



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

Citation: 2016 TMOB 82
Date of Decision: 2016-05-31

IN THE MATTER OF AN OPPOSITION

Restaurant Development Group LLC	Opponent
and	
Vescio Group Inc.	Applicant
1,571,343 for BurgerFi	Application

[1] Restaurant Development Group LLC opposes registration of the trade-mark BurgerFi (the Mark), that is the subject of application No. 1,571,343 by Vescio Group Inc.

[2] The application was filed based on proposed use of the Mark in Canada in association with “all natural, antibiotic and hormone free beef hamburgers; vegetarian burgers; all natural hot dog; French fries; onion fries; ice cream; frozen desserts; milkshakes; soft drinks; and water”, as well as “restaurant services”.

[3] The Opponent has opposed the application for the Mark on the basis that: (i) the application does not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the Applicant is not entitled to registration of the Mark under section 16 of the Act; and (iii) the Mark is not distinctive under section 2 of the Act.

[4] For the reasons that follow, I reject the opposition. Among other reasons as will be discussed below, the Opponent has not sufficiently evidenced that its trade-marks were known to some extent at least or that its reputation was substantial, significant or sufficient to negate the distinctiveness of the Mark.

The Record, Onus and Material Dates

[5] The application for the Mark was filed on June 8, 2012.

[6] It was advertised for opposition purposes in the *Trade-marks Journal* dated November 21, 2012. On April 19, 2013, the Opponent filed a statement of opposition to oppose it under section 38 of the Act. The Applicant then filed and served its counter statement on September 20, 2013.

[7] In support of its opposition, the Opponent filed the affidavits of Amanda Gauthier, Michael Stephan, and Josh Lorence, all sworn on February 19, 2014. The Opponent also filed the affidavit of Andreas Oberleitner, sworn February 18, 2014. None of the Opponent's affiant's was cross-examined on their affidavit.

[8] In support of its application, the Applicant filed the affidavit of Joseph Vescio, sworn June 19, 2014. Mr. Vescio was also not cross-examined on his affidavit.

[9] Both parties filed written arguments and were represented at a hearing.

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could be reasonably concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD); *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155; and *Wrangler Apparel Corp v The Timberland Company*, 2005 FC 722, 41 CPR (4th) 223].

[11] In its written argument the Opponent indicated that it would no longer be pursuing the grounds of opposition based on section 16(3)(a) of the Act. At the hearing, the Opponent further withdrew the ground of opposition based on section 30(a) of the Act.

[12] With respect to the remaining grounds of opposition, it is the following material dates that apply:

- Sections 38(2)(a)/30 - the filing date of the application, namely, June 8, 2012 [see *Canadian National Railway Co v Schwauss* (1991), 35 CPR (3d) 90 at 94 (TMOB) re: section 30(e); and *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB) re: section 30(i)]; and
- Sections 38(2)(d)/2 – the date of filing of the statement of opposition, namely, April 19, 2013 [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

Overview of the Parties' Evidence

The Opponent's Evidence

The Gauthier Affidavit

[13] Ms. Gauthier is a legal assistant employed by the agent for the Opponent.

[14] With regards to the remaining grounds of opposition, Ms. Gauthier's affidavit contains the following evidence:

- Exhibit A: a certified copy of the file history for the Application.
- Exhibits B, C, and D: certified copies of the file histories for the Opponent's applications for application Nos. 1,613,716 (for BURGERFI), 1,613,717 (for BURGERFI & Design), and 1,637,770 (for BURGERFI).
- Exhibits E, F and G: certified copies of U.S. Trade-mark Registrations 4,036,302, 4,043,391, and 4,357,894 (BURGERFI marks).
- Exhibit H: a certified copy of a letter dated March 26, 2012 from Judith L. Grubner of Arnstein & Lehr LLP to Mr. Joseph Vescio. The letter refers to the Applicant's registration of the domain name <*burgerfi.org*>, and informs the

Applicant of the Opponent's US trade-mark registrations noted above. The letter then outlines demands that the Applicant immediately cease any such use of the burgerfi trade-mark, as well as transfer the domain name to BFI.

The Stephan Affidavit

[15] Mr. Stephan, a senior investigator and supervisor with Canpro King-Reed LP, conducted a general background investigation into the Applicant, which began upon obtaining a copy of a Corporate Profile Report for the Applicant, dated March 18, 2013. He attaches a copy of this report under Exhibit B to his affidavit, which identifies both Joseph Vescio and Loredana Vescio as officers of the corporation.

[16] Mr. Stephan attests that he then conducted further searches which led to an entity called Roma's Hospitality Centre. He attaches as Exhibit C, a copy of the registration under the Ontario Business Names Act for this entity. The registration identifies Joseph Vescio as the individual authorizing the registration, and the address listed on the registration is the same address that is recorded for the Applicant on the Corporate Profile Report in Exhibit B. Further to this, Mr. Stephan attaches as Exhibit D to his affidavit, printouts from websites located through Internet searches for Roma's Hospitality Centre, dated March 25, 2013.

[17] Mr. Stephan then attests that on or about March 27, 2013, he conducted real property searches using the search term "vescio", which he states led to property records showing the names Guiseppe Vescio and Loredana Buzzanca. He states that he then conducted Internet searches using the terms "vescio" and "loredana buzzanca", and located on-line records at the website: <http://southflorida.blockshopper.com> (see Exhibit E). The records show that a property located at 1900 S. Ocean Boulevard in Florida was purchased by Guiseppe Vescio and Loredana Buzzanca Vescio on August 19, 2011. Additional online Florida county records searches revealed similar information (per Exhibits G and H).

[18] Lastly, Mr. Stephan attests that on or about March 26, 2013 and again on January 28, 2014, he examined the website www.burgerfi.com, and clicked on the link for "locations". He attaches as Exhibit I printouts from the website showing four Florida BurgerFi locations. To demonstrate the proximity of these locations to the 1900 S. Ocean Boulevard owned by Guiseppe and Loredana Vescio, Mr. Stephan provides printouts at Exhibit J of Google Maps

searches he conducted on or about January 28, 2014. The printouts refer to three of the four aforementioned BurgerFi locations, and show that the distance from these locations to 1900 S. Ocean Boulevard, ranges from 1.7 miles to 23.3 miles.

The Lorence Affidavit

[19] Mr. Lorence is the Director of Operations for BurgerFi International (BFI), the licensee of the Opponent's BurgerFi trade-mark and other trade-marks which are the subject of U.S. applications for registration (see copy of license agreement under Exhibit E). He states that BFI is the franchisor of fast-casual franchise restaurants operating under the trade-mark BurgerFi, to which there are 39 BurgerFi restaurants as of the date of swearing of his affidavit (see Exhibit C for a list of all BurgerFi locations and their opening dates).

[20] Mr. Lorence then provides a brief history of the Opponent's BurgerFi mark and restaurant, which he explains was borne out of an eco-friendly concept with a focus on free-range beef with no chemicals or additives. He states that the trade-mark "BurgerFi", an abbreviation of "Burgerfication", was coined after considerable discussion among Mr. Rosatti, the principal of both BFI and the Opponent, and his staff. The first BurgerFi restaurant, he attests, was then opened for business in Lauderdale-by-the-Sea, Florida on February 5, 2011. He attaches as Exhibit E a photograph of this first BurgerFi location, which although is current, is representative of how the restaurant appeared on opening day.

[21] From that first location, Mr. Lorence explains, BurgerFi locations began to expand, including an additional sixteen locations both in and outside of the state of Florida from the period February 5, 2011 to April 19, 2013. He attests that each of these locations used and continue to use the BurgerFi trade-mark on their signage, menus, cups, napkins, balloons, shopping bags, employee uniforms, sunglasses, pens, coupons, and advertisements; examples of which he provides at Exhibit F to his affidavit.

[22] With respect to the Opponent's BurgerFi trade-mark and its exposure to Canadians, Mr. Lorence attests that he has read BurgerFi restaurant reviews posted on the Internet (namely, Yelp, Urban Spoon and Trip Advisor), and BurgerFi staff have conducted surveys at several locations. He states that based on this information, he believes that Canadians, both tourists and

seasonal residents have visited BurgerFi restaurants in the United States since at least as early as the end of 2011. In support, he attaches, under Exhibit G, copies of restaurant reviews by BurgerFi guests whose profiles state that they live in Canada.

[23] With respect to the surveys, Mr. Lorence describes an in-house survey commissioned by BFI of BurgerFi guests at three BurgerFi restaurant locations in Florida. He states that the purpose of the survey, which was conducted from January 10, 2014 through February 14, 2014, was to determine the number of guests from Canada visiting the BurgerFi restaurants at those locations. He explains that cashiers at the restaurants were instructed to ask every guest: “Do you mind telling me where you are from?”, and if the guest answered “Canada”, the cashier then asked “Where in Canada?” and “How many people are in your party today?”. Mr. Lorence attests that the cashiers recorded the answers to these questions on daily log sheets, copies of which he attaches under Exhibit H to his affidavit. Mr. Lorence further attaches a chart (Exhibit I) that he prepared detailing the number of guests from Canada at each restaurant during the survey period, indicating that 1,142 guests from Canada visited these restaurants during this time.

[24] In addition to Canadians visiting BurgerFi locations in the United States, Mr. Lorence attests that between February 5, 2011 and April 19, 2013, 34 Canadians have also expressed interest in becoming BurgerFi franchisees (see Exhibit J for list of Canadian franchise inquiries). He attests that in response to these inquiries, the BurgerFi franchise team sent sales literature, photographs, videos and franchise disclosure information to each of these Canadian prospects. Specifically, he provides brief details regarding one such inquiry that has now materialized into agreements for two BurgerFi franchise locations intended to be open in British Columbia by the end of 2014.

[25] Lastly, Mr. Lorence attests that a BFI sublicensee has been using the BurgerFi trade-mark in Canada, at the Abbey Arms Pub & Restaurant in Oakville, Ontario since February 7, 2014. Based on conversations with the operator of Abbey Arms, he attests that Abbey Arms has been selling and serving to its guests various BurgerFi food products since February 8, 2014. In support, he attaches, as Exhibit K, copies of posters and menus bearing the BurgerFi trade-mark, used and displayed by this Canadian sublicensee.

The Oberleitner Affidavit

[26] Mr. Oberleitner is the Reputation Management and Enterprise Management Server Coordinator of BFI, and a member of BFI's Information Technology Department.

[27] He attests that BurgerFi operates a website at *www.burgerfi.com*, which based on information and belief was launched on or about February 5, 2011 and has always been accessible to Canadians. He attaches, as Exhibit A to his affidavit, printouts of various pages from the BurgerFi website. He states that although the site has evolved since the date it was launched, it has always prominently displayed the BurgerFi trade-marks.

[28] Mr. Oberleitner attests that he conducted research to determine how many Canadian web users visited the BurgerFi website during the period February 5, 2011 to April 19, 2013. He states that the website visitor information was collected using Google Analytics, a service offered by Google Inc. that details web traffic on individual website, and that during the period BurgerFi.com received a total of 4,272 visits from Canadian web users. Exhibit B consists of a more detailed Google Analytics report in this regard, which provides further information such as percentage of new visits, as well as the province where each Canadian visitor was located, etc.

[29] Lastly, Mr. Oberleitner researched estimates regarding the number of Canadian visitors generally to Florida annually and by quarter. To do so, Mr. Oberleitner contacted the state of Florida's official tourism planning office and obtained a chart entitled "Florida Visitation Estimates" on December 23, 2013 (a copy of which is attached as Exhibit C). Based on this document, Mr. Oberleitner states that he believes that from April 1, 2011 to March 31, 2013, there were 6,936,000 Canadian visitors to the state of Florida.

The Applicant's Evidence

The Vescio Affidavit

[30] Mr. Vescio is the Owner/President of the Applicant.

[31] He states that between June 16, 2014 and June 18, 2014, he conducted surveys outside various specialty burger restaurants in Ontario at four locations (Mississauga, Oakville, Toronto,

and Vaughan). He states that the purpose of conducting the surveys at these locations was to determine if BurgerFi is known in Canada. He attests that in this regard, participants were asked “If they had ever heard of BurgerFi” and the response was logged onto a survey sheet. He states that 290 people were surveyed, only one of which initially said “yes, with a confused look and then replied no.” He states that he asked a second time and the answer was no. He provides as Exhibit A to his affidavit copies of the surveys detailing the number of people surveyed and their responses.

[32] Lastly, Mr. Vescio states that on June 18, 2014, he conducted a Google search for “Fi in Florida” to determine if “Fi” is a common term. He states that he was able to find numerous businesses operating in various parts of Florida using the term “Fi” and lists nine such businesses. He attaches, as Exhibit B to his affidavit, a copy of the aforementioned search results.

Grounds of Opposition

Sections 30(e) and 30(i) Grounds of Opposition

[33] Section 30(e) of the Act requires an applicant to make a statement that it, either by itself or through a licensee intends to use the applied-for trade-mark in Canada. In the present case, the application contains such a statement. It therefore formally complies with section 30(e) of the Act. The question then becomes whether the Applicant has substantively complied with section 30(e) of the Act; that is, did the Applicant have a *bona fide* intention to use the applied for trade-mark in Canada at the time of filing of the application?

[34] Since it is difficult to prove a negative, and certainly more so in a case of a proposed use application, the initial burden upon an opponent with respect to a ground of opposition based upon non-compliance with section 30(e) is a relatively light one [see *Molson Canada v. Anheuser-Busch Inc.*, (2003) 2003 FC 1287, 29 CPR (4th) 315]. Furthermore, the fact that the material date is the filing date of the application does not preclude the consideration of evidence arising subsequent to that date insofar as it may indicate a situation existing as of the material date [see *Bacardi & Co v Jack Spratt Manufacturing* (1984), 1 CPR (3d) 122 at 125-126 (TMOB)].

[35] Similarly, with respect to section 30(i) of the Act, if an applicant makes a statement that it is satisfied that it is entitled to use the trade-mark in Canada, as in the present case, the application formally complies with this section of the Act. Where an applicant has provided the statement required by section 30(i) of the Act, a section 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[36] With respect to substantive compliance with the sections 30(e) and (i) of the Act, the Opponent has alleged that the Applicant not only has no intention of using the Mark in Canada, but that the application was filed for the express purpose of impeding the Opponent's business activities; in other words, the application was filed in bad faith.

[37] In this regard, the Opponent submits (i) that the Applicant became aware of the Opponent's BurgerFi restaurants in 2011; (ii) that the Applicant registered the domain name <*burgerfi.org*> in 2012, which is parked and does not lead to an active website, and; (iii) that the Opponent's American counsel wrote to the Applicant asking that the domain name be transferred to the Applicant, to which the Applicant did not respond and then filed the subject application in Canada on June 8, 2012. The Opponent submits that the evidence taken together suggests that the application was not filed with any legitimate intention as part of an existing business or part of a potential business concern; rather, it would seem that Mr. Vescio is simply squatting on the trade-mark of a US entity that is well known and where Mr. Vescio owns a condo. Furthermore, the Opponent submits that where an opponent provides evidence suggesting bad faith on the part of an applicant, and where the applicant does not provide any evidence in response, a section 30(i) ground of opposition will succeed [citing *L'Oréal v Marcon*, 2010 TMOB 67].

[38] In support of the aforementioned, the Opponent refers to the Stephan affidavit, particularly Exhibits F and G which shows that Mr. Vescio acquired property in Florida in 2011. The Opponent submits that Mr. Vescio must have therefore become aware of the Opponent's BurgerFi restaurant 1.7 miles away, which had opened approximately six months earlier.

[39] The Applicant submits that the assumption that Mr. Vescio knew of the Opponent's BurgerFi location in Florida is tenuous and irrelevant with regards to whether the Applicant had an intention to use the Mark *in Canada* at the time of filing of the application. Further to this,

the Applicant submits that the domain name is also irrelevant, and an applicant does not have to evidence use of a proposed trade-mark as there is no requirement to use a proposed trade-mark until it is approved [citing *Adams v Sven Bullaert*, 2014 TMOB 144; and *Black Entertainment Television, Inc v CTV Limited* (2008), 66 CPR (4th) 274]. Lastly, the Applicant submits that the letter from the Opponent's American counsel is also irrelevant, and that mere awareness of prior rights alleged by an opponent does not preclude an applicant from truthfully making the statements required by section 30(i) of the Act [citing *Effigi Inc v ZAM Urban Dynamics Inc*, 2010 TMOB 214; and *Bousquet v Barmish Inc* (1991), 37 CPR (3d) 516 (FCTD), affirmed (1993), 46 CPR (3d) 510 (FCA)].

[40] The Opponent submits that it has not issue with the proposition that an applicant does not have to show use of a proposed trade-mark. However, the Opponent submits that the *Black Entertainment* and *Adams and Bulleart* cases relied upon by the Applicant are distinguishable from the present case, as in these cases, the opponents had not filed any evidence, and were trying to make their cases entirely based on the lack of evidence from the applicants. In the present situation, the Opponent submits, the Opponent has filed evidence and it is clear that it has done what it can to discharge its relatively light evidentiary burden. In contrast, the Opponent submits, the Applicant has done nothing to meet its burden, as it has not filed any evidence in this regard.

[41] The Applicant submits that the facts pleaded in the present case are hardly exceptional and that it was merely informed that the Opponent owned the U.S. trade-mark registrations for the Opponent's BURGERFI trade-marks in the United States. The Applicant submits that it is perfectly reasonable to conclude that the Opponent's trade-mark rights pursuant to its U.S. trade-mark registrations are limited to the United States, since this is exactly what the law prescribes. Thus, the Applicant submits, it was satisfied that it was entitled to use the Mark in Canada at the date of filing. Taken as a whole, the Applicant submits, there is no evidence establishing that it had falsely made the statements required by sections 30(e) and (i) of the Act; thus, these grounds of opposition ought to be dismissed for the Opponent's failure to meet its evidential burden.

[42] I agree that it appears likely that the Applicant knew of the Opponent's BurgerFi restaurants in Florida upon registering the domain name <*burgerfi.org*>, and was subsequently

informed of the Opponent's US trade-mark registrations. In this regard, the evidence does indicate that Mr. Vescio purchased a condominium in Florida, to which one of the Opponent's restaurant locations opened in close proximity shortly thereafter. Furthermore, I note that the Applicant's application is not only for the identical mark, but also for goods that make reference to "all natural" and "anti-biotic and hormone free" in the context of restaurant services, which thus appears to be closely aligned with the Opponent's offerings and business strategy. While this may demonstrate a lack of originality or ingenuity on behalf of the Applicant, there is no evidence to suggest that the Applicant had any reason to believe that the Opponent's restaurants and associated trade-mark rights extended beyond the United States. Furthermore, distinguishable from *L'Oréal, supra*, there is no evidence, such as a pattern of filing applications for the registration of well-known trade-marks in Canada and the United States, wherein one could reasonably draw the inference that the Applicant, in this case, would be intending to traffic in trade-marks.

[43] Indeed, a person may file an application for a trade-mark in Canada which it knows has been used in another country, and this does not necessarily constitute bad faith. In this case, the Opponent's evidence is insufficient to result in the inference that the Applicant would have known that the Opponent's identical trade-mark had been used, made known or had a reputation *in Canada*, such that the Applicant could not have stated it was entitled to use the Mark in Canada [see *Viper Room Development, LLC v 672661 Alberta Ltd*, 2014 TMOB 201; see also *Skinny Nutritional Corporation v Bio-Synergy Limited*, 2012 TMOB 186 and *Taverniti SARL v DGGM Bitton Holdings Inc* (1986), 8 CPR (3d) 400 (TMOB) at 404-405 re: mere awareness of foreign registration and use not sufficient].

[44] Accordingly, having regard to the aforementioned, the sections 30(e) and (i) grounds of opposition are dismissed.

Non-distinctiveness Ground of Opposition

[45] There is an initial evidential burden on the Opponent to establish the facts relied upon in support of its non-distinctiveness ground. Once the burden has been met, there is a legal onus on the Applicant to show that the Mark is adapted to distinguish or actually distinguishes its goods and services from those of others [see *Labatt Brewing Company Limited v Molson Breweries, a*

Partnership (1996), 68 CPR (3d) 216 (FCTD) at 298; *Muffin Houses Incorporated v The Muffin House Bakery Ltd*, (1985) 4 CPR (3d) 272 (TMOB); *Imperial Tobacco Canada Limited v Philip Morris Products SA*, 2013 TMOB 175 (TMOB) para 24, aff'd 2014 FC 1237 para 15-16 and 68; *JTI-Macdonald TM Corp v Imperial Tobacco Products Limited*, 2013 FC 608 para 55].

[46] This means that in order to meet its initial burden under this ground, the Opponent must establish that as of the filing date of the statement of opposition, namely, April 19, 2013, one or more of the Opponent's marks had become known sufficiently to negate the distinctiveness of the Mark, and that its BurgerFi mark(s) reputation in Canada was substantial, significant or sufficient [see *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657, 48 CPR (4th) 427; *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, (2004), 34 CPR (4th) 317 (FC); and *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 at 58 (FCTD)]. In doing so, it is not necessary that the Opponent show that its BurgerFi mark(s) have become well known in Canada in the technical sense of Section 5 of the Act. Indeed, the Opponent may rely on evidence of knowledge or reputation of its mark(s) spread by means of word of mouth and evidence of reputation and public acclaim and knowledge by means of newspaper or magazine articles as opposed to advertising [*Motel 6*, at 58-59].

[47] The Opponent has plead that contrary to section 2 of the Act, the Mark is not distinctive of the Applicant in that it cannot distinguish nor can it be adapted to distinguish the goods and services of the Applicant from the goods and/or services sold and/or provided by the Opponent in association with the Opponent's trade-marks BURGERFI and BURGERFI & Design, both of which have been made known in Canada, and both of which have acquired a reputation among Canadians. More specifically, the Opponent submits the Mark can neither distinguish nor be adapted to distinguish the goods and services of the Applicant, since the Opponent has used its BURGERFI trade-marks extensively in the United States, and those trade-marks had acquired a strong reputation among Canadians [citing *Motel 6*, *supra*].

[48] The Opponent correctly submits that reputation of a trade-mark in Canada can be established through means other than the use of that trade-mark in Canada. In this regard, the Opponent submits that acceptable evidence includes: public acclaim and knowledge through articles or postings [citing *Motel 6*, *supra*]; statistics regarding the number of Canadians

purchasing or using the trade-mark owner's goods or services while travelling outside Canada [citing *Motel 6, supra*]; the trade-mark owner's commercial presence in vacation areas and other cities that are frequented by Canadians [citing *Nature Co v Sci-Tech Educational Inc* (1991), 40 CPR (3d) 184 (FCTD)]; and website hits from Internet users located in Canada [citing *Ace Café London Ltd v Ace Café Toronto Ltd*, 2012 TMOB 219].

[49] With respect to its BURGERFI marks, the Opponent submits that it has established a strong reputation of these marks in Canada through the following evidence:

- a. A significant number of Canadians from across the country have dined at BurgerFi restaurants in Florida, where they would have seen the BURGERFI marks being used prominently (per Lorence affidavit, Exhibits E, F, H, and I);
- b. BurgerFi restaurants have been mentioned on social media by Canadians from various provinces (Lorence affidavit, Exhibit G);
- c. Canadians from various provinces have made inquiries about becoming franchisees of BFI, and promotional material was sent to these potential franchisees (per Lorence affidavit, Exhibit J);
- d. Thousands of Canadian visitors from every single province have visited the BFI website, where the BURGERFI marks are prominently featured (per Oberleitner affidavit, Exhibit B).

[50] The Opponent further submits that in contrast, the Applicant has not met its legal burden to demonstrate that BurgerFi is distinctive of its goods or services, or can be adapted to so distinguish. The Opponent submits that although the Applicant has purported to tender a market research survey pertaining to brand awareness, market research surveys, in order to have any weight, must meet certain criteria [as per the Trade-marks Examination Manual, section IV.12.2.3 on "Survey Evidence"]. The Opponent submits, the Vescio affidavit did not include any of the required criteria, and for this reason alone, the purported survey should be disregarded in its entirety. This, the Opponent submits, is to be contrasted to the Opponent's simple "questionnaire" seeking basic factual information.

[51] The Applicant, on the other hand, submits that the Opponent's evidence is insufficient to support the conclusion that the Opponent's BURGERFI marks have a substantial, significant or even sufficient reputation in Canada. In particular, with respect to the evidence relied upon by the Opponent as noted above, the Applicant responds with the following submissions:

- a. The Opponent's survey was conducted after the material date and is therefore irrelevant to this ground of opposition.
- b. There are only 10 online reviews of the Opponent's BurgerFi restaurants by unverified Canadian reviewers. Furthermore, 10 individuals' awareness of the Opponent's BurgerFi trade-marks is not persuasive evidence of the existence of a reputation in Canada;
- c. Only 34 franchise inquiries were made by individuals who provided unverified Canadian addresses. Even if there was sufficient evidence to show that 34 actual Canadians were sent promotional material prior to the material date, these publications were not targeted to the public at large, but people interested in running a BurgerFi franchise in Canada. Such advertising cannot have any notable impact on the reputation of the Opponent's BURGERFI marks from the standpoint of a Canadian customer at the material time.
- d. Evidence of 3,237 Canadian visits (including 1,699 from Ontario) to the <*burgerfi.com*> website cannot significantly add to the Opponent's BURGERFI trade-marks reputation in Canada or Ontario.

[52] Having weighed the evidence in its entirety, I find that the Opponent's evidence is insufficient for me to conclude that its BurgerFi mark(s) had become known to some extent at least in Canada to negate the distinctiveness of the Mark, and that its BurgerFi mark(s) reputation in Canada was substantial, significant or sufficient as of the material date. In this respect, I agree with the Applicant that 10 online reviews are not persuasive, nor are 34 franchise inquiries. In addition, the Opponent's survey post-dates the material date under this ground of opposition.

[53] The Opponent is asking that its survey results be considered relevant, submitting that the survey needs to be considered in context with the evidence of Canadian visitor statistics to Florida, particularly with respect to the first quarter of each year. In this regard, the Opponent

submits that more Canadians visited Florida in the first quarter in any given year, which covers the period in which BurgerFi administered its in-house survey. Further to this, with respect to the survey's admissibility, the Opponent submits that although the Lorence affidavit refers to it as a survey, it is an in-house questionnaire which is not purporting to be a market research survey; rather, it involves a simple question that does not comprise an opinion survey and is not being offered as an expert opinion.

[54] While the survey question asked does not appear to be asking consumers for their opinions *per se*, the survey or questionnaire must nonetheless meet proper standards of relevance and reliability. In the present case, I am not prepared to afford the survey/questionnaire any weight. In this regard, it was conducted outside of the relevant period, and I am not willing to draw any inferences from this survey, as the Opponent is inviting the Registrar to do, as to the number of Canadian visitors to the Opponent's BurgerFi restaurants prior to the material date. Further to this, the questions asked in the survey do not necessarily capture clear answers as to number of Canadian visitors to the Opponent's BurgerFi restaurants, as the Opponent purports. For example, the number of Canadian visitors recorded could include non-Canadian individuals simply accompanying the survey respondents as members of their dining party. The results do not disclose a large number of Canadian patrons to begin with, which number could be much smaller. In any event, while this evidence may show that some Canadians had used the Opponent's services in the United States and had therefore been exposed to the Opponent's mark(s), I agree with the Applicant that it does not speak to whether these customers had any recollection of the Opponent's mark(s) such that any reputation in Canada could be inferred [see *Bojangles, supra* at para 52].

[55] Lastly, statistics on hits to an opponent's website by Canadians without other evidence relating to reputation in Canada (eg – sales or advertising directly related to the Canadian marketplace), has been held to be insufficient to support a finding that the mark had become known sufficiently in Canada to negate the distinctiveness of the Mark [see *River Island Clothing Co v International Clothiers Inc*, 2013 TMOB 88, at para 39]. Furthermore, the decision in *Ace Bakery, supra* relied upon by the Opponent with respect to reputation of a mark in Canada supported by evidence of website hits from Internet users located in Canada, is clearly distinguishable. In that case, there were over 19,000 such hits from Canada, with further

supporting evidence of emails generated from the subject website confirming delivery of merchandise to Canadian addresses. In the present case, the number of new hits to the Opponent's BurgerFi website is far less than 19,000, and indeed, is even significantly less than the 5,000-40,000 website hits that was deemed insufficient in *River Island, supra*.

[56] Furthermore, any inferences that can be drawn with respect to Canadians having patronized the Opponent's BurgerFi restaurants in the United States is far less compelling than the cases of *Motel 6, supra*, *Brown Group, Inc v St Thomas Marketing Inc*, 1996 CanLII 113398 and *Nature Co, supra* cited by the Opponent. In both the *Motel 6* and *Brown Group* case, for example, there was clear evidence of significant sales to Canadians, with each entity involved operating 300 chain locations, many of which were in close proximity to the Canadian border. Likewise, in *Nature Co*, the plaintiff had 69 stores in the US, with collaborative evidence of significant sales to Canadians.

[57] While a mark need not be well known and it is sufficient to show that a mark is known at least to some extent in Canada and that its reputation in Canada was substantial, significant or sufficient, the evidence in the present case, for the reasons discussed above, falls short of that threshold. Consequently, the ground of opposition based upon non-distinctiveness of the Mark is dismissed as the Opponent has failed to meet its burden under this ground.

Disposition

[58] Having regard to the foregoing, 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.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

Hearing Date: 2015-12-03

Appearances

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For the Applicant

Agents of Record

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