

IN THE MATTER OF AN OPPOSITION
by Hard Rock Cafe Limited to
application No. 572,635 for
the trade-mark HOT ROCK filed
by Ulrich Hustert

On November 12, 1986, the applicant, Ulrich Hustert, filed an application to register the trade-mark HOT ROCK based on proposed use in Canada for the following wares:

 serving platters cut from stone and supported
 in a basket

and for the following services:

- (1) provision of restaurant services to the public
- (2) serving of meals on stone platters contained
 in a basket.

The application was amended to include a disclaimer to the word ROCK and was subsequently advertised for opposition purposes on November 2, 1988.

The opponent, Hard Rock Cafe Limited, filed a statement of opposition on March 2, 1989, a copy of which was forwarded to the applicant on March 14, 1989. The grounds of opposition include, among others, that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark HARD ROCK CAFE & Design (illustrated below) registered under No. 301,896 for the "operation of a restaurant and bar" and for the following wares:

- (1) T-shirts, scarves, hats, baseball caps, sweatshirts, kimonos, sportswear, namely sweatpants, headbands, toques, visors and golf shirts, shorts, underwear
- (2) visors, lapel pins, lapel buttons, towels, belt buckles
- (3) expanded polystyrene beer coolers, glassware namely drinking glasses, porcelain beer steins, drink coasters, coffee mugs, ashtrays
- (4) pennants, key chains, umbrellas, pens, lighters
- (5) socks, stationery namely notebooks, writing paper, letter paper and note paper, stickers, pencils, school supplies namely pencil cases, rulers and binders, mirrors, dresses, chinaware namely souvenir plates and cups, posters, jackets and coats.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavit of Nicholas L. Bitove. The applicant did not file evidence. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

As for the ground of opposition based on Section 12(1)(d) of the Act, the material

time for considering the circumstances respecting the issue of confusion with a registered trade-mark is as of the date of my decision: see the unreported opposition decision in The Conde Nast Publications Inc. v. The Canadian Federation of Independent Grocers (S.N. 584,296; July 31, 1991). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The opponent's mark HARD ROCK CAFE & Design is inherently distinctive in relation to both the wares and services set forth in registration No. 301,896. The mark is, however, somewhat suggestive of restaurant and bar services in view of the word CAFE.

The Bitove affidavit evidences fairly extensive revenues for the period 1978 to 1989 for the opponent's restaurant and bar located in Toronto. The Bitove affidavit also evidences advertising expenditures which appear to relate primarily to radio advertisements. I am thus able to conclude that the opponent's mark has become known in Toronto and surrounding areas in association with the opponent's restaurant and bar.

The Bitove affidavit also evidences more recent sales figures for the wares listed in registration No. 301,896. However, Mr. Bitove did not provide a breakdown of those sales figures. Thus, it is difficult to determine the extent to which the opponent's mark has become known for any particular item.

The applicant's mark is less inherently distinctive than the opponent's mark. The words HOT ROCK are suggestive of serving platters cut from stone and are also somewhat suggestive of restaurant services where such platters are used. There being no evidence from the applicant, I must conclude that its mark has not become known at all in Canada.

The length of time the marks have been in use clearly favors the opponent. The services of the parties are similar if not identical. The opponent's registration covers the operation of a restaurant and bar and the applicant's services are related to the operation of a restaurant. Presumably the trades of the parties would also be similar.

There appears to be an overlap in the wares of the parties. The applicant's proposed wares are serving platters. The opponent's registration includes such items as drinking glasses, coffee mugs, beer steins and "chinaware namely souvenir plates and cups." The applicant has submitted that the opponent's wares are simply promotional items for its restaurant and bar operation. Even if that is so, there is nothing to preclude the sale of the applicant's "serving platters" and the opponent's glassware and chinaware through the same stores. In any event, the wares listed in the opponent's registration are not limited to any particular manner of sale: see the decisions in Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at 112 (F.C.A.). Thus, I must conclude that the trades of the parties in relation to their respective wares would, or could, be similar.

As for Section 6(5) (e) of the Act, I consider there to be some degree of visual resemblance between the marks since the second word in each is identical and the first word in each is a single syllable word commencing with the letter "h." The marks differ in some respects, particularly due to the word CAFE and the design component used in the

opponent's mark. The degree of phonetic resemblance, on the other hand, is greater since the phrases HOT ROCK and HARD ROCK sound similar and the design component of the opponent's mark is of no relevance in a phonetic comparison of the marks. The ideas suggested by the marks could be similar, both arguably referring to rock music.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the resemblance between the wares, services and marks of the parties, I find that I am left in a state of doubt regarding the issue of confusion. Since the onus or legal burden is on the applicant, I must resolve my doubt against the applicant. Consequently, the ground of opposition based on Section 12(1) (d) of the Act is successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 29th DAY OF November, 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.