

BAM!

By John McKeown

A recent decision of the Trade-marks Opposition Board illustrates the care that must be taken in determining the positions to be taken in response to an opposition.

The Facts

The owner of the trade mark BAM! (the “Applicant”), for use in association with food products namely vinegar; salad dressings namely marinades and dipping sauces (the “Wares”), filed trade-mark applications to register the trade-mark BAM! BULLY! and the mark BAM! BOOZLED! (collectively the “Marks”) based on proposed use in association with the Wares.

Emeril's Food of Love Productions, LLC (the “Opponent”) opposed both applications on the ground, among others, that the Applicant was not the person entitled to registration because at the filing date of each application, the Marks were confusing with the Opponent's trade-mark BAM!, previously used and made known in Canada in association with "food, namely food seasoning; apparel; footwear; cookware, cooking utensils and accessories; printed matter; books; television shows; cooking demonstrations, wine and/or food tastings.”

The Onus and Burden of Proof

The Hearing Officer stated that the legal onus was on the Applicant to show that the Marks were not confusing with the Opponent's trade-mark, but there was 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 the ground of opposition existed.

The Opponent successfully showed prior use of its trade-mark BAM! as of the Applicant's filing dates and that such use was not abandoned at the advertisement date of the applications. As a

result, the Applicant had to prove, on the balance of probabilities, that the Marks were not likely to cause confusion with the Opponent's trade-mark BAM!.

The Decision

The Applicant mistakenly admitted that the Marks were confusing with the Opponent's trade-mark BAM!, but asserted priority as result of its prior use and registration of its BAM! trade-mark. Presumably the Marks were confusing with the Applicant's BAM! registration but not with the Opponent's trade-mark.

The Hearing Officer refused to accept this argument. He stated the fact that the Applicant obtaining the registration of a trade-mark prior to the relevant date (the filing date of the applications for the marks) did not necessarily give it the right to obtain the registration of a similar trade-mark.

The rights conferred by the *Trade-marks Act* (the "Act") on the owner of a registered trade-mark did not give the owner of a registration the automatic right to obtain any further registrations no matter how closely they may be related to the original registration.

The Hearing Officer also said that any use of a trade-mark similar to the Marks by the Applicant was not a relevant factor. This may be correct in light of the admission, but is otherwise questionable, since the fact that the respective marks coexisted presumably without confusion is relevant. Also, it is relevant that the Opponent obtained its mark over the Applicant's registered mark.

Comment

The rights conferred by the Act on the owner of a registered trade-mark do not give the owner of a registration the automatic right to obtain any further registrations of the same or related mark

no matter how closely they may be related to the original registration. Each new application, including an extension application, must stand or fall on its own merits at the relevant date.

Obviously, care needs to be taken when an admission is made during the course of an opposition.

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These comments are of a general nature and not intended to provide legal advice as individual situations will differ and should be discussed with a lawyer.