



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

**Citation: 2016 TMOB 137**  
**Date of Decision: 2016-08-05**

**IN THE MATTER OF AN OPPOSITION**

**DUKE UNIVERSITY**

**Opponent**

**and**

**SIR Corp.**

**Applicant**

**1,581,948 for DUKES REFRESHER &  
Design**

**Application**

**I Background**

[1] The Opponent is a private university with its main campus in Durham, North Carolina. It is the owner of the mark DUKE, in respect of which the Registrar gave public notice of adoption and use under application Nos. 914701 (December 4, 2002) and 905675 (March 24, 1993), pursuant to section 9(1)(n)(ii) of the *Trade-marks Act*.

[2] The Applicant is a Canadian corporation that owns and operates a portfolio of restaurants in Canada. It applied to register the trade-mark DUKE'S REFRESHER & Design (as shown below), on June 13, 2012.



(the Mark)

[3] The application for the Mark is based upon proposed use in Canada and it covers “restaurant services”.

[4] The Opponent has opposed the application for the Mark on the basis that it is not registrable under section 12(1)(e) of the Act, as it is a mark, the adoption of which is prohibited by section 9 (1)(n)(ii) of the Act, in view of the publication of the Opponent’s mark DUKE under application Nos. 914701 and 905,675 (hereinafter collectively referred to as the DUKE mark).

[5] For reasons that follow, the opposition is rejected.

## **II Onus**

[6] 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 its ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29 (CanLII), 20 CPR (4th) 155].

## **III Evidence**

[7] I will proceed to provide a brief overview of the parties’ evidence in this proceeding. However, I note that much of it is irrelevant in assessing a ground of opposition based upon sections 12(1)(e) and 9(1)(n)(ii) of the Act. None of the affiants was cross-examined.

*Opponent's Evidence*

*Affidavit of James Earl Wilkerson*

[8] Mr. Wilkerson is the Director of Trademark Licensing and Store Operations at Duke University. His affidavit was sworn on July 14, 2014 and it provides background information on the Opponent, its graduate and undergraduate programs, its sports teams, store operations, reputation and use of DUKE.

[9] As part of its evidence, the Opponent has also filed certified copies of application Nos. 905675 and 914701 for the DUKE mark.

*Applicant's Evidence*

*Affidavit of Patrick Balzamo*

[10] Mr. Balzamo is a Research Analyst. His affidavit was sworn on June 24, 2015. It provides details pertaining to Canadian common law and web common law dilution searches he performed for the word DUKE for all goods and services. The common law search considers the extent to which the word DUKE appears in trade-names and company names in Canada. The web common laws search considers the extent to which DUKE appears in trade names and company names on the Internet in Canada. The results of his searches are attached as Exhibit A to his affidavit. Exhibit B consists of a list of the specific Canadian and web common law sources and business name registers that he consulted in conducting his searches, as well as brief descriptions of those sources, their geographical scopes and the approximate frequency at which they are updated.

[11] According to the Applicant, Mr. Balzamo's searches located a fairly large number of company names/trade-names and trade-marks incorporating the terms DUKE, DUKES or DUKE'S [paras 7 and 8; Exhibits A-1 and A-2]. In addition, his searches also identified several definitions for the word DUKE, some of which include, a man of very high rank in the British nobility, the ruler of an independent area of land especially in some parts of Europe in the past, a first name or nickname of an individual or a surname of an individual [para 7; Exhibit A-1].

*Affidavit of Aleksandar Vukovic*

[12] Mr. Vukovic is a trade-mark searcher employed by the agent for the Applicant. His affidavit was sworn on June 8, 2015. It provides the results of a search of the Canadian trade-marks database for applications and registrations for marks consisting of or containing the word DUKE. He located 39 such marks, the particulars of which are attached as Exhibit A to his affidavit.

[13] I will not discuss the results in detail as it has previously been held that the state of the register is not relevant when determining a ground of opposition based on section 9 of the Act, where the issue is simply whether an applicant's trade-mark consists of or so nearly resembles a mark as to be likely to be mistaken for it [*Concordia University v 649643 Ontario Inc*, 2006 CanLII 80381 (TMOB); *Canadian Olympic Association v IMI Norgren Enots Ltd.* (1989), 23 CPR (3d) 389 (TMOB)].

*Affidavit of Kim Anna Van Nieuwkoop*

[14] Ms. Van Nieuwkoop is General Counsel of the Applicant. Her affidavit was sworn on June 4, 2015 and it provides background on the Applicant, its restaurant operations and its use of the Mark. Notably, it also includes a statement that in her experience, customers associate the Mark with the Applicant's restaurant services and that she is not aware of any instance in which any member of the public or otherwise has questioned, suggested or believed that the Mark or the Applicant's business in general was owned by, associated with, authorized by or otherwise connected with Duke University [para 10].

[15] I do not consider this evidence to be of assistance to the Applicant, as the test under section 9 of the Act is not concerned with whether consumers, upon seeing the Mark, would believe that it was owned by, associated with, authorized by or otherwise connected with Opponent. Rather, as previously indicated, the issue in this case is whether the Mark consists of or so nearly resembles the DUKE mark, as to be likely to be mistaken therefor. Source confusion is not the issue in this case.

[16] Furthermore, I note that marketplace considerations such as the goods or services of the parties, or their trades, are not relevant considerations in determining whether a mark is one, the adoption of which, is prohibited under section 9 of the Act [*Canada Post Corp v 736217 Ontario Ltd* (1993), 51 CPR (3d) 112 (TMOB) at 122; *WWF-World Wide Fund for Nature v 676166 Ontario Ltd* (1992), 44 CPR (3d) 563 (TMOB) at 567; *Ontario Lottery Corp v Arkay Marketing Associates Inc* (1993), 47 CPR (3d) 398 (TMOB) at 401; and *Ontario Federation of Anglers and Hunters v Upper Canada Specialty Hardware Ltd* (1992), 41 CPR (3d) 428 (TMOB) at 431].

#### **IV Analysis**

[17] The Opponent has pleaded that the Mark is not registrable having regard to the provisions of section 12(1)(e) of the Act in that it is a mark, the adoption of which is prohibited by section 9(1)(n)(ii) of the Act.

[18] Section 9(1)(n)(ii) of the Act is reproduced below:

9(1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for...

(n) any badge, crest, emblem or mark...

(ii) of any university...

...in respect of which the Registrar has, at the request of Her Majesty or of the university...given public notice of its adoption and use.

[19] The material date for assessing this ground of opposition is the date of my decision [*University of Texas System v Texas Longhorn Café Inc* (1992), 42 CPR (3d) 211 (TMOB) at 215].

[20] In support of this ground, the Opponent relies upon application Nos. 914701 and 905675 for DUKE. I have exercised my discretion and checked the register to confirm that each of these marks are extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)].

[21] The Opponent has therefore met its initial burden with respect to this ground. Accordingly, I must go on to determine whether the Applicant has established, on a balance of probabilities, that its Mark is not a mark, the adoption of which, is prohibited under section 9(1)(n)(ii).

[22] As stated in section 9(1)(n)(ii) of the Act, the test to be applied is whether or not an applicant's mark consists of, or so nearly resembles as to be likely to be mistaken for, the badge, crest, emblem or mark of a university.

[23] The case law has interpreted “consisting of” in section 9 to mean “identical to”. In the present case, the Mark is clearly not identical to the Opponent’s DUKE mark. Accordingly, the issue becomes whether the Mark so nearly resembles the Opponent’s mark as to likely be mistaken therefor [*Insurance Corp of British Columbia v Stainton Ventures Ltd* (2014), 128 CPR (4th) 303 (BCCA) at 312; *Terrace v Canadian Pacific Phytoplankton* (2013), 114 CPR (4th) 81 (TMOB) at 88; *Canada Post Corp v Butterfield & Daughters Computers Ltd* (2008), 68 CPR (4th) 280 (TMOB) at 292; *University of Texas supra* at 218].

[24] The case law indicates that the resemblance between the marks should be assessed as a matter of first impression and imperfect recollection, having regard to the factors set out in section 6(5)(e) of the Act, namely, the degree of resemblance between the marks in appearance, sound and idea suggested [*Big Sisters Assn of Ontario v Big Brothers of Canada* (1999), 86 CPR (3d) 504 (FCA), affirming (1997), 75 CPR (3d) 177 (FCTD) and *Canadian Council of Professional Engineers v APA-The Engineered Wood Assn* (2000), 7 CPR (4th) 239 (FCTD); *Canada Post supra* at 292; *London Regional Transport v Planet Luv-Tron, Inc* (2004), 45 CPR (4th) 348 (TMOB) at 351-352; *WWF-World Wide Fund for Nature supra* at 567].

[25] At the hearing, the Opponent made reference to the Supreme Court of Canada decision in *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)]. In that decision, the Court observed that while the first word of a trade-mark may be the most important for purposes of distinction [*Conde Nast Publications v Union des Editions Modernes* (1979), 46 CPR (2d) 183 (FCTD)], the preferable approach is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[26] The Opponent points out that its DUKE mark consists solely of the word DUKE and submits that since that is the only element that is present in the mark, it must be the most distinctive. The Opponent further points out that in the Mark, the word DUKE'S appears in the dominant first position and in much larger font than the remaining elements in the Mark. The Opponent is of the view that this gives the impression that DUKE'S is also the most distinctive or important part of the Mark. The Opponent therefore argues that parties' marks are visually and phonetically similar to one another, as a matter of first impression.

[27] With respect to the ideas suggested by the parties' marks, the Opponent submits that the fact that DUKE'S has an apostrophe in it in the Mark indicates a possessive form, thereby narrowing the possible interpretations that can be given to the Mark as a matter of first impression. The Opponent submits that because the mark is in the possessive form, it conveys the idea of a person who is either a "duke" or who is named "Duke". Either way, the Opponent submits that both parties' marks may be said to convey the same message.

[28] Even if I accept that DUKE and DUKE'S are the dominant parts of both of the parties' marks and that they may be said to be similar or the same in terms of connotation, I am of the view that when the marks in question are viewed as a whole, as they should be, they are quite different and readily distinguishable from one another.

[29] As the Applicant has pointed out, the only similarity between the marks is that the Mark includes the word DUKE'S, which incorporates the Opponent's DUKE mark. Otherwise, the marks in question do not sound or look alike. The Mark would be sounded as DUKE'S REFRESHER, rather than as DUKE and it features a fairly distinctive design element, including a swimmer wearing a swim suit and cap, lines and stylized font. The swimmer is partially superimposed over the word DUKE'S and the word REFRESHER appears below. In my view, the swimmer and the word REFRESHER in the Mark serve to create a different overall visual and phonetic impression. In addition, they result in the Mark having a different connotation, as the word REFRESHER, coupled with a swimmer suggests the idea of something refreshing, like swimming, water, a drink or perhaps a place for such things.

[30] In view of the foregoing, when considering the parties' marks in their entirety and as a matter of first impression, I find the resemblance between them in appearance, sound and idea

suggested insufficient to result in the Mark being likely to be mistaken for the Opponent's DUKE mark.

[31] Accordingly, the opposition is unsuccessful.

#### **IV Disposition**

[32] In view of 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.

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Lisa Reynolds  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office



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

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**HEARING DATE:** 2016-07-14

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