

IN THE MATTER OF AN OPPOSITION
by Mary Christie-Huerlimann and
Ernst Huerlimann to application
No. 637,468 for the trade-mark
BOCCALINO Design filed by
Amarillo Consulting Ltd.

On August 1, 1989, the applicant, Amarillo Consulting Ltd., filed an application to register the trade-mark BOCCALINO Design (illustrated below) for the following wares:

- (1) pasta dishes, casseroles, meat dishes, pizzas, desserts, salads, appetizers, hors d'oeuvres, including Swiss and Italian cuisine, alcoholic beverages namely wine, cocktails, liqueurs, liquors, dessert wines, and distilled spirits and non-alcoholic beverages namely softdrinks [sic], milk, coffee, tea, fruit punches [sic]
- (2) beer, ale, mead, lager and stout
- (3) pants, shirts, sweaters, neckties, children's bibs, hats, socks, sweatpants [sic], sweatshirts [sic], aprons, wrist watches, drinking mugs, drinking glasses, tableware
- (4) newspapers, newsletters

and for the following services:

- (1) operation of a restaurant, tavern and bar
- (2) operation of a passenger bus to and from sporting events
- (3) operation of retail outlet selling clothing, ornaments, time pieces and tableware.

The application is based on use of the trade-mark in Canada since September 1, 1981 in association with the wares marked (1) and the services marked (1); since September 30, 1985 with the services marked (2); since June 22, 1986 with the wares marked (2); since July 1, 1986 with the wares marked (3) and the services marked (3) and since December 28, 1987 with the wares marked (4). The application was advertised for opposition purposes on July 4, 1990.

The opponents, Mary Christie-Huerlimann and Ernst Huerlimann, filed a statement of opposition on July 31, 1990, a copy of which was forwarded to the applicant on August 27, 1990. The sole ground of opposition is that the applied for trade-mark is not distinctive of the applicant's wares and services in view of the operation of a restaurant and lounge in association with the trade-mark BOCCALINO in Canmore, Alberta since at least as early as October, 1985.

The applicant filed and served a counter statement. As its evidence, the opponents filed the affidavit of Mary Christie-Heurliemann. The applicant filed the affidavit of its President, Lynn Johner. Both parties filed a written argument but no oral hearing was conducted.

As for the sole ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from

those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - July 31, 1990): see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Finally, there is an evidential burden on the opponents to prove the allegations of fact in support of the ground of non-distinctiveness.

The opponents' evidence establishes that the opponents acquired a restaurant in Canmore, Alberta in 1987 that had been operating under the trade-mark BOCCALINO since 1984. The opponents continued to operate the restaurant under that trade-mark after they acquired it and they have spent modest amounts on advertising on a regular basis since then. Their BOCCALINO restaurant has been reviewed by local media outlets including CBC Radio and The Calgary Herald. Thus, as of the material time, it is apparent that the opponents' trade-mark BOCCALINO had become known in Canmore, Alberta and, to some extent, in the surrounding region including Calgary.

The Johner affidavit establishes that the applicant has used the trade-mark BOCCALINO in association with a restaurant and pub in Edmonton, Alberta since 1981. However, Ms. Johner is not clear as to when her company first began using the particular design version of its mark for which registration is sought. It would appear that use of the trade-mark BOCCALINO Design did not commence until 1984 and possibly as late as 1987. This suggests that some of the bases of the applicant's application may be inaccurate since use for some of the wares and services has been claimed as far back as September 1, 1981. However, the opponents did not rely on a ground of opposition based on non-compliance with Section 30(b) of the Trade-marks Act and I am therefore precluded from considering such a ground.

Although the Johner affidavit is not as precise as it could be, it does show that there has been fairly extensive advertising of the trade-mark BOCCALINO Design in Edmonton from at least 1987 on. From that I can infer that the applicant has carried on a fairly substantial restaurant and pub business in association with that mark at one location in Edmonton. Ms. Johner also evidences print advertisements which suggest that the reputation for the applicant's mark may extend beyond Edmonton.

In summary, the evidence shows that both parties have been operating a restaurant in association with different design versions of the trade-mark BOCCALINO for several years in different Alberta locations. The evidence even shows that both restaurants specialize in Swiss-Italian cuisine. There is no evidence that the opponents or their predecessors in title adopted their trade-mark with knowledge of the applicant's mark. Since the opponents' trade-mark BOCCALINO has acquired a reputation in parts of southern Alberta and the applicant's trade-mark has only acquired a reputation in the Edmonton area, the applicant's trade-mark cannot distinguish its restaurant and pub throughout Canada. This conclusion also applies to the other wares and services of the applicant since it appears that they are merely incidental to the operation of the restaurant and pub. The applicant has therefore failed to satisfy the onus on it to show that its trade-

mark BOCCALINO Design is distinctive and the sole ground of opposition is successful.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29th DAY OF October, 1993.

David J. Martin,
Member,
Trade Marks Opposition Board.