



28 juin/Jun 2023
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RE: Trademark: ZELLERS RESTAURANT & Design
Applicant: Zellers Inc.

This examiner's report concerns the above identified application. To avoid abandonment proceedings, a proper response must be received by this office by December 28, 2023. All correspondence respecting this application must indicate the file number.

The applicant's correspondence dated April 25, 2023 is acknowledged.

In view of paragraph 12(1)(d) of the *Trademarks Act*, the trademark does not appear to be registrable since it is considered confusing with registered trademark nos. TMA445,428, TMA445,249, TMA434040, TMA445,430, TMA434,003, TMA434,004, TMA445,429 and, TMA452,495, particulars of which are attached.

In view of paragraph 37(1)(c) of the *Trademarks Act*, the applicant does not appear to be entitled to registration. Specifically, the entitlement date October 2, 2021 of the application is later than the entitlement date of June 30, 2021 of co-pending and confusing application nos. 2,117,653, 2,117,654 and 2,117,731, particulars of which are attached.

In assessing whether there is a reasonable likelihood of confusion between the trademark and the cited registered trademark(s), the Registrar must have regard to the provisions of subsection 6(2) of the *Trademarks Act*, which provides that:

The use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to 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.

The Registrar must consider all the surrounding circumstances including those stated in subsection 6(5) of the *Act*:

- (a) the inherent distinctiveness of the trademarks or tradenames and the extent to which they have become known;
- (b) the length of time the trademarks or tradenames have been in use;
- (c) the nature of the goods, services or business;
- (d) the nature of the trade;

(e) the degree of resemblance between the trademarks or tradenames in appearance or sound or in the ideas suggested by them.

Confusion is tested in terms of the average consumer's first impression of the one trademark and imperfect recollection of the other mark(s), and not by a side-by-side scrutiny. The "average consumer" is a likely buyer of the associated goods or services who has an average education in English and/or French.

The applicant's action and/or written comment is awaited.

In addition to the above objections, the following requirements must also be addressed:

The original application filed on October 2, 2021 contained the goods "sunglasses" in Class 25. The proper class for "sunglasses" is Class 9. Please note that as per the June 17, 2019 Practice Notice on Application Fees, the applicant cannot avoid the fee for additional classes by removing goods or services after an application has been granted a filing date. Therefore, in the present case, the applicant is still required to pay for "**sunglasses**" which appeared in the initial application but not in the amended application.

In view of the number of classes in respect of the goods and services listed in the application at the date of filing, as determined by the Registrar, the applicant is required to pay for **1 additional class**.

Note: The prescribed application fee, including fees for additional Nice classes, is adjusted every year on the first of January. The amount depends on the date on which the payment is received by the Registrar, even if the prescribed fee for the first class of goods or services to which the application relates was paid prior to the annual adjustment. To find out the exact amount of a fee, please consult the list of fees available on CIPO's website at www.Canada.ca/IP-fees.

As of the date of this report, an additional **\$105.26** is required to cover the prescribed application fee.

The applicant's action and/or written comment is awaited.

If the applicant has any specific questions in respect of this Office action, please contact the assigned examiner. Please note that for general inquiries, including assistance with filing of the revised application, queries about the status of an application or receipt of correspondence, you may contact our Client Service Centre toll free at 1-866-997-1936.

Yours truly,



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