



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

Citation: 2011 TMOB 231
Date of Decision: 2011-11-30

**IN THE MATTER OF AN OPPOSITION
by Don Cullen to application
No. 1,283,166 for the trade-mark
BOHEMIAN EMBASSY in the name of
Triple Canon Corporation**

[1] On December 15, 2005, Triple Canon Corporation (the Applicant), filed an application to register the trade-mark BOHEMIAN EMBASSY (the Mark) based upon proposed use of the Mark in Canada. The statement of wares/services currently reads:

Wares:

(1) Buildings, namely, residential houses and condominium buildings, (2) Promotional materials, namely flags, brochures, business forms, caps, t-shirts, golf wear, jackets and signage; (3) Publications, namely new home construction publications (4) Architectural models.

Services:

(1) Construction services, namely, residential and commercial property building, road and street paving; (2) Contracting services, namely, building construction; (3) development of land; (4) land development services for third parties; (6) Advertising agency services, namely, promotional services for third party builders and new homes, through printed material, promotional contests, audio, video and internet media; (7) Consulting services, namely sales promotion advice to third parties.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of May 30, 2007.

[3] On July 18, 2007, Don Cullen (the Opponent) filed a statement of opposition against the application. The grounds of opposition, as amended, are that the Applicant's application does not conform to the requirements of s. 30(i) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act), the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) and (c), and the Mark is not distinctive. Each of these grounds is based on confusion with the Opponent's use of its BOHEMIAN EMBASSY trade-mark and trade-name in association with the operation of a coffee house, and the organization and promotion of literary, musical, dramatic and artistic events.

[4] The Applicant filed and served a counter statement, in which it denied the Opponent's allegations.

[5] The Opponent's evidence consists of the affidavits of Don Cullen, Dane Penney and Christopher Valley Ban. Both Mr. Cullen and Mr. Ban were cross-examined on their affidavits and the cross-examination transcripts and exhibits form part of the record. The Applicant's evidence consists of the affidavit of Tony Canonaco. Mr. Canonaco was not cross-examined.

[6] Neither the Applicant nor the Opponent filed a written argument but both were represented at an oral hearing.

Onus and Material Dates

[7] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is however an initial burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.).]

[8] The material dates that apply to the grounds of opposition are as follows:

- s. 30 - the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.) at 475];
- s. 16(3) - the filing date of the application [see s. 16(3)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

History of the Opponent's Mark

[9] The history of the BOHEMIAN EMBASSY mark of the Opponent, as I understand it from the evidence presented to me, is as follows.

[10] The first BOHEMIAN EMBASSY coffee house opened in 1960 on Nicholas Street in Toronto, Ontario, and operated at that location until 1966. It was a venue where Canadian musicians, writers, poets and other artists were discovered and encouraged. For example, it featured musical performances by Ian and Sylvia, Gordon Lightfoot and Joni Mitchell, and literary readings by Margaret Atwood, Gwendolyn McEwan, Michael Ondaatje and John Robert Colombo, among others. While Mr. Cullen claims to have been the founder of this coffee house (see Cullen cross-ex, q. 58), he later states at q. 83 that he started the BOHEMIAN EMBASSY coffee house with Ted Morris and three other partners. Mr. Cullen was, however, involved with booking talent and with the day to day running of the place (q. 120).

[11] Although Mr. Cullen admits on cross-examination that he never spent a nickel advertising the existence of the BOHEMIAN EMBASSY at the Nicholas Street location (q. 187), he does maintain that the mark appeared on flyers (q. 117), was on a sign displayed in front of the building (q. 170-171), was marked on posters (q. 179), was referenced in newspaper and radio publicity (q. 185-189) and also appeared on membership badges that were given out to between 10,000 and 15,000 people (q. 198-201).

[12] From 1974 until 1976, the BOHEMIAN EMBASSY coffee house was located on the Toronto Harbourfront. Once again, Mr. Cullen was very involved in the hands-on operation of the location (q. 327) but he had a partner named Roy Woodsworth who looked after other details such as contracts (q. 327). The events held at this location were free of charge (q. 345). The

Harbourfront management board printed out brochures advertising events at this location (q. 339-341). Mr. Cullen was paid a salary (q. 317, q.333) and he reported to various supervisors (q. 354-364).

[13] From 1983 until 1984, Mr. Cullen claims that musical performances, literary readings and plays were broadcast in a CBC radio show in association with the BOHEMIAN EMBASSY mark. CBC advertised the show, decided which entertainers would appear, and paid Mr. Cullen a salary for his role in the show (q. 410, 414, 415, 417-419). Mr. Cullen admitted at q. 414 and q. 415 of his cross-examination transcript that he did not control any aspect of the show.

[14] Mr. Cullen further states that he and four others decided to open another edition of the BOHEMIAN EMBASSY on Queen Street between 1991 and 1992. This location was advertised through posters (q. 461-463) and ads in the NOW magazine (q. 465-469). Mr. Cullen later admits that this location was a failure because it did not attract enough attention to become viable as a business (q. 480).

[15] The Opponent claims that it has held BOHEMIAN EMBASSY nights and engagements between April 18, 2001, and May 2008. These evenings have been held at various locations in and around Toronto including the Artwood Theatre, a bar in Toronto known as Hugh's Room, the Performing Arts Lodge, the Tranzac Club, the Arts and Letters Club and the Mariposa Festival and have featured similar types of entertainment as were offered at the original BOHEMIAN EMBASSY locations, including poetry readings and folk singers. Mr. Cullen is not always paid for these engagements. At least one of these evenings was a fundraiser for the Humanist Association at the Artwood Theatre (q. 525) and was advertised through both the Humanist Association newsletter and website (q. 529) and through Ron Weihs and Judith Sanford who ran the Artwood Theatre (q. 535). There is very little other information about how the Opponent's mark was used in association with the performance or advertising of these services. Even if it could be shown to have been used, it is not clear that such use enured to the benefit of Mr. Cullen.

[16] Mr. Cullen wrote a book about his coffee house entitled BOHEMIAN EMBASSY (a copy of which was attached as Exhibit A to his affidavit) and such book was released in 2007. Mr. Ban approached Mr. Cullen about making a documentary about the BOHEMIAN

EMBASSY in 2001. As of the date of Mr. Ban's cross-examination, the documentary had not been completed.

Section 16 Grounds of Opposition

[17] The Opponent has pleaded that the Applicant is not the person entitled to registration pursuant to s. 16(3)(a) and s. 16(3)(c) of the Act on the basis that the Mark is confusing with the trade-mark and trade-name BOHEMIAN EMBASSY previously used in Canada by the Opponent in association with, *inter alia*, the operation of a coffee house, and the organization and promotion of literary, musical, dramatic and artistic events.

[18] The evidential burden on the Opponent under this entitlement ground is two-fold:

1. the Opponent must demonstrate use of its mark or name prior to December 15, 2005; and
2. the Opponent must establish non-abandonment of its mark or name as of the date of advertisement of the Applicant's application.

[19] In order to show use of a mark in association with services, the evidence must satisfy the test set out in s. 4(2) of the Act. Section 4(2) states as follows:

A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

The Opponent must therefore provide assertions of fact and documentary evidence showing that the services were performed and how the BOHEMIAN EMBASSY mark was displayed in association with the performance or advertising of the services.

[20] There are no provisions in the Act which define and describe the use of a trade-name. However, in his decision in *Professional Publishing Associates Ltd. v. Toronto Parent Magazine Inc.* (1986), 9 C.P.R. (3d) 207, Mr. Justice Strayer considered the problem and held that the principles in s. 2 and 4(1) of the Act apply to trade-name use, saying:

While there is no definition in the *Trade Marks Act* of "use" in relation to trade names, I am satisfied that consistent with the purposes of the Act such "use" would have to be in the normal course of trade and in relation to the class or classes of persons with whom such trade is to be conducted.

[21] The present case is somewhat unusual because, while the Opponent alleges that it has used the BOHEMIAN EMBASSY mark intermittently in association with the above noted services since 1960, the Opponent has not provided any examples of advertising, signage or telephone listings showing how the BOHEMIAN EMBASSY mark was displayed in association with such services. Further, the Opponent has not provided any invoices or sales figures pertaining to such services.

[22] What the Opponent has provided to support its allegations of use include: the testimony of Mr. Cullen about how the BOHEMIAN EMBASSY mark was used in association with the advertising and performance of the Opponent's services since 1960, the testimony of Mr. Ban about his knowledge about the BOHEMIAN EMBASSY coffee house, a copy of the book entitled BOHEMIAN EMBASSY written by Mr. Cullen about the coffee house and entertainment services provided in association with it, the evidence of Mr. Ban regarding the production of a documentary film entitled BOHEMIAN EMBASSY, and the results of Internet searches conducted by Mr. Penney for the terms Bohemian Embassy and Don Cullen.

[23] From the evidence furnished, I am prepared to conclude that the above noted services were performed in Canada in association with the BOHEMIAN EMBASSY trade-mark prior to the Applicant's filing date. I am not satisfied, however, that the Opponent has shown how BOHEMIAN EMBASSY has been used as a trade-name or has been used or displayed as a trade-mark by the Opponent in association with the Opponent's services pursuant to s. 4(2) of the Act. A trade-mark is defined in the Act as "a mark that is use used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others." In my view, if the Opponent's mark has been used for the purpose of distinguishing the Opponent's services from those of others on an intermittent basis between 1960 and the date of advertisement of the Applicant's mark (i.e. May 30, 2007), the Opponent should have been able to produce at least one example of how its mark was displayed in association with the

Opponent's services to corroborate such assertion. As a result, I do not find that the Opponent has met its evidential burden under this ground of opposition and it is therefore not successful.

Distinctiveness Ground of Opposition

[24] The Opponent pleaded its distinctiveness ground as follows:

“Pursuant to s. 38(2)(d), the Trade Mark is not distinctive, within the meaning of s.2, by reason of the fact that the Trade Mark neither actually distinguishes nor is adapted to distinguish the wares and services in association with which it is proposed to be used from the wares and services of the Opponent.”

[25] The legal onus is on the Applicant to show that its mark is adapted to distinguish or actually distinguishes its services from the services of others throughout Canada [see *Muffin Houses Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272 (T.M.O.B.)]. However, there is an evidential burden on the Opponent to prove the allegations of fact supporting its ground of non-distinctiveness. While the Opponent need not show that its trade-mark is well known in Canada in order to meet this evidential burden [see *Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 (F.C.T.D.)], its mark must be known to some extent at least to negate the established distinctiveness of another mark, and its reputation in Canada should be substantial, significant or sufficient [*Bojangles' International LLC v. Bojangles Café Ltd.* (2006), 48 C.P.R. (4th) 427 (F.C.)]. Further, the Opponent's use of its mark need not qualify as trade-mark use within the scope of s. 4 of the Act in order to be relied upon in challenging the distinctiveness of the Applicant's Mark [*Mutual Investco Inc. v. Knowledge is Power Inc.*, 14 C.P.R. (4th) 117].

[26] Evidentiary limitations aside, the totality of evidence from Mr. Cullen, Mr. Ban and Mr. Penney is sufficient for me to be satisfied that the BOHEMIAN EMBASSY mark had acquired a reputation in Canada prior to July 18, 2007. However, while the BOHEMIAN EMBASSY mark may have been sufficiently known in Canada by the relevant date, the Opponent has failed to evidence that the use accrues to its benefit pursuant to s. 50(1) of the Act and that the trade-mark has become sufficiently known as the Opponent's trade-mark [see *Créations Méandres Inc. v. Xentel DM Incorporated* (February 3, 2005 T.M.O.B. (unreported), application No. 780,430)].

The Opponent has therefore failed to meet its evidential burden under this ground and this ground is unsuccessful.

[27] Even if the Opponent had met its initial onus, the distinctiveness ground of opposition fails for the following reasons.

[28] As noted above, the legal burden is on the Applicant to satisfy the Registrar that its Mark is capable of distinguishing its wares and services throughout Canada. Specifically, the onus is on the Applicant to establish that there is no likelihood of confusion between the parties' marks.

test for confusion

[29] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the wares, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight [see, in general, *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al.* (2006), 49 C.P.R. (4th) 401].

[30] Recently, in *Masterpiece Inc. v. Alavida Lifestyles Inc.* (2011), 96 C.P.R. (4th) 361 (S.C.C.) [*Masterpiece*], the Supreme Court of Canada discussed the importance of the s. 6(5)(e) factor in conducting an analysis of the likelihood of confusion between the parties' marks in accordance with s. 6 of the Act (see para 49):

...the degree of resemblance, although the last factor listed in s. 6(5), is the statutory factor that is often likely to have the greatest effect on the confusion analysis ... if the

marks or names do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion. The other factors become significant only once the marks are found to be identical or very similar... As a result, it has been suggested that a consideration of resemblance is where most confusion analyses should start...

[31] Under the circumstances of the present case, I consider it appropriate to analyze the degree of resemblance between the parties' marks first.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[32] The parties' marks are identical in all respects.

[33] Having found that the parties' marks are identical, I must now assess the remaining relevant surrounding circumstances to determine whether any of these factors are significant enough to shift the balance of probabilities in favour of the Applicant [see *Masterpiece*, supra, at para. 49].

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[34] Both of the parties' marks are inherently distinctive.

[35] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The evidence of the Opponent shows that its mark has become known to some extent in Canada, and particularly in Toronto, prior to the material date.

[36] The evidence of the Applicant's affiant, Mr. Canonaco, establishes the following:

- from approximately August, 2006 to the date of his affidavit, the Applicant, by itself and through its licensee Baywood Homes, has been continuously using the Mark in association with the Applicant's services and in particular a residential condominium property located at 1171 Queen St. W. in Toronto;
- 278 units had been sold by the date of his affidavit, generating revenue in excess of \$65 million;

- approximately 120,000 copies of flyers, brochures and information sheets promoting the sale of units in the property have been distributed by direct mail and by e-mail to real estate agents and brokerages in Canada since September 2006 (examples of which are attached as Exhibits 5-13 of Mr. Canonaco's affidavit);
- the Mark has been displayed on signage located at the sales office (see Canonaco Affidavit, Exhibit 14);
- units in the property have been extensively advertised in print periodicals circulated in Toronto including Condo Life, FAB Magazine, Condo Guide, Home Builders Annual, Metro News, Condo Life and Dream Homes between 2006 and November, 2008 (information regarding the volume of circulation of the periodical publications is attached as Exhibit 30);
- 10,000 people visited Baywood's website www.bohemianembassy.ca between September 2007 and September 2008; and
- in order to promote the Applicant's services, the Applicant, by itself or through Baywood Homes, has spent in excess of \$5.5 million on advertising, marketing and promotion of the Applicant's services since 2006.

[37] I therefore find that the Mark has also become known in Canada, and particularly in Toronto, as of the date of opposition.

s. 6(5)(b) - the length of time each trade-mark has been in use

[38] The Opponent's mark has become known in association with the above noted services since the 1960s. As the Applicant only began using its mark in 2006, I consider this factor to favour the Opponent.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[39] The applied for wares and services all relate to the construction and real estate development of the Applicant's condominium buildings on Queen St. in Toronto. The

Opponent's services, on the other hand, include the operation of a coffee house (where entertainment is the primary function), musical performances, literary readings and plays.

[40] I agree with the Applicant that there is a complete absence of connection between the parties' wares and services. The Opponent's services comprise the provision of entertainment while the Applicant's wares and services pertain to real estate development. Mr. Cullen even admitted twice on cross-examination that the Opponent had nothing to do with real estate development (q. 608 and 609). The parties' channels of trade therefore do not overlap.

conclusion re likelihood of confusion

[41] The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees BOHEMIAN EMBASSY in association with the Applicant's real estate development and construction services and related wares at a time when he or she has no more than an imperfect recollection of the Opponent's BOHEMIAN EMBASSY trade-mark, and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot*].

[42] Having considered all of the surrounding circumstances, I find that the Applicant has satisfied its onus to show that, on a balance of probabilities, confusion between the marks is unlikely. This is because of the differences between the Opponent's services and the Applicant's wares and services, and between their respective channels of trade. Even though the marks are the same, and even if the use of the Opponent's mark by others did accrue to the Opponent's benefit for the purposes of s. 50(1), the fact that the Opponent's reputation lies in the entertainment field, combined with the fact that the Opponent's services include the operation of a coffee house and the organization and promotion of literary, musical, dramatic and artistic events, makes it seem unlikely that the average consumer would think that the Applicant's construction and real estate wares and services emanate from the Opponent. I am therefore satisfied that the Applicant has met its legal burden of demonstrating that its Mark has been capable of distinguishing its wares and services as of July 18, 2007.

[43] The s. 38(2)(d) ground of opposition therefore fails.

Section 30(i) Ground of Opposition

[44] The Opponent has pleaded that the application does not conform to the requirements of s. 30(i) of the Act because the Applicant cannot be satisfied that it is entitled to use the Mark in Canada in association with the wares and services covered by the application because the Applicant was or should have been aware of the prior rights of the Opponent in the BOHEMIAN EMBASSY trade-mark and trade-name.

[45] Where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155] I note that the Applicant in the present case has made the requisite statement and there is no evidence that it did so in bad faith. I am therefore dismissing this ground of opposition.

Disposition

[46] 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.

Cindy R. Folz
Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office