

# Translation



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

**Reference: 2012TMOB 223**  
**Date of Decision: 2012-11-28**

**IN THE MATTER OF THE OPPOSITION  
submitted by Ali Baba's Middle Eastern  
Cuisine Ltd. against registration application  
No. 1,357,619 for the ALI BABA PIZZA  
trade-mark in the name of Nilgun Dardere**

## Introduction

[1] On July 30, 2007, Nilgun Dardere (the Applicant) filed application No. 1,357,619 to register the trade-mark ALI BABA PIZZA (the Mark) based on a use in Canada since May 12, 1998.

[2] This application covers the following wares:

Pizza, poutine, submarines, chicken, salad, fries, pizza, sandwiches,  
hamburgers, lasagna and spaghetti (the Wares);

as well as the following services:

Delivery, dining room, take-out and catering service (the Services).

[3] The application was published for purposes of opposition in the *Trade-Marks Journal* on July 22, 2009. On September 21, 2010, Ali Baba's Middle Eastern Cuisine

Ltd. filed a statement of opposition that the registrar sent to the Applicant on October 28, 2010.

[4] On December 22, 2010, the Applicant filed a counter-statement in which it denies all grounds of opposition listed below.

[5] The Opponent filed the affidavit of Sazia Aftab. The Applicant filed the sworn statement of Nilgun Dardere.

[6] The parties filed written pleadings and no hearing was held.

Grounds of opposition

[7] The grounds of opposition raised by the Opponent are:

1. The application does not meet the requirements of Section 30 of the *Trade-marks Act*, RSC 1985, c. T-13 (the Act), in that the Applicant did not start using the Mark on the date of the first use claimed in its Application for registration and that in any event it ceased using it for an abnormally long period, and that it no longer uses it;
2. The request does not meet the requirements of Section 30 of the Act in that the Applicant could not be convinced that it had the right to use and register the Mark in Canada in regard to the prior use and registration of the Opponent's trade-marks identified below;
3. The Mark could not be registered according to subsection 12(1)d) of the Act since it creates confusion with the Opponent's trade-marks, namely:

TMA717,834 ALI BABA'S MIDDLE EASTERN CUISINE

TMA718,962 ALI BABA'S MIDDLE EASTERN CUISINE & Dessin

4. The Applicant is not the person holding rights to the registration of the Mark according to the provisions of subsection 16(1)a) of the Act because, on the date of the first use claimed in the application, the Mark created confusion with the above-mentioned trade-marks, as well as ALI BABA, ALI BABA'S and ALI BABA PIZZA previously used by the Opponent, as well as Ali Baba Pizza Ltd. and their affiliates, predecessors in title and licensees in relation to various food products and services;
5. The Applicant is not the person holding rights to the registration of the Mark according to the provisions of subsection 16(1)a) of the Act because, on the date

of the first use claimed in the application, the Mark created confusion with the trade names ALI BABA, ALI BABA'S, ALI BABA PIZZA, ALI BABA'S MIDDLE EASTERN CUISINE, ALI BABA'S MIDDLE EASTERN CUISINE LTD. and ALI BABA PIZZA LTD. previously used in Canada by the Opponent or other entities, their affiliates, predecessors in title and licensees;

6. According to subsection 38(2)d) and Section 2 of the Act, the Mark is not distinctive in that it does not truly distinguish nor is it suitable for distinguishing between the Applicant's wares and services and the wares and services of the Opponent and/or other persons as previously mentioned.

#### Burden of proof

[8] Although it is incumbent on the Applicant to show that its application complies with the provisions of the Act, the Opponent has the initial burden of presenting sufficient eligible proof to reasonably conclude in the existence of the facts claimed in support of each ground of opposition. Once the Opponent has fulfilled this initial burden, the Applicant must prove, according to the preponderance of probabilities, that the grounds of opposition should not be an obstacle to registration of the Mark [see *Joseph E Seagram & Sons Ltd et al v. Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 CPR (3d) 293 (C.F 1st inst.) and *Wrangler Apparel Corp v. The Timberland Company* [2005] CF 722].

#### Material dates

[9] The relevant date for analysis of each ground of opposition varies according to the ground of opposition pleaded:

- Non-compliance with the requirements of Section 30 of the Act: Filing date of the application (July 30, 2007);
- Registrability of the Mark according to subsection 12(1)d) of the Act: Date of the registrar's decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413, page 424 (CAF)];
- Rights to registration of the Mark, when the application is based on a use: Date of the first use claimed in the registration application (May 12, 1998) [see subsection 16(1) of the Act];

- Distinctive nature of the Mark: Filing date of the statement of opposition (September 21, 2010) [see *Andres Wines Ltd and E & J Gallo Winery* (1975), 25 CPR (2d) 126, page 130 (CAF) and *Metro-Goldwyn-Meyer Inc v. Stargate Connections Inc* (2004), 34 CPR (4th) 317 (CF 1st inst.)].

Ground of opposition based on subsection 30b) of the Act

[10] It is recognized in case law that the Opponent can refer to the Applicant's evidence to prove the claims relating to the ground of opposition based on subsection 30(b) of the Act and thereby fulfill its initial burden of proof. However, this proof must raise serious doubts regarding the veracity of the date of the first claimed use of the Mark by the Applicant in its registration application [see *Tune Masters v. Mr P's Mastertune Ignition Services Ltd* (1986) 10 CPR (3d) 84 (TMOB), *Williams Telecommunications Corp v. William Tell Ltd*, (1999) 4 CPR. (4th) 107 (TMOB) and *Labatt Brewing Company v. Molson Breweries, Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. The simple fact of claiming that the Applicant had not used the Mark on the date of the first use claimed in its registration application is not sufficient in itself to fulfill this initial burden of proof.

[11] The Opponent refers to exhibit M of the affidavit by Ms. Aftab who describes herself as a legal assistant in the office of the agent representing the Opponent. She produced several documents and I will return in greater detail to the eligibility as evidence of the majority of these documents. Exhibit M is a photocopy of an excerpt of the Canadian Intellectual Property Office (CIPO) website referring to registration application No. 1,419,209 for the trade-mark LA MAISON DES METS DE QUALITÉ ALI BABA PIZZA 2 POUR 1 TOUJOURS FRAIS & Dessin, filed by 9118-9118 Québec Inc. This application is based on a use in Canada since May 22, 1998.

[12] In its written argument, the Opponent pleads on the one hand that the Applicant in this registration application should have been a corporate entity and not the Applicant. Accordingly, it would be false to claim that it is the Applicant that used the Mark since the date of the first use claimed in this registration application. On the other hand, it says

the date of the first use should have been May 12, 1998 and not May 22, 1998, as can be seen in the registration application 1,419,209.

[13] I can set aside these two arguments in highlighting that the registration application cited by the Opponent in support of its ground of opposition is for the registration of a trade-mark quite different from the Mark and that, moreover, it was filed by an entity other than the Applicant, so there exists no proof on file connecting the Applicant to 9118-9118 Québec Inc.

[14] Accordingly, the first ground of opposition is refused.

#### Ground of opposition based on subsection 30i) of the Act

[15] Subsection 30i) of the Act requires only that the Applicant states itself convinced of having the right to use the Mark. The statement is included in the application. The prior use of similar trade-marks to the point of creating confusion is covered by the ground of opposition described in Section 16 of the Act, known under the name of “right to registration” and which is also raised by the Opponent. Regarding the confusion with the filed marks, the correct ground of opposition is that based on Section 12 of the Act. Subsection 30i) of the Act could be raised only in very specific cases, including when the Applicant's statement had been made in bad faith [see *Sapodilla Co Ltd v. Bristol Myers Co.* (1974) 15 CPR (2d) 152 (TMOB)]. This has neither been claimed nor proven in this file.

[16] Accordingly, the second ground of opposition is also refused.

#### Grounds of opposition based on sections 16 and 2 of the Act

[17] To fulfill its initial burden of proof in relation to its fourth ground of opposition, the Opponent must show the use of the trade-marks claimed in support of this ground of opposition prior to May 12, 1998 and that there had been no abandonment of such use on the filing date of the Applicant's application (July 22, 2009) [see subsections 16(1) and (5) of the Act].

[18] The Opponent has simply submitted the affidavit of Ms. Aftab. This contains excerpts from the register for the registrations cited in support of the third ground of opposition; a documentary proof attesting to the change of the Opponent's name in 1996 from a numbered company to the Opponent's current name; the title page of the Opponent's website dated July 24, 2007 and that of April 18, 2011; a photo of the Opponent's place of business located at 229 Church St., Toronto taken on April 16, 2011; a menu that she had taken from this latter address without specifying the date of this visit; a receipt for the purchase of food dated April 16, 2011 issued at the same address on which can be seen the name ALI BABA. The rest of the contents of her affidavit concerns the use of the ALI BABA PIZZA trade name or trade-mark in British Columbia prior to May 12, 1998. However, none of the documents submitted prove use of the ALI BABA PIZZA mark in British Columbia prior to May 12, 1998.

[19] Nothing in the Opponent's evidence shows the use of the trade-marks mentioned in support of its fourth ground of opposition prior to May 12, 1998. Accordingly, the fourth ground of opposition is refused since the Opponent has not fulfilled its initial burden of proof.

[20] Regarding the fifth ground of opposition, this is also refused for the same reasons, since there is no proof in the file on use of the trade names listed in support of this ground of opposition prior to May 12, 1998.

[21] With regard to the ground of opposition based on the absence of distinctive character of the Mark, the Opponent must first show that the trade-marks listed in its statement of opposition were sufficiently known on the relevant date (September 21, 2010) to deny the distinctive character of the Mark [see *Motel 6, Inc v. No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)].

[22] In addition to the documentary evidence appended to Ms. Aftab's affidavit described above, she also submitted: excerpts from the Canada 411 website dated April 18, 2011; an excerpt from the *waybackmachine.org* showing the title page of the website of Ali Baba Gourmet Pizza of Victoria, British Columbia, dated October 29,

2001; pages from the website of Ali Baba Pizza located in the British Columbia, dated October 10, 2007 and January 26, 2010.

[23] Accordingly, the only relevant evidence in support of this ground of opposition can be summarized as follows:

title page of the Opponent's website, dated July 24, 2007;

title page of the Ali Baba Gourmet Pizza of Victoria, British Columbia website, dated October 29, 2001;

pages from the website of Ali Baba Pizza located in British Columbia, dated October 10, 2007 and January 26, 2010.

[24] There is no affidavit from a representative of the Opponent attesting to the veracity of the content of the title page of its website or from a representative of the entities operating under the trade names Ali Baba Gourmet Pizza and Ali Baba Pizza also attesting to the veracity of the content of these webpages. These simple webpages, produced by a person who cannot attest to the veracity of their content, do not show, in my opinion, that these trade-marks or trade names were sufficiently known in Canada as at September 21, 2010 such that the Mark could not be distinctive or suited to distinguish the Wares and Services from the wares and services of the Opponent and of those of third-parties.

[25] I conclude that the Opponent has not fulfilled its initial burden of proof concerning its sixth ground of opposition and this is therefore also refused.

Ground of opposition based on subsection 12(1)d) of the Act

[26] Ms. Aftab's affidavit contains excerpts from the registrar on the trade-marks ALI BABA'S MIDDLE EASTERN CUISINE, registration certificate TMA717,834 covering restaurant services and ALI BABA'S MIDDLE EASTERN CUISINE & Dessin, registration certificate TMA718,962 for the same services. I checked the register and these registrations are still in order. The Opponent has therefore fulfilled its initial burden of proof.

[27] I consider that the Opponent has the best chance of success in comparing the Mark with the ALI BABA'S MIDDLE EASTERN CUISINE mark, registration certificate TMA717,834. If it cannot win its case with this registration, it would scarcely have more success with the other registration given the presence of the additional distinctive element of a graphic.

[28] It is therefore incumbent on the Applicant to prove, according to the preponderance of probabilities, that the use of the Mark in relation to the Wares and Services does not risk creating confusion with the ALI BABA'S MIDDLE EASTERN CUISINE mark. The test to be applied to rule on this issue is stated in subsection 6(2) of the Act. I must take into account all relevant circumstances, including those listed in subsection 6(5): the inherent distinctive nature of the trade-marks and the extent to which they have become known; the period during which the trade-marks have been in use; the type of wares, services or enterprises; the type of business; the degree of similarity between the trade-marks in their presentation or sound, or in the ideas they suggest.

[29] This list is not exhaustive, and it is not necessary to grant the same weight to each of these factors. The Supreme Court of Canada, in its ruling on *Masterpiece Inc v. Alavida Lifestyles Inc et al* 2011 SCC 27 interpreted subsection 6(2) of the Act and has enlightened us on the scope of the various criteria listed in subsection 6(5) of the Act. It stems from this analysis that the degree of similarity between the marks in dispute remains the most significant factor.

[30] In the dictionary *Le Petit Larousse*, "Ali Baba" is defined as being "one of the heroes of *One Thousand and One Nights*." It is the name of a fictional character and therefore has no elevated degree of inherent distinctive character [see *Camiceria Pancaldi & B Srl v. Cravatte Di Pancaldi Srl* (1996), 74 CPR (3d) 551 (TMOB)]. The words "Middle Eastern cuisine" are for the least very suggestive of the origin of meals served in restaurants operating under this trade-mark. Regarding the Mark, it is also not distinctive, since the word "pizza" is descriptive of one item of the Wares.

[31] The distinctive character of a mark can be heightened by its use and the extent to which it has become known in Canada. I have already concluded that there was proof of



use of the ALI BABA MIDDLE EASTERN CUISINE mark before the relevant dates associated with the grounds of opposition already analyzed. However, the relevant date for this ground of opposition is the date of the registrar's decision. Accordingly, I must consider all of the evidence that had been excluded under the other grounds of opposition, since it is prior to the relevant date associated with this ground of opposition.

[32] However, the evidence is very thin. Ms. Aftab's affidavit includes a photograph of a restaurant with an outdoor sign bearing the ALI BABA MIDDLE EASTERN CUISINE mark as well as a menu on which this mark appears. I have carefully read Exhibit H in Ms. Aftab's affidavit, but the cash receipt bears only the name Ali Baba. The Opponent did not think it fit to provide more information and proof concerning the use of its mark, such as the date of the first use of its mark, the annual sales, the promotional activities, and so forth. This evidence constitutes hearsay.

[33] There is indeed the registration certificate TMA717,834 which describes a use of the ALI BABA MIDDLE EASTERN CUISINE mark since May 1996, but I have no proof of continuous use of this mark since this date. The only thing I can draw from the date of use appearing on the registration certificate is a *de minimis* use and this use cannot be considered as a significant factor [see *Cartier Men's Shops Ltd v. Cartier Inc* (1981), 58 CPR (2d) 58 (FCTD) and *Entre Computer Centers Inc v. Global Upholstery Co* (1992), 40 CPR (3d) 427 (TMOB)].

[34] Regarding the evidence of use of the Mark, this is limited to a laconic statement by Ms. Dardere to the effect that the Applicant had used the Mark in relation to the Wares and Services since May 12, 1998. I must conclude in the use of the Mark based on the facts placed in evidence. However, the Applicant has produced no evidence to show the use of the Mark in relation to the Wares and Services since the date of use claimed in the registration application.

[35] It goes without saying that there exists a relationship between the services covered by the registration certificate TMA717,834 and the Wares and Services described in this registration application.

[36] There remains only the degree of similarity between the parties' marks. Both begin with the fictional name Ali Baba. The opposing marks are followed by words that are highly suggestive of the place of origin of the services or wares, for the Opponent's mark, or descriptive of the wares, for the Mark. However, there exists a distinction between "Middle Eastern Cuisine" on the one hand and "Pizza" on the other. Accordingly, the overall ideas suggested by the marks are sufficiently different to distinguish them and thus avoid there being a potential for confusion.

[37] I conclude that the Applicant has fulfilled its burden of proof, according to the preponderance of probabilities, that the Mark, if it is used in relation to the Wares or Services, does not create confusion with the trade-mark ALI BABA MIDDLE EASTERN CUISINE, since it is sufficiently different from the latter, both visually and in the ideas it suggests.

[38] I therefore refuse the third ground of opposition.

#### Decision

[39] In exercising the authority delegated to me by the Registrar of Trade-Marks pursuant to section 63(3) of the Act, I refuse the opposition in compliance with the provisions of subsection 38(8) of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Traduction certifiée conforme  
Alan Vickers