



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

**Citation: 2011 TMOB 221**  
**Date of Decision: 2011-11-14**

**IN THE MATTER OF AN OPPOSITION  
by CEG License Inc. to application  
No. 1,411,592 for the trade-mark LOCAL  
PUBLIC EATERY in the name of Joey  
Tomato's (Canada) Inc.**

[1] On September 22, 2008, Joey Tomato's (Canada) Inc. (the Applicant) filed an application to register the trade-mark LOCAL PUBLIC EATERY (the Mark). The application is based upon proposed use of the Mark in Canada in association with the following wares and services:

wares

- (1) Beverageware including wine glasses and other glasses, cups and mugs; beverage coasters; wine cranks.
  - (2) Promotional items, namely key chains, flags, novelty buttons, greeting cards, note cards, pencils, pens, coffee mugs, and magnets, namely fridge magnets.
- (collectively the Wares)

services

- (1) Restaurant, bar and lounge services; food take-out services including online ordering services for take-out food; catering services.
- (collectively the Services)

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of August 12, 2009.

[3] On January 20, 2010, CEG License Inc. (the Opponent) filed a statement of opposition that the Registrar served on the Applicant on February 2, 2010. The Applicant filed and served a counter statement, denying the Opponent's allegations.

[4] An affidavit of Victor Choy, the Opponent's President, was filed in support of the opposition. An affidavit of Britt Innes, the Applicant's Director of Marketing, was filed in support of the application. Neither of the affiants was cross-examined.

[5] Both parties filed a written argument. An oral hearing was not held.

#### Grounds of Opposition

[6] The statement of opposition pleads four grounds of opposition pursuant to the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act). However, in its written argument, the Opponent "disclaims" the first three grounds of opposition and therefore I am treating those grounds as withdrawn. I also agree with the Applicant's submissions that the Opponent did not meet its initial burden with respect to the first three grounds of opposition.

[7] The surviving ground of opposition reads:

The trademark applied for is not distinctive, having regard to the provisions of Sections 38(2)(d) and 2 of the *Trade-marks Act* because it is not capable of distinguishing the Applicant's services from the services of others, particularly the services provided by the Opponent under the trade-names LOCAL 510 PUBLIC TAVERN & KITCHEN and LOCAL 522 PUBLIC TAVERN & KITCHEN, nor is it adapted to so distinguish the Opponent's trade-names.

[8] The last phrase of the above pleading makes no sense and will be disregarded. Regarding the remainder of the pleading, I note that the Opponent has not referred to the Applicant's Wares, with the result that this ground of opposition can at best succeed with respect to the Applicant's Services.

#### Material Date re Distinctiveness Ground

[9] The material date for assessing the issue of distinctiveness is the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

#### Initial Onus re Distinctiveness Ground

[10] There is an initial burden on the Opponent to establish that, as of January 20, 2010, one or both of the pleaded trade-names was known to an extent that could negate the distinctiveness of the Mark; the trade-name's reputation should be substantial, significant or sufficient [see *Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)].

[11] I therefore turn now to the Opponent's evidence to see if it has met its initial evidential burden. The evidence of the use or reputation of the pleaded trade-names as of January 20, 2010 can be summarized as follows.

[12] Mr. Choy states that the Opponent "operates restaurants, lounges and nightclubs in Calgary, Alberta known as Local 510 Public Tavern & Kitchen and Local 522 Public Tavern & Kitchen under the trade-names LOCAL 510 and LOCAL 522" and that the Opponent "has used the trade-names LOCAL 510 and LOCAL 522 in association with nightclub, bar, tavern, restaurant and lounge services since at least May 31, 2009." He does not refer anywhere in his affidavit to the trade-names referred to in the pleadings, namely LOCAL 510 PUBLIC TAVERN & KITCHEN or LOCAL 520 PUBLIC TAVERN & KITCHEN. However, Mr. Choy's various exhibits show the following logos:

1.



2.



[13] In particular, the above logos appear in the following exhibits:

Logo #1:

- Exhibit G – a copy of an undated food and beverage menu
- Exhibit H – “samples of the posters for daily specials” (these bear dates, namely days in August and October – although they do not indicate a year, I accept that these posters predate January 20, 2010 because Mr. Choy’s affidavit was sworn on July 29, 2010)

- Exhibits K through Q – copies of posters advertised in the Beatroute magazine of the *Calgary Herald* in June, July, August, September, October, November and December of 2009;

Logo #2:

- Exhibit D – a receipt dated June 4, 2010 (which postdates the material date) and undated copies of business cards
- Exhibit E – a copy of an undated food and beverage menu
- Exhibit F – a copy of an undated corporate menu
- Exhibit H – “samples of the posters for daily specials” (these bear dates, namely days in November – although they do not indicate a year, I accept that these posters predate January 20, 2010 because Mr. Choy’s affidavit was sworn on July 29, 2010)
- Exhibit I – samples of undated posters/advertisements
- Exhibits N, O, P, Q - copies of posters advertised in the Beatroute magazine of the *Calgary Herald* in September, October, November and December of 2009.

[14] The Applicant has pointed out that while Mr. Choy states that the trade-name LOCAL 510 and LOCAL 522 are in use in Canada, he never says that the trade-names LOCAL 510 PUBLIC TAVERN & KITCHEN and LOCAL 522 PUBLIC TAVERN & KITCHEN are in use in Canada. Moreover, even though Mr. Choy refers to the above logos as showing use of “the trade-name and associated logo”, I interpret his statement as meaning that the logos show use of the trade-name LOCAL 510 or LOCAL 522 and associated logo because the only trade-names that he has referred to in his affidavit are LOCAL 510 and LOCAL 522.

[15] Section 2 of the Act defines “trade-name” as “the name under which any business is carried on whether or not it is the name of a corporation, a partnership or an individual.” Clearly logos 1 and 2 above function as trade-marks. The question is whether the words within the marks

can simultaneously function as trade-names. I am not aware of any case law that says that they cannot. In the circumstances of this case, which include the fact that no other corporate/trade name appears on the materials, I will consider the use of the logos to qualify as use of the two pleaded trade-names, even though Mr. Choy has not referred to them as such.

[16] However, the totality of the evidence of use of the pleaded trade-names that predates January 20, 2010 comprises simply one or two daily menus and at the most seven advertisements appearing in a magazine associated with the *Calgary Herald*. Since there is marginally more evidence with respect to the trade-name LOCAL 510 PUBLIC TAVERN & KITCHEN, I will focus on whether the Opponent has met its initial burden in respect thereof. If the Opponent has not met its initial burden with respect to that trade-name, then it has not met its initial burden with respect to the other pleaded trade-name.

[17] Mr. Choy has provided the 2009 sales “for LOCAL 510 and LOCAL 520”; in excess of one million dollars and two million dollars respectively. However, it is unclear to what extent, if any, these figures can be attributed to the pleaded trade-names.

[18] Mr. Choy has provided the average daily 2009 circulation figures for the *Calgary Herald* newspaper, namely 124,607 copies (Exhibit R). Such evidence is inadmissible hearsay, but I can take judicial notice of the general circulation of the *Calgary Herald* as a major Canadian newspaper [see *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.)]. However, as pointed out by the Applicant, there is “no information as to how the average daily circulation figures of the *Calgary Herald* is related to circulation of the Beatroute magazine” (paragraph 17, Applicant’s written argument).

[19] To summarize, there is some evidence that the trade-name LOCAL 510 PUBLIC TAVERN & KITCHEN was promoted prior to January 20, 2010; so the question becomes whether the reputation evidenced is sufficient to negate the distinctiveness of the Mark.

[20] We do not know how many people saw the daily menus that Mr. Choy introduced as Exhibit H. That leaves the seven advertisements in a magazine of the *Calgary Herald*. Are they sufficient to affect the distinctiveness of the Applicant’s Mark? In this regard, I refer to the first part of paragraph 33 of *Bojangles’ International LLC*, as reproduced below:

[33] The following propositions summarize the relevant jurisprudence on distinctiveness where there is an allegation that a mark's reputation negates another mark's distinctiveness, as per s. 2 and para. 38(2)(d) of the Act :

- The evidential burden lies on the party claiming that the reputation of its mark prevents the other party's mark from being distinctive;
- However, a burden remains on the applicant for the registration of the trade-mark to prove that its mark is distinctive;
- A mark should be known in Canada to some extent at least to negate another mark's distinctiveness;
- Alternatively, a mark could negate another mark's distinctiveness if it is well known in a specific area of Canada;
- A foreign trade-mark owner cannot simply assert that its trade-mark is known in Canada, rather, it should present clear evidence to that effect;
- The reputation of the mark can be proven by any means, and is not restricted to the specific means listed in section 5 of the Act, and it is for the decision-maker to weigh the evidence on a case-by-case basis.

...

[21] As noted in the fourth bullet above, when an opponent's reputation is restricted to a specific area of Canada, the opponent's initial onus may be satisfied if its trade-mark (or trade-name) is well known in that specific area. However, the evidence before me does not enable me to conclude that the Opponent's trade-name was well known in Calgary. As I am not satisfied that the pleaded trade-name's reputation was substantial, significant or sufficient as of the material date, I find that the Opponent has not met its initial onus, with the result that the distinctiveness ground of opposition is dismissed.

[22] Even if I had found that the Opponent's evidence was sufficient to meet its initial burden, this does not mean that the distinctiveness ground of opposition would have succeeded. I say this for two reasons. First, the Applicant has evidenced that it commenced use of its Mark prior to January 20, 2010 and its reputation combined with the differences between the Mark and name(s) may have sufficed to prevent confusion. Second, as submitted by the Applicant, there is ambiguity as to whether the pleaded trade-names have been used by more than one legal entity. The evidence regarding this second point is as follows.

[23] Mr. Choy has attested, "The trade-name LOCAL 510 was registered for use in Alberta in association with Restaurant and Lounge services by 1454402 Alberta Inc. on March 27, 2009." He explains that 1454402 Alberta Inc. is a predecessor to Local 510 Public Tavern & Kitchen Ltd. and that he is the sole owner and director of both Local 510 Public Tavern & Kitchen Ltd.

and the Opponent. He states that Local 510 Public Tavern & Kitchen Ltd. and the Opponent are related entities, but he does not explain what Local 510 Public Tavern & Kitchen Ltd. does. He has however filed as Exhibit A, a copy of an Alberta Trade Name/Partnership Search dated 2010/7/27 that shows the predecessor of Local 510 Public Tavern & Kitchen Ltd. as the owner of the trade name LOCAL 510. According to an Alberta Corporation/Non-Profit Search provided as Exhibit B, prior to 2009/10/04 the legal entity known as Local 510 Public Tavern & Kitchen Ltd. was known as Local 522 Public Tavern & Kitchen Inc., which in turn was known as 1454402 Alberta Inc. prior to 2009/09/08.

[24] As noted earlier, Mr. Choy does not say that the Opponent is using the trade-name LOCAL 510 PUBLIC TAVERN & KITCHEN. Instead, he provides evidence that another company (Local 510 Public Tavern & Kitchen Ltd.) is the registered owner of the trade-name Local 510; such evidence implies that it is Local 510 Public Tavern & Kitchen Ltd., not the Opponent, who owns the alleged trade-name LOCAL 510 PUBLIC TAVERN & KITCHEN. Mr. Choy says that the Opponent uses the trade-name LOCAL 510, so perhaps this is under licensee from the owner of that registered trade-name. However, there are no provisions in the Act whereby the use of a trade-name by a related company, whether under license or otherwise, would accrue to the benefit of the trade-name owner [see *Gould Inc. v. Gould Fasteners Ltd.* (1998), 85 C.P.R. (3d) 549 (T.M.O.B.) at p. 556]. Overall, it is questionable if the pleaded trade-names are distinctive of the Opponent.

[25] The multiple parties associated with the pleaded trade-names, the reputation associated with the Applicant's Mark as of the material date, and the differences between the Mark and names are all factors that could have presented obstacles to the success of the distinctiveness ground if I had found the Opponent to have satisfied its initial burden.

### Disposition

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



---

Jill W. Bradbury  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office