



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

Citation: 2015 TMOB 198
Date of Decision: 2015-10-30

IN THE MATTER OF AN OPPOSITION

| | |
|---|--------------------|
| Ate My Heart Inc. | Opponent |
| and | |
| The Shortbread Bakery Ltd. | Applicant |
| 1,564,438 for Gaga For Gluten-Free | Application |

Background

[1] On February 16, 2012, the Applicant filed application no. 1,564,438 for the trade-mark Gaga For Gluten-Free (the Mark).

[2] The application is based upon use in Canada since March 10, 2011 in association with “gluten-free cookies” and based upon proposed use in Canada in association with a wide range of other gluten-free baked goods and food products. A list of the specific goods which are covered by the application is attached hereto as Schedule “A”.

[3] The application was advertised for opposition purposes in the *Trade-marks Journal* of July 3, 2013 and on August 9, 2013, the Opponent opposed it under section 38 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act). An amended statement of opposition was subsequently filed on October 10, 2014.

[4] The grounds of opposition are based upon sections 30(b), 30(i), 12(1)(d), 12(1)(e), 16(1)(a), 16(3)(a), 16(1)(b), 16(3)(b) and 2 (distinctiveness) of the Act.

[5] The Applicant denied each of the allegations set out in the statement of opposition in a counterstatement dated October 16, 2013.

[6] As evidence in support of its opposition, the Opponent filed the affidavit of Joe Germanotta, sworn February 5, 2014 (the Germanotta affidavit), the affidavit of Aleem Abdulla, sworn February 14, 2014 (the first Abdulla affidavit) and the further affidavit of Aleem Abdulla, sworn February 14, 2014 (the second Abdulla affidavit). The affiants were not cross-examined.

[7] As evidence in support of its application, the Applicant filed the affidavit of Mary P. Noonan, sworn August 26, 2014 (the Noonan affidavit) and the affidavit of Robyn Kay, sworn August 26, 2014 (the Kay affidavit). The affiants were not cross-examined.

[8] Both parties filed written arguments and attended a hearing.

[9] For the reasons which follow, the opposition is successful, in part.

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[10] The Applicant bears the legal onus of establishing on a balance of probabilities that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could 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].

Analysis

Grounds of Opposition Based upon Non-compliance

Section 30(i) – Non-compliance

[11] Section 30(i) of the Act merely requires that an applicant declare in its application that it is satisfied that it is entitled to registration of its trade-mark. Where an applicant has provided the

requisite statement, a section 30(i) ground should only succeed in exceptional cases, such as where there is evidence of bad faith [*Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. Mere knowledge of the existence of an opponent's trade-mark does not in and of itself support an allegation that an applicant could not have been satisfied of its entitlement to use the Mark [*Woot, Inc v WootRestaruants Inc Les Restaurants Woot Inc* 2012 TMOB 197 (CanLII)]. The application for the Mark contains the requisite statement and there is no evidence that this is an exceptional case. Accordingly, the section 30(i) ground is dismissed.

Section 30(b) – Non-compliance

[12] The Opponent has pleaded that the application for the Mark does not comply with section 30(b) of the Act because the Applicant has not used the Mark in Canada in association with “gluten-free cookies” since the March 10, 2011 claimed date of first use in the application. In support of this ground of opposition, the Opponent relies upon the Kay affidavit, wherein Ms. Kay states that the first sale of cookies in association with the Mark took place on September 20, 2011 [para 12]. In view of the statements made in Ms. Kay's affidavit, the Applicant conceded at the hearing that this ground of opposition should succeed. I agree. Accordingly, this ground of opposition is successful.

Grounds of Opposition Based Upon Likelihood of Confusion

[13] The grounds of opposition pleaded under sections 12(1)(d), 16(1)(a), 16(3)(a), 16(1)(b), 16(3)(b) and 2 of the Act are all premised, in part or in whole, on an allegation that there is a likelihood of confusion between the Mark and one or more trade-marks of the Opponent that consist of or include the word GAGA.

[14] The material date for assessing each of the aforementioned grounds of opposition varies as follows:

- section 12(1)(d) - today's date [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 (FCA)];
- section 16 – February 16, 2012 filing date of the application for the Mark [section 16 – note that the material date for assessing the sections 16(1)(a) and 16(1)(b) grounds would

normally be the claimed date of first use in the application for the Mark, however, since the Opponent has successfully challenged the claimed date of first use under its section 30(b) ground of opposition, the material date becomes the applicant's filing date - see *American Cyanamid Co v Record Chemical Co Inc* (1972), 6 CPR (2d) 278 (TMOB); and *Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB);

- section 2 – August 9, 2013 – the date of filing of the statement of opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)].

[15] The Opponent's case regarding confusion is strongest under its section 12(1)(d) ground of opposition because the later material date allows all of the Opponent's evidence concerning its reputation to be considered and the Opponent has met its initial evidential burden in respect of this ground. If the Opponent is not successful under this ground, then it will not be successful under its section 16 and section 2 grounds of opposition.

[16] I will therefore focus my confusion analysis on the section 12(1)(d) ground of opposition.

Section 12(1)(d) – Non-registrability

[17] The Opponent has pleaded that the Mark is not registrable under section 12(1)(d) of the Act because it is confusing with the Opponent's trade-mark LADY GAGA, which is the subject of registration No. TMA852,242.

[18] The Opponent has filed a certified copy of its registration as part of its evidence [para 2 and Exhibit A of the first Abdulla affidavit] and I have exercised my discretion to check the register to confirm that it is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. The Opponent has therefore met its initial burden with respect to this ground. As the Opponent's evidential burden has been satisfied, the Applicant must establish on a balance of probabilities, that there is no reasonable likelihood of confusion between the Mark and the Opponent's trade-mark LADY GAGA.

[19] 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 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.

[20] 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 enumerated factors need not be attributed equal weight [*Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC)].

Section 6(5)(a) – the inherent distinctiveness of the Marks and the extent to which they have become known

[21] Both of the parties' trade-marks are somewhat inherently distinctive.

[22] The distinctiveness of a trade-mark may be further increased through promotion or use.

[23] According to the Kay affidavit, the Applicant's bakery company was founded by Ms. Kay in 2009 [para 1]. In 2010, Ms. Kay began testing and developing gluten-free cookies and sold the first of such cookies in association with the Mark on September 20, 2011 [paras 5-12, Exhibits 2-3].

[24] Ms. Kay states that the Applicant has used the Mark on all of its packaging, its website, advertising and promotional materials since September 2011 [paras 13-15; Exhibit 4]. According to Ms. Kay, the Applicant has promoted its product at numerous trade and consumer shows at which it displays, features and sells its products in association with the Mark. A list of the particular consumer and trade-shows which the Applicant has attended is provided in paragraph 16 of Ms. Kay's affidavit. Attached as Exhibits 5 and 6 to her affidavit are representative photographs from the trade-shows and consumer shows and a copy of the

Applicant's business and consumer cards, which accompany the display and sale of the Applicant's products at the shows [para 17].

[25] According to Ms. Kay, the Mark has also been featured on television, on websites, in social media, in grocery store flyers and in magazine advertising [paras 18-19; Exhibits 7-12]. In paragraph 20 of her affidavit, Ms. Kay states that Canadian consumers have posted very favourable reviews of the Applicant's products, including by way of YouTube video [Exhibits 13-14].

[26] In paragraph 21, Ms. Kay states that the GAGA FOR GLUTEN-FREE products are currently offered for sale in 284 retailers across 7 provinces in Canada and they are predominantly sold in grocery stores, grocery chains and health food specialty stores. A list of the retailers which sell the Applicant's products is attached as Exhibit 15. Attached as Exhibit 16 are representative photographs showing the display of the Applicant's products in association with the Mark in grocery and specialty stores [para 22].

[27] According to Ms. Kay, from 2011 to 2014, the Applicant sold over 76, 800 units of GAGA FOR GLUTEN-FREE products and sales of its products for those years totaled \$286,235.60 [pars 23-25]. Examples of invoices and purchase orders for the Applicant's products are attached as Exhibit 17 to Ms. Kay's affidavit.

[28] Notably, the evidence of use which has been shown in Ms. Kay's affidavit appears to relate to gluten-free cookies only and not to the other gluten-free food products and baked goods which are covered by the application for the Mark.

[29] Turning to the Opponent's evidence, according to the Germanotta affidavit, the Opponent is a company owned by Stefani Joanne Germanotta, an American singer, songwriter, performing artist, record producer, philanthropist and businesswomen known as Lady Gaga [para 3].

[30] Mr. Germanotta states that Ms. Germanotta first performed under the stage name Lady Gaga in September 2006 and has dominated the global music industry since 2008. According to Mr. Germanotta, Lady Gaga has sold in excess of 24 million albums and 65 million singles worldwide [paras 4 and 5].

[31] Details pertaining to Lady Gaga's musical career, achievements and recognition are provided in paragraphs 6 to 12 and Exhibit A of the Germanotta affidavit. As the Applicant does not appear to dispute that Lady Gaga is well known, I will not provide a detailed summary of this evidence.

[32] In paragraph 15, Mr. Germanotta provides a list of the particular goods and services in association with which the Opponent's trade-mark LADY GAGA has been registered and used in Canada. The goods and services include a wide range of music and entertainment related goods and services, as well as ancillary goods and services, such as cosmetics, clothing, jewelry, posters, the issuance of gift cards, etc. Mr. Germanotta has provided the dates of first use for the goods and services in association with which the trade-mark LADY GAGA has been used in paragraph 15 of his affidavit. A copy of the particulars for the Opponent's registration No. TMA852,242 for LADY GAGA is attached as Exhibit C to Mr. Germanotta's affidavit.

[33] In paragraph 18, Mr. Germanotta states that all use of the trade-mark LADY GAGA in association with the Opponent's goods and services has been by the Opponent itself or by a licensee under circumstances in which the Opponent has direct or indirect control of the character or quality of the goods and services.

[34] In paragraph 20, Mr. Germanotta states that the Opponent's goods are sold in association with its trade-mark LADY GAGA worldwide in at least 40 countries, including Canada, Australia, France, Germany, Hong Kong, Japan, the United States and the United Kingdom. In paragraph 21, Mr. Germanotta provides revenues generated annually for worldwide sales of LADY GAGA goods (not including music related goods) in association with the trade-mark LADY GAGA. They range from USD \$2,500,000 in 2009 to USD \$2,600,000 in 2013 (up until September). Mr. Germanotta has not provided a breakdown per category of the goods which were sold during that time period. In paragraph 22, Mr. Germanotta provides Canadian sales figures for these products. They range from USD \$6,800 to USD \$43,900 for the years of 2009 to 2013. As the Applicant has pointed out, the figures for non-music related products are not substantial. In fact, they total less than the Applicant's sales of its cookies over a similar time period.

[35] In paragraph 23, Mr. Germanotta provides revenues generated annually from worldwide sales of music related LADY GAGA products and services. Revenues ranged from between USD\$9,700,000.00 and USD\$145,700,000.00 between the years of 2009 and 2013 (up until September). In paragraph 24, Mr. Germanotta provides revenues generated annually from sales in Canada of music related LADY GAGA products and services. These revenues ranged from between USD\$170,000 to 4,900,000.00 for the years of 2009 to 2013.

[36] In paragraph 13, Mr. Germanotta states that in 2011, Lady Gaga and her mother founded an American non-profit organization known as the Born This Way Foundation, which aims to inspire youth and build better communities. Attached as Exhibit B are materials downloaded and printed from various websites relating to the foundation. According to Mr. Germanotta, in 2012, Lady Gaga was awarded the *LennonOno Grant for Peace* from Yoko Ono for her work with the foundation [para 14]. There is no evidence to suggest that Canadians would have any awareness of the existence of this American organization or its objectives and activities.

[37] In paragraph 25, Mr. Germanotta states that in fall of 2011, as a means of raising money for the Born This Way Foundation, the department store Barney's New York held a holiday campaign in partnership with Lady Gaga. For the campaign, a "GAGA'S WORKSHOP" was set up in the department store and 25% of sales from the items featured were to be donated to the foundation. Some of the items sold included chocolate candies and cookies, some of which featured the likeness of LADY GAGA. Attached as Exhibit "D" are photographs of some of these cookies and chocolates. According to Mr. Germanotta, some of these cookies and candies were featured and promoted on various websites. Print-outs from some of these websites are attached as Exhibit "E" to Mr. Germanotta's affidavit. There is no evidence to suggest that any Canadians would have purchased any of the cookies or candies or that they would have been aware of the fundraising event itself.

[38] In paragraph 28, Mr. Germanotta states that Lady Gaga is well-known for promoting self-acceptance, a positive body image and healthy gluten-free dieting. According to Mr. Germanotta, in September 2012, Lady Gaga launched a project called *A Body Revolution* to address poor body image and body acceptance. Attached as Exhibit "F" are printouts from various websites relating to Lady Gaga and her promotion of self-acceptance and of a positive body image as well

as her gluten-free dieting. There is no indication that any of the websites are Canadian and no information has been provided with respect to the extent to which the content of them has been accessed by Canadians.

[39] I note that in the second Abdulla affidavit, Mr. Abdulla provides the results of internet searches which he conducted using the terms “I love Gaga” and “‘gaga for gluten-free’ lady” [second Abdulla affidavit, paras 3 and 4, Exhibits A and B]. Exhibit “A” consists of the first six pages of the “I love Gaga” search and they show that many of the hits appear to relate to Lady Gaga. Exhibit B consists of only three short articles regarding the Born This Way Foundation. There is no indication that any of them appeared on Canadian websites or that they were accessed and viewed by any Canadians.

[40] Overall, I find that this factor, which is a combination of inherent distinctiveness and the extent to which the parties’ trade-marks have become known, favours the Opponent.

Section 6(5)(b) – the length of time each has been in use

[41] According to the Opponent’s registration and Mr. Germanotta, the Opponent has been using its trade-mark LADY GAGA in association with at least some of its goods and services since at least as early as 2008. This pre-dates the Applicant’s 2011 date of first use which has been provided in Ms. Kay’s affidavit.

Sections 6(5)(c) and (d) – the nature of wares, services or business and trade

[42] When considering sections 6(5)(c) and (d) of the Act, it is the statement of goods in the application for the Mark and the statement of goods in the Opponent’s registration that governs the assessment of the likelihood of confusion under section 12(1)(d) of the Act [*Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export Inc* (1986), 12 CPR (3d) 110 (FCA); and *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA)]. 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. Evidence of the parties’ actual trades is useful in this respect [*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 Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)].

[43] The application for the Mark essentially covers a variety of baked goods and food products. By contrast, the Opponent's registration for its trade-mark LADY GAGA covers a wide range of music and entertainment related goods and services, as well as ancillary goods and services, such as cosmetics, clothing, jewelry, posters, the issuance of gift cards, etc.

[44] Thus, the goods and services which are covered by the Opponent's registration and the application for the Mark differ substantially. In view of the disparate nature of the parties' goods and services, I find it reasonable to conclude that their respective channels of trade would also differ.

[45] These factors therefore favour the Applicant.

Section 6(5)(e) – the degree of resemblance between the trade-marks

[46] In *Masterpiece Inc v Alavida Lifestyles Inc et al* [supra], the Supreme Court of Canada clearly indicated that the most important factor amongst those listed under section 6(5) of the Act is often the degree of resemblance between the parties' trade-marks [see also *Beverley Bedding & Upholstery Co v Regal Bedding & Upholstering Ltd* (1980), 47 CPR (2d) 145 (FC), at 149, affirmed (1982), 60 CPR (2d) 70 (FCA)]. If the parties' trade-marks do not resemble one another, it is unlikely that even a strong finding on the remaining factors would lead to a likelihood of confusion.

[47] In *Masterpiece*, the Supreme Court observed that even though the first word of a trade-mark may be the most important, for the purpose of distinctiveness [*Conde Nast Publications Inc v Union des éditions modernes* (1979), 46 CPR (2d) 183 (FCTD)], the preferable approach when comparing marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique.

[48] Although "gaga" is arguably the more distinctive part of each of the parties' marks, I still find the marks to be quite different from one another. I say this because of the composition of the

marks in question. I am of the view that the words in each of the parties' trade-marks would be viewed, read and understood in conjunction with the other words in parties' trade-marks.

[49] In the case of LADY GAGA, because GAGA follows the word LADY, I think it likely that the Opponent's trade-mark would be read as being a reference to a person (i.e. a "lady") by the name of "gaga". According to the Noonan affidavit, "gaga" is a given name and the Opponent's evidence shows that LADY GAGA is a well-known music artist [Noonan affidavit, para 12, Exhibit 10].

[50] In the case of the Mark, Gaga For Gluten-Free, I find it likely as a matter of first or immediate impression, that it would be read as a phrase which suggests the idea of being "gaga" (i.e. crazy) for "gluten-free" [*Canadian Oxford Dictionary* (2nd edition); Noonan affidavit, Exhibit 7]. I am not persuaded by the evidence that the average consumer would perceive the word "gaga" in the Mark, to be a reference to anything other than this commonly understood meaning. While the Opponent has filed evidence to suggest that LADY GAGA adheres to a gluten-free diet and that she was once associated with a fundraising event involving cookies, the evidence does not establish that the average Canadian consumer would be aware of either of those facts.

[51] In view of the foregoing, I consider the parties' trade-marks to be quite different in connotation. The trade-marks in question also differ considerably both visually and phonetically. Thus, overall, I do not find there to be a particularly high degree of resemblance between them.

Surrounding Circumstances

State of the Register and Marketplace

[52] The Applicant has submitted state of the register evidence to show that GAGA is a component of other trade-marks which currently exist on the trade-mark register [Noonan affidavit, para 3; Exhibit 1]. In addition, the Applicant has submitted the results of a business directory search for business names containing the word GAGA [Noonan affidavit, para 7, Exhibit 5]. The Applicant located only 9 trade-marks (a number of which are owned by the Opponent) and 4 business names. The Applicant has not provided any detailed explanation

regarding the significance of this evidence. It has simply stated that these results demonstrate that marks containing GAGA are not exclusive to the Opponent.

[53] This evidence suggests that GAGA is not a component of a large number of third party trade-marks or business names and in my view, the mere fact that a few other traders have incorporated it into their trade-marks or business names does not necessarily render the Applicant's Mark registrable. In view of this, I do not consider this evidence to be of assistance to the Applicant.

Fame of the Opponent's LADY GAGA trade-mark

[54] The Opponent submits that as a further surrounding circumstance I should consider the fame of its LADY GAGA trade-mark. The Opponent asserts that the evidence establishes an association in the minds of consumers between a healthy gluten-free diet and the Opponent's trade-mark. The Opponent further submits that the fame of its trade-mark has transcended the goods which it is normally associated with and that an ordinary consumer would be likely to mistakenly associate the goods of the Applicant with LADY GAGA.

[55] I am not satisfied that the evidence establishes that there would be an association in the minds of Canadian consumers between a gluten-free diet and the Opponent's trade-mark. The evidence which the Opponent is relying upon in support of its submission is, in my view, both qualitatively and quantitatively lacking. We do not have any circulation or viewership figures for the print-outs attached as Exhibit B to the second Abdulla affidavit or as Exhibit F to the Germanotta affidavit and there is no indication that any of the websites associated with those print-outs are Canadian or were accessed by Canadians. Likewise, there is no indication that any Canadian consumers attended or had any awareness of the one-time fundraising event involving cookies which took place in 2011 in the United States.

[56] Even if I were to accept that the Opponent's trade-mark has become famous in Canada, the evidence does not establish that it has become famous for anything other than the music related goods and services which are covered by the Opponent's registration and it does not, in my view, establish any association in the mind of the average Canadian consumer between the Opponent's trade-mark and a gluten-free diet, baked goods or food products.

Conclusion on Likelihood of Confusion

[57] While the fame of the Opponent's trade-mark is certainly a "surrounding circumstance" of importance, the scope of its protection requires a consideration of all of the surrounding circumstances, including the factors enumerated under section 6(5) of the Act [*Mattel, Inc v 3894207 Canada Inc* (2006) 49 CPR (4th) at 354].

[58] The Court in *Mattel* agreed with an earlier quote from Professor McCarthy that "a relatively strong trade-mark can leap vast product line differences at a single bound". However, it also noted that implicit in this statement is the fact that the "product line" will generally represent a significant obstacle for even a famous mark to leap over [*Mattel, supra* at 355-356]. The Court stated that when all of the surrounding circumstances are taken into consideration, in some cases, some circumstances (such as a difference in goods), will carry greater weight than others [*Mattel, supra* at 354].

[59] In *Mattel*, the Court also pointed out that in opposition proceedings, trade-mark law will afford protection that transcends the traditional product lines unless the applicant shows the likelihood that registration of its mark will not create confusion in the marketplace within the meaning of section 6 of the Act. The Court observed that confusion is a defined term, and that section 6(2) requires the Trade-marks Opposition Board to address the *likelihood* that in areas where both trade-marks are used, prospective purchasers will infer (incorrectly) that the goods and services -- though not being of the same general class -- are nevertheless supplied by the same person [*Mattel, supra* at 331].

[60] In the present case, such a mistaken inference can therefore only be drawn if a link or association is likely to arise in the consumer's mind between the source of the LADY GAGA goods and services and the source of the Applicant's less well-known Gaga For Gluten-Free baked goods and food products. If there is no likelihood of a link, there can be no likelihood of a mistaken inference, and thus no confusion within the meaning of the Act [*Mattel, supra* at 331].

[61] Having considered all of the surrounding circumstances in this case, I am satisfied that the Applicant has established that no mistaken inference is likely to arise. There is no overlap between the goods which are associated with the Mark and the goods and services which are

associated with the Opponent's trade-mark and the Opponent has not established that there is any connection in the mind of the average Canadian consumer between the Opponent's trade-mark and a gluten-free diet or baked goods. Moreover, the trade-marks at issue differ significantly in appearance, sound and suggested idea. Thus, despite how well-known LADY GAGA may be and despite the Opponent's lengthier use of its trade-mark, I have come to the conclusion that on a balance of probabilities, there is no likelihood of confusion between the parties' trade-marks.

[62] Accordingly, the section 12(1)(d) ground of opposition is unsuccessful.

Section 12(1)(e) – Prohibited Mark

[63] The Opponent has pleaded that the Mark 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)(k) of the Act. The Opponent asserts that the mark may falsely suggest a connection with a living individual, namely the well-known musical entertainer LADY GAGA. The relevant sections of the Act read as follows:

12(1) Subject to section 13, a trade-mark is registrable if it is not

(e) a mark of which the adoption is prohibited by section 9 or 10

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...

(k) any matter that may falsely suggest a connection with any living individual...

[64] While there is a legal burden on the Applicant to establish that its Mark is registrable and that its adoption is not prohibited by section 9(1)(k) of the Act, there is an initial evidential burden on the Opponent to adduce sufficient evidence from which it may reasonably be concluded that the Mark would be so identified with Lady Gaga.

[65] Based upon the evidence in this case, I am prepared to accept that Lady Gaga is well-known, if not famous, in Canada as a musical entertainer. However, for reasons previously

discussed, the evidence does not, in my view, establish that a significant number of Canadians would make an association between the Mark and the musical entertainer, Lady Gaga. Overall, I do not consider the evidence in this case sufficient to enable me to conclude, on a balance of probabilities, that the average person who would purchase the Applicant's baked goods and other food products bearing the Mark would falsely assume that the living individual known as Lady Gaga has sponsored/approved or licensed the Applicant's goods or that the Applicant's goods are a spin-off from or somehow otherwise connected to or associated with Lady Gaga.

[66] Accordingly, this ground of opposition is also unsuccessful.

Sections 16(1)(a), 16(3)(a), 16(1)(b), 16(3)(b) and 2 - Non-entitlement and Non-distinctiveness

[67] As indicated previously, the section 12(1)(d) ground represented the Opponent's strongest case with respect to confusion. Any non-entitlement and non-distinctiveness grounds in respect of which the Opponent has met its initial evidential burden therefore fail for reasons similar to those set out in my analysis with respect to the section 12(1)(d) ground.

[68] I note that in addition to pleading that the Mark is non-distinctive due to confusion with its trade-marks, in its ground of opposition based upon section 2, the Opponent also pleaded that the Mark is non-distinctive due to being a prohibited mark under section 10 of the Act. However, the Opponent has not made any submissions or filed any evidence in this regard.

Disposition

[69] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to “gluten-free cookies” and I reject the opposition with respect to the remainder of the goods pursuant to section 38(8) of the Act [see *Produits Ménagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 482 (FCTD) as authority for a split decision].

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

Hearing Date: 2015-09-17

Appearances

Donna White

For the Opponent

Kelly Gill

For the Applicant

Agents of Record

Osler, Hoskin & Harcourt LLP

For the Opponent

Gowling Lafleur Henderson LLP

For the Applicant

Schedule “A”

GOODS:

(1) Gluten-free cookies.

(2) Gluten-free cakes, gluten-free granola bars, gluten-free bread crumbs, gluten-free pastries, gluten-free cupcakes, gluten-free granola, gluten-free breakfast bars, gluten-free brownies, gluten-free rice treats, gluten-free macarons, gluten-free bread, gluten-free bagels, gluten-free croissants, gluten-free pretzels, gluten-free popcorn, gluten-free muffins, gluten-free cornbread, gluten-free croutons, gluten-free pizza crust, gluten-free breadsticks, gluten-free biscotti, gluten-free banana bread, gluten-free fruit cakes, gluten-free cinnamon buns, gluten-free streusel, gluten-free cheese buns, gluten-free torte, gluten-free donuts, gluten-free flatbread, gluten-free pita, gluten-free potato chips, gluten-free corn chips, gluten-free soy crisps, gluten-free crackers, gluten-free pies, gluten-free cereal, gluten-free pancakes, gluten-free waffles, gluten-free ice cream cones, gluten-free frosting, gluten-free marshmallows, gluten-free pie crust, gluten-free polenta chips, gluten-free polenta crackers, gluten-free rice cakes, gluten-free pasta, gluten-free cheese puffs, gluten-free burger buns, gluten-free hot dog buns, gluten-free tortilla chips, gluten-free tortilla wraps, gluten-free english muffins, gluten-free spices, gluten-free herbs, gluten-free hot chocolate, gluten-free cocoa, gluten-free graham crackers, gluten-free graham crumbs, gluten-free biscuits, gluten-free scones, gluten-free taco shells, gluten-free rice mixes, gluten-free risotto, gluten-free candy, gluten-free brown rice, gluten-free wheat germ, gluten-free oats, gluten-free oat bran, gluten-free quinoa, gluten-free bulgur, gluten-free millet, gluten-free baking soda, gluten-free baking powder, gluten-free pudding, gluten-free ice cream, gluten-free sorbet, gluten-free frozen yogurt, gluten-free rice, gluten-free buckwheat, gluten-free flax, gluten-free sunflower seeds, gluten-free cornstarch, gluten-free potato starch, gluten-free cream of rice cereal, gluten-free puffed rice, gluten-free puffed corn, gluten-free corn meal, gluten-free tapioca, gluten-free baking soda, gluten-free baking powder, gluten-free pudding, gluten-free flours, gluten-free oatmeal.

(3) Gluten-free cake mixes, gluten-free granola bar mixes, gluten-free bread crumbs, gluten-free pastries, gluten-free cupcake mixes, gluten-free granola mixes, breakfast bar mixes, gluten-free brownie mixes, gluten-free rice treat mixes, gluten-free pie mixes, gluten-free cereal, gluten-free macaroon mixes, gluten-free pancake mixes, gluten-free waffle mixes, gluten-free bread mixes , gluten-free bagel mixes, gluten-free croissant mixes, gluten-free pretzel mixes, gluten-free popcorn mixes , gluten-free muffin mixes.

(4) Gluten-free ready to bake cakes, gluten-free ready to bake pastries, gluten-free ready to bake cupcakes, gluten-free ready to bake granola, gluten-free ready to bake breakfast bars, gluten-free ready to bake brownies, gluten-free ready to bake rice treats, gluten-free ready to bake pancakes, gluten-free ready to bake waffles, gluten-free ready to bake bread, gluten-free ready to bake bagels, gluten-free ready to bake croissants, gluten-free ready to bake pretzels, gluten-free ready to bake muffins, gluten-free ready to bake scones, gluten-free ready to bake pies, gluten-free ready to bake macarons, gluten-free ready to bake pie crust, gluten-free ready to bake cornbread, gluten-free ready to bake polenta chips, gluten-free ready to bake pizza crust, gluten-

free ready to bake bread sticks, gluten-free ready to bake biscotti, gluten-free ready to bake banana bread, gluten-free ready to bake fruit cakes, gluten-free ready to bake cinnamon buns, gluten-free ready to bake streusel, gluten-free ready to bake cheese buns, gluten-free ready to bake torte, gluten-free ready to bake donuts, gluten-free ready to bake flatbread, gluten-free ready to bake bread dough, gluten-free ready to bake burger buns, gluten-free ready to bake hot dog buns.

CLAIMS:

Used in CANADA since March 10, 2011 on goods (1).

Proposed Use in CANADA on goods (2), (3), (4).