



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

**Citation: 2016 TMOB 134**  
**Date of Decision: 2016-07-29**

**IN THE MATTER OF OPPOSITIONS**

**Revenue Properties Company Limited**

**Opponent**

**and**

**Colonnade Restaurant (Ottawa) Limited**

**Applicant**

**1,526,570 for COLONNADE PIZZA**

**Applications**

**1,529,639 for COLONNADE**

**RESTAURANT**

**1,526,571 for CAFÉ COLONNADE**

**1,529,637 for THE COLONNADE**

[1] Revenue Properties Company Limited (the Opponent) opposes registration of the trade-marks COLONNADE PIZZA, COLONNADE RESTAURANT, CAFÉ COLONNADE, and THE COLONNADE, which are the subject of application Nos. 1,526,570, 1,526,639, 1,526,571, and 1,529,637 respectively (sometimes hereafter referred to as the COLONNADE Marks).

[2] Application Nos. 1,526,570 (COLONNADE PIZZA) and 1,526,571 (CAFÉ COLONNADE) were filed on May 6, 2011 on the basis of use in Canada since at least as early as 1997 and 1967 respectively, in association with *restaurant services*. The remaining application Nos. 1,526,639 (COLONNADE RESTAURANT) and 1,529,637 (THE

COLONNADE) were filed on May 30, 2011 on the basis of use in Canada since at least as early as May 27, 2011, also in association with *restaurant services* (the Services).

[3] The Opponent has opposed the applications for the above trade-marks on the basis that: (i) the applications do not conform to the requirements of section 30 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act); (ii) the trade-marks are not registrable under section 12(1)(d) of the Act; (iii) the Applicant is not entitled to registration of the trade-marks under section 16 of the Act; and (iv) the trade-marks are not distinctive under section 2 of the Act. The last three grounds of opposition revolve around the likelihood of confusion between the Applicant's COLONNADE Marks and the following trade-mark (registration No. TMA247,272) and trade-name of the Opponent:

- THE COLONNADE – used in association with the services: “*Establishing, maintaining and leasing multiple and diversified merchandise, commercial, entertainment and residential facilities and services in connection with a building embracing the establishment and maintenance of an apartment building, commercial space and retail stores for the use of the public together with related shopping, parking and other conveniences*” (the Opponent's Services).

[4] For reasons that follow, I reject the oppositions.

#### The Record

[5] The Marks were all advertised for opposition purposes in the *Trade-marks Journal* dated December 28, 2011.

[6] On February 28, 2013, the Opponent filed statements of opposition to oppose each of the Marks under section 38 of the Act. The Applicant then filed and served its counter statements on May 14, 2013.

[7] In support of its oppositions, the Opponent filed a certified copy of its Canadian trade-mark registration No. TMA247,272, an affidavit of Paul Miatello, sworn September 16, 2013, and an affidavit of Dane Penney, sworn September 13, 2013.

[8] In support of its applications, the Applicant filed an affidavit of Peter Dahdouh, sworn February 24, 2014.

[9] The evidence filed in all four oppositions is identical.

[10] No cross-examinations were conducted.

[11] While only the Opponent filed written arguments, both parties attended an oral hearing.

#### Onus and Material Dates

[12] The Applicant bears the legal onus of establishing that, on a balance of probabilities, its applications comply with the requirements of the Act. There is, however, an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298; *Dion Neckwear Ltd v Christian Dior, SA et al*, 2002 FCA 29, 20 CPR (4th) 155].

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

- Sections 38(2)(a)/30(b) – the filing dates of the applications, namely,
  - May 6, 2011 (for application Nos. 1,526,570 and 1,526,571), and
  - May 30, 2011 (for application Nos. 1,529,639 and 1,529,637)[see *Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 at 475 (TMOB); and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 at 296 (FCTD)];
- Sections 38(2)(a)/30(i) – the dates of filing of the applications, namely,
  - May 6, 2011 (for application Nos. 1,526,570 and 1,526,571), and
  - May 30, 2011 (for application Nos. 1,529,639 and 1,529,637)[see *Tower Conference Management Co v Canadian Exhibition Management Inc* (1990), 28 CPR (3d) 428 at 432 (TMOB)];
- Sections 38(2)(b)/12(1)(d) – the date of my decision [see *Park Avenue Furniture Corp v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)];

- Sections 38(2)(c)/16(1)(a) and (c) – the dates of first use claimed in the applications, namely,
  - Since at least as early as 1997 (for application No. 1,526,570),
  - Since at least as early as May 27, 2011 (for application Nos. 1,529,639 and 1,529,637), and
  - Since at least as early as 1967 (for application No. 1,526,571) [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FCTD)]; and
- Sections 38(2)(d)/2 – the date of filing of the oppositions, in this case being February 28, 2013 with respect to all applications [see *Metro-Goldwyn-Mayer, supra*].

## The Evidence

### Opponent’s Rule 41 Evidence

#### Summary – Affidavit of Paul Miatello

[14] Mr. Miatello is the Chief Financial Officer of Morguard Corporation (Morguard). He attests that the Opponent, to which he is also the Vice-President, Finance and Chief Financial Officer, is a wholly owned subsidiary of Morguard.

[15] He attests that “The Colonnade” is a mixed use building located at 131 Bloor Street in Toronto that includes 157 residential apartment suites and 96,000 square feet of commercial (retail and office) leasable area.

[16] He states that the Opponent and its predecessor-in-title, One Thirty One Bloor West Limited, have continuously, since 1962, used the trade-mark THE COLONNADE in association with the services listed in registration TMA247,272, specifically in connection with “The Colonnade” property. This building, he attests, was officially opened to the public on October 16, 1963, which he describes as a landmark on the stretch of Bloor Street between Yonge Street and Avenue Road, long known for its luxury shopping and fine dining, and is designated by the City of Toronto as a heritage building in recognition of its architectural significance. He states

that the significance of “The Colonnade” as a retail and dining destination is indicated by the annual revenue generated by the property, which has grown steadily since 1963 and has significantly exceeded \$10 million annually for each of the last seven years.

[17] He attests that the tenants at “The Colonnade” have continuously since 1963 included one or more restaurants or cafés. He further states that based on a review of his company’s records, he believes that a restaurant called Colonnade Restaurant operated in “The Colonnade” between 1963 and 1982.

[18] In support of the aforementioned, Mr. Miatello provides the following:

- Exhibit A – articles and restaurant reviews relating to restaurants that have operated in The Colonnade, including a pizza restaurant that operated in the 1980s.
- Exhibit B – a table listing the revenue generated by The Colonnade property for each year from 1965 to 2012. He states that the word “estimated” in the table refers to revenues prior to 1996, which were extrapolated based on information that is available today.
- Exhibit C – photographs of a sampling of current signs, which Mr. Miatello attests is generally representative of the prominence with which the mark has been displayed at The Colonnade building.
- Exhibit D – a sampling of advertisements that have been distributed at various times in a variety of publications, including the *Toronto Star* and *The Globe and Mail*. Mr. Miatello notes that some of the advertisements refer to “on-site fine dining”. He states that for each of the last five years, the annual advertising budget for The Colonnade has been approximately \$10,000.
- Exhibit E – printouts from [www.thecolonnade.ca](http://www.thecolonnade.ca), a website that Mr. Miatello states has been operated by the Opponent since 2003 to provide information about the property to prospective residential and commercial tenants. He states that the trade-mark THE COLONNADE has continuously and prominently been displayed on the website since 2003, having been accessed by thousands of Canadians since that time.

Summary – Affidavit of Dane Penney

[19] Mr. Penney is a searcher employed by the agents for the Opponent.

[20] He states that on September 11, 2013, he conducted searches using the *Toronto Star's* online archive for *Toronto Star* newspaper pages containing the terms “131 BLOOR” in combination with the word “COLONNADE” for the following time periods:

- Between October 15, 1963 and October 15, 1967;
- For every third year between 1970 and 2000, starting with 1970; and
- Between the years 1962 and 1982 (with the terms COLONNADE RESTAURANT).

The results of these searches are attached under Exhibits A, B, and C respectively to the Penney affidavit. The newspaper excerpts contain advertisements for The Colonnade building, including activities held at the building, such as theatre shows, as well as various advertisements for retail and commercial tenants of the Opponent's building. Both the trade-mark and trade-name THE COLONNADE appear in the various advertisements.

[21] He further states that on September 11, 2013 he also conducted searches of *Toronto Star* newspaper articles containing the following search strings, dating between 1985 and the present:

- “131 Bloor” AND Colonnade AND Food;
- “131 Bloor” AND Colonnade AND Restaurant; and
- “131 Bloor” AND Colonnade AND Café.

The results of this search are attached under Exhibit D to Mr. Penney's affidavit. He indicates that this search was conducted through the Infomart database, which he identifies as Canada's largest provider of news and broadcast media monitoring, containing full text articles from the *Toronto Star* published since 1985.

## Applicant's Rule 42 Evidence

### Summary – Affidavit of Peter Dahdouh

[22] Mr. Dahdouh is the Manager of the Applicant, a restaurant business founded by his father in 1967 that also licenses its marks to others for the operation of restaurant franchises. He provides at Exhibit H to his affidavit, a sample licensing agreement and confirms that all of the Applicant's franchise locations have signed a similar licensing agreement. He further attests that he exercises control over the character and quality of the services performed by the Applicant's licensees by personally visiting each of the franchise locations and inspecting the outside and inside premises including the kitchen, dining and food storage areas.

[23] Mr. Dahdouh attests that the Applicant owns and operates two restaurants in the Ottawa area; one since 1967 (the original location) and the other since 2007. He further attests that the Applicant also has three franchise locations in the Ottawa area, operating since 2000, 2005, and 2012 respectively.

[24] With respect to display of the COLONNADE Marks, Mr. Dahdouh provides, as Exhibit A to his affidavit, copies of menus presently used in both the Applicant-owned and franchise locations. The first page of the menu displays the CAFÉ COLONNADE trade-mark, indicating that the restaurant has been in operation "since 1967", and includes the text "Also known as Colonnade Restaurant & The Colonnade". He further provides as Exhibit B to his affidavit, photos of the exterior signage of the aforementioned locations taken on February 14, 2014. The exterior signage displays the CAFÉ COLONNADE and the COLONNADE PIZZA trade-marks. Mr. Dahdouh confirms that the exterior signage shown in these photographs and the menus are representative of those used from 1967 to date, apart from the inclusion of the remaining COLONNADE Marks as described below and apart from adjustments to menu offerings and prices.

[25] Mr. Dahdouh states that he has reviewed the Applicant's records, is advised by his father and confirms based on his personal experience that since 1967, the Applicant has carried on business as a restaurant under the trade-name "Colonnade Restaurant (Ottawa) Limited". He provides as Exhibit C to his affidavit, copies of a letter from the Applicant's solicitor, dated

November 1, 1967, advising of the incorporation of the Applicant under the trade-name “Colonnade Restaurant (Ottawa) Limited”, by Letters Patent dated October 26, 1967. Also enclosed in this exhibit is a copy of a plaque dated 1976 attesting that the Applicant is a member of the Better Business Bureau of Ottawa-Hull and a copy of the June 24, 2003 restaurant inspection report from the City of Ottawa. In addition, he states that the Applicant has also used the trade-mark CAFÉ COLONNADE since 1967 in association with its restaurant services on signage, menus, advertising, business cards, telephone directory and newspaper advertisements, and when answering the telephone for reservations or take-out orders.

[26] Regarding evidence of sales, Mr. Dahdouh explains that the Applicant only retains receipts for 18 months, and that the sole documentary evidence available to show past sales is audited financial statements. He provides a sample of such statements for the years 2000, 2001, and 2003 under Exhibit D, but explains that there are others for every year since 1967. While exact revenue figures in the Applicant’s financial statements have been redacted, he states that they are in the range of several millions of dollars per year. In addition, he provides as Exhibit E to his affidavit, copies of sample receipts from the Applicant’s original location showing sales to individual customers for various dates over the past 18 months.

[27] With respect to promotion of the Applicant’s restaurants, he provides as Exhibit F to his affidavit, copies of promotional articles from the *Ottawa Citizen* newspaper dated March 8, 1997 and May 30, 1997, which feature the Applicant and describe the Applicant’s history. While he does not have 1997 circulation figures for the newspaper, he attests that it is a large daily newspaper in the Ottawa region that would have reached a significant portion of the residents of the Ottawa area.

[28] With respect to the trade-mark COLONNADE PIZZA, he explains that after years of staff and customers informally referring to the Applicant’s restaurant as “Colonnade Pizza”, it was decided in 1997 to formally add the trade-mark COLONNADE PIZZA to the Applicant’s branding as of that year. In addition, he attests, the trade-marks COLONNADE PIZZA and CAFÉ COLONNADE began to be used interchangeably in the Applicant’s outside signage, menus, advertising, business cards, telephone directory and newspaper advertisements and when answering the telephone for reservations or take-out orders.



[29] Mr. Dahdouh states that as the Applicant began to open up franchise locations, he decided to add the trade-marks THE COLONNADE and COLONNADE RESTAURANT to the Applicant's branding. He states that since at least as early as May 27, 2011, the trade-marks THE COLONNADE, COLONNADE RESTAURANT, COLONNADE PIZZA, and CAFÉ COLONNADE began to be used interchangeably in some of the Applicant's outside signage, menus, advertising, business cards, telephone directory and newspaper advertisements and when answering the telephone for reservations or take-out orders. He confirms that all of the above-mentioned trade-marks continue to be used by the Applicant to the date of his affidavit in association with the Applicant's restaurant services.

[30] With respect to the Applicant's Internet presence, Mr. Dahdouh attaches as Exhibit G to his affidavit, a copy of the home page of the Applicant's website at *www.colonnadepizza.com* and a copy of a WHOIS search of the domain registration showing that he registered the domain name on December 14, 2003. He confirms that the website became active shortly thereafter in a state very similar to that shown in the exhibit, with the exception of the inclusion of the additional trade-marks noted above.

[31] Mr. Dahdouh also attaches as Exhibit I to his affidavit, the results of Google searches that he conducted as of the date of his affidavit for the terms "Colonnade Building" with select Canadian cities, as well as dictionary and encyclopaedia definitions for the term "colonnade". Additionally, he encloses in this exhibit, copies of printouts from the website of Colonnade Management, Inc., which he attests is a large Ottawa property management company.

[32] Lastly, Mr. Dahdouh attests that he has never encountered or heard from any of his staff or franchisees of a single customer who came into any of the Applicant's restaurants and asked whether the Applicant was affiliated with or owned by the Opponent or by Colonnade Management Inc., a large Ottawa property management company, as shown in Exhibit I.

## The Grounds of Opposition

### Section 30(b)

[33] The Opponent has pleaded that the applications for the Mark are contrary to section 30(b) of the Act in that the Marks have not been used in Canada in association with the services described in the applications since the alleged dates of first use.

[34] While the legal burden is upon an applicant to show that its application complies with section 30 of the Act, there is an initial evidential burden on an opponent to establish the facts relied upon by it in support of its section 30 ground [see *Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 at 329 (TMOB); and *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)]. With respect to section 30(b) of the Act in particular, an opponent's initial burden has been characterized as light due to an opponent's limited access to information regarding use relative to the applicant. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence [*Corporativo de Marcas GJB, SA De CV v Bacardi & Company Ltd* 2014 FC 323 (CanLII); *Molson Canada v Anheuser-Busch Inc* 2003 FC 1287; 2003 FC 1287 (CanLII), 29 CPR (4th) 315 (FC)]. However, it has been held that in order to do so, the opponent must show that the applicant's evidence is "clearly inconsistent" with the claims set forth in its application [see *Ivy Lea Shirt Co v 1227624 Ontario Ltd* (1999), 2 CPR (4th) 562 at 565-6 (TMOB), aff'd 11 CPR (4th) 489 (FCTD)]. In a more recent decision, the Federal Court has described this "clearly inconsistent" burden as being slightly higher than the lesser burden imposed on an opponent who may rely on its own evidence under this ground [per *Marcas, supra*]. The Federal Court has therefore now instructed that an opponent may successfully rely upon an applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's application. That is, the key issue is whether non-use has been established on a balance of probabilities. On this issue, all of the pertinent evidence of record is to be assessed according to the normal criteria, that is, taking into consideration "its provenance (including its quality and reliability), the absence of evidence that might reasonably be expected to exist, and whether it has been

tested on cross-examination and if so, how it fared. Multiple diverse considerations inform the assessment of evidence” [*Marcas, supra*].

[35] If an opponent succeeds in discharging its initial evidential burden, the applicant must then, in response, substantiate its claim of use during the material time. However, while an opponent is entitled to rely on the applicant’s evidence to meet its evidential burden, the applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by an opponent meeting its evidential burden [see *Kingsley v Ironclad Games Corporation*, 2016 TMOB 19, at para 63].

[36] In the present case, the Opponent relies on the Applicant’s evidence and submits that Mr. Dahdouh only makes bare assertions that the trade-marks were used since the dates claimed in the respective applications, but does not provide any specific factual statements or documentary evidence showing use since those dates. For example, with respect to the mark COLONNADE PIZZA, the Opponent points to Mr. Dahdouh’s assertion that:

As of that year [1997], the trade-marks COLONNADE PIZZA and CAFÉ COLONNADE began to be used interchangeably in my company’s outside signage, inside signage, restaurant menus and take-out menus, advertising, business cards, and telephone directory and newspaper advertising and listings and when answering the telephone for reservations or take-out orders.

Yet, the Opponent submits, the Applicant has not introduced any such evidence as it existed in 1997. The Opponent submits that on a generous interpretation, the Applicant’s evidence shows section 4 “use” of the COLONNADE PIZZA trade-mark starting 14 years after the claimed date of first use in October 2011, which is the earliest date in which this trade-mark was shown to be displayed on receipts. The Opponent submits that while the Applicant may have informally been orally referred to as COLONNADE PIZZA and Mr. Dahdouh may have intended to use the name COLONNADE PIZZA as a trade-mark, this does not amount to use of the name as a trade-mark.

[37] The Opponent further submits that the evidence that the Applicant has failed to produce is evidence that might reasonably be expected to exist and to be readily available to the

Applicant; it is also evidence with respect to which the Opponent has far less ready access to than the Applicant. Having regard to the aforementioned and relying on *Marcas, supra* for the proposition that an applicant's evidence need not be "clearly contradictory", the Opponent submits that on a balance of probabilities, evidence of non-use has been established. The Opponent has advanced similar arguments with respect to each of the Applicant's Marks.

[38] The Applicant submits that the Opponent has not met its burden and that the ground of opposition should be rejected. In any event, the Applicant submits, on a balance of probabilities, it has shown use of the Marks as of the claimed dates of first use.

[39] As previously mentioned, the Applicant is under no obligation to evidence its claimed dates of first use if these dates are not first put into issue by the Opponent in meeting its evidential burden. In any event, the Applicant submits, and I agree, that Mr. Dahdouh provides statements of fact regarding use of the Marks together with corroborative evidence; and as such, the evidence as a whole cannot be characterized as comprising bare allegations. For example, while the menus in Exhibit A and the photographs in Exhibit B are current as of the swearing of Mr. Dahdouh's affidavit, he provides a sworn statement that such examples are representative of the use of all of the Marks described in his affidavit; such use which is described in detail, including context regarding the commencement of use of the Marks. Further to this, Mr. Dahdouh provides a reasonable explanation as to the absence of sales receipts beyond the business practice of retaining such records for only 18 months. In the absence of cross-examination and/or evidence to the contrary from the Opponent, I have no reason to doubt the veracity of Mr. Dahdouh's statements or draw negative inferences from any shortcomings in his evidence; furthermore, I see nothing in the evidence, when considered in its entirety, that casts doubt on the Applicant's compliance with section 30(b) sufficient to meet the Opponent's burden [see *Les Montres Marciano Inc v Guess*, 2015 TMOB 177 at para 31; and *1772887 Ontario Limited v Vancouver Free Press Publishing Corp*, 2015 TMOB 120 at paras 37-39].

[40] This ground of opposition is therefore rejected in each case.

### Section 30(i)

[41] 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].

[42] In the present case, the Opponent has plead that the Applicant could not have been satisfied that it was entitled to use its Marks in Canada in association with the services described in its applications, because it was aware at that time that the Opponent's predecessor-in-title had previously used and registered in Canada the trade-mark THE COLONNADE, with which it knew the trade-marks had been confusing at all material times.

[43] However, even if the Applicant had been aware of the Opponent's trade-mark, which has not been shown, the mere knowledge of the existence of the Opponent's trade-mark does not in and of itself support an allegation that the Applicant could not have been satisfied of its entitlement to use its Marks [see *Woot, Inc v WootRestaurants Inc Les Restaurants Woot Inc*, 2012 TMOB 197].

[44] In the present case, the Applicant has provided the necessary statement and this is not an exceptional case. Accordingly, the section 30(i) ground is dismissed in each case.

### Confusion

#### *Section 12(1)(d)*

[45] The Opponent has pleaded that the Applicant's trade-marks are not registrable having regard to the provisions of section 12(1)(d) of the Act in that they are confusing with its registered trade-mark THE COLONNADE (TMA247,272).

[46] I have exercised the Registrar's discretion to confirm that this registration is in good standing as of today's date, which as previously indicated is the material date for assessing a section 12(1)(d) ground of opposition [per *Park Avenue Furniture Corp, supra*].

[47] As the Opponent's evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Marks and the registered trade-mark of the Opponent.

*The test for confusion*

[48] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that the 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 goods or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class.

[49] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has been in use; c) the nature of the goods, services or business; d) the nature of the trade; and e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see, in general, *Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, 1 SCR 772 (SCC) at para 54; *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, 49 CPR (4th) 401; and *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361].

*Section 6)(5)(a) – inherent distinctiveness and the extent to which the marks have become known*

[50] The overall consideration of the section 6(5)(a) factor, involves a combination of inherent and acquired distinctiveness of the parties' marks.

[51] The word "Colonnade", the most distinctive portion of both parties' marks, is an ordinary dictionary word, which is defined in *The Canadian Oxford Dictionary, 2<sup>nd</sup> edition*, as follows:

**Colonnade:** *noun* ► a row of columns, esp. supporting an entablature or roof.

[52] The Opponent submits that however its mark is inherently distinctive, as it has no connotations in relation to the associated services.

[53] As above though, the word “colonnade” is not unrelated to the notion of a structure or building; indeed, the word appears to be associated with a particular type of architecture. The Opponent’s statement of services indicates that its services are conducted in “connection with a building”. Indeed, I note that Mr. Miatello attests in his affidavit that the Opponent’s Services are offered through a mixed-use (residential and commercial) building, “designated by the City of Toronto as a heritage building in recognition of its architectural significance.” Furthermore, it is not a coined word and to the extent that it relates to the Opponent’s Services, it can be seen as suggestive of the type of architectural style or impression employed in the design of the building through which the Opponent’s Services are conducted. Indeed, photographs of “The Colonnade” building in Exhibit A to the Miatello affidavit appear to show a building with column designs.

[54] In the case of the Applicant however, the use of the word “Colonnade” has no inherent connection to restaurant services, and as such, has some degree of inherent distinctiveness.

[55] Thus, while the word “colonnade” is an ordinary dictionary word, having regard to the aforementioned, I consider that the Applicant’s Marks have greater inherent distinctiveness.

[56] Nonetheless, the strength of a trade-mark may be increased by means of it becoming known in Canada through promotion or use.

[57] In the case of the Opponent’s mark, the evidence shows that the Opponent’s “The Colonnade” mixed-use commercial/residential building was opened to the public in Toronto on October 16, 1963 (Miatello affidavit, para. 6 and Exhibit A). The Opponent’s evidence also shows that its mark was used on interior and exterior signage over that time period (see representative use, Miatello affidavit, para. 10 and Exhibit C). Sales figures for services associated with the Opponent’s “The Colonnade” building demonstrate that sales have grown considerably over the years, ranging from approximately \$1.8 million in 1965 to over \$17 million in 2012 (Miatello affidavit, para. 8 and Exhibit B).

[58] Having regard to the aforementioned, I accept that the Opponent’s mark has become known to an extent in Toronto through use for an extended period of time.

[59] With respect to the Applicant's THE COLONNADE mark on the other hand, the Opponent submits that the evidence suggests that the Applicant has only used this mark since February 2014. This is the date of Mr. Dahdouh's affidavit in which he states that the copies of menus in Exhibit A, which display this Mark (in addition to the other Marks), are the menus that are presently used at the Applicant's restaurants and franchise locations. However, it is the evidence as a whole that must be considered, and as such, I accept that the evidence shows that the Applicant began using this mark since at least as early as the date claimed in its application, namely, May 27, 2011. In this regard, Mr. Dahdouh attests that the menu, although current as of the date of his affidavit, is representative of those which have been used in association with each of its Marks since the dates claimed in the respective applications (see para 8 of the Dahdouh affidavit). Context surrounding the commencement of such use also has been provided.

[60] However, I agree with the Opponent that the acquired distinctiveness of its mark is greater than that of the Applicant's THE COLONNADE mark. The Opponent's mark has enjoyed a much longer history of use, with recognizable growth spanning more than 50 years. The Applicant's THE COLONNADE mark, on the other hand, has simply not been used nearly as long such that it could be said to have acquired distinctiveness to the same extent.

[61] The same can be said for the Applicant's marks COLONNADE PIZZA and COLONNADE RESTAURANT, the evidence of which I accept shows use of these marks since the respective dates claimed, namely, since at least as early as 1997 and since at least as early as May 27, 2011.

[62] However, with respect to the Applicant's CAFÉ COLONNADE mark, the conclusion of this factor is quite different given that the evidence demonstrates this mark has been used since the 1960's and has become known in Ottawa. Given the geographic displacement of the markets of the parties, and that they have both been operating for roughly the same amount of time, I cannot say that this factor overwhelmingly favours either party with respect to the Applicant's CAFÉ COLONNADE mark.



*Section 6(5)(b) – length of time of use*

[63] As per my analysis under section 6(5)(a) above, this factor strongly favours the Opponent with respect to the Applicant's marks COLONNADE PIZZA, COLONNADE RESTAURANT, and THE COLONNADE.

[64] However, with respect to the Applicant's CAFÉ COLONNADE mark, I do not consider this factor to significantly favours either party. In this regard, while the Opponent's mark has been used for a marginally longer period of time (that is, since 1963 with respect to the Opponent's mark versus 1967 with respect to the Applicant's mark), both parties' marks have been used in their respective geographic locales for nearly 50 years.

*Sections 6(5)(c) and (d) – nature of the services and the trade*

[65] It is the Applicant's statement of services as defined in its applications versus the Opponent's registered services that govern my determination of this factor [see *Esprit International v Alcohol Countermeasure Systems Corp* (1997), 84 CPR (3d) 89 (TMOB)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording. The evidence of the parties' actual trades is useful in this respect particularly where there is an ambiguity as to the services covered in the application or registration at issue [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB); and *American Optional Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[66] The Opponent's services are that which involve the management and operation of a mixed commercial/residential building, described in the Opponent's evidence as a "dining and retail destination". With respect to the commercial aspect of the Opponent's "The Colonnade" building, the Opponent's evidence indicates that it leases (or has leased) retail and commercial space to third parties, which are diverse, including among others, clothing, jewellery, footwear, and electronics retailers, hair salons, medical and educational services offices, a health club, and restaurants, etc. Indeed, the Opponent draws particular attention to the fact that restaurants have

and continue to operate within “The Colonnade” building, including evidence of a third party pizza restaurant that went by the name of Colonnade Pizza from 1980-83.

[67] However, the Opponent nonetheless does not operate any restaurants itself, nor does it provide any food related services; indeed, as per the statement of services in the Opponent’s registration, the Opponent’s evidence demonstrates that they are in the business of *leasing* commercial and retail space to *third parties*, as well as residential dwellings, all housed within the Opponent’s “The Colonnade” building.

[68] The Applicant submits that there is a clear distinction between the services of the parties, and that the Opponent’s arguments consistently confuse and comingle the Opponent’s commercial leasing services with restaurant services, when the Opponent has never operated a restaurant. The Applicant submits that the Opponent operates a shopping mall, is involved in retail leasing and residential apartment rentals. The Applicant further submits that consumers of the parties’ services are distinct, in that the average consumer of the Opponent’s services is looking for a 5-10 year lease, is acquainted with the lessor, etc., while the average consumer of the Applicant’s restaurant services is the general public looking to eat, perhaps making a fleeting decision in this regard. Consumer decisions with respect to the Applicant’s services, the Applicant submits, are based on immediate to near immediate considerations; on the other hand, the Opponent is involved in commercial leasing services which have serious financial implications and require substantial background research. Thus, not only are the services distinct, but the types of clientele are different as well.

[69] The Opponent submits that the services of the parties are closely related in that the Opponent’s tenants include restaurants and use by the Applicant would impair the Opponent from licensing its mark to its tenants. Further to this, the Opponent submits that it is not claiming to have offered restaurant services, but that the evidence shows that the Opponent operates a building that is known as a dining destination. The Opponent submits that the Applicant has characterized the services as “commercial leasing services”, but that this is not the most accurate or comprehensive description of the services. The Opponent submits that its services are not just commercial leasing, but include services of operating and managing a building that has commercial leasing opportunities.

[70] However, I agree with the Applicant's submissions regarding the distinctions between the services of the parties and the nature of the trade of the parties. Furthermore, I agree with the Applicant that the Opponent is effectively arguing that anyone that is involved in any service that may lease in its building should prevent others from using "colonnade" in its name. Examples would include dental offices, toy stores, etc.; a situation wherein protection would be extended to areas where the Opponent has only a tangential relationship. Moreover, as previously indicated, the Opponent leases to *third parties*, and the Opponent's evidence demonstrates that any restaurants housed within the Opponent's The Colonnade building, with exception of a restaurant dating back to 1965-66 (per Exhibit A to the Penney affidavit), are not offered in association with Opponent's mark, but in relation to marks of third parties. This further supports a distinction between the parties' services [see *Euromed Restaurant Limited v Trilogy Properties Corporation*, 2012 TMOB 19 (CanLII) at para 24].

[71] With respect to the Opponent's submission that use by the Applicant would impair the Opponent from licensing its mark to its tenants, it must be recognized that the Opponent's Services do not include restaurant services. If the Opponent wants to expand the scope of protection of its registered mark to include the operation of a restaurant or related services, the Opponent would then have to make an application for registration to do so.

[72] Having regard to the aforementioned, I find these factors significantly favour the Applicant.

*Section 6(5)(e) – Degree of resemblance in appearance, when sounded, and in idea suggested*

[73] The Applicant's mark THE COLONNADE is identical to the Opponent's mark. The word "colonnade" is the most striking feature of the Applicant's remaining Marks, being the most distinctive portion of these Marks relative to the services provided. Although not identical to the Opponent's mark, there remains a high degree of similarity in appearance and when sounded between the Applicant's remaining Marks and the Opponent's mark, owing to the word "colonnade".

[74] With respect to the ideas suggested between the parties' marks, as previously indicated, the Opponent's mark can be seen as suggestive of the type of architectural style or impression

employed in the design of the building through which the Opponent's Services are conducted. A similar image of a "colonnade" structure may be conjured in respect of the Applicant's Marks, however, the use of the word "colonnade" in this context, appears to relate more to creating an association with Italian culture or heritage as the Applicant's restaurants offer Italian cuisine. This view is supported by the Applicant's menu in Exhibit A to the Dahdouh affidavit, which includes an image of a Romanesque architectural structure with arched columns similar in appearance, for example, to the Leaning Tower of Pisa, or The Colosseum.

[75] However, given the high degree of similarity of the parties' marks in appearance and when sounded, this factor favours the Opponent.

*Additional Surrounding Circumstances – No Evidence of Instances of Actual Confusion*

[76] The Opponent submits that this is not a relevant consideration since the Applicant and the Opponent use their marks in different geographic locations, namely, Ottawa and Toronto, respectively. The Opponent submits however, that the confusion analysis to be undertaken is based on the hypothetical assumption that both marks are used "in the same area", irrespective of whether this is actually the case.

[77] The Applicant submits that both parties have been in business for 50 years and that there is a substantial amount of tourism between both cities such that it can be assumed that a good proportion of the Applicant's consumers would have been exposed to the Opponent's building. Yet, the Applicant submits, Mr. Dahdouh clearly attested in his affidavit to a lack of instances of actual confusion, and he was not cross-examined on his affidavit.

[78] The Opponent submits, in reply, that notwithstanding that consumers could be familiar with both, the geographic displacement of the parties explains the absence of actual confusion. That is, the Opponent's services relate to a specific building in Toronto, while the Applicant's services are that of a family run business in Ottawa, both geographically isolated in which uses would not be expected to expand beyond their present domains.

[79] It is true that in some circumstances an adverse inference concerning the likelihood of confusion may be drawn when concurrent use on the evidence is extensive and no evidence of

confusion has been given by the opponent [*Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA)]. However, in the present case, the parties operate in separate geographic markets with no evidence of overlapping customers; as such, I am not prepared to give weight to the lack of actual instances of confusion and therefore do not find that this is an additional surrounding circumstance that favours the Applicant.

### Conclusion

[80] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection.

[81] In most instances, the degree of resemblance between the marks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [see *Masterpiece Inc v Alavida Lifestyles* 2011 SCC 27 (CanLII), 92 CPR (4th) 36 and *Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2d) 145, conf 60 CPR (2d) 70 (FCTD)]. However in the present case, notwithstanding any similarity between the parties' marks, I find the differences in the nature of the parties' services and respective trades to be the determining factors. Indeed, I do not consider that patrons of a restaurant would think that the restaurant also administers a commercial building and leases retail and residential spaces. There is simply no confusion as to the source of those two completely different types of services. Thus, finding in favour of the Opponent would be akin to granting the Opponent a trade-mark monopoly on for the word "colonnade" with respect to any goods/services tangentially related to the Opponent's Services.

[82] Consequently, I am satisfied that the Applicant has discharged its onus of showing on a balance of probabilities, that there was no reasonable likelihood of confusion between the parties' marks. Accordingly, the ground of opposition based on 12(1)(d) of the Act is dismissed in each case.

*Sections 16(1)(a) and (c)*

[83] Pursuant to sections 16(1)(a) and (c) of the Act, the Opponent alleges that the Applicant is not the person entitled to registration of the Marks in association with the Services, because at each of the respective dates of alleged first use in Canada, and at all relevant times, the opposed Marks were confusing with the trade-mark and trade-name THE COLONNADE, which the Opponent's predecessor-in-title had previously used in Canada in association with the Opponent's Services.

[84] In order to meet its initial burden, the Opponent must show that its trade-mark THE COLONNADE had been used or made known in Canada and that its trade-name THE COLONNADE had been used in Canada prior to the claimed dates of first use of the Marks, in Canada, by the Opponent or its predecessor-in-title. The Opponent must also demonstrate that it had not abandoned its trade-mark or trade-name at the date of advertisement of the Marks, namely, December 28, 2011.

[85] As previously indicated in the evidence summary, and as discussed in the aforementioned section 12(1)(d) ground, I am satisfied that the Opponent has shown that its trade-mark THE COLONNADE had been used in Canada prior to the claimed dates of first use of the Marks. Furthermore, I am satisfied that the evidence (per Penney affidavit, Exhibits A, B, and C) also supports use of the Opponent's trade-name, and that the Opponent had not abandoned its trade-mark or trade-name as of the date of advertisement of the Mark.

[86] As the Opponent has satisfied its initial burden, the Applicant must therefore establish, on a balance of probabilities, that as of respective dates of first use claimed in the Applicant's applications, there was not a reasonable likelihood of confusion between its Marks and the Opponent's THE COLONNADE trade-mark and trade-name. In this regard, my findings under the ground of opposition based on section 12(1)(d) are equally applicable here. That is, I find the differences in the nature of the parties' services and respective trades to be the determining factors, and thus I am satisfied that the Applicant has discharged its onus of showing on a balance of probabilities, that there was no reasonable likelihood of confusion between the Applicant's Marks and the Opponent's trade-mark and trade-name. Accordingly, the grounds of opposition based on section 16(1) of the Act are dismissed in each case.

## Section 2

[87] The Opponent has pleaded that the Marks are not distinctive of the Services of the Applicant. The Opponent must prove that its trade-mark and trade-name THE COLONNADE had become sufficiently known as of February 28, 2013 to negate the distinctiveness of the Marks [*Motel 6, Inc v No. 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD) at 58; *Bojangles' International, LLC v Bojangles Café Ltd*, 2006 FC 657 (CanLII), 48 CPR (4th) 427 at para 34]. The difference in material dates is not significant and as a result, the conclusion reached on the issue of likelihood of confusion between the Marks and the Opponent's trade-mark and trade-name under the other grounds of opposition are equally applicable to this ground of opposition. Consequently, I am satisfied that the Marks are adapted to distinguish and actually distinguish the Services from the Opponent's Services. Accordingly, this ground of opposition is also dismissed in each case.

### Disposition

[88] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I reject the oppositions in each case pursuant to section 38(8) of the Act.

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Kathryn Barnett  
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:** 2015-10-23

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