



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

**Citation: 2012 TMOB 175**  
**Date of Decision: 2012-09-14**

**IN THE MATTER OF AN OPPOSITION  
by MTY Tiki Ming Enterprises Inc. to  
application No. 1,435,980 for the trade-  
mark ROYAL TANDOOR in the name of  
William Aranha**

[1] On April 27, 2009, William Aranha (the Applicant) filed an application to register the trade-mark ROYAL TANDOOR (the Mark) based on proposed use in Canada in association with “prepared meals” and “restaurant services; take out and delivery restaurant services; catering services” (hereinafter referred to together as the Wares and Services).

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of June 30, 2010.

[3] On August 27, 2010, MTY Tiki Ming Enterprises Inc. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

- Pursuant to sections 38(2)(b) and 12(1) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act), the Mark was not registrable since it is clearly descriptive or deceptively misdescriptive of the conditions of the production of the wares and services in association with which it is proposed to be used.
- Pursuant to sections 38(2)(c) and 16(3) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the application the Mark was confusing with the trade-mark/trade-name “Royal Tandoori Indian Restaurant” previously used in Canada in association with restaurant services.

- Pursuant to sections 38(2)(c) and 16(3) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the application the Mark was confusing with the trade-mark/trade-name “Royal Tandoori Indian Cuisine” previously used in Canada in association with restaurant services.
- Pursuant to sections 38(2)(c) and 16(3) of the Act, the Applicant is not the person entitled to registration of the Mark because at the date of filing the application the Mark was confusing with the trade-mark/trade-name “La Tandoor” previously used in Canada by La Tandoor Restaurant Ltd. in association with restaurant services.
- Pursuant to sections 38(2)(d) and 2 of the Act, the Mark is not distinctive of the Wares and Services in that it does not distinguish nor is it adapted to distinguish nor is it capable of distinguishing the Wares and Services from the services in association with which the trade-marks Royal Tandoori Indian Restaurant, Royal Tandoori Indian Cuisine and La Tandoor are and have been used and made known in Canada.

[4] The Applicant served and filed a counter statement in which it denied the Opponent’s allegations and put the Opponent to the strict proof thereof.

[5] In support of its opposition, the Opponent filed the affidavits of Sarah Kissel, sworn February 24, 2011 with Exhibits SK-1-2 and Jasminder Singh sworn February 23, 2011. The Applicant did not file any evidence.

[6] Both parties filed written arguments. An oral hearing was not conducted.

Non-registrability Ground of Opposition – Section 12(1)(b) of the Act

[7] The Opponent has not filed any evidence in support of its section 12(1)(b) ground of opposition. Rather, it bases the ground on submissions made in its written argument along with dictionary definitions attached to the written argument.

[8] The Opponent submits the following in support of its section 12(1)(b) ground of opposition:

...the word “tandoor” is an Indian and/or Western Asian clay oven and is inherently associated with Indian food or Western Asian food.

The word “tandoor” is defined in *Collins Canadian Dictionary, First Edition* as “a type of Indian clay oven”. It is defined in *Oxford Canadian Dictionary, second edition* as “a clay oven of a kind used in N India and Pakistan”. The *Oxford Canadian Dictionary, second edition* also gives the word “tandoor” an attributive meaning which is “designating food cooked in such an oven”. The word originates from the Urdu language which is spoken in India and Pakistan.

The word “royal” is laudatory and clearly descriptive of quality and character. Together, the words give to the everyday consumer a first impression that the Applicant’s Wares are Indian food cooked in quality tandoors and that the Applicant’s Services are the preparation of quality Indian food cooked in tandoors.

[9] The issue as to whether the Mark is clearly descriptive or deceptively misdescriptive of the character or quality of the conditions of the production of the Wares and Services must be considered from the point of view of the average purchaser of the Wares and Services. Further, “character” means a feature, trait or characteristic of the associated wares and/or services and “clearly” means “easy to understand, self-evident or plain” [see *Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 (Ex Ct) at 34]. The Mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety as a matter of immediate impression [see *Wool Bureau of Canada Ltd v Registrar of Trade Marks* (1978), 40 CPR (2d) 25 (FCTD) at 27-8; *Atlantic Promotions Inc v Registrar of Trade Marks* (1984), 2 CPR (3d) 183 (FCTD) at 186]. Finally, the purpose of the prohibition in section 12(1)(b) is to prevent any single trader from monopolizing a term that is clearly descriptive or common to the trade, thereby placing legitimate traders at a disadvantage [see *Canadian Parking Equipment Ltd v Canada (Registrar of Trade-marks)* (1990), 34 CPR (3d) 154 (FCTD) at para 15].

[10] While I acknowledge that the word “tandoor” could be understood to be clearly descriptive or deceptively misdescriptive of the character or quality of the type of oven in which the Applicant’s food products are prepared, I note that the law is clear that the Mark must be considered in its entirety. While the Opponent has submitted that the word “royal” is laudatory, I do not find that when it is combined with the word “tandoor” the Mark as a whole is clearly descriptive or deceptively misdescriptive for the reasons that follow.

[11] The Opponent has not provided a dictionary definition for the word “royal”. As I may refer myself to a dictionary to determine the meaning of words (*Insurance Co of Prince Edward*

*Island v Prince Edward Island Insurance Co* (1999), 2 CPR (4th) 103 (TMOB)), I have looked into the *Canadian Oxford Dictionary* and found the following definition for the word “royal”: “adjective; of or suited to or worthy of a king or queen”.

[12] Based on this dictionary definition, I find that the word “royal” does not have a precise meaning with respect to the character of the conditions of production of the Wares and Services. Based on the foregoing, I am unable to accept the Opponent’s submission that the Mark “give(s) to the everyday consumer a first impression that the Applicant’s Wares are Indian food cooked in quality tandoors and that the Applicant’s services are the preparation of quality Indian food cooked in tandoors”. At most, I find that the Mark may suggest that the Applicant’s Wares and Services feature Indian cuisine.

[13] Based on the foregoing, this ground of opposition is dismissed.

#### Non-entitlement Grounds of Opposition – Section 16(3)(a) and (c) of the Act

[14] The Opponent bases one of its non-entitlement grounds of opposition on prior use of the trade-mark/trade-name “La Tandoor” by La Tandoor Restaurant Ltd. This entity is not the Opponent. No evidence has been provided to establish a connection between this entity and the Opponent.

[15] Section 17 of the Act states that no application for the registration of a trade-mark shall be refused due to previous use or making known of a confusing trade-mark or trade-name by a person other than the applicant or his predecessor-in-title, except at the instance of that other person or his successor-in-title. Therefore, an opponent can only rely upon prior use or making known of its own trade-marks or trade-names. A ground of opposition based upon prior use or making known of a third party’s trade-marks or trade-names is an invalid ground of opposition.

[16] Based on the foregoing, the non-entitlement ground of opposition based on use of the trade-mark/trade-name La Tandoor by La Tandoor Restaurant Ltd. is dismissed as an invalid ground of opposition.

[17] The Opponent bases one of the non-entitlement grounds of opposition on prior use of the trade-mark/trade-name “Royal Tandoori Indian Restaurant” without referring to who is using or making known this trade-mark/trade-name.

[18] According to *Novopharm Limited v. AstraZeneca AB* (2002), 21 CPR (4th) 289 (FCA), I must assess the sufficiency of the pleadings in association with the evidence. The Opponent has filed affidavits of Sarah Kissel and Jasminder Singh in support of its opposition. In her affidavit, Ms. Kissel provides materials printed from the website for Royal Tandoori Indian Restaurant ([www.royaltandoori.ca](http://www.royaltandoori.ca)) and Google Maps (<http://maps.google.ca>). In his affidavit, Mr. Singh states that he is the president and owner of Royal Tandoori Indian Restaurant which has been offering restaurant services in New Westminster B.C. continuously since as early as 2001. Considering the statement of opposition in conjunction with the evidence as a whole, I am able to infer that the Opponent is alleging prior use of the trade-mark/trade-name Royal Tandoori Indian Restaurant by Mr. Singh’s business “Royal Tandoori Indian Restaurant”. As with the previous non-entitlement ground of opposition, I note that there is no evidence establishing a connection between Royal Tandoori Indian Restaurant and the Opponent. Thus, this non-entitlement ground of opposition is dismissed for the same reasons as the first, namely, that it is an invalid ground of opposition.

[19] The last non-entitlement ground of opposition claims prior use and/or making known of the trade-mark/trade-name “Royal Tandoori Indian Cuisine”. I note that the Opponent’s evidence does not include any reference to this trade-mark/trade-name or who was using it at the material times and thus this ground of opposition has been insufficiently pleaded. Accordingly, this non-entitlement ground of opposition is also dismissed.

#### Non-distinctiveness Ground of Opposition - section 38(2)(d) of the Act

[20] Contrary to the non-entitlement grounds of opposition, the Opponent is permitted to rely on third party uses of confusingly similar trade-marks/trade-names in support of its non-distinctiveness ground of opposition. In order to meet its initial burden with respect to this ground, the Opponent must establish that one or more of the alleged trade-marks and trade-names (Royal Tandoori Indian Restaurant, Royal Tandoori Indian Cuisine and La Tandoor) was known to some extent at least in Canada as of August 27, 2010 [see *Bojangles’ International*

*LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC) and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. As stated in *Bojangles' International LLC* at para 34:

A mark must be known to some extent at least to negate the established significance of another mark, and its reputation in Canada should be substantial, significant or sufficient.

[21] The Opponent has not filed any evidence whatsoever with respect to the alleged use and/or making known of the trade-marks/trade-names Royal Tandoori Indian Cuisine and La Tandoor. As a result, the non-distinctiveness grounds based on Royal Tandoori Indian Cuisine and La Tandoor are dismissed due to the Opponent's failure to meet its evidential burden.

[22] With respect to the alleged use and/or making known of the trade-mark/trade-name Royal Tandoori Indian Restaurant by Royal Tandoori Indian Restaurant, the Opponent has filed the affidavits of Sarah Kissel and Jasminder Singh. Ms. Kissel's affidavit provides website evidence in the form of print-outs from the Royal Tandoori Indian Restaurant website ([www.royaltandoori.ca](http://www.royaltandoori.ca)) as well as from the Google Maps website (<http://maps.google.ca>). I am inclined to disregard the website evidence as hearsay; however, in the present case Mr. Singh's affidavit serves to confirm the accuracy and reliability of some of the information found on the websites attached to Ms. Kissel's affidavit. Taking the two affidavits together, I am prepared to find that Royal Tandoori Indian Restaurant was operating a restaurant at the material date (i.e. continuously since at least 2001) under the trade-mark/trade-name Royal Tandoori Indian Restaurant in New Westminster, BC. However, the Opponent has not provided any evidence which enables me to determine whether Royal Tandoori Indian Restaurant had developed any sort of reputation in Canada in association with the Royal Tandoori Indian Restaurant trade-mark/trade-name at the material date.

[23] Even if I was to infer some degree of reputation for this trade-mark/trade-name in New Westminster, BC as a result of the operation of a restaurant under this name there since 2001, this would not be sufficient to meet the Opponent's burden under the non-distinctiveness ground for the reasons that follow. Specifically, I note that in paragraph 33 of *Bojangles' International LLC*, the Court commented that "a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada", but it is not evident that the Royal Tandoori Indian

Restaurant trade-mark/trade-name was well known in New Westminster, BC as of the material date.

Disposition

[24] Pursuant to the authority delegated to me under section 63(3) of the Act, I reject the opposition pursuant to section 38(8) of the Act.

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office