



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 099

**Date of Decision:** 2023-06-14

## **IN THE MATTER OF OPPOSITION**

**Opponent:** Mary Brown's Inc.

**Applicant:** 2532365 Ontario Limited o/a Mary Be Kitchen

**Application:** 1,827,780 for MARY BE KITCHEN

### **INTRODUCTION**

[1] 2532365 Ontario Limited o/a Mary Be Kitchen (the Applicant) has applied to register the trademark MARY BE KITCHEN (the Mark) in association with the following (collectively, the Goods and Services):

Class 21 - (1) Aprons, tea towels and dishes namely mugs, cups, plates, bowls and serving platters.

Class 25 - (2) T-shirts.

Class 29 - (3) Prepared and fresh foods namely, salads, fresh fruits and vegetables; Prepared meals, soups and stocks; Snacks namely, chocolate bars, popcorn, and pre-portioned nuts; Desserts and baked goods namely, cookies, muffins, bars, namely cereal-based bars, granola bars and fruit-based bars, cakes and breads; Granola, breakfast cereals, muesli and yoghurt parfaits; Savoury sauces namely, pesto, ketchup and barbeque sauce; Salad dressing; Jam,

chutney and compote; Coffee, tea and cocoa; Carbonated and non-carbonated beverages, iced teas, lemonade and non-alcoholic fruit and vegetable juice.

Class 39 - (1) Restaurant services namely, food delivery services.

Class 43 - (2) Restaurant services namely, dine-in and take-out services; Catering services.

All of the Goods and Services were filed for on the basis of the Applicant's proposed use in Canada.

[2] For the reasons that follow, I refuse the application.

### **BACKGROUND**

[3] The application was filed on March 16, 2017 and advertised for opposition in the *Trademarks Journal* issue dated October 17, 2018. The Opponent opposed the application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on September 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[4] The grounds of opposition at issue are set out below:

- (a) The Mark is not registrable as it is confusing with the Opponent's registered MARY BROWN'S trademarks at Schedule A.
- (b) The Applicant is not the person entitled to registration of the Mark since it is confusing with the use of the Opponent's MARY BROWN'S trademarks including those at Schedule A.
- (c) The Mark is not distinctive of the Applicant in view of the use of the Opponent's MARY BROWN trademarks including those at Schedule A.

[5] The Opponent confirms that it will not pursue the section 30 grounds of opposition (Opponent's written representations, para 61).

[6] The Opponent filed as its evidence the affidavit of Angela M. Windsor, its Brand Manager. The Applicant filed as its evidence the affidavit of Sarah Huggins, its CEO. Ms. Huggins was cross-examined on her evidence. As its evidence in reply, the Opponent filed a second affidavit of Ms. Windsor. For the purposes of this decision, it

unnecessary for me to refer to Ms. Windsor's reply evidence. Both parties filed written representations and attended a hearing.

### **EVIDENTIAL BURDEN AND LEGAL ONUS**

[7] Before considering the grounds of opposition, it is necessary to review some of the 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.

[8] With respect to (i) above, there is an evidential burden on an opponent to support the facts in its allegations pleaded in the statement of opposition: *John Labatt Limited v The Molson Companies Limited*, 30 CPR (3d) 293 (FCTD) at 298. 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 the opponent has met its evidential burden). A legal onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against an applicant.

### **GROUND OF OPPOSITION**

[9] The determinative issue for decision raised by the section 12(1)(d), 16 and 2 grounds of opposition is whether the Mark is confusing with any of the Opponent's MARY BROWN'S trademarks (set out at Schedule A). The material dates to assess the issue of confusion are: (i) the filing date of the application with respect to the entitlement ground; (ii) the date of my decision with respect to the ground of opposition alleging that the Mark is not registrable; and (iii) the date of opposition with respect to the ground of opposition alleging that the Mark is not distinctive of the Goods and Services [for a review of material dates in opposition proceedings see *American Association of Retired Persons v Canadian Assn of Retired Persons* (1998), 84 CPR (3d) 198 (FCTD) at 206 - 208].

**Trademarks Used by the Opponent**

[10] Since the introduction of the MARY BROWN brand, the Opponent has adopted several different trademarks. Some of the examples from Ms. Windsor’s affidavit are shown below:

	Exhibit B
	Exhibit S
	Exhibit T
	Exhibit W-1

I consider each of the trademarks featuring MARY BROWN’S above to be use of the trademark MARY BROWN’S as these trademarks preserve the dominant component MARY BROWN’S and remain recognizable [*Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA); *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

**Opponent Meets its Evidential Burden for all Confusion Grounds**

[11] The Opponent meets its evidential burden for all of the confusion grounds for the following reasons. I will focus my analysis on the Opponent’s MARY BROWN’S trademark (registration no. TMA543085 listed in Schedule A) as I consider it to represent the Opponent’s strongest case. That is, if the Opponent is not successful based on this trademark, then it will not be successful based on its other trademarks.

- (a) Section 12(1)(d) Ground of Opposition – I have exercised my discretion [*Quaker Oats Co of Canada v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)] and confirm that the registrations in Schedule A are extant.

- (b) Section 16 Entitlement Ground of Opposition – the Opponent’s evidence of its MARY BROWN’S trademark appearing on its restaurant signage, menus, and uniforms (Windsor affidavit, para 22, Exhibits S-V) are sufficient to meet its evidential burden that it had used this trademark as of March 16, 2017.
- (c) Section 2 Ground of Opposition – the Opponent’s evidence of over \$10 million sales from 1980 onwards increasing to over \$100 million in 2017 combined with the examples of use on signage, menus and uniforms (Windsor affidavit, para 24, Exhibits S-V) are sufficient to show that its MARY BROWN’S trademark was known to some extent in Canada and the reputation of this trademark was substantial, significant or sufficient [*Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles’ International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)].

### ***Test for confusion***

[12] The test to determine the issue of confusion is set out in section 6(2) of the Act which stipulates that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would likely lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[13] Therefore, section 6(2) of the Act does not concern confusion of the trademarks themselves, but of the goods or services from one source as being from another. Essentially, the question here is whether a consumer, with an imperfect recollection of the Opponent’s trademark MARY BROWN’S, would think that the Applicant’s MARY BE KITCHEN Goods and Services emanate from, are sponsored by or approved by the Opponent. In addition, while the Supreme Court has clarified that subsequent research and care may "unconfuse" a consumer, what is relevant for the confusion analysis is the

confusion that may have occurred when the consumer first encounters the trademark: *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 87.

[14] In applying the test for confusion, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time they have 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 trademarks including in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context-specific assessment [*Veuve Cliquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23]. I also refer to *Masterpiece Inc*, *supra* where the Supreme Court of Canada states at para 49 that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis.

#### Inherent Distinctiveness

[15] A trademark is inherently distinctive when nothing about it refers the consumer to a multitude of sources [*Compulife Software Inc v CompuOffice Software Inc*, 2001 FCT 559 at para 19]. As noted by Justice Bédard in *Philip Morris Products SA v Imperial Tobacco Canada Limited*, 2014 FC 1237, citing *Apotex Inc v Canada (Registrar of Trademarks)*, 2010 FCA 31, whether a trademark is distinctive is a question of fact that is determined by reference to the message that it conveys to the casual consumer of the goods or services in question when the trademark is considered in its entirety as a matter of first impression.

[16] Considering the inherent distinctiveness of the Opponent's trademarks MARY BROWN'S and MARY BROWN'S FRIED CHICKEN, these trademarks have a very limited degree of inherent distinctiveness as each includes a name and in the case of MARY BROWN'S FRIED CHICKEN, a description of the services at issue.

[17] The Mark has a slightly higher degree of inherent distinctiveness as consumers may be uncertain as to what MARY BE KITCHEN indicates and whether BE is a last

name or indicates another meaning. With respect to the Applicant's submissions that the Mark is a play on the expression "Eat. Drink. Be Merry" or symbolizes a "joyful state of mind and a way of eating and living" (Huggins affidavit, para 4), there is no basis on which I could find that these meanings would occur to consumers as a matter of first impression.

#### Extent Known and Length of Time in Use

[18] The extent known and length of time in use of the parties' trademarks significantly favours the Opponent at all material dates.

[19] The Opponent's evidence is that its MARY BROWN'S trademark has been used since at least the early 1970s in association with the operation of a restaurant (Windsor affidavit, paras 3-4). By 1977, there were approximately 17 MARY BROWN'S locations in Canada (para 24). The earliest example of use in Ms. Windsor's affidavit is a container with the trademark MARY BROWN'S from 1986 (Exhibit U). In contrast, the application is based on proposed use and the evidence is that the Applicant's restaurant opened in November 2017 (Huggins affidavit, para 3).

[20] The Opponent's use of its trademarks is extensive as detailed in Ms. Windsor's evidence:

- (a) The Opponent and its franchisees operate approximately 160 restaurants in Canada (para 5).
- (b) The MARY BROWN'S trademark appears on store signage, menus, advertising, containers, employee uniforms, and coupons as well as the Opponent's website and social media (Windsor affidavit, para 14; Exhibits O-R; Exhibits S-V, W-1).
- (c) The evidence shows that the Opponent maintains sufficient control over the quality of the restaurant services for use of its trademarks by its franchisees to enure to it pursuant to section 50 of the Act. The Opponent has a mirror report system which assesses operational

processes, service standards and quality control on a store by store basis (Exhibit L). Further, franchisees must use the Opponent's suppliers to ensure consistent products and services (Exhibit L). Finally, the Opponent's real estate specialists choose franchisee locations and the construction team manages the store design and building (Exhibit L).

- (d) The Opponent provides sales information for a number of years showing sales increasing from 10 million in 1989, to 55 million in 2011, to 115 million in 2017 (para 24).

[21] In contrast, the Applicant's restaurant has a single location opened in November 2017 with the Mark being on signage and on menus (Huggins affidavit, para 3, Exhibit A). The Applicant has not provided any sales information.

#### Nature of the Goods, Services and Trade

[22] There is direct overlap in the restaurant and catering services of the Applicant and the Opponent's restaurant services. The Applicant highlights that it offers predominantly plant-based foods with a focus on health, none of which are deep fried, served on real plates with real cutlery (i.e., not disposable), delivered to the customer's table (Huggins affidavit, paras 8 and 11, Exhibit A) while the Opponent predominantly offers fried-chicken based entrees accompanied by sides of fries, gravy, coleslaw, mac & cheese, salad, or onion rings served at the counter (Windsor Affidavit, Exhibit B). This, however, does not result in a significant difference in the nature of the services, trade or business.

[23] First, neither the Opponent's registrations, nor the application restrict the types of restaurant services that may be provided. Second, the differences are not so significant that the average consumer would use them to distinguish the source of the parties trademarks as a matter of first impression. Importantly, although the food sold at the Applicant's restaurant is overall more expensive than that sold at the Opponent's, the difference is not so great to result in services of a different nature.



[24] With respect to the Goods, the Applicant submits that the Goods are in the nature of pre-made food and grocery items and t-shirts and dishware, separate and distinct from the food items served by the Applicant through its restaurant services (Applicant's written representations, paras 75-76). In assessing the potential for overlap in the parties' goods and services, the statement of goods must be read with a view to determining the probable type of business or trade rather than all possible trades that might be encompassed by the wording [*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); *American Optical Corp v Alcon Pharmaceuticals Ltd* (2000), 5 CPR (4th) 110 (TMOB)]. In this case, Ms. Huggins' evidence is that at least some of these goods are sold at the restaurant with the Summer 2020 menu showing a number of "grab-and-go" grocery items sold through the Mary Be Kitchen restaurant, such as soups, stews, ready-to-bake cookies, granola, guacamole, salmon burgers, fruit compotes, coffee beans, and oat milk (Exhibit A). Therefore, for the Goods, I conclude that some overlap remains with the Opponent's restaurant services.

#### Degree of Resemblance

[25] In most instances, the degree of resemblance between the trademarks at issue is likely to have the greatest effect on the confusion analysis [*Masterpiece*, supra at para 49]. One must consider the degree of resemblance between the marks in appearance, sound and ideas suggested. However, it is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [*Veuve Clicquot*, supra].

[26] In *Masterpiece*, the Supreme Court of Canada stated that a preferred approach when assessing the degree of resemblance is to first consider whether there is an aspect of a trademark that is particularly striking or unique [para 64].

[27] Here, I find the most striking part of the Mark is the component MARY BE. With respect to the Opponent's trademark MARY BROWN'S, I find the most striking component to be the trademark as a whole MARY BROWN'S. Both parties' trademarks may suggest or allude to the same idea – a restaurant founded by someone named

Mary. I do not find that the word component KITCHEN would assist consumers distinguishing between the parties' trademarks because this component is suggestive, if not descriptive, of the Services [*Reno-Dépôt Inc v Homer TLC Inc* (2009), 84 CPR (4th) 58 (TMOB) para 58]. In view of the foregoing, I find that while there are differences in the parties' trademarks ultimately there is a significant degree of resemblance between the parties' marks in appearance, sound and ideas suggested.

[28] Finally, as explained in *Arterra Wines Canada, Inc v Diageo North America, Inc*, 2020 FC 508 at para 62, I must take into account different possible presentations of a trademark:

In addition, possible future presentations of a trademark available to a registered trademark owner and an applied for trademark owner must be considered in respect of word marks: *Masterpiece*, above at paras 55-56, 85; *Cheah v McDonald's Corporation*, 2013 FC 774 at paras 3-4; *Pizzaiolo*, above at para 24. It was incumbent on the TMOB, therefore, to consider adequately whether both the registered trademark NAKED GRAPE and the applied for trademark THE NAKED TURTLE could be presented in a format that would create an opportunity for consumer confusion.

Here, I consider that the MARY BE KITCHEN trademark could be displayed in a format which increases the chance of consumer confusion (ie) if the MARY BE portion of the trademark was emphasized in a larger font, for example.

[29] On balance, this factor favours the Opponent.

#### No Evidence of Actual Confusion

[30] In some cases, the absence of evidence of actual confusion between the parties' marks, despite an overlap of sales of goods and the channels of trade, may lead to a negative inference about the strength of an opponent's case [*Christian Dior, SA v Dion Neckwear Ltd*, 2002 FCA 29, at 19; *Mattel* at 55].

[31] The Opponent has not evidenced any instances of confusion between any of its trademarks and the Mark. The Applicant's evidence is that in the four years between

when its restaurant was launched with the Mark and the swearing of Ms. Huggins' affidavit that there is no evidence of confusion (para 16).

[32] This evidence is not relevant for the section 16(3)(a) ground of opposition. I am not able, to make any inferences about a potential lack of confusion between the Opponent's use of its trademark and the Applicant's use of its Mark, as all of this evidence postdates the material date and is not intrinsically connected with facts occurring at the material date [see *Servicemaster Co v 385229 Ontario Ltd* 2015 FCA 114 at paras 21-22].

[33] With respect to the distinctiveness and section 12(1)(d) ground of opposition, this factor only favours the Applicant to a very limited extent. In *Dior*, the Federal Court of Appeal explains that an adverse inference may be drawn when concurrent use on the evidence is extensive, but no evidence of confusion is given by an opponent. In this case, however, the evidence of concurrent use is not extensive. There is no evidence that any of the Opponent's locations or advertising co-exist with the Applicant's use of its Mark in a single location.

Additional Surrounding Circumstance – Use of MARY'S DINER and MB Design

[34] The Opponent's evidence shows that it has used the trademark MARY'S DINER in association with a single sit down restaurant in Newfoundland and used the MB Design trademark including on containers. First, the Opponent's use of the MB Design trademark commenced after the material date for the section 16 ground of opposition meaning that the use of this mark is not relevant for that particular ground of opposition. Second, as sales figures for goods and services sold in association with these trademarks have not been provided, there is no basis on which I could find that the use of the MARY'S DINER or MB Design trademarks result in an increased likelihood of confusion.

### Additional Surrounding Circumstance – Jurisprudence Concerning Weak Trademarks

[35] The Applicant submits that the Opponent as the owner of a weak trademark should be held to accept some risk of confusion [*General Motors v Bellows* (1949), 10 CPR 101 at 115–116 (SCC)].

[36] It is well accepted that comparatively small differences will suffice to distinguish between weak trademarks [*Boston Pizza International Inc v Boston Chicken Inc* (2001), 15 CPR (4th) 345 (FCTD) at para 66]. As explained in *Provigo Distribution Inc v Max Mara Fashion Group SRL* 2005 FC 1550 at para 31:

The two marks being inherently weak, it is fair to say that even small differences will be sufficient to distinguish among them. Were it otherwise, first user of words in common use would be unfairly allowed to monopolize these words. A further justification given by courts in coming to this conclusion is that the public is expected to be more on its guard when such weak trade names are used ...

[37] It is possible, however, for the degree of distinctiveness attributed to a weak trademark to be enhanced through extensive use [*Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD) at para 6]. Here, the Opponent has filed evidence of extensive use of its trademark over a long period of time.

### Additional Surrounding Circumstance – Applicant’s GOOGLE Searches

[38] As part of her evidence, Ms. Huggins attaches the first five pages of Google searches for Mary Be and Mary B which show that MARY BROWN’S does not come up in the search results (Exhibits B and C). I note that these search results are outside the material date for the sections 16 and 2 grounds of opposition. With respect to the section 12(1)(d) ground of opposition, I do not find that these search results assist the Applicant as there is no evidence that the Google search results track a casual consumer with imperfect recollection’s ability to distinguish between the trademarks at issue.

## Conclusion

[39] 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 when they have no more than an imperfect recollection of the Opponent's MARY BROWN'S trademark and does not pause to give the matter any detailed consideration or scrutiny.

[40] Having considered all of the surrounding circumstances, in particular, the degree of resemblance between the trademarks, and the direct overlap in the parties' restaurant services, I find that at best for the Applicant, the probability of confusion is evenly balanced between a finding of confusion and no confusion, at the earliest material date. In my view, a casual consumer might not be particularly alert to the distinction between the Opponent's trademark MARY BROWN'S and the Mark given all the surrounding circumstances and may think that the source of the Goods and Services of the Applicant is the Opponent.

[41] In so finding, I acknowledge that MARY BROWN'S is not the type of trademark that is typically afforded a broad scope of protection and there are differences between it and the Mark. At the material date for the section 16 ground of opposition, however, only the Opponent had acquired a reputation in association with its trademarks and the goods and services of the parties overlap. As the onus is on the Applicant to demonstrate on a balance of probabilities that there is no reasonable likelihood of confusion between the marks, I find against the Applicant and the section 16(3)(a) ground of opposition succeeds.

[42] With respect to the material dates for the section 2 and 12(1)(d) grounds of opposition, while the Applicant had commenced use of the Mark, given the quite limited evidence regarding the manner in which and extent to which the Mark has been used, it also fails to meet its legal onus for these grounds of opposition which succeed.

**DISPOSITION**


[43] In view of the above, and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(12) of the Act.




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Natalie de Paulsen  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**SCHEDULE A**

***Schedule A Registered Trademarks of the Opponent***

Trademarks	Registration No.	Goods and Services
MARY BROWN'S FRIED CHICKEN	TMA546986	(1) Restaurant and take-out food services
MARY BROWN'S	TMA543085	
	TMA542740	
MARY BROWN'S FAMOUS CHICKEN AND TATERS	TMA592862	
MARY'S DINER	TMA824185	

	<p>TMA824184</p>	<p><b>Goods</b>  (1) Clothing, namely, t-shirts, shirts, sweatshirts, polo shirts, sport shirts, jackets, caps and hats.  (2) Duffel bags and sports bags.</p> <p><b>Services</b>  (1) Restaurant and take-out food services.  (2) Franchise services in the field of restaurants, ...</p>
	<p>TMA975406</p>	<p>(1) Restaurant services; take-out restaurant services</p>
	<p>TMA975408</p>	



# Appearances and Agents of Record

**HEARING DATE:** 2023-01-24

## **APPEARANCES**

**For the Opponent:** Stephanie Chong

**For the Applicant:** John H. Simpson

## **AGENTS OF RECORD**

**For the Opponent:** Hoffer Adler LLP

**For the Applicant:** Shift Law Professional Corporation