



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 53
Date of Decision: 2015-03-25

**IN THE MATTER OF AN OPPOSITION
by Liverton Hotels International Inc. to
application No. 1,505,429 for the trade-
marks DIVA DELIGHTS & Design in the
name of Diva Delights Inc.**

Introduction

[1] Diva Delights Inc. (the Applicant) has applied to register the trade-mark DIVA DELIGHTS & Design (the Mark), shown below, based upon use since at least as early as May, 2005, in association with various baked goods, sweet and savoury snack goods and the operation of a bakery shop.



[2] Liverton Hotels International Inc. (the Opponent) has opposed the application primarily on the basis that there is a reasonable likelihood of confusion between this trade-mark and the Opponent's previous use and making known of its registered marks DIVA, registration No. TMA480,444 and DIVA AT THE MET, registration No. TMA480,443 in association with

restaurant services. The Opponent also alleges technical grounds of opposition based on non-compliance of the application under section 30 of the Act.

[3] For the reasons that follow, I refuse the application.

The Record

[4] The Applicant filed application No. 1,505,429 for the Mark on November 25, 2010. The Mark is applied for in association with the following goods and services:

Baked products, namely, cookies, crackers, squares, cakes, loaves, cheese straws, cupcakes, muffins and pies; sweet and savoury snack foods, namely, flour-based snacks.

The operation of a bakery shop.

[5] The application for the Mark was advertised on September 7, 2011, and the Opponent filed a statement of opposition on January 18, 2012, based on the following grounds of opposition set out under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act): non-compliance with section 30(i), non-registrability under section 12(1)(d), non-entitlement under sections 16(1)(a) and 16(1)(b) of the Act, and non-distinctiveness under section 38(2)(d) and section 2. As noted above, the determinative issue in this proceeding is the likelihood of confusion between the Mark and the Opponent's marks DIVA, registration No. TMA480,440 and DIVA AT THE MET, registration No. TMA480,443, both previously used and registered in association with restaurant services. The Applicant filed a counter statement on July 18, 2013, denying each of the grounds of opposition.

[6] In support of its opposition, the Opponent filed the affidavits of Henry Wu, President of the Opponent, and Dori Walton, clerk employed with the Opponent's agent. Neither of the Opponent's affiants was cross-examined. The Opponent also filed certified copies of its trade-mark registrations.

[7] As its evidence, the Applicant filed the affidavit of Angela Husmann, President of the Applicant. Ms. Husmann was not cross-examined.

[8] On September 26, 2013, the Opponent was granted leave to file an amended statement of opposition pursuant to section 40 of the *Trade-mark Regulations*, SOR/96-195 (the Regulations).

The statement of opposition as amended includes a ground of non-compliance with section 30(b) of the Act.

[9] Both parties filed a written argument.

[10] Both parties were represented at a hearing wherein the Opponent's opposition to the Applicant's application No. 1,572,061 for the trade-mark DIVA DELIGHTS was heard at the same time. A separate decision will issue for that file.

Onus and Material Dates

[11] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298; and *Dion Neckwear Ltd v Christian Dior, SA* (2002), 20 CPR (4th) 155 (FCA)].

[12] The material dates that apply to the grounds of opposition are as follows:

- Section 38(2)(a)/Section 30 - the filing date of the application [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/Section 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- Section 38(2)(c)/Section 16(1)(a) and (b) – the Applicant's date of first use;
- Section 38(2)(d)/non-distinctiveness - the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Grounds of Opposition Summarily Dismissed

Non-compliance – Section 30(i)

[13] The Opponent pleads that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada because the Applicant should have been aware of the Opponent's trade-marks previously used in Canada in association with restaurant services.

[14] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the mark [see *Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)].

[15] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. This ground is accordingly dismissed.

Non-entitlement – Section 16(1)(b)

[16] Section 16(1)(b) requires the Opponent to have filed a trade-mark application in Canada prior to the Applicant's claimed date of first use of May, 2005. Although the Opponent relies on its DIVA and DIVA AT THE MET registrations, which issued from applications both filed on August 20, 1996, section 16(4) requires that an application relied upon pursuant to section 16 be pending at the date of advertisement of the applicant's application (i.e. September 7, 2011) [see *Governor and Co of Adventurers of England trading into Hudson's Bay v Kmart Canada Ltd* (1997), 76 CPR (3d) 526 (TMOB) at p 528]. Given that the Opponent's applications both issued to registration on August 14, 1997, they were not pending as of September 7, 2011 and therefore cannot support a section 16(1)(b) ground of opposition. Accordingly, this ground of opposition is also dismissed.

Remaining Grounds of Opposition

Non-compliance – Section 30(b)

[17] The Opponent pleads that the Applicant has not used the Mark in association with the services “the operation of a bakery shop” since at least as early as May 2005 given that the Applicant abandoned the trade-mark in association with these services in 1999.

[18] The initial burden on the opponent is light respecting the issue of non-conformance with section 30(b) of the Act, because the facts regarding the applicant’s first use are particularly within the knowledge of the applicant [*Tune Masters v Mr P’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89]. Section 30(b) of the Act requires that there be continuous use of the applied for trade-mark in the normal course of trade from the date claimed to the date of filing the application [*Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD) at 262]. The opponent may meet its burden under section 30(b) either by relying on its own evidence or it may rely on the applicant’s evidence.

[19] The affidavit of Angela Husmann confirms that any reference to a bakery being in operation since May 2005 is in error. In this regard, Ms. Husmann states the following at paragraph 6 of her affidavit:

“In or about February 1997, I operated a small bakery that was accessible to the general public. The bakery was open until early 1999. The bakery comprised of only 1% of my overall sales. The majority of my business continued to be wholesale contracts. Diva Delights has not operated a bakery since 1999. To the extent the Application indicates that a bakery has been in operation since May 2005, it is in error and should state manufacturer and distributor of baked products, as noted in the following paragraph.”

[20] The Opponent’s submission, as I understand it, is that there is an obligation on the Applicant to ensure that all of its claims are correct when it files its application. In view that the Applicant’s own evidence in the present case is that the Applicant has not used the Mark in association with the Applicant’s services since the date claimed, it is the Opponent’s submission that the application must be dismissed in its entirety.

[21] I am satisfied that the Opponent has met its burden with respect to the services “operation of a bakery shop”. As Ms. Husmann concedes that the Applicant has not operated a bakery since 1999, this ground succeeds with respect to these services.

[22] I am not satisfied, however, that the Opponent has met its burden with respect to the remaining goods. In this regard, I disagree with the Opponent that an application must be dismissed in its entirety because one of the Applicant’s claims is incorrect. Further, I note that the Opponent’s section 30(b) pleading is restricted to the services “operation of a bakery”.

[23] In view of the above, the section 30(b) ground succeeds with respect to the Applicant’s services only, which shall be deleted from the application [see *Service Experts Inc v Pope and Sons Refrigeration Ltd* (2011), 93 CPR (4th) 313 (TMOB)].

Main Issue

[24] As noted above, each of the remaining grounds of opposition is based on the allegation that there is a likelihood of confusion between the Mark and the Opponent's marks. The determinative issue in this proceeding therefore is whether the applied for mark DIVA DELIGHTS & Design is confusing with either of the Opponent's marks DIVA or DIVA AT THE MET.

[25] The material date with respect to the registrability ground is the latest, being today’s date. I will therefore address that ground first.

Non-registrability – Section 12(1)(d)

[26] I have exercised the Registrar's discretion to confirm that the Opponent’s registrations are in good standing as of today's date and, as such, the Opponent has met its burden under this ground [see *Quaker Oats Co of Canada Ltd/Cie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410, (TMOB) at 411-412]. As I consider the Opponent’s DIVA mark to be more similar to the Mark than is DIVA AT THE MET, I will focus my discussion on this mark.

[27] The legal onus is on the Applicant to show that there would be no reasonable likelihood of confusion, within the meaning of section 6(2) of the Act. Section 6(2) does not concern the

confusion of the marks themselves, but confusion of goods or services from one source as being from another source. In the instant case, the question posed by section 6(2) is whether there would be confusion of the Applicant's goods provided under the Mark as emanating from or sponsored by or approved by the Opponent [see *Glen-Warren Productions Ltd v Gertex Hosiery Ltd* (1990), 29 CPR (3d) 7 (FCTD) at 12].

test for confusion

[28] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has 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 trade-marks in appearance or sound or in the ideas suggested by them.

[29] This list of enumerated factors is not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC)]. In *Masterpiece Inc v Alavida Lifestyles Inc et al* (2011), 92 CPR (4th) 361 (SCC), the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the marks.

section 6(5)(a) – the inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[30] The word “diva” is defined as “a great or famous woman singer; a prima donna” [*Paperback Oxford Canadian Dictionary*, second edition]. The Applicant’s affiant, Ms. Husmann, states that she chose the Mark to incorporate her two passions: the opera and baking [Husmann, para. 4].

[31] Both parties’ marks possess a fair degree of inherent distinctiveness owing to the word “diva”. While the word “diva” is not a coined word, it is not suggestive of any particular aspect

of either party's goods or services. Although the Mark includes a fanciful woman design, it also includes the word DELIGHTS which is suggestive of the Applicant's associated goods and also has a laudatory connotation. I therefore consider the inherent strength of the parties' marks to be the same.

[32] The Opponent's mark has acquired distinctiveness through promotion and use. The Opponent's affiant, Mr. Wu, states that the Opponent owns and operates luxury hotels, restaurants and condominium residences in Canada. In Vancouver, the Opponent owns and operates the METROPOLITAN hotel, also sometimes referred to as THE MET. At this hotel, the Opponent has operated the DIVA restaurant, sometimes also known as DIVA AT THE MET, since 1996.

[33] Since opening in 1996, the Opponent's DIVA restaurant has received much favourable publicity and has gained a national reputation for the excellence of its cuisine. Attached as Exhibit A to Mr. Wu's affidavit are numerous examples of newspaper and magazine articles in which the Opponent's restaurant has been referenced between 1996 and 2006. Although circulation figures were not provided, I am prepared to take judicial notice that *The Globe and Mail* has a substantial circulation in Canada, and that the *Vancouver Sun* and the *Toronto Sun*, each have a substantial circulation in their respective cities [see *Northern Telecom Ltd v Nortel Communications Inc* (1987), 15 CPR (3d) 540 at 543 (TMOB); *R Griggs Group Ltd v 359603 Canada Inc* (2005), 47 CPR (4th) 215 at 227 (TMOB)]; *Milliken & Co v Keystone Industries (1970) Ltd* (1986), 12 CPR (3d) 166 (TMOB), at 168; and *Carling O'Keefe Breweries of Canada Ltd v Anheuser-Busch, Inc* (1985), 4 CPR (3d) 216 (TMOB), at 224]. The Opponent's restaurant has also been described by the words "Diva Delights" (Wu affidavit, para. 7, Exh. B).

[34] Mr. Wu further states that the Opponent has used its trade-marks in association with the operation of a restaurant as well as for catering services. The restaurant is open for breakfast, lunch and dinner and services in excess of 40,000 guests per year. Since the restaurant first opened in 1996, over 600,000 guests have been served. In 2011, the gross sales for the Opponent's restaurant were in excess of \$1,000,000 and had been in excess of \$1,000,000 for several years prior to that.

[35] The Opponent also spends a great deal of effort in promoting the restaurant and the Opponent's trade-marks both to hotel guests and non-hotel guests. Attached as Exhibit C to Mr. Wu's affidavit are numerous examples which the Opponent uses to promote its restaurant including brochures, dinner vouchers, promotional cards, etc. The examples provided are dated between 2000 and 2012. Mr. Wu states that over the last several years, the Opponent has spent in excess of \$150,000 promoting the Opponent's restaurant and its marks. Most of the materials display the following design:



[36] In the design above, the word "diva" is set apart from the other parts of the design and is used with a significantly different sized font. I therefore find that the design shown above qualifies as use of the trade-mark DIVA [see *Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA), at 164; and *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) at 538-9].

[37] The Opponent also promotes its marks on its website at www.metropolitan.com. Mr. Wu testifies that the Opponent's website receives in excess of three thousand hits per month (Wu affidavit, para. 12). As well as promoting the restaurant on its website, the Opponent promotes the restaurant on various social media sites, including Facebook and Twitter.

[38] The Opponent has used the DIVA mark in at least one other restaurant, namely Hemispheres in Toronto (Wu, para. 23). Attached as Exhibit M to his affidavit is a copy of a menu from 2006 offering Diva's Onion Dip as part of the bistro tapas menu.

[39] The Opponent submits that given the Opponent's presence on the Internet and social media, the fact that guests at the hotel from other parts of Canada dine at the restaurant, and the favourable publicity the Opponent's restaurant has received in numerous newspaper and magazine articles, it is reasonable to infer that the Opponent's mark has become known outside of Vancouver. Regardless of whether or not I draw this inference, I am satisfied from the

evidence furnished that the Opponent's mark has become known in Canada, and particularly in Vancouver.

[40] With respect to the acquired distinctiveness of the Mark, the evidence of Ms. Husmann may be summarized as follows:

- The Applicant was incorporated in 1997, but had started as a sole proprietorship approximately 20 years prior to the date of her affidavit (i.e. 1992);
- Early on in the Applicant's business, the Mark was used in association with baked goods including cakes, torts and cookies which were sold to coffee shops by special order;
- Since 1999, the Applicant has been a wholesale manufacturer of baked products including cookies, crackers, squares, cakes, loaves, cheese straws, cupcakes, muffins and pies as well as flour based sweet and savoury snack foods;
- The Applicant manufactures the goods at its plant located at 548 King Edward Street in Winnipeg, Manitoba;
- The Applicant has been using the Mark with the goods since as early as May, 2005 and examples of such use including samples of packaging and an invoice dated February 21, 2005 for the sale of various baked goods were attached as Exhibits A-D of her affidavit; and
- The goods made by the Applicant since May, 2005, have been for wholesale sales to Costco in Canada and the USA, and to Price Smart in Central and South America.

[41] In the absence of sales figures or information about promotional expenses or publicity, it is difficult for me to determine the extent known of the Mark in Canada in association with the Applicant's goods. Suffice is to say that in view of the evidence furnished by the Opponent, I am able to find that the Opponent's mark has become known to a greater extent in Canada than the Mark. This factor therefore favours the Opponent.

section 6(5)(b) - the length of time each trade-mark has been in use

[42] As set out in more detail above, the Applicant has shown use of the Mark in association with the applied for goods since at least as early as 2005. While the Opponent's affiant Mr. Wu makes the sworn statement that the Opponent has offered restaurant services in association with the Opponent's DIVA mark since 1996, the supporting documentary evidence dates back only to 2000.

[43] Regardless of whether the Opponent has shown use of its marks since 1996 or 2000, this factor favours the Opponent since both dates predate the Applicant's claimed date of first use of 2005.

sections 6(5)(c) and (d) - the nature of the goods, services or business; the nature of the trade

[44] It is the Applicant's statement of goods and services as defined in its application versus the Opponent's registered services that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. As the Applicant has confirmed that it is no longer pursuing its application with respect to the operation of a bakery, this service is no longer relevant.

[45] The applied for goods are various baked goods and sweet and savoury snack goods while the Opponent's registered services are restaurant services. Ms. Husmann states that since two years prior to the date of her affidavit (i.e. November 23, 2010), the main products produced by the Applicant have been Chewy Gingersnaps cookies and crisps. As noted above, the Applicant's goods are manufactured for wholesale sales to Costco in Canada and the U.S.A. and to Price Smart in Central and South America. Be that as it may, the application for the Mark does not limit the Applicant's goods to pre-packaged goods, nor does it restrict which channels of trade its products can be sold within.

[46] The Opponent operates its restaurant in association with a high-end hotel and has shown that dessert items are part of its restaurant's menu (Wu affidavit, paragraph 12 Exhibit D). The restaurant has also been recognized for its dessert offerings by the 2009 Restaurant Awards sponsored by Vancouver Magazine (Wu affidavit, paras. 18-19, Exhibits I-L). The Opponent

also makes available to the public recipes for Diva's Pecan Bread and Diva Stilton Cheesecake with Rhubarb Compote (Wu, para. 22, Exhibit I).

[47] In view of the evidence furnished, I find that the parties' goods and services are related in that they both comprise food items. With respect to the parties' channels of trade, the evidence in the present case shows that there does not appear to have been any overlap of the parties' channels of trade to date. In this regard, the Applicant has sold pre-packaged goods wholesale while the Opponent has operated a restaurant.

[48] While the fact that the goods or services sold by each party in different channels of trade to date is meaningful, I must keep in mind that in *Masterpiece*, above at para 53, the Supreme Court held that the focus must be on the terms set out in the application for the trade-marks and on what the "the registration would authorize the [applicant] to do, not what the [applicant] happens to be doing at the moment." The Court added at para 59 that while actual use is not irrelevant, "it should not be considered to the exclusion of potential uses within the registration. In the present case, neither of the parties' statements of goods or services is restricted to any particular channel of trade.

[49] I therefore conclude that the parties' channels of trade could overlap.

section 6(5)(e) - the degree of resemblance between the marks in appearance, sound and ideas suggested

[50] The law is clear that when assessing confusion marks must be considered in their entirety [see *British Drug Houses Ltd v Battle Pharmaceuticals*, [1944] Ex CR 239, at 251, affirmed [1946] SCR 50 and *United States Polo Assn v Polo Ralph Lauren Corp* (2000), 9 CPR (4th) 51 at para 18, aff'd [2000] FCJ No 1472 (CA)]. The Supreme Court has also advised in *Masterpiece*, however, that when comparing marks one should begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[51] In the present case, the word DIVA, while a dictionary word, has no meaning with respect to the parties' goods and services and as a result it forms the most striking or unique element of both parties' marks. In fact, it is the dominant and only component of the Opponent's

mark and the Applicant has incorporated the whole of the Opponent's mark DIVA as the dominant component of its mark. In view that the addition of the word DELIGHTS in the Mark is suggestive of the Applicant's associated goods (as shown by the affidavit of Ms. Walton), and the fanciful woman design appears to be a representation of a "diva", these additional components do not serve to decrease the degree of resemblance between the parties' marks. As a result, I consider there to be a high degree of resemblance between the marks in appearance, sound and idea suggested owing to the striking DIVA component present in each mark.

[52] In considering this issue, I have had regard to the recent decision of Justice LeBlanc in *Les Restaurants La Pizzaiolle Inc v Pizzaiolo Restaurants Inc* (2015), 2015 FC 240 where he stated the following at para 61:

Given that the registration of a trade-mark confers, under section 19 of the Act, exclusive rights upon its owner, the issue is whether the trade-mark for which registration is being sought creates confusion with a registered word mark must be examined keeping in mind not only the current use of the registered mark but also the likelihood of confusion arising from the use of this mark which is nonetheless permitted by the registration; the current use of registered word mark does not therefore limit the rights of its owner because the registration of the mark grants the owner the right to use the words that constitute the mark in any size and with any style of lettering, colour or design; (*Masterpiece*, above, at paras 55-57; *Mr. Submarine Ltd v Amandista Investment Ltd*, [1988] 3 FC 91 (FCA), [1987] FCJ No 1123 (QL) at pages 102-103).

[53] Applying this reasoning to the present case, I must bear in mind that the Opponent is authorized to represent its DIVA trade-mark in a manner similar to the Applicant's DIVA DELIGHTS & Design Mark.

Surrounding Circumstances

Co-existence without any evidence of confusion

[54] An absence of confusion despite an overlap of the goods or services and channels of trade during a meaningful length of time may entitle one to draw a negative inference about an opponent's case [see *MonSport Inc v Vêtements de Sport Bonnie (1978) Ltée* (1988), 22 CPR (3d) 356 (FCTD); and *Mercedes-Benz AG v Autostock Inc* (1996), 69 CPR (3d) 518 (TMOB)]. In order for a negative inference to be drawn, however, concurrent use of the marks needs to be extensive [see *Dion Neckwear, supra*].

[55] In the present case, there has been some concurrent use of the parties' marks since 2005. Ms. Husmann states the following in her affidavit at paragraph 19:

I have never had any inquiries with respect to the Diva Marks. I have never had anyone inquire as to whether Diva Delights is associated with the Restaurant or the Hotel or with any restaurant.

[56] I agree with the Applicant that a period of almost 10 years of co-existence is a meaningful length of time. However, in the absence of evidence of significant use of the parties' marks in similar areas in Canada, I am unable to draw a negative inference about the Opponent's case. In this regard, while the Applicant has shown some use of its Mark in Canada, in the absence of sales figures, I am unable to determine the extent the Mark has become known in Canada. Further, the Applicant has not shown that the parties have been active in the same parts of Canada.

[57] I therefore do not consider the absence of confusion a relevant surrounding circumstance in the present case.

State of the Register Evidence

[58] As a further surrounding circumstance, I have considered the state of the register evidence of Ms. Husmann. She conducted a search of the Canadian Trade-marks Database for marks containing the word "diva", and located four third party DIVA formative registrations and one third party DIVA formative application for various goods and services, including alcoholic cocktails, alcohol liqueurs, tomatoes, glassware and cooking classes.

[59] State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located [see *Ports International Ltd v Dunlop Ltd* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); *Kellogg Salada Canada Inc v Maximum Nutrition Ltd* (1992), 43 CPR (3d) 349 (FCA)].

[60] In my view, the existence of four registrations and one application, three of which do not even relate to food or food products, is insufficient to support the drawing of an inference that there are third parties who use DIVA formative trade-marks in association with food or restaurant services in the marketplace. Thus, this evidence does not assist the Applicant.

Conclusion re likelihood of confusion

[61] As indicated above, section 6(2) of the Act is not concerned with the confusion of the marks themselves, but confusion of goods and services from one source as being from another source. The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees DIVA DELIGHTS & Design on the Applicant's goods, at a time when he or she has no more than an imperfect recollection of the Opponent's DIVA trade-mark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [see *Veuve Clicquot, supra*, at para 20]. The question posed is whether this individual would be likely to conclude that the Applicant's goods are manufactured, sold, performed or otherwise authorized by the Opponent. In view of my reasons set out above, I find that they would be.

[62] While I acknowledge that the marks in issue are not identical, I find that the differences existing between them are not sufficient to outweigh the overall consideration of the section 6(5) factors discussed above. The Opponent's mark is inherently strong with respect to its services. Further, the Opponent's registration of the word mark DIVA permits use of the mark in any size and with any style of lettering, color or design. As reminded in *Masterpiece, supra* at para 59 "a subsequent use that is within the scope of a registration, and is the same or very similar to an existing mark will show how that registered mark may be used in a way that is confusing with an existing mark".

[63] Finally, the scope of the Applicant's goods as currently described in the application goes well beyond the limitations which the Applicant claims are applicable to it. Had the description of goods in the application for the Mark been more precise and included at least some limitations with respect to the nature of its goods or their channels of trade which would take these goods outside of the ambit of what the Opponent is doing with its DIVA trade-mark, I may have concluded differently.

[64] I therefore find that the Applicant has not met its legal burden to satisfy me that, based on a balance of probabilities, confusion between the marks is unlikely. This ground therefore succeeds to the extent that it is based on the Opponent's registration for the word mark DIVA.

Non-entitlement – Section 16(1)(a)

[65] The Opponent has also pleaded that the Applicant is not the person entitled to registration of the Mark in view of the provisions of section 16(1)(a) of the Act because the Mark was confusing with the Opponent's trade-marks DIVA and DIVA AT THE MET that the Opponent had previously used and/or made known in Canada in association with restaurant services.

[66] I note that despite filing evidence of alleged use of the Opponent's DIVA marks in association with catering services and cooking classes, the Opponent did not base its non-entitlement pleading on use with these services. The non-entitlement pleading is therefore limited to use of the Opponent's DIVA marks in association with restaurant services only.

[67] In order to meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the alleged date of first use of the Mark in Canada, the Opponent's trade-marks DIVA and DIVA AT THE MET had been previously used or made known in Canada and had not been abandoned as of the date of advertisement of the Applicant's application in the *Trade-marks Journal* [section 16(5) of the Act]. As per my review above of the relevant parts of the Wu affidavit, the Opponent has met this burden.

[68] For the most part, my conclusions above also apply to this ground of opposition. In this regard, I do not find that the circumstances were particularly different at the material date for this ground as compared to the circumstances at the material date for the section 12(1)(d) ground of opposition. As a result, this ground of opposition also succeeds to the extent that it is based on the Opponent's registration for the word mark DIVA.

Non-distinctiveness – Section 2

[69] In order to meet its initial burden with respect to this ground of opposition, the Opponent had to show that its trade-marks had become known sufficiently as of January 18, 2012, to negate the distinctiveness of the Mark [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*

(2004), 34 CPR (4th) 317 (FC); and *Bojangles' International LLC and Bojangles Restaurants Inc v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. The Opponent has met this burden.

[70] For the most part, my conclusions above under the section 12(1)(d) ground also apply to this ground of opposition. This ground therefore also succeeds to the extent that it is based on the Opponent's registration for the word mark DIVA.

Disposition

[71] Having regard to the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Cindy R. Folz
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office