

**IN THE MATTER OF AN OPPOSITION
by The Black Dog Tavern Company, Inc.
to application No. 779,865 for the trade-mark
THE BLACK DOG FREEHOUSE & Design
filed by 533737 Alberta Ltd.**

On April 4, 1995, the applicant, 533737 Alberta Ltd., filed an application to register the trade-mark THE BLACK DOG FREEHOUSE & Design in association with operation of a bar and restaurant based upon use of the trade-mark in Canada since at least as early as December, 1992. The mark is shown below:

The application was advertised for opposition purposes on February 7, 1996.

The opponent, The Black Dog Tavern Company, Inc., filed a statement of opposition on July 5, 1996. The applicant filed and served a counter statement.

The opponent filed as its evidence the affidavits of Elaine Sullivan, Joseph Hall, Robert Douglas and Robert W. White. As its evidence, the applicant filed the affidavit of Oliver Friedmann. The opponent obtained an order for the cross-examination of Mr. Freidmann on his affidavit but did not proceed with the cross-examination.

Both the applicant and the opponent filed a written argument. An oral hearing was held at which both parties were represented.

I will deal first with the ground of opposition based on non-compliance with Subsection 30(b) of the *Trade-marks Act*. The opponent alleges that the application does not set forth the correct date from which the applicant used the trade-mark and contests that if the trade-mark has been used since December 1992, which is denied, then it has not been continuously used since December 1992.

The legal burden or onus is on the applicant to show that its application complies

with Section 30. This includes both the question as to whether or not the applicant has filed an application that formally complies with the requirements of Section 30 and the question as to whether or not the statements contained in the application are correct. To the extent that the opponent relies on allegations of fact in support of its Section 30 ground, there is an evidential burden on the opponent to prove those allegations [see *Joseph E. Seagram & Sons Ltd. et al. v. Seagram Real Estate Ltd.* (1984), 3 C.P.R. (3d) 325 at pp. 329-330]. That burden is lighter respecting the issue of non-compliance with Subsection 30(b) [see *Tune Masters v. Mr. P's Mastertune* (1986), 10 C.P.R. (3d) 84 at p. 89]. To meet the evidential burden upon it with respect to a particular issue, the opponent must adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support that issue exist [see *John Labatt Limited v. The Molson Companies Limited* (1990), 30 C.P.R. (3d) 293 at p. 298]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [see *Labatt Brewing Company Limited v. Molson Breweries, a Partnership* (1996), 68 C.P.R. (3d) 216 at p. 230].

The material time for considering the circumstances respecting the issue of the applicant's compliance with Section 30 of the *Act* is the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469 at p. 475].

The opponent has not submitted any evidence in support of its Section 30 ground of opposition. However, the applicant has filed evidence concerning its use of its mark, which the opponent may rely on in support of its Section 30 ground of opposition.

Mr. Freidmann attests that he is the owner of the applicant and that the applicant has owned and operated THE BLACK DOG FREEHOUSE bar and restaurant in Edmonton since October 1992. He states that THE BLACK DOG FREEHOUSE bar and restaurant opened on December 4, 1992 and provides a copy of the invitation for the opening night as Exhibit "A". The invitation displays the applied for mark.

Mr. Freidmann has also provided pages of the lease agreement for the premises in which the bar and restaurant is operated and the occupancy permit issued therefore. The lease agreement is dated October 22, 1992. The occupancy permit is dated January 20, 1993. Neither the agreement nor the permit contain any reference to the applied for mark. No explanation is provided as to how an opening night

event could be held prior to the issuance of an occupancy permit.

Mr. Freidmann goes on to say that the applicant has used **THE BLACK DOG FREEHOUSE & Design** mark throughout Edmonton in advertisements placed in local publications. He attaches a copy of an advertisement that appeared in the September 7 to September 20, 1994 issue of a certain newspaper as Exhibit "D". However, the mark that appears in that advertisement is not the mark applied for. The advertisement is reproduced below.

Mr. Friedmann has also provided other promotional material used to promote special functions at **THE BLACK DOG FREEHOUSE** bar and restaurant. However, none of these display the applied for mark. In addition, the year in which they were used is not indicated.

Based on Mr. Friedmann's evidence, I conclude that the applicant has not in fact used the applied for mark continuously from December 1992 through April 4, 1995. Mr. Friedmann's allegations that the mark has been used are merely bald assertions that are not supported by the documentary evidence, with the exception of the invitation for the opening night on December 4, 1992. It appears that the applicant stopped using the applied for mark, choosing to use instead the words **THE BLACK DOG FREEHOUSE** with a depiction of one or more black dogs in varying arrangements. The new versions differ substantially from the applied for trade-mark and the differences do not fall within those considered to be acceptable in *Nightingale Interloc Ltd. v. Prodesign Ltd.* 2 C.P.R. (3d) 535.

Conclusion re Section 30(b) Ground

Subsection 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed [see *Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership* (1996), 67 C.P.R. (3d) 258 at p. 262 (F.C.T.D.)]. The opponent has met its evidential burden in this regard through the applicant's own evidence and the applicant has not met its legal burden as it has not shown that it has continuously used its trade-mark since the date claimed. The Subsection 30(b) ground of opposition therefore succeeds on that basis.

The three remaining grounds of opposition rely on there being a likelihood of confusion between the applicant's mark and the opponent's marks and trade-name. The first is based on Paragraph 16(1)(a) of the *Trade-marks Act*, the opponent alleging that the applicant is not the person entitled to register the trade-mark THE BLACK DOG FREEHOUSE & Design because, as of December 1992, such mark was confusing with 1) the opponent's trade-mark THE BLACK DOG, which had been made known in Canada since 1971 in association with services of operation of a bakery and restaurant and used in Canada since 1971 in association with T-shirts, hats, sweatshirts and shorts, and 2) the opponent's Black Dog Design mark, which had been made known in Canada since 1971 in association with services of operation of a bakery and restaurant and since 1978 in association with clothing, namely hats, T-shirts, sweatshirts and shorts. The opponent's Black Dog Design mark is shown below:

The second ground of opposition is based on Paragraph 16(1)(c) of the *Act*, the opponent alleging that the applicant is not the person entitled to register the trade-mark because, as of December 1992, such mark was confusing with the opponent's trade-name THE BLACK DOG TAVERN COMPANY, INC. which had been made known in Canada since 1971 in association with services of operation of a bakery and restaurant.

The third ground of opposition based on a likelihood of confusion is that the applicant's mark is not distinctive since it does not actually distinguish nor is it adapted to distinguish the applicant's services from the wares or services of the opponent. In support of this ground, the opponent relies on the allegations set out in the two previous grounds plus the

allegation that its "BLACK DOG trade-marks" have been used in Canada since 1995 in association with catalogues offering food, jewellery, toys and gift items.

The material dates with respect to the above three grounds of opposition are as follows: Paragraphs 16(1)(a) and (c) - the date of first use claimed by the applicant; non-distinctiveness - the date of filing of the opposition [see *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at p. 130 (F.C.A.) and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at p. 424 (F.C.A.)].

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in Subsection 6(2) of the *Trade-marks Act*, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Subsection 6(5) of the *Act*. The weight to be given to each relevant factor may vary, depending on the circumstances [see *Clorox Co. v. Sears Canada Inc.* 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)].

There is a legal burden on the applicant to establish that there would be no reasonable likelihood of confusion between the marks in issue. This means that if a determinate conclusion cannot be reached, the issue must be decided against the applicant [see *John Labatt Ltd. v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293].

I will consider first the Section 16 grounds of opposition. With respect to these grounds of opposition, there is an initial burden on the opponent to evidence use or making known of its trade-marks/trade-name in Canada prior to December 1992. Such use must be by the opponent or a licensee whose use satisfies the requirements of Section 50 of the *Act*.

The opponent's evidence of its use of its marks is provided primarily by the Sullivan affidavit. Ms. Sullivan, the opponent's Marketing Director/Assistant General Manager, states that she created the first Black Dog catalogue in 1987 and that they now produce an award-winning catalogue. 400,000 catalogues were distributed annually as of 1997 and worldwide sales for 1996 were approximately five million dollars. Ms. Sullivan provides examples of the catalogues from 1988 through to 1997. "The catalogue offers clothing, kitchen wares, stationery, pet care items and a wide range of games and novelty items." [paragraph 4, Sullivan affidavit]

The 1988, 1990 and 1991 catalogues bear the words THE BLACK DOG, as well as the opponent's Black Dog Design. They also shows these marks displayed on T-shirts that are offered for sale. The Black Dog Design also appears on hats, sweatshirts and shorts offered for sale in these catalogues, but I do not see any such wares displaying the word mark THE BLACK DOG in these catalogues. Advertising a mark in association with wares does not usually qualify as use of the mark pursuant to Subsection 4(1) of the *Act*, but to the extent that the marks are shown on the actual goods in the catalogue I am prepared to accept that catalogue sales of such wares would qualify as use of the mark for the wares. However, as these catalogues are primarily selling non-edible items, it is difficult to see how they show use of the opponent's marks for services of operation of a bakery and restaurant.

Conclusion re Section 16 Grounds

I conclude that the opponent has failed to meet its evidential burden to show use of its trade-marks in Canada prior to December 1992. Although catalogues predating this date have been provided, there is no evidence that any sales of the trade-marked wares were made to Canadians prior to December 1992. In paragraph 13 of her affidavit, Ms. Sullivan provides a summary of sales to Canadian customers, together with invoices for sales to them, but these do not predate 1993. Accordingly, the Section 16 grounds of opposition fail to the extent that they rely on the opponent's prior use.

In order for the making known arms of the Section 16 grounds of opposition to succeed, the opponent's trade-marks and trade-name must meet the making known requirements set out in Section 5 of the *Act*. This requires a finding that the marks/name have become well known in Canada by reason of the distribution or advertising of the opponent's wares or services in association with the marks/name in Canada. As of December 1992, there is no evidence of any such distribution or advertising. The Section 16 grounds of opposition therefore also fail to the extent that they rely on prior making known of the opponent's trade-marks or trade-name.

I will now consider the circumstances set out in Paragraph 6(5)(a) of the *Act* in so far as they relate to the sole remaining ground of opposition, the one alleging that the applicant's mark is not distinctive as of July 5, 1996.

Inherent Distinctiveness

The applicant's trade-mark and the opponent's trade-marks and trade-name are each inherently distinctive with respect to their respective wares and services. This circumstance therefore favours neither party.

Extent to which Marks have Become Known

There is little evidence that the applicant's mark had become known as of July 5, 1996. There is also only limited evidence that the opponent's trade-marks or trade-name had become known in Canada as of that date.

The opponent's evidence reveals that 30 of its catalogues were sent to Canadian addresses in 1994. Invoices provided for sales to Canadian addresses prior to the material date are as follows: 1993 – 4 invoices (3 of which were to the same individual) amounting to sales of less than \$350; 1994 – 22 invoices for sales amounting to approximately \$1000; 1995 – 6 invoices for sales amounting to less than \$300; 1996 (pre July 5) – 3 invoices for sales amounting to less than \$200. These sales are not only insignificant, but also not all of the wares sold bore either of the opponent's trade-marks or were wares of the type pleaded by the opponent.

The most significant spill-over advertising from American publications is from a small advertisement for the catalogue placed in the April 1993 U.S. national edition of Rolling Stone magazine. Mr. White's affidavit indicates that Canadian circulation for the March 18, 1993 edition of Rolling Stone magazine was 30,331, of which approximately 14,000 were by subscription. However, Mr. White's evidence refers to six geographical editions, with no reference to a national edition. If this ad was in fact seen by Canadian readers, its impact appears to have been insignificant given the small number of catalogues and wares ordered by Canadians in the subsequent year.

The remaining evidence of advertisements or articles relating to the opponent's business are either after the material date or are not relevant either because of their extremely small Canadian circulation or because they do not display or refer to the trade-marks or trade-name listed in the statement of opposition.

Overall, I conclude that this circumstance at most barely favours the opponent.

Length of Time the Marks Have Been in Use

The applicant began using its mark in 1992 whereas the first evidence of use of any of the opponent's marks in Canada is 1993. However, given the short head start that the applicant had and the lack of evidence of its continuing use of its mark, I do not consider this factor to favour either party.

Nature of the Wares, Services, Business and Trade

The parties' services overlap. The opponent's clothing does not seem to bear any connection to the applicant's services. The opponent's merchandise is not sold merely to promote its services but rather seems to have a life of its own.

Degree of Resemblance Between the Marks

There is a considerable degree of resemblance between THE BLACK DOG FREEHOUSE & Design mark and both THE BLACK DOG and Black Dog Design marks orally, visually and in idea suggested.

Considering first the resemblance between THE BLACK DOG FREEHOUSE & Design and THE BLACK DOG, it is noted that the applicant has incorporated the opponent's entire mark into its mark.

Considering THE BLACK DOG FREEHOUSE & Design versus Black Dog Design, there is the commonality of the depiction of a black dog. Although the applicant has included words in its mark, those words are primarily a written description of the design feature.

I conclude that a consideration of the resemblance between the applied for mark and THE BLACK DOG heavily favours the opponent. A consideration of the resemblance between the applied for mark and Black Dog Design also favours the opponent, but to a lesser degree.

Conclusion re Non-distinctiveness Ground

While the legal burden is on the applicant to establish that its trade-mark is distinctive, there is an evidential burden upon the opponent to establish the facts being relied upon by it in support of this ground. In order for the distinctiveness ground of opposition to succeed, the opponent need only have shown that as of July 5, 1996, its trade-marks or trade-name had become known sufficiently to negate the distinctiveness of the applied for mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)].

Although there is a significant degree of resemblance between the opponent's marks/name and the applicant's mark, the opponent has not provided evidence that would lead me to conclude that its trade-marks or trade-name had become known to any extent in Canada in association with its services as of July 5, 1996. The non-distinctiveness ground of opposition therefore fails to the extent that it relies on the opponent's services.

There is some evidence that the opponent's trade-marks/trade-name had become known in association with its catalogues and clothing as of July 5, 1996, but not to any significant degree. In view of this and the significant differences between the applicant's services (the operation of a bar and restaurant) and the opponent's wares (catalogues and clothing), I find that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the opponent's trade-marks and trade-name as of July 5, 1996. The non-distinctiveness ground of opposition therefore does not succeed.

Conclusion

Having been delegated by the Registrar of Trade-marks by virtue of Subsection 63(3) of the *Trade-marks Act*, I refuse the applicant's application pursuant to Subsection 38(8) of the *Act*.

DATED AT TORONTO, ONTARIO, THIS 27th DAY OF OCTOBER, 2000.

Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board