



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

**Citation: 2016 TMOB 70
Date of Decision: 2016-04-29**

**Boston Pizza International Inc. and
Boston Pizza Royalties Limited
Partnership**

Opponents

and

TCC Holdings Inc.

Applicant

1,565,696 for BOSTON BEST

Application

[1] TCC Holdings Inc. (the Applicant) has applied to register the trade-mark BOSTON BEST for use in association with various food and drink products and services including restaurant services and food preparation services. The application for the trade-mark BOSTON BEST is based on the Applicant's proposed use and there is no evidence that use of this trade-mark has commenced in Canada.

[2] Boston Pizza Royalties Limited Partnership (Boston Pizza Royalties LP), the owner of the BOSTON PIZZA trade-mark, and Boston Pizza International Inc. (BPI), its exclusive licensee, (collectively, the Opponent) allege that the application for BOSTON BEST is confusing with its BOSTON PIZZA trade-marks for use in association with restaurant and related food products. Boston Pizza is the largest casual dining brand in Canada with locations in every province and territory except for Nunavut. The trade-mark BOSTON PIZZA appears on signage, menus, advertisements, coupons and on-line. In 2013, there were over 350 Boston

Pizza restaurants in Canada which served over 40 million customers. From 2008-2012, yearly sales exceeded \$830 million and yearly advertising expenditures exceeded \$16 million.

[3] In this case, the confusion analysis is impacted by (i) the fact that the trade-marks at issue are inherently weak trade-marks each consisting of a geographic component and a descriptive component, and (ii) the fact that the Opponent's trade-mark BOSTON PIZZA has acquired considerable distinctiveness through its use and promotion. Given the similarity of the trade-marks, the lack of evidence of use of the BOSTON BEST trade-mark and the fact that there is no evidence diminishing the potential overlap in the goods and services of the parties, I find that the Applicant has failed to prove that there is not a reasonable likelihood of confusion. As such, the application for BOSTON BEST is refused.

File Record

[4] On February 24, 2012, the Applicant applied for the trade-mark BOSTON BEST (the Mark) for use in association with the following Goods and Services on the basis of its proposed use:

Goods	Food and food products, namely, sandwiches, prepared salads, herbal tea beverages, non-alcoholic chocolate based beverages, non-alcoholic tea based beverages, non-dairy soy beverages, energy drinks, non-alcoholic carbonated drinks, non-alcoholic fruit drinks, non-carbonated soft drinks, soft drinks, sport drinks, yoghurt drinks.
Services	Restaurant services, food preparation services, food and nutrition consultation services, online sales of food items, retail sale of food, food concession stands.

[5] The application was advertised for opposition purposes in the *Trade-marks Journal* of March 13, 2013.

[6] On April 25, 2013, the Opponent opposed the application for BOSTON BEST. The Applicant requested an interlocutory ruling and the Opponent submitted an amended statement of opposition in response. The Registrar granted the Opponent leave to file the amended statement of opposition and subsequently issued an interlocutory ruling on August 21, 2013. The grounds of opposition as amended by this interlocutory ruling are summarized below:

(a) The Mark is not registrable pursuant to section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) because it is confusing with trade-mark registration Nos.:

TMA171,428	TMA778,093	TMA429,024
TMA629,841	TMA804,670	

(b) The Applicant is not the person entitled to registration pursuant to section 16(3)(a) of the Act because at the date of filing the application, the Mark was confusing with the use of some or all of the trade-marks set out in paragraph 6(a) by BPI, pursuant to a license from Boston Pizza Royalties LP;

(c) The Applicant is not the person entitled to registration pursuant to section 16(3)(b) because at the date of filing of the application, the Mark was confusing with trade-mark application Nos.:

1,554,939	1,563,494	1,563,495
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(d) The Applicant is not the person entitled to registration of the Mark in view of section 16(3)(c) of the Act because at the date of filing of the application, the Mark was confusing with the registered and used trade-names Boston Pizza International Inc. and Boston Pizza Royalties Limited Partnership;

(e) The Mark does not and will not actually distinguish, nor is it adapted to distinguish or capable of distinguishing the Goods and Services, from the goods and services offered in association with some or all of the trade-marks and trade-names detailed above; and

- (f) The Mark does not and will not actually distinguish, nor is it adapted to distinguish or capable of distinguishing the Goods and Services on the basis that the Opponent has been the sole owner/user of registered rights in respect of any BOSTON trade-mark on the Canadian trade-mark register in association with restaurant services.

The Opponent further alleged as part of its pleadings that the word BEST in the Mark which lauds the merits of superiority of the Goods and Services, is clearly descriptive or deceptively misdescriptive of their quality and does not serve to distinguish the Mark.

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

[8] The Opponent filed as its evidence the affidavits of Wes Bews, Joanne Forrester, Darrell J. Bricker, Karen E. Thompson, Bethany Watson, and a certified copy of each of the following registrations: TMA171,428; TMA629,841; TMA429,024; TMA778,093 and TMA804,670.

[9] The Applicant filed as its evidence the affidavits of Ann Nagpala and Karen Blau.

[10] The Opponent filed as its evidence in reply the affidavits of Jonathan Jeske and Marianne Crozier. Mr. Jeske and Ms. Crozier were cross-examined and the transcripts of examination were filed. However, no answers to outstanding questions were provided by Mr. Jeske or Ms. Crozier.

[11] Both parties filed a written argument and were represented at a hearing held on October 13, 2015.

Material Dates and Onus

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

- sections 38(2)(b)/ 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 37 CPR (3d) 413 at 422 (FCA)];

- sections 38(2)(c)/16(3) - the filing date of the application [see section 16(3)]; and
- sections 38(2)(d)/2 - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 at 324 (FC)].

[13] Before considering the grounds of opposition, it is necessary to review some of the technical requirements with regard to (i) the evidential burden on an opponent to support the allegations in the statement of opposition and (ii) the legal onus on an applicant to prove its case.

[14] With respect to (i) above, there is an evidential burden on an opponent to prove the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298. The presence of an evidential burden on an opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. With respect to (ii) above, the legal onus is on an applicant to show that the application does not contravene the provisions of the Act as alleged by an opponent (for those allegations for which an opponent has met its evidential burden). The presence of a legal onus on an applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against it.

Analysis of the Grounds of Opposition

[15] I will now consider the grounds of opposition beginning with the section 12(1)(d) ground of opposition.

Section 12(1)(d) Ground of Opposition

[16] The Opponent has pleaded that the Mark is not registrable because it is confusing with one or more of registration Nos. TMA171,428; TMA629,841; TMA429,024; TMA778,093 and TMA804,670 each which consists of or includes the component BOSTON PIZZA. I have exercised my discretion and checked the Register to confirm that each of these registrations is extant [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground.

[17] I now have to determine, on a balance of probabilities, if the Mark is likely to cause confusion with one or more of the Opponent's registered trade-marks.

[18] I consider that the Opponent's best case scenario is registration No. TMA171,428 for the trade-mark BOSTON PIZZA which covers the following goods and services (the Registered Goods and Services):

- | | |
|----------|--|
| Goods | (1) Pizza and spaghetti, both in hot and frozen form, as well as the ingredients, in combination, for making these dishes. |
| Services | (1) Restaurant services and the franchising of restaurant services. |

[19] If the Opponent is not successful based on this mark, then it will not be successful based on any of the other marks.

Test to Determine Confusion

[20] The test to determine the issue of confusion is set out in section 6(2) of the Act where it is stipulated 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 likely lead to the inference that the goods and services associated with those trade-marks are manufactured, sold or leased by the same person, whether or not the goods and services are of the same general class. In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5): the inherent distinctiveness of the trade-marks and the extent to which they have become known; the length of time the trade-marks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trade-marks in appearance, or sound or in the ideas suggested by them. The criteria in section 6(5) are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 at para 54]. I also refer to *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) at para 49, where the

Supreme Court of Canada states that section 6(5)(e), the resemblance between the marks, will often have the greatest effect on the confusion analysis.

[21] In *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, [2006] 1 SCR 824 at para 20, the Supreme Court of Canada set out how the test is to be applied:

The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the [mark] at a time when he or she has no more than an imperfect recollection of the [prior] trade-marks and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

Summary of the Opponent's Evidence

[22] The Opponent's evidence summarized below leads to the conclusion that the BOSTON PIZZA brand is well known, if not famous, in Canada for restaurant services.

Affidavit of Jo-Anne Forrester

[23] Ms. Forrester is Vice President, Marketing of the opponent BPI (para 1).

History

[24] BPI and its predecessors have been carrying on the business of operating and franchising restaurants under the name "Boston Pizza" since 1964 when the restaurant "Boston Pizza and Spaghetti House" opened in Edmonton, Alberta (para 6). By 1970, there were 17 Boston Pizza restaurants throughout Western Canada including 15 that were franchised (para 6). In 1982, BPI was formed and in 1983 it purchased the Boston Pizza business and its chain of 44 restaurants (para 7).

Licensing and Franchising

[25] As part of the initial public offering of the Boston Pizza Royalties Income Fund, on July 17, 2002, BPI assigned ownership of its trade-marks that contain the word BOSTON to Boston Pizza Royalties LP (para 16). Simultaneous with the assignment, BPI and Boston Pizza Royalties LP entered into a license agreement pursuant to which BPI was granted an exclusive

license to use of the BOSTON PIZZA trade-marks for a term of 99 years with the right to sublicense (para 16).

[26] With respect to the use of the BOSTON PIZZA trade-mark, the evidence demonstrates that use of this trade-mark enures to the benefit of Boston Pizza Royalties LP by virtue of sections 50(1) and 50(2) of the Act. The license agreement between the two entities includes terms requiring adherence to the “[BOSTON PIZZA] Mark Standards” as well as inspection rights (para 16, Exhibit C). With respect to use by franchisees, BPI exercises tight control over its franchisees to ensure that the décor, nature and quality of food are consistent in order to ensure that the value of the brand is maintained (para 19). Every franchisee is required to sign a comprehensive franchise agreement which controls virtually every aspect of the franchisee’s operations (para 19). The franchise agreement is supplemented by an operations manual, memoranda, and inspections to ensure that quality control is achieved (para 19). The franchise agreement empowers BPI to terminate the franchise if quality standards are not met (para 19). Ms. Forrester’s evidence is also that trade-marks notice identifying Boston Royalties LP as the owner of trade-marks containing BOSTON, BOSTON PIZZA, and/or PIZZA and indicating that these are used under license has appeared on advertising material distributed (see, for example, Exhibits K-U).

Boston Pizza Restaurants

[27] Boston Pizza is the largest casual dining brand in Canada serving over 40 million customers annually at 351 locations (para 8). Since 2007, Boston Pizza has had over 300 restaurants in Canada (para 10). Boston Pizza restaurants provide for “two experiences under one roof” with a full service, family friendly casual dining restaurant and a separate sports bar (para 8). Boston Pizza restaurants offer over 100 menu items including gourmet pizzas, pastas, appetizers, salads and entrées, desserts and feature dine-in, take-out and delivery services. Boston Pizza also offers on-line food ordering and delivery sales through the website www.bostonpizza.com and, in each of the years 2011-2013, the value of sales was over \$15 million (para 71).

[28] Ms. Forrester’s evidence is that the BOSTON PIZZA trade-mark is used in the following ways: on exterior signage (para 33; Exhibit F), on marketing and promotional

materials including banners, menus and inserts (paras 34-35; Exhibits G-H); food delivery boxes and pizza slice holders (paras 55-56, Exhibit X-Y), on promotional contests, co-promotions, offers, table talkers and coupons (paras 42-53; Exhibits K-V), and on the website www.bostonpizza.com which was accessed 5 million times in each of 2012 and 2013 (para 70; Exhibit JJ). In this regard, I note that I consider the trade-marks BOSTON PIZZA RESTAURANT & SPORTS BAR and BP BOSTON PIZZA such as those set out below to constitute use of the BOSTON PIZZA trade-mark.



Affidavit of Wes Bews

[29] Mr. Bews is the Chief Financial Officer of BPI and the Chief Financial Officer and the Assistant Secretary of Boston Pizza GP Inc., the managing general partner of Boston Pizza

Royalties LP (para 1). Mr. Bews provides that from 2008-2012 yearly gross sales exceeded \$830 million (para 8) and that yearly advertising expenditures exceeded \$16 million (para10).

Affidavit of Karen E. Thompson

[30] Ms. Thompson is a Trade-mark Searcher employed by the agents for the Opponent (para 1). Ms. Thompson performed a search for active trade-marks having reached the advertisement stage consisting of or including the word BOSTON in the trade-mark and restaurant in the goods or services (para 3). Her search identified 11 trade-marks: the Mark, trade-marks owned by the Opponent and two registrations for BOSTON MARKET (registration Nos. TMA743,583 and TMA798,725) both of which are for food products other than pizza, pizza crusts, pizza mixes and lasagna distributed through retail channels other than in any kind of restaurant (Exhibits B and C).

Affidavit of Darrel J. Bricker

[31] Mr. Bricker is the Global CEO of the Public Affairs division of Ipsos Reid Corporation (“Ipsos Reid”), the third largest market research firm in the world (para 1). Ipsos Reid conducted an on-line survey of 1645 Canadians in October 2013 to examine Canadians’ word association with the term “Boston” in a food service setting (paras 3-6). The on-line survey was conducted utilizing the Ipsos Reid I-Say platform. Mr. Bricker’s affidavit details the results of this study which provides that when asked “when thinking about the word “Boston” in a food service context, what’s the first thing that comes to mind?”, 71% of respondents said, specifically, “Boston Pizza”. Other specific mentions in response to this question include “Boston cream pie/donuts (6%)”, “Boston baked beans” (3%), or “Boston clam chowder” (1%). The survey also asked consumers specifically about whether they would perceive that restaurants operated under the names “Boston Best” and “Boston Pizza” to be operated by the same company, or otherwise affiliated” to which 25% of respondents answered yes.

[32] The relevance and admissibility of expert evidence in trade-mark cases was discussed by the Supreme Court in *Masterpiece Inc v Alavida Lifestyles Inc*, *surpa* at paras 75-99. In this case, Justice Rothstein reminds us that in order to be admissible, expert evidence must meet the four criteria set out in *R v Mohan*, 1994 CanLII 80 (SCC), [1994] 2 SCR 9:

- relevance;
- necessity in assisting the trier of fact;
- absence of any exclusionary rule; and
- a properly qualified expert.

[33] The concept of relevance in survey evidence, as described by the Supreme Court in *Mattel, Inc v 3894207 Canada Inc, supra* at 45, includes the following issues: 1) reliability (in the sense of producing the same results if repeated); and 2) validity (in the sense of asking the right questions to the right pool of respondents in the correct circumstances to provide the information sought).

[34] With respect to surveys, the Court in *Masterpiece* at para 93 states that surveys have the potential to provide empirical evidence which demonstrates consumer reactions in the marketplace, which is not something generally known to a judge and serves to answer the question that the judge is addressing in a confusion case. The use of consumer surveys in trademark cases has been recognized as valid evidence to inform the confusion analysis and its main difficulty is often its reliability and possible invalidity (eg. instead of addressing the likelihood of confusion, it addresses the possibility of confusion). In the present case, I have no reason to doubt that Mr. Bricker is a properly qualified expert. Further, I do recognize the survey as relevant to the confusion analysis. In this regard, the Applicant could have requested an order to cross-examine Mr. Bricker on his affidavit, if it had concerns regarding Mr. Bricker's qualifications as an expert or the content of his affidavit.

[35] I am therefore prepared to give weight to his evidence with the exception of questions 3 and 4. With respect to these questions and, in particular, question 4 "would you perceive that restaurants operated under the name BOSTON BEST and BOSTON PIZZA are operated by the same company or otherwise affiliated?", as these questions cannot be described as open ended or non-leading, I am not prepared to give any weight to the results [see the discussion in *Canada Post Corporation v Mail Boxes Etc. USA, Inc*, 1996 CanLII 11370 (TMOB)].

Affidavit of Bethany Watson

[36] Ms. Watson is a legal assistant employed by the agents for the Opponent (para 1). She submits a copy of the response to an official action issued by the Registrar with respect to this

application (Exhibit A), excerpts from the Trade-marks Examination Manual (Exhibit B), various Google searches (para 1, Exhibits C and D) and copies of the applications for BOSTON PIZZA FOOD LEAGUE, BOSTONS, and BOSTONS SPORTS BAR (Exhibits E-G).

Summary of the Applicant's Evidence

[37] The Applicant filed the affidavits of Karen Blau and Ann Nagpala who both provide evidence concerning the use of BOSTON by third parties.

Affidavit of Ann Nagpala

[38] Ann Nagpala is a secretary employed by the agents for the Applicant (para 1). Ms. Nagpala requested a full Canadian common law search with respect to BOSTON for use in association with food and food products and restaurant services, catering services and food supply services (para 4). Attached as Exhibit A is a printout of the search results she received from Thomson Reuters. While search results performed by those other than the person swearing the affidavit have been excluded on the basis of hearsay in the past see, [for example, *Royal Bank of Canada v Manufacturers Life Insurance Company*, 2002 CanLII 61430 (TMOB)], in this case as the search parameters have been provided and the Opponent did not object to the admissibility of the search in its written argument, I am not excluding these search results or diminishing the weight given to them on this basis.

[39] Many of the results located in the search, however, appear to be irrelevant, for example, they are abandoned or inactive, owned by the Opponent, are for trade-marks which do not include BOSTON or are for unrelated goods and services [*In-Touch Network Systems Inc v 01 Communique Laboratory Inc*, [2007] TMOB 11]. As these results do not support the inference that customers in the food and restaurant field are used to distinguishing between trade-marks including BOSTON, nor that BOSTON lacks distinctiveness in the Opponent's and Applicant's fields of interest, they will not be discussed further.

[40] Trade-marks including BOSTON for food related goods and services include the following:

Registration No.	Trade-mark	Owner	Goods and Services
TMA358,725	BOSTON	Sazerac North America, Inc.	Liqueurs
TMA356,423	MR. BOSTON	Sazerac North America, Inc.	Liqueurs
TMA548,441	THE BOSTON CHIPYARD	The Boston Chipyard, Inc.	Cookies Retail sales of cookies ...
TMA427,983	BOSTON BAKED BEANS	Ferrara Candy Company	Candies
TMA457,213	HARICOTS CUIITS A LA BOSTON	Ferrara Candy Company	Candy
TMA475,520	BOSTON ICE TEA	Lassonde Industries Inc.	Non-alcoholic beverages, namely, prepared tea, herbal tea, flavoured tea
TMA681,158	BOSTON TEA CAMPAIGN	Projektwerkstatt ...	Tea
TMA798,725	BOSTON MARKET	Boston Market	Food products other than pizza ... all of which are distributed through retail distribution channels other than (i) ... restaurant[s] ...
TMA743,583	BOSTON MARKET	Boston Market	Prepared food products other than pizza ... all of which are distributed through retail distribution channels other than (i) ... restaurant[s] ...
TMA500,569	BOSTON PRIDE	McCain Foods Limited	Frozen potato products Advertising, marketing and promotional services...
TMA592,344	SAMUEL ADAMS BOSTON ALE	Boston Beer Corporation	Beer and ale

[41] The search attached to Ms. Nagpala's affidavit also includes results of searches for trade-names that include BOSTON. I do not find these results helpful since (i) in most instances it is not clear whether the businesses operate in the fields of interest of the Applicant or the Opponent and (ii) for those businesses in the relevant field there is no evidence that any of the trade-names including BOSTON has a reputation in Canada.

Affidavit of Karen Blau

[42] Karen Blau is a principal of and senior investigator of Scout Intelligence Inc. (para 1). Scout Intelligence Inc. was retained by the agents for the Applicant to identify and contact businesses in Canada that offer food and/or beverages in association with a trade-name or trademark which includes the word BOSTON (para 3). Ms. Blau was provided with a copy of the common law search attached as Exhibit A to Ann Nagpala's affidavit (para 4). Ms. Blau identified and contacted eleven entities from the common law search by telephone and provides print-outs of corporate search and directory listings. Ms. Blau's investigations identified: the following restaurants and bars including the BOSTON component: Boston's Best Coffee Canada Inc. (Carp, Ontario), Boston Café (Parry Sound, Ontario), Le Boston (Sherbrooke, Quebec), Boston Café/Boston Chinese Restaurant (Gananoque, Ontario), Boston Spicy & BBQ Restaurant (Etobicoke, Ontario), Boston Steak House Inc. (Scarborough, Ontario), Boston Fish & Chips Inc. (Burlington, Ontario), and Boston Common Restaurant (Waterford, Ontario). Ms. Blau's affidavit also includes the web-page for BOSTON PRIDE straight cut french-fries from the website www.mccainfoodservice.ca (Exhibit F). I do not find the following results to be relevant as they do not appear to be related to the interests of the Opponent and Applicant: Boston Farms Ltd (a potato grower in Coaldale, Alberta); Boston Bay Foods Inc. / Les Aliments Boston Bay Inc. (a food broker in Longueuil, Quebec); and Boston Variety Fish & Fruit (a grocery store in Toronto, Ontario).

Request for Judicial Notice of Other BOSTON Marks

[43] In paragraph 28 of its Written Argument, the Applicant requests that the Registrar:

take judicial notice of his own register and in particular, the response filed by the Applicant dated September 27, 2012 with respect to the present application wherein the

Applicant cited many trade-marks including the word BOSTON in the name of third parties for the same or similar goods

[44] The state of the register evidence referred to by the Applicant in its response has not been filed as evidence. I note that state of the register evidence cannot be considered without filing certified copies of the registrations or at least an affidavit affixing particulars of the relevant registrations [*Papillon Eastern Imports Ltd v Apex Trimmings Inc* (2007), 63 CPR (4th) 101 (TMOB) at para 14]. The Registrar does not generally exercise discretion to take cognizance of third party applications and registrations [*Quaker Oats of Co of Canada Ltd*, supra]. The parties to opposition proceedings are expected to prove each aspect of their case and registrations listed in the response are not admissible as they are unsupported allegations of fact [*1772887 Ontario Ltd v Bell Canada*; 2012 TMOB 42 at para 24].

Opponent's Reply Evidence

Affidavit of Marianne Crozier

[45] Ms. Crozier is a paralegal employed by the agents for the Opponent (para 1). Ms. Crozier contacted Boston's Best Coffee, Boston Café, Le Boston, Boston Café/Boston Chinese Restaurant, Boston Spicy & BBQ Restaurant and Boston Steak House (para 3). She confirmed that each of these entities were restaurants with the exception of Le Boston which is a night club. Ms. Crozier did not contact any other entities including BOSTON in their trade-names identified in the affidavit of Karen Blau.

Affidavit of Jonathan Jeske

[46] Mr. Jeske is General Counsel for BPI (para 1). Mr. Jeske indicates since 2008 approximately 20 cease and desist letters have been sent to different entities in Canada with respect to infringement or potential infringement of the Opponent's trade-marks (para 3). He indicates that he had no knowledge of any of the businesses referred to in Ms. Blau's affidavit except for Boston Bay Foods and McCain Foods Limited (but not with respect to the BOSTON PRIDE brand). In Mr. Jeske's cross-examination, he states that he has not sent out any cease and desist letters to any of the companies or businesses listed in the Blau affidavit (answer 37). Mr.

Jeske also states that there is an agreement which permits BOSTON MARKET to do business in Canada (answer 52).

Analysis of the Section 6(5) Factors

Inherent Distinctiveness

[47] I consider both the Mark and the BOSTON PIZZA trade-mark to lack or possess a very low level of inherent distinctiveness. The word BOSTON is a geographic location in the United States and geographic designations are not inherently distinctive [*California Fashion Industries Inc. v Reitmans (Canada) Ltd.* (1991), 38 CPR (3d) 439 (FCTD) at para 13; *Multi-Marques Inc. v Nat's Ah Pizza Ltd.*, 2009 CanLII 82138 (TMOB) at para 27]. The word BEST in the Mark does not add any inherent distinctiveness as it is laudatory with respect to the Goods and Services [*Astro Dairy Products Limited v Compagnie Gervais Danone*, 1996 CanLII 11346 (TMOB)]. With respect to the Opponent's trade-mark, while there is no evidence that "boston pizza" is a specific type of pizza, the fact that PIZZA is descriptive of the Opponent's Registered Goods and Services and BOSTON is a geographic location means that it is not inherently distinctive [*London Drugs Limited v International Clothiers Inc.*, 2014 FC 223 at paras 46-51].

Extent Known and Length of Time in Use

[48] I am satisfied from the evidence in the affidavits of Ms. Forrester and Mr. Bews that the BOSTON PIZZA trade-mark has been promoted and used extensively in Canada for a lengthy period of time. Consequently, I find it reasonable to conclude that the BOSTON PIZZA trade-mark is quite well known, if not famous. As the Applicant has filed no evidence of use or reputation in Canada, this factor favours the Opponent.

Nature of Goods, Services and Trade

[49] The nature of the goods and services of the parties are identical with respect to restaurant services and show a high degree of overlap with respect to the other Goods and Services. The Opponent's BOSTON PIZZA restaurant menus which prominently feature the BOSTON PIZZA trade-mark include sandwiches, salads, chocolate beverages, tea, fruit juice, and soft drinks

(Exhibits G,I). With respect to the Opponent's restaurant services, sold in association with the BOSTON PIZZA trade-mark, I note that these services are available not only in sit down restaurants but also through online ordering (Forrester affidavit, para 71) and concession stands (Forrester affidavit, para 57; Exhibit Z). In the absence of evidence from the Applicant, there is no basis on which I can infer that there is any difference between the nature of the goods, services and trade that consumers could use to distinguish between the trade-marks at issue.

Degree of Resemblance

[50] As stated earlier, the degree of resemblance between the trade-marks will often have the greatest effect on the confusion analysis. When considering the degree of resemblance, the law is clear that the trade-marks must be considered in their totality. The appropriate test is not a side by side comparison but an imperfect recollection in the mind of a consumer of an opponent's trade-mark [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée, supra* at para 20]. The preferable approach when comparing trade-marks is to begin by determining whether there is an aspect of the trade-mark that is particularly striking or unique [see *Masterpiece* at para 64].

[51] The Applicant submits that "none of the Opponent's marks include the word BEST. Thus, there is no similarity between the marks of the Opponent and the [Mark] other than in a non-distinctive portion" (Applicant's Written Argument at para 36). I find, however, that there are both similarities and differences between the parties' trade-marks in appearance and sound and ideas suggested. With respect to the trade-mark BOSTON PIZZA, I am of the view that neither component is particularly striking or unique given that the expression in its entirety evokes the idea that the Opponent's Registered Goods and Services include pizza and have some connection with the city of Boston. With respect to the Mark, it begins with BOSTON and ends with the laudatory component BEST. Again, I am of the view that neither component is particularly striking or unique given that the expression in its entirety evokes the idea that the Goods and Services have some connection with the city of Boston and are superlative.

[52] In the end, when the parties' trade-marks are viewed in their entirety, I find that the trade-marks have a considerable degree of resemblance. The visual and phonetic differences in the second portions of the trade-marks are not significant enough to outweigh the nearly identical first portions. Further, having a view to the acquired distinctiveness of the BOSTON PIZZA

trade-mark, a consumer familiar with the BOSTON PIZZA restaurant chain who encounters a BOSTON BEST restaurant may find that the Mark suggests the idea of food services or goods affiliated with BOSTON PIZZA due to the shared first component BOSTON. While this appears to be supported by the survey evidence that when asked “When thinking about the word “Boston” in a food service context, what’s the first thing that comes to mind?” 71% of respondents answered BOSTON PIZZA, I note that I would have made this finding in the absence of the survey evidence.

Surrounding Circumstance: Use of BOSTON or BOSTON’S

[53] At para 36 of her affidavit, Ms. Forrester sets out that BPI has branded certain menu items under the BOSTON or BOSTON’S mark, including “Boston’s Famous Wings”, “Boston’s Pizza Bread”, “Boston Royal”, “Boston’s Smoky Mountain Spaghetti and Meatballs”, and “Boston Brute” and attaches a current menu showing these items (Forrester affidavit, Exhibit I). In the absence of evidence that consumers have been impacted by such use, I do not consider this to be a relevant surrounding circumstance.

Surrounding Circumstance: Trade-marks with Geographic Significance

[54] The Applicant submits that where a party adopts a descriptive trade-mark, such as a geographical location or style of food, the party must accept that a certain amount of confusion may arise, since in such cases, confusion is inevitable (Applicant’s Written Argument, para 43 citing *Walt Disney Productions v Fantasyland Hotel Inc* (1994), 56 CPR (3d) 129 (Alta QB) at 183). The Applicant also relies on the following passage from *Prince Edward Island Mutual Insurance Co. v Insurance Co. of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD) at paras 32-34:

32 With respect to the first factor in subsection 6(5) of the Act, inherent distinctiveness of the trade marks in question, it is well established that marks which contain descriptive words are not inherently distinctive and will be afforded only a minimal degree of protection by the Court. In particular, trade marks or trade names which contain a reference to a geographic location, such as those in issue here, are descriptive rather than distinctive and do not deserve a wide ambit of protection. Where the court is called upon to determine the "likelihood of confusion" in respect of a descriptive name or mark, even small differences between the marks will be sufficient to diminish the "likelihood of confusion".

33 Furthermore, where a party adopts a descriptive name, it must accept that a certain amount of confusion may arise. In *Walt Disney Productions v. Fantasyland Hotel Inc.* (1994), 56 C.P.R. (3d) 129 (Alta. Q.B.); aff'd (1996), 67 C.P.R. (3d) 444 (Alta. C.A.); the Court made the following comments in this regard at p. 183:

Even where services are identical, where the name is descriptive rather than distinctive, a certain amount of confusion may be inevitable without sanction: ... *Office Cleaning Services Ltd. v. Westminster Window and Sign General Cleaners Ltd.*, *supra*. In the latter authority, Lord Simonds, at p. 41, said:

So long as descriptive words are used by two traders as part of their respective trade names, it is possible that some [m]embers of the public will be confused whatever the differentiating words may be.... It comes in the end, I think, to no more than this, that where a trader adopts words in common use for his trade name, *some risk of confusion is inevitable*. But that risk must run unless the first user is allowed unfairly to monopolize the words. *The Court will accept comparatively small differences as sufficient to avert confusion*. A greater degree of discrimination may fairly be expected from the public where a trade name consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered.

34 In the present case, the plaintiff's name is highly descriptive (Insurance Company) and includes a descriptive geographic element (Prince Edward Island). Accordingly, it is not entitled to a high degree of protection and it must accept the inevitable risk of some confusion in the use of such a highly descriptive.

[55] Acquired distinctiveness through use and promotion, however, can increase the scope of protection to be afforded, even for inherently weak trade-marks [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 at 240 (FCTD); Gill: *Fox on Canadian Law of Trade-marks and Unfair Competition*, at 8.2(c)]. Further, the Registrar has found this to be the case even where the trade-mark at issue has included geographic elements [see, for example, *Era Clothing Inc v Burton*, 2001 CanLII 38003 (TMOB)].

Surrounding Circumstance: Federal Court Decisions Involving the Trade-mark BOSTON PIZZA

[56] The Applicant relies on the decision of Mr. Justice Nadon of the Federal Court in *Boston Pizza International Inc. v Boston Chicken Inc*, 2001 FCT 1024 where Justice Nadon found at paras 75-76 that there was no likelihood of confusion between the trade-marks BOSTON PIZZA and BOSTON CHICKEN. It is trite law that the conclusions and findings in these decisions are

not binding on me to the extent that the evidence differs from that before me [*Vibe Ventures LLC v CTV Limited*, 2010 TMOB 166 (CanLII) paras 59-60].

Surrounding Circumstance: State of the Register and State of the Marketplace

[57] The Applicant submits that its evidence establishes a multitude of traders using the word BOSTON for the same goods and services as the Opponent (Applicant's written argument, para 19) and that Canadian consumers are used to seeing and distinguishing between various BOSTON trade-marks that are associated with the goods in question (Applicant's written argument, para 37).

[58] The Opponent submits that the Applicant's evidence is insufficient to allow for inferences to be made about the state of the marketplace and points to various decisions including *Mondo Foods Co. Ltd v Saverio Coppola*, 2011 TMOB 228 and *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD) at 209. While I agree with the Opponent that the state of the register evidence is insufficient to find that BOSTON prefixed marks have been commonly adopted in association with restaurant and related food services, I am prepared to find that the evidence presented results in the inference that the Opponent does not have a monopoly over the use of the component BOSTON with respect to food and beverage goods.

[59] With respect to the Applicant's evidence that there are a handful of restaurants with a few locations across Canada, given the number of Boston Pizza outlets, the few restaurants identified have little, if any, effect on the distinctiveness of the trade-mark BOSTON PIZZA (see *Boston Pizza International Inc v Boston Chicken, Inc*, 2005 43 CPR (4th) 133 at 151 (TMOB) where a similar finding was made).

Surrounding Circumstance: Enforcement of the BOSTON PIZZA Trade-mark

[60] I reject the Applicant's submissions that as the Opponent has permitted traders to use trade-marks and trade-names including BOSTON it cannot now say that there is a likelihood of confusion arising from use of BOSTON BEST (Applicant's Written Argument, para 66). I do not find that the evidence shows that the Opponent had acquiesced to use third party trade-marks

involving the word BOSTON in such a way as to undermine the distinctiveness of the Opponent's BOSTON PIZZA trade-mark.

Conclusion

[61] In applying the test for confusion, I have considered it as a matter of first impression and imperfect recollection. Having examined all of the surrounding circumstances of the case, I conclude that the Applicant has failed to meet its legal onus of showing, on a balance of probabilities, that there is no reasonable likelihood of confusion. While the Applicant argues that the Opponent's mark is not entitled to a broad scope of protection, I believe that if I were to find that there was no likelihood of confusion in the present case then I would be finding an overly narrow scope of protection. Just because a trade-mark is inherently weak does not mean that it cannot have acquired sufficient distinctiveness to prevent the registration of another trade-mark. Given the absence of any use by the Applicant, in view of the extensive and lengthy use of the Opponent's trade-mark for identical or highly similar goods and services, I conclude that a consumer, who has an imperfect recollection of the Opponent's trade-mark, might reasonably infer that Goods and Services sold in association with the Mark share the same source as the BOSTON PIZZA restaurant services or are otherwise associated with the Opponent. I note that the result may have been different if the Applicant had filed evidence showing its trade-mark had acquired distinctiveness or that there were differences in the nature of the goods, services or business of the parties.

Section 2 Ground of Opposition

[62] The Opponent pleads in paragraph 1(e) of the statement of opposition:

.. the [Mark] is not distinctive, having regard to the provisions of Sections 38(2)(d) and 2 of the [Act] because the [Mark] does not and will not actually distinguish, nor is it adapted to distinguish or capable of distinguishing, the wares and services in association with which the [Mark] is proposed to be used by the Applicant or its licensees from the wares or services of other persons, and in particular, the wares and services in association with [the Opponent's trade-marks].

[63] In order to meet its evidentiary burden under this ground of opposition, the Opponent has to show that as of the filing of the statement of opposition one or more of the Opponent's trade-

marks had become sufficiently known to negate the distinctiveness of the Mark and its reputation in Canada is substantial, significant, or sufficient [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 at para 34]. The evidence summarized in paragraphs 22-29 of this decision is sufficient to meet the Opponent's burden. The Applicant is accordingly required to show that its Mark is adapted to distinguish or actually distinguishes its goods and services from the services of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[64] The Applicant's position is no stronger as of April 25, 2013 than it is as of today's date. Accordingly, I reach the same conclusion regarding the likelihood of confusion as under the section 12(1)(d) ground of opposition and this ground of opposition is successful.

Remaining Grounds of Opposition

[65] As I have already found in favour of the Opponent under two grounds, I do not consider it necessary to address the remaining grounds of opposition.

Disposition

[66] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Natalie de Paulsen
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE: 2015-10-13

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