

Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 161

Date of Decision: 2023-09-13

IN THE MATTER OF AN OPPOSITION

Opponent: The Board of Regents of the University of Texas System

Applicant: EDAM Ltd.

Application: 1848513 for KASAP TURKISH STEAKHOUSE & Design

INTRODUCTION

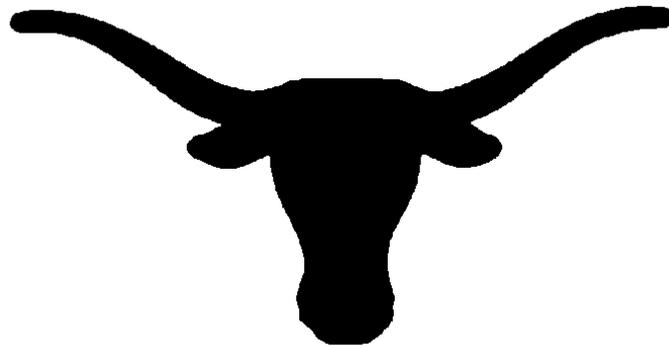
[1] The Applicant EDAM Ltd. has applied to register the trademark KASAP TURKISH STEAKHOUSE & Design (the Applied-for Mark), shown below:



[2] The Applicant seeks to register the Applied-for Mark in association with services “cafés; food and drink catering; restaurants” (the Applied-for Services).

[3] The Opponent, The Board of Regents of the University of Texas System, opposes the registration of the Applied-for Mark. The opposition is based primarily on two allegations:

- that the Applied-for Mark consists of the Opponent’s official mark shown below (the Official Mark), or so nearly resembles the Official Mark as to be likely to be mistaken therefor; and



The Opponent’s Official Mark

- the Applied-for Mark is confusing with the Official Mark, which had been used and made known in Canada as a trademark, prior to the application filing date.

[4] For the following reasons, the opposition is rejected.

THE RECORD

[5] The Application was filed on July 20, 2017, and was advertised pursuant to section 37(1) of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on April 28, 2021.

[6] The Applicant included the following foreign character translation and transliteration as part of its Application: “the translation of the Arabic words is “Turkish Steakhouse“; and “the transliteration of the Arabic characters is “kasap”, Bait Allahim Alturky”.

[7] As well, the application includes the following colour claim:

From outside to inside (the left and upper side) the first contour is dark red, the second is beige and the third is brown, (the right and lower side) the first contour is brown, the second is dark red, the third is beige and the fourth is brown. The inner surface is beige. The Arabic words and the letters ASA are brown. The letters K and P and the bull head are red. Underneath the design, the first and the third Arabic writings are dark red. The Arabic writings in the middle, the terms TURKISH STEAKHOUSE, the line below and the fancy lines are brown. The whole trademark being is on a white background.

[8] On October 26, 2021, the Opponent filed a statement of opposition pursuant to section 38 of the Act. In its statement of opposition, the Opponent raises four grounds of opposition, each of which are ultimately based on its Official Mark, and alleged use and making known of the Official Mark as a trademark in Canada.

[9] The Applicant served and filed a counterstatement on December 15, 2021, indicating that it intends to respond to the opposition.

[10] In support of its opposition, the Opponent served and filed the following evidence:

- the affidavit of Craig Westemeier, the Senior Associate Athletic Director, Trademark Licensing, at The University of Texas at Austin (UT Austin), dated April 18, 2022; and
- a certified copy of the Official Mark.

[11] Mr. Westemeier's affidavit describes the Opponent as the governing body of the University of Texas system (the UT System), a public entity consisting of several universities, including its "flagship", UT Austin [paras 3-11]. The affidavit describes the Opponent's use of the Official Mark in association with UT Austin's sports teams [paras 12-15], athletic apparel and equipment, college web sites, sports games and facilities, official college merchandise, and on signage and menus at food markets and dining facilities [paras 17-39]. Mr. Westemeier's affidavit also describes the Opponent's advertising and promotion using the Official Mark on web sites, social media, prospective student information packages, and in mainstream media such as Sports

Illustrated magazine [paras 40-46]. At the hearing of this matter, the Opponent's agent confirmed that the Official Mark is used primarily in association with UT Austin, rather than the UT System as a whole.

[12] Mr. Westemeier also addresses the extent to which Canadians are exposed to the Opponent's use of the Official Mark, in the following ways:

- the attendance of Canadians at the Opponent's colleges and universities;
- alumni association branches located in Canada;
- the recruitment of Canadians for graduate studies programs;
- collaboration of the Opponent's universities with Canadian universities;
- the broadcast in Canada of sports games featuring the opponent's college sports teams; and
- the sale of branded merchandise in Canada [paras 47-61].

[13] The Applicant did not cross-examine Mr. Westemeier on his affidavit, and did not submit evidence in support of the application.

[14] Only the Opponent submitted written representations. A hearing was held on June 14, 2023, at which only the Opponent was present.

GROUND OF OPPOSITION, EVIDENTIAL BURDEN, AND LEGAL ONUS

[15] The Opponent relies on the following grounds of opposition:

- Non-registrability Ground - Pursuant to section 38(2)(b) of the Act, the Applied-for Mark is not registrable in view of section 12(1)(e) of the Act, because adoption of the Applied-for Mark is prohibited by section 9(1)(n)(ii) of the Act. Specifically, the Applied-for Mark consists of, or so nearly resembles as to be likely to be mistaken for, the Official Mark;

- Non-entitlement To Use Ground - Pursuant to section 38(2)(f) of the Act, as of the filing date of the application, the Applicant was not entitled to use the Applied-for Mark in Canada, because adoption of the Applied-for Mark was prohibited by section 9(1)(n)(ii) of the Act;
- Non-entitlement To Registration Ground - Pursuant to section 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the Applied-for Mark in view of section 16(1)(a) of the Act because, as of the filing date of the application, the Applied-for Mark was confusing with the Official Mark, which the Opponent had previously used and made known in Canada in association with the Opponent's "university goods and services", and the Official Mark had not been abandoned at any time; and
- Non-distinctiveness Ground - Pursuant to section 38(2)(d) of the Act, as of the date of filing of the statement of opposition, the Applied-for Mark was not distinctive within the meaning of section 2 of the Act, because the Applied-for Mark does not actually distinguish, nor is it adapted to distinguish, the Services from the goods and services of the Opponent associated with the Official Mark, which has become known in Canada to such an extent as to negate the potential for the Applied-for Mark to be distinctive of the Applied-for Services.

[16] For each of the Opponent's grounds of opposition, there is an initial evidential burden on the Opponent to adduce evidence from which it could reasonably be concluded that the facts alleged to support that ground of opposition are true. If this initial burden is met, then the Applicant bears the legal onus of satisfying the Registrar that, on a balance of probabilities, the ground of opposition should not prevent registration of the Mark [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

NON-REGISTRABILITY GROUND

[17] In respect of this ground, the Opponent can meet its initial burden by putting into evidence a copy of its Official Mark, which the Opponent has done [see e.g., *Boy Scouts of Canada v Aleksiuik*, 2006 CanLII 80339 (TMOB)].

[18] The Opponent having met its initial burden, the Applicant now bears the legal onus of demonstrating, on a balance of probabilities, that this ground of opposition should not prevent the registration of the Applied-for Mark. In this case, the onus is to show that section 9(1)(n)(ii) of the Act, in view of the Official Mark, does not prohibit the adoption of the Applied-for Mark. Although the Applicant has not submitted evidence or representations, I am nonetheless satisfied that adoption of the Applied-for Mark is not prohibited.

[19] Section 9(1) of the Act prohibits the adoption of any mark that either (a) consists of, or (b) so nearly resembles as to be likely to be mistaken for, a lengthy list of official marks. The official marks of a university, such as the Opponent's Official Mark, are included on this list [see section 9(1)(n)(ii) of the Act]. Therefore, section 9(1)(n)(ii) prohibits the adoption of two types of marks; those that consist of a university's official mark, and those that so nearly resemble as to likely be mistaken for the official mark.

[20] In respect of the first type of prohibited mark, an applied-for mark "consists of" an official mark when it is the same as, or identical to a university's official mark. Since the Applied-for Mark in this case is clearly not the same as, or identical to, the Official Mark, adoption of the Applied-for Mark is not prohibited under the first prong of section 9(1)(n)(ii). While the Opponent argues that the Applied-for Mark consists of the Official Mark because it includes the Official Mark in its entirety [Opponent's written representations, para 25(a)], the law is clear that trademarks which include an official mark alongside other elements do not "consist of" that official mark, for the purposes of section 9 of the Act [*Canadian Council of Professional Engineers v APA – The Engineered Wood Assn* (2000), 7 CPR (4th) 239 at paras 66, 69 (FCTD) (CCPE)].

[21] As for the second type of prohibited mark, the question is whether the Applied-for Mark is similar to the Official Mark such that it is likely to be mistaken for the Official

Mark [see *CCPE* at para 71]. In other words, the test is whether a person, on first impression, knowing the Official Mark and having an imperfect recollection of it, would likely mistake the Applied-for Mark for the Official Mark [see *Techniquip Ltd v Canadian Olympic Assn* (1998), 80 CPR (3d) 225 at para 16 (FCTD); see also *Chartered Professional Accountants of Ontario v American Institute of Certified Public Accountants*, 2021 FC 35 at para 31.]. Importantly, “mistaken for” is not synonymous with “confusing”, as that term is defined in section 6 of the Act [*CCPE* at para 71].

[22] The Opponent asserts that the Applied-for Mark so nearly resembles the Official Mark that the former is likely to be mistaken for the latter. The Opponent asserts that the Applied-for Mark incorporates the Official Mark in its entirety, with only minor modification by horizontal stretching. It also asserts that the modified Official Mark is the most striking element of the Applied-for Mark, and that the other elements of the Applied-for Mark have minimal visual impact [Opponent’s written representations, at para 25(b)]. In the Opponent’s submission, it would defeat the underlying legislative purpose of section 9 of the Act if such superficial changes and additional elements were sufficient to circumvent an official mark and obtain a registration [para 28].

[23] I disagree with Opponent’s assessment of the Applied-for Mark. In my view, the word element KASAP in the Applied-for Mark is at least as striking as the cow’s head element, if not more so. It is the most prominent word element of the Applied-for Mark by far, and it is presented in a unique, distinctive font, with distinctive colours (namely, the first and last letters being presented in a different colour from the rest of the letters). As well, the word itself is unique and distinctive, there being no evidence that this word has any meaning in either English or French.

[24] When the Applied-for Mark is viewed on first impression, from the perspective of a person having an imperfect recollection of the Official Mark, I find that the two marks are not so similar that the Applied-for Mark would be mistaken for the Official Mark. Such a person viewing the Applied-for Mark would be struck by the word KASAP as least as much as the cow’s head element. There is nothing even remotely similar to or suggestive of this word in the Official Mark. Accordingly, due at least to the presence of

the word KASAP in the Applied for Mark, I find that a person is not likely to mistake this trademark for the Official Mark.

[25] The Opponent argues that trademark users should not be permitted to appropriate official marks in their entirety by adding visual elements to the official mark. However, it must be borne in mind that marks which incorporate an official mark in their entirety, alongside other elements, do not “consist of” that official mark, for the purposes of section 9 of the Act [CCPE at para 71]. Therefore, incorporating an official mark in its entirety into a trademark is not prohibited by section 9, unless the trademark so nearly resembles the official mark that it is likely to be mistaken therefor. In this case, I have found that the Applied-for Mark contains additional elements that are both striking and entirely different from anything found in the Official Mark. It is unlikely that a person will mistake the Applied-for Mark from the Official Mark. Given the substantial differences between the Official Mark and the Applied-for Mark, to find otherwise would effectively mean that any mark containing an image of a longhorn cow’s head is prohibited by section 9 of the Act, in view of the Official Mark. Such a finding would extend an “absurdly great ambit of protection” to the Official Mark, of the sort referred to by the Federal Court in CCPE [at para 70].

[26] Since the Applied-for Mark does not consist of the Official Mark, and is not so similar to the Official Mark that it is likely to be mistaken therefor, the adoption of the Applied-for Mark is not prohibited by section 9(1)(n)(ii) of the Act, in view of the Official Mark. This ground of opposition therefore fails.

NON-ENTITLEMENT TO USE GROUND

[27] In respect of this ground the Opponent alleges that, as of the filing date of the application, the Applicant was not entitled to use the Mark in Canada because adoption of the Mark by anyone was prohibited by section 9(1)(n)(ii) of the Act, in view of the Opponent’s Official Mark. However, since I have already found that adoption of the Mark was not so prohibited, the Opponent has not met its initial burden in respect of this ground. Accordingly, this ground of opposition fails.

NON-ENTITLEMENT TO REGISTRATION GROUND

[28] To meet its initial evidential burden in respect of this ground, the Opponent must demonstrate that the Official Mark was used as a trademark in Canada prior to the earlier of: (a) the date of the Applicant's first use of the Applied-for Mark in Canada; and (b) the filing date of the application. Since there is no evidence that the Applicant has ever used the Applied-for Mark in Canada, the relevant date is the filing date of the application (July 20, 2017). The Opponent must also show that use of the Official Mark as a trademark had not been abandoned as of the date of advertisement for opposition purposes (April 28, 2021).

[29] The prior use that must be demonstrated is that which is defined in section 4 of the Act. In the case of goods, "use" as a trademark occurs if, at the time of the transfer of property in or possession of the goods, in the normal course of trade, the trademark is marked on the goods themselves or on the packages in which they are distributed, or is in any other manner associated with the goods such that notice of the association is given. In the case of services, "use" as a trademark occurs if the mark is used or displayed in the performance or advertising of those services.

[30] When considering whether the Official Mark has been used as a trademark in Canada, it is important to consider the specific goods and services in association with which the Official Mark has been used (if any). It is these goods and services that will be compared with the services stated in the application, for the purposes of assessing trademark confusion [see *Hayabusa Fightwear Inc v Suzuki Motor Corporation*, 2014 FC 784 at paras 46-47].

[31] The Opponent asserts that the Official Mark has been used in Canada as a trademark, prior to the filing date of the application, in association with the following goods and services:

- providing student admissions packages and student communications, which bore the Official Mark and were provided to Canadian students attending the

Opponent's university, and to prospective students [written representations, para 76(a); Westemeier Affidavit, paras 42, 44, 49-51, and Exhibits 11-B, 12];

- merchandise such as hats, clothing and bags, as well as food-related merchandise such as cooking accessories, beverage-ware, bowls, coolers and aprons, all of which were marked with the Official Mark, and were sold and shipped to Canada [written representations, para 76(c); Westemeier Affidavit, paras 26, 27, 29, 59, and Exhibit 17];
- dining services offered at the UT Club, a private member club located inside the football stadium at UT Austin. Menus for the UT Club dining service, featuring the Official Mark, have been available online prior to the filing date of the application. The UT Club web site also allows users to set up a tour, and memberships for non-residents of Austin, Texas are available. Furthermore, the UT Club is advertised via various social media platforms [written representations, paras 76(c) and (d); Westemeier Affidavit, paras 32, 33, 37, 38 and 41, and Exhibits 8, 10-A and 10-B].

[32] I find that the evidence demonstrates use of the Official Mark, as a trademark in Canada, in association with the provision of information about attending the Opponent's universities. The student admissions packages provided to prospective Canadian students of the Opponent's universities include promotional materials that feature the Official Mark, constituting display of the Official Mark during the performance of the aforementioned service [Westemeier Affidavit, para 44 and Exhibit 11-B]. These student admissions packages were provided to Canadian students prior to the July 20, 2017 filing date of the application [Westemeier Affidavit, para 51].

[33] I also find that the evidence demonstrates use of the Official Mark, as a trademark in Canada, in association with some, but not all, of the Opponent's merchandise. Exhibit 17 of the Westemeier Affidavit lists numerous items of merchandise branded with the Official Mark that were purchased via the Opponent's web site, and billed and/or shipped to Canadian addresses. However, only the first ten items listed in Exhibit 17 were ordered prior to the application filing date (July 20, 2017).

These items consist of various types of clothing, hats, and bags (such as backpacks and gym bags). There is no evidence that any of the Opponent's food-related merchandise was sold or billed to Canadian addresses prior to July 20, 2017. Accordingly, the Opponent has met its initial evidential burden in respect of clothing, hats, and bags, but not food-related merchandise.

[34] I am not satisfied that the Opponent has offered restaurant or dining services in Canada, in association with the Official Mark. The use of a trademark in advertising for services only constitutes use of the trademark in Canada if the advertised services are performed (or available to be performed) in Canada [see e.g. *Supershuttle International, Inc v Fetherstonhaugh & Co*, 2015 FC 1259 at para 40]. Advertisement of services in Canada in connection with a trademark, without physical performance of the services in Canada, does not constitute use of the trademark in Canada [*Porter v Don the Beachcomber*, 1966 CanLII 972 (Ex Ct)]. The Westemeier Affidavit is clear that the dining services provided by the UT Club are provided at the stadium at UT Austin, and not in Canada [para 32]. Accordingly, any use of the Official Mark in advertisements of the dining services at the UT Club cannot constitute use of the Official Mark as a trademark in Canada.

[35] The Opponent asserts that the online availability of menus, the availability of memberships for non-residents, and the ability to set up a tour are services that are ancillary to the Opponent's dining services, and that persons in Canada receive a benefit from these services [written representations, para 76(b)]. Citing *TSA Stores, Inc v Registrar of Trade-marks* (2011 FC 273 at paras 15-21), the Opponent argues that such ancillary activities constitute performance of the service so long as some members of the public, consumers or purchasers receive a benefit.

[36] While the Opponent is correct in general regarding ancillary services benefitting the consuming public, I find that the specific facts of this case are distinguishable from those in *TSA Stores*. In *TSA Stores*, the ancillary services in question included a web site that provided a significant amount of information and guidance, which allowed Canadian visitors to the web site to select products that best suited their needs [*TSA*

Stores at paras 19-20]. The Opponent's UT Club web site does not provide such voluminous information or guidance. Rather, the UT Club web site provides the menu of the Opponent's dining services. I find that these facts are more analogous to those in *Pain & Ceballos LLP v Crab Addison Inc* (2017 TMOB 158), where the online availability of menus and other information regarding restaurants in the United States was found to constitute advertising of the restaurants' services, rather than the performance of an ancillary service [see *Crab Addison* at para 40]. I agree with the reasoning presented in *Crab Addison*, and find that the Opponent's menu provided online does not constitute the provision of a service ancillary to restaurant or dining services in Canada.

[37] As for the ability to set up a tour of the club, and the availability of memberships for non-residents, I find the facts of this case analogous to those of *Henri Simon (Simon & Associés) v RIU Hotels, SA* (2021 TMOB 83), where it was held that the ability to make a reservation for a restaurant abroad does not confer a tangible or meaningful benefit until the consumer leaves Canada to attend the restaurant [see *RIU Hotels* at para 41]. In this case, there is no tangible or meaningful benefit received by customers of the UT Club until they actually attend at the Club's premises to obtain a tour, or dining services.

[38] In view of all the foregoing, and in view of the absence of any evidence of abandonment of the Official Mark, I find that the Opponent has met its initial evidential burden in respect of the following goods and services (the Opponent's Canadian Goods and Services):

- clothing, hats, and bags; and
- providing information on attending the Opponent's universities.

Confusion as of Application Filing Date

[39] The Opponent having met its initial evidential burden in respect of the Opponent's Canadian Goods and Services, the Applicant bears the legal onus of demonstrating that the Applied-for Mark is not confusing with the Official Mark, used as a trademark in association with these goods and services.

[40] The use of a trademark will cause 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 emanate from the same source [see section 6(2) of the Act]. The test for confusion is a matter of first impression in the mind of a casual consumer somewhat in a hurry, who sees the applicant's trademark at a time when they have no more than an imperfect recollection of the opponent's trademark. This casual, hurried consumer does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the trademarks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[41] Applying the test for confusion is an exercise in finding facts and drawing inferences [*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 102]. All surrounding circumstances of the case must be considered, including those listed at section 6(5) of the Act, namely:

- 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, services or business;
- the nature of the trade; and
- the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them.

[42] This list is not exhaustive; all relevant factors are to be considered, although they are not necessarily attributed equal weight [see *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54; *Veuve Clicquot, supra* at para 21].

Inherent Distinctiveness, and Extent Known

[43] The inherent distinctiveness of a trademark refers to its originality. Trademarks consisting of or including words or designs that are descriptive of the goods or services to be sold have a low degree of inherent distinctiveness, and attract a more limited range of protection relative to an invented, unique, or non-descriptive word, or an original design [see *General Motors Corp v Bellows*, 1949 CanLII 47 (SCC), [1949] SCR 678; see also *Fairmount Properties Ltd v Fairmount Management LLP*, 2008 FC 876]. The distinctiveness of a trademark increases when the trademark becomes known to the consuming public, for example, through use or promotion of the trademark in the marketplace [see, e.g., *Mondo Foods Co Ltd v TorreMondo Industries Inc*, 2022 FC 926, at para 24].

[44] The Official Mark consists of an image of a longhorn cow's head. It is not particularly unique or original. At the same time, it is not descriptive of the Opponent's Canadian Goods and Services, or any aspect of them. Accordingly, the Official Mark has a fair degree of inherent distinctiveness, when used in association with the Opponent's Canadian Goods and Services.

[45] As for the extent to which the Official Mark had become known in Canada, the Opponent submits that the Official Mark has acquired significant distinctiveness in Canada, on account of the strong reputation in Canada of the UT System, UT Austin and its sports teams, as well as extensive sales and advertising of merchandise [written representations, paras 42, 54, 77]. However, the evidence as of the relevant date for this ground does not support the Opponent's contention. Specifically, the evidence shows the following:

- between 2011 and 2021, over 110 students from Canada were enrolled at UT Austin each year, and the prospective student and admissions packages they received featured the Official Mark since at least 2013 [Westemeier Affidavit, paras 44, 51, and Exhibit 11-B]. However, the evidence does not distinguish between new students and returning students, and therefore does not provide the total number of individual Canadian students who attended UT Austin as of the

relevant date. The evidence also does not provide a total number of prospective student and admissions packages distributed to Canadian residents as of the relevant date;

- the UT System has exchange student and research agreements with Canadian institutions, namely McGill University, Concordia University, and the University of Toronto [Westemeier Affidavit, para 52, 55, and Exhibit 14]. However, the number of Canadian students participating in its exchange programs as of the relevant date is not provided. As well, the Opponent does not appear to use the Official Mark in association with its exchange student and research programs with Canadian institutions, since the Official Mark does not appear anywhere on the web site promoting these programs [see Westemeier Affidavit, Exhibit 14];
- over 550 UT Austin alumni are in Canada, and the UT System alumni organization has 3 chapters in Canada [Westemeier Affidavit, paras 48, 53, 54, and Exhibit 13]. However, the Official Mark does not appear to be used by the UT System alumni organization, as it does not appear on its web site [see Westemeier Affidavit, Exhibit 13];
- NCAA football games featuring UT Austin's team and the Official Mark have been broadcast in Canada since at least 2015. Specifically, the evidence shows that at least three such games have appeared on TSN [Westemeier Affidavit, Exhibit 16]. The evidence contains no other indication of the extent to which games featuring UT Austin's team appeared on Canadian television;
- UT Austin's teams have also been featured in articles appearing in the *Toronto Star* and on the web sites *tsn.ca* and *sportsnet.ca* [Westemeier Affidavit, para 56-57, Exhibits 15A and 15B]. The Official Mark does not appear in any of these articles;
- UT Austin merchandise featuring the Official Mark is advertised and sold to people in Canada, with over 1500 purchases totalling over USD\$186,000 billed to addresses in Canada since 2017 [Westemeier Affidavit, para 58-60, Exhibit 17].

However, only ten orders of the Opponent's clothing, hats and bags bearing the Official Mark were sold and shipped to Canadian addresses as of the relevant date;

- the Opponent has a multi-million dollar partnership with Nike for over 20 years, to produce branded merchandise bearing the Official Mark [Westemeier Affidavit, para 28]. As well, millions of dollars are spent each year advertising and promoting the goods and services of the UT System, including those featuring the Official Mark [Westemeier Affidavit, para 45]. However, the evidence does not disclose the extent to which Canadian consumers had been impacted by the partnership with Nike as of the relevant date (aside from the ten sales of merchandise as of that date), or the extent of advertising that is circulated in Canada (if any).

[46] Based on the foregoing, I find that the Official Mark had become known in Canada only to a very limited degree, as of the relevant date (July 20, 2017). I accept that the Official Mark would have been seen on television to at least some degree during the three broadcasts of games that occurred in Canada prior to the relevant date. Furthermore, the Official Mark would have become known to a few hundred Canadian students who attended UT Austin, and to the ten individuals who ordered merchandise prior to the relevant date. I find this amount of use of the Official Mark to be quite minimal.

[47] Turning to the Applied-for Mark, I find that it is somewhat more inherently distinctive than the Official Mark. The word element KASAP is original and unique, and there is no evidence that this word has any meaning in English or French, either descriptive of the Applied-for Services or otherwise. The Applied-for Mark also contains the words "Turkish Steakhouse" in both English and Arabic, which is fairly descriptive of the Applied-for Services. As a whole, since the original and unique element KASAP is a fairly striking component of the Applied-for Mark, and is more prominent than the descriptive components of the Applied-for Mark, I find that the Applied-for Mark has a fair degree of inherent distinctiveness, somewhat more so than the Official Mark.

[48] As for the extent to which the Applied-for Mark is known in Canada, there is no evidence to suggest that the Applied-for Mark has become known to any extent in Canada, either through use or promotion in Canada or otherwise.

[49] Considering all of the foregoing, I find that the inherent distinctiveness of the marks, and the extent to which they have become known, favours neither party. While the Applied-for Mark is more inherently distinctive than the Official Mark, the Official Mark had become known in Canada to a very limited degree as of the relevant date for this ground of opposition. Ultimately, this factor does not favour either party to any appreciable extent.

Length of Time in Use

[50] There is no evidence that the Applied-for Mark has ever been used in Canada. The evidence does demonstrate use of the Official Mark as a trademark in Canada, in association with the Opponent's Canadian Goods and Services. However, as of the relevant date for this ground of opposition, such use was minimal. Accordingly, this factor favours the Opponent, but only slightly.

Nature of the Goods and Services, and Nature of the Trade

[51] As stated above, it is the Opponent's Canadian Goods and Services, in connection with which the Official Mark had been used in Canada as of the relevant date, that must be compared with the Applied-for Services.

[52] When one compares the relevant goods and services, it is apparent that there is little relationship between them. The nature of the goods and services themselves are entirely dissimilar, as are the channels of trade in which they move (online retail for the Opponent's Canadian Goods, mail or courier for the Opponent's Canadian services, and restaurants or banquet halls for the Applied-for Services). Indeed, the only apparent relationship between the parties' goods and services is that restaurants are frequently located at or near universities, which are the subject of the information provided by the Opponent's Canadian Services, and are featured on the Opponent's Canadian Goods. In my view, this connection is too tenuous to support a conclusion that consumers will

infer a common source of these goods and services. Accordingly, these factors favour the Applicant.

Degree of Resemblance

[53] When considering the degree of resemblance, the trademarks must be considered in their entirety as a matter of first impression. They must not be carefully analyzed and dissected into their component parts [*Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD)]. That being said, the preferable approach is to consider whether there is an aspect of each trademark that is particularly striking or unique [*Masterpiece* at para 64].

[54] Considering the Applied-for Mark as a whole, as a matter of first impression, I find that the word KASAP, presented in a unique and original font, is particularly striking. It is the largest word element in the Applied-for Mark by a large margin, and is similar in size to the longhorn cow's head element. The word KASAP is also more original and unique than the longhorn cow's head element, which is a fairly generic representation of a longhorn cow's head. Furthermore, the word KASAP has no descriptive or suggestive meaning in relation to the Applied-for Services, whereas the design element of the longhorn cow's head is suggestive of café or catering services featuring beef.

[55] When comparing both parties' marks, it is obvious that there is some degree of similarity between them. Both marks contain representations of a longhorn cow's head that are nearly identical in appearance and suggest the same idea.

[56] However, when considering both trademarks as a whole, as a matter of first impression, and bearing in mind the particularly striking nature of the word KASAP in the Applied-for Mark, I find that the marks at issue are more different than they are similar. Put simply, the Official Mark does not contain anything remotely resembling the unique, original word KASAP, or whatever idea it may suggest to consumers. The Applied-for Mark is also entirely dissimilar in sound, due to the word KASAP. Given the prominent, striking nature this word, and its complete absence from the Official Mark, I find that the marks are more different than they are similar, and that this factor favours the Applicant.

Other Surrounding Circumstance – Alleged Fame of the Opponent’s Mark

[57] The Opponent asserts that the UT System and UT Austin are famous in Canada, that this fame extends to the Official Mark, and that such fame entitles the Official Mark to a much wider ambit of protection [Opponent’s written representations, paras 68-70]. In support of this assertion, the Opponent relies on much the same evidence as was discussed above, namely: (i) Opponent’s merchandise sales, partnership with Nike, and advertising; (ii) the numbers of Canadians attending the Opponent’s universities; and (iii) media coverage of the Opponent’s sports teams in Canada.

[58] As stated above the evidence shows that, as of the relevant date for this ground of opposition, the Opponent had sold only ten orders of branded merchandise to Canadian residents, and had provided student admission packages to a few hundred Canadian students who had attended UT Austin. Furthermore, the evidence shows that, as of the relevant date for this ground of opposition, three of the Opponent’s sports teams’ games had been broadcast on TSN over a two-year period [see Westemeier Affidavit, Exhibit 16], and articles featuring the Opponent’s sports teams had appeared in the *Toronto Star*, on *tsn.ca* and on *sportsnet.ca* (although none of these articles appear to have included the Official Mark) [see Westemeier Affidavit, Exhibits 15A and 15B]. I am prepared to accept that TSN and its web site, the *Toronto Star*, and the Sportsnet web site are, in general, widely viewed and read in Canada. I accept that the appearances of UT Austin’s teams on Canadian television, along with the Official Mark, have likely caused the Official Mark to become known to some extent in Canada. However, no other evidence has been provided to establish the extent of the Canadian public’s exposure to the Official Mark through media coverage or advertising. I am not prepared to accept that UT Austin’s teams and the Official Mark are *famous* in Canada, such that the Official Mark would be entitled to a much wider ambit of protection, simply because the Official Mark has been on Canadian television a few times.

[59] Accordingly, the alleged fame of the Official Mark has not been established, and does not assist the Opponent.

Conclusion Regarding Confusion

[60] Having considered all of the foregoing, I find on a balance of probabilities that, as of the filing date of the application (July 20, 2017), the Applied-for Mark was not confusing with the Official Mark used as a trademark in association with the Opponent's Canadian Goods and Services. In my view, it is less likely than not that consumers seeing the Applied-for Mark used in association with the Applied-for Services would infer that such services emanate from or are associated with the source of the Opponent's Canadian Goods and Services. I make this finding primarily because the Applied-for Mark was, as of the filing date: (a) more different than it was similar to the Official Mark; and (b) used in association with entirely dissimilar services.

[61] In view of the foregoing, the Non-entitlement To Registration Ground fails.

NON-DISTINCTIVENESS GROUND

[62] To meet its initial evidential burden under this ground, the Opponent must show that, as of the date of filing of the statement of opposition (October 26, 2021), the Official Mark was known in Canada to some extent at least to negate the distinctiveness of the Applied-for Mark [*Bojangles' International, LLC v Bojangles Café Ltd*, (2006), 48 CPR (4th) 427 at para 33].

[63] To meet its initial burden, the Opponent relies again on its evidence of the extent to which the Official Mark has become known in Canada, or is famous in Canada [written representations, para 42]. The Opponent also asserts that, as of the relevant date for this ground of opposition (October 26, 2021), the Official Mark's reputation negated the distinctiveness of the Applied-for Mark because there was a likelihood of confusion between the Official Mark and the Applied-for Mark [para 43].

[64] I have already found that the Applied-for Mark was not confusing with the Official Mark as of the filing date of the application (July 20, 2017, the "Earlier Relevant Date"). For the reasons that follow, I make the same finding as of the date of filing of the statement of opposition (October 26, 2021, the "Later Relevant Date"). Accordingly, even if the Opponent has demonstrated a sufficient reputation to meet its initial burden,

I find that the Official Mark did not in fact negate the distinctiveness of the Applied-for Mark as of the Later Relevant Date, and that the Non-distinctiveness Ground fails.

Confusion as of the Relevant Date of Non-Distinctiveness Ground

[65] As of the Later Relevant Date, the evidentiary landscape is somewhat different from what it was as of the Earlier Relevant Date:

- as of the Later Relevant Date, a few hundred more Canadian students would have attended UT Austin and would have been exposed to the Official Mark. [Westemeier Affidavit, paras [Westemeier Affidavit, paras 44, 51, and Exhibit 11B]. As was the case in respect of the Earlier Relevant Date, the evidence does not disclose how many more unique students have attended, or the total number of prospective student and student admission packages that were sent to Canadian addresses;
- many more sales of merchandise to Canadian addresses had occurred as of the Later Relevant Date. The majority (though not all) of the 1500 sales to Canadian addresses listed in Exhibit 17 of the Westemeier Affidavit occur prior to the Later Relevant Date. However, the vast majority of these sales are of clothing, hats and bags. A close inspection of Exhibit 17 reveals fewer than twelve sales of the “food-related” merchandise referred to in the Westemeier Affidavit, as of the Later Relevant Date.

[66] The change in evidence as of the Later Relevant Date is sufficient to change the extent to which the Official Mark has become known in Canada. The substantial increase in merchandise sales, along with a few hundred additional Canadian students attending UT Austin, supports the inference that the Official Mark had become better known in Canada as of the Later Relevant Date, relative to the Earlier Relevant Date. This factor therefore favours the Opponent to a greater degree than it did in respect of the Non-entitlement to Registration Ground. However, it important to note the absence of any evidence that the increased renown of the Official Mark extends to restaurant or catering services, or food-related goods in any way. As of the later Relevant Date, the

Official Mark had not been used in Canada at all in association with food-related services, and only to a minimal degree in association with food-related merchandise.

[67] Aside from the foregoing, the change in evidence as of the Later Relevant Date does not affect my prior findings in respect of confusion. The degree of resemblance between the marks (which has been held to be the factor having the greatest effect on the confusion analysis [see *Masterpiece* at para 49]) still favours the Applicant, for the same reasons as those stated in respect of the Earlier Relevant Date. As well, the inherent distinctiveness of the marks also favours the Applicant, again for the same reasons as stated in respect of the Earlier Relevant Date.

[68] The nature of the services and the channels of trade in which they move also still favour the Applicant. The Opponent asserts that it offers services similar to the Applied-for Services through its UT Club restaurant and concession stands located at UT Austin's sports stadium [written representations, para 63, 64]. However, as stated above, these services are not offered in Canada, and the extent to which they have been advertised in Canada is not in evidence. The Opponent also asserts that its merchandise includes food-related products such as cooking accessories and apparel, bowls, coolers and food bags, and that such goods are closely related to the Applied-for Goods [written representations, para 65]. However, the sales of such goods in Canada as of the Later Relevant Date (fewer than twelve) are insufficient to demonstrate that the Official Mark is known for such goods in Canada to any appreciable extent.

[69] Ultimately, as was the case as of the Earlier Relevant Date, at the Later Relevant Date the Applied-for Mark was still more different from the Official Mark than it was similar, and was to be used in association with services that are entirely different from the goods and services for which the Official Mark was known. Despite the fact that the Official Mark was known in Canada to a greater extent as of the Later Relevant Date, I find this insufficient to change my finding that the Applied-for Mark is not confusing with the Official Mark.

DISPOSITION

[70] 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.

Jaimie Bordman
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-06-14

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