in issue have some similarities namely, the word portion is identical and they incorporate a leaf and a drop design.



### *Conclusion on Confusion*

[69] For reasons similar to those set out above with respect to the likelihood of confusion between the Opponent's ZAATAR W ZEIT trademark and the Mark, I find that the Applicant has not established, on a balance of probabilities, the absence of any likelihood of confusion with respect to the Overlapping Goods between the Opponent's ZAATAR W ZEIT & Design mark and the Mark.

[70] Consequently, the section 16(1)(a) ground of opposition is allowed in part in so far as the Overlapping Goods are concerned.

### ***Section 2 Ground – The Trademark is not Distinctive***

[71] Per section 38(2)(d) of the Act, the Opponent pleads that the Mark is not distinctive of the Applicant within the meaning of “distinctive” as set out in section 2 of the Act “because of the Opponent's prior and continuing use (and other adoption) in Canada of the ZAATAR W ZEIT Marks”.

[72] The material date for this ground is the date of the filing of the statement of opposition (March 30, 2020).

[73] In order to meet its initial burden under this ground, the Opponent must establish that one or more of the Opponent's trademarks had become “known to some extent at least to negate the distinctiveness of the applied for mark, and its reputation in Canada should be substantial, significant or sufficient” [*Bojangles' International, LLC v Bojangles Café Ltd* (2006), 2006 FC 657, 48 CPR (4th) 427]. As per my review above of the Opponent's affidavits and finding made under the section 6(5)(a) factor, I am prepared to accept that the Opponent has demonstrated that its ZAATAR W ZEIT trademarks in association with pita bread had become known to some extent in Canada.

[74] Given that the Opponent met its initial burden, the Applicant was therefore required to show that its Mark was adapted to distinguish or actually distinguishes the Goods and Services from the goods of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[75] I consider that the difference in material dates does not affect my conclusion reached under the section 16(1)(a) ground of opposition discussed above. Even though the material date for this ground of opposition is later and the Applicant did file evidence of use of the Mark in Canada since 2019, the Applicant did not provide any invoices or volume of sales for the services performed or the goods sold through the Vancouver restaurant or its website. Without such information, I cannot determine the extent to which the Mark has become known in Canada, and therefore the 6(5)(a) factor still favours the Opponent. As for the other factors, they still favour the Opponent, at least for the Overlapping Goods.

[76] Accordingly, I reach the same conclusion regarding the likelihood of confusion as under the 16(1)(a) ground of opposition and, this ground of opposition is also successful in so far as the Overlapping Goods are concerned.

### **DISPOSITION**

[77] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the goods “flour, bread, biscuits, preparations made from cereals, namely dough, yeast, baking-powder,” and I reject the opposition with respect to the remainder of the goods and the services pursuant to section 38(12) of the Act.

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Jean Carrière  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

# Appearances and Agents of Record

**HEARING DATE:** 2023-02-07

## **APPEARANCES**

**For the Opponent:** No one appearing

**For the Applicant:** Ted B. Urbanek

## **AGENTS OF RECORD**

**For the Opponent:** Bereskin & Parr LLP/S.E.N.C.R.L., S.R.L.

**For the Applicant:** Urbanek Intellectual Property Law