IN THE MATTER OF AN OPPOSITION by Kenneth Hutfelter and Rose Hutfelter doing business as Kenrose Enterprises to application No. 713,711 for the trade-mark PITA PAZZAZ filed by 517577 Ontario Ltd.

On September 29, 1992, the applicant, 517577 Ontario Ltd., filed an application to register the trade-mark PITA PAZZAZ for "operation of a restaurant and food distribution business" based on use since at least as early as December 18, 1991.

The application was advertised for opposition purposes on July 14, 1993. The opponent, Kenneth Hutfelter and Rose Hutfelter doing business as Kenrose Enterprises, filed a statement of opposition on September 14, 1993, a copy of which was forwarded to the applicant on October 28, 1993. The first ground of opposition is that the applicant is not the person entitled to registration of the applied for mark pursuant to Section 16(3) of the Trade-marks Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the trade-mark and trade name PITA PIZZAZZ which had been previously used in Canada by the opponent for the operation of fast-food and food fair type outlets specializing in the preparation and sale of ready to eat pitas. The second ground is that the applied for trade-mark is not distinctive of the applicant's services because it fails to distinguish the applicant's services from the services of others, namely the opponent, and it is not adapted to so distinguish them.

The applicant filed and served a counterstatement. The counterstatement does not specifically deny any of the grounds of opposition but merely sets out the grounds on which the applicant relies as supporting its application. Most of these grounds are allegations such as that the opponent has not registered or applied to register its trade-mark, that the applicant obtained an opinion from a trade-mark agent before filing its application, that the applicant has in fact used its trade-mark since 1983, that the trade-marks themselves are different and that the parties' signage differs, and that the applicant is a "vibrant franchisor" while the opponent is not. To the extent that the contents of the counterstatement are an attempt to introduce evidence or make arguments, the contents will be disregarded.

The opponent filed as its evidence the affidavit of Kenneth Hutfelter. The applicant submitted as its evidence the affidavits of Lynn Colledge, Vicki Vasiliou, and Ray Gauthier. It also filed a photograph which is inadmissible as evidence as it was not submitted as an exhibit to an affidavit or in any other acceptable form. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

Both opposition grounds are based on an allegation of confusion between the opponent's PITA PIZZAZZ trade-mark/trade name and the applicant's trade-mark PITA PAZZAZ. The material date with respect to the Section 16 ground of opposition is the claimed date of first use of the applicant's trade-mark namely December 18, 1991. The

material date with respect to the non-distinctiveness ground is the date of filing of the opposition, September 14, 1993 [see Re Andres Wines Ltd. and E.& J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.) and Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.)].

Sections 16(5) and 17(1) of the Trade-marks Act place a burden on the opponent to establish its use of its PITA PIZZAZZ trade-mark/trade name prior to December 18, 1991 and non-abandonment of such as of the date of advertisement of the present application, July 14, 1993. Kenneth Hutfelter, attesting on behalf of the opponent, states that beginning in or about August 1987, he and his wife, Rose Hutfelter, doing business as Kenrose Enterprises, have consistently used PITA PIZZAZZ in connection with the operation of retail fast food outlets specializing in the preparation and sale of ready-to-eat pitas in British Columbia. In particular, he attests that such use was made at the Cloverdale Rodeo each year from 1989 to 1994, the date of his affidavit. He provides photographs of their most recent signage as well as signage used since 1987. The applicant has pointed out that the opponent has not filed any documentary evidence supporting its claimed dates of use. However, I do not believe that such is mandatory. We have Mr. Hutfelter's sworn testimony that the signage shown in his exhibits was in use at certain locations at certain times and there is no reason to not believe such statements. The applicant was at liberty to cross-examine Mr. Hutfelter if it wished to try to discredit his testimony. On the basis of Mr. Hutfelter's evidence, I find that the trade-mark PITA PIZZAZZ was in use by the opponent as of December 18, 1991 and was not abandoned as of July 14, 1993. Thus, the legal burden is on the applicant to show that there would have been no reasonable likelihood of confusion between the trade-marks at issue as of December 18, 1991.

Before proceeding with an analysis of the likelihood of confusion, I must address the applicant's attempt to rely on use of its trade-mark as of a date preceding that claimed in its application. The Trade-marks Regulations state in Rule 32 that no application may be amended after advertisement to change the date of first use of the trade-mark. For the purposes of this opposition, the applicant is stuck with the date of first use claimed in its application. To allow the applicant to now rely on an earlier date of first use would be inequitable as the opponent necessarily proceeds on the basis of the details of the application. This does not however mean that the applicant is without recourse, as it can at any time file a new application relying on an earlier date of first use, provided that such earlier use does in fact enure to the applicant's benefit.

In applying the test for confusion set forth in Section 6(2) of the Trade-marks Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act.

The opponent's trade-mark, PITA PIZZAZZ, does possess a reasonable degree of inherent distinctiveness as the combination of these two words is somewhat unique. However, the applicant's trade-mark, PITA PAZZAZ, has a greater degree of inherent distinctiveness because the word PAZZAZ is an invented word.

The extent to which the trade-marks had become known as of December 18, 1991 favours the opponent as its trade-mark was in use since 1987 although it is unclear how many people would have seen the opponent's PITA PIZZAZZ sign. Although the applicant claims that its trade-mark was in use prior to December 1991, it is unclear if such use was by the applicant or any other party whose use would enure to the benefit of the applicant. The wording in the affidavit of Mr. Gauthier, the President of the applicant, is quite loose and any ambiguity must be interpreted against the interest of the affiant. Mr. Gauthier clearly states that another company, of which he was also President, was using the PITA PAZZAZ trade-mark in its restaurants in 1984. He goes on to say that "I have continuously used prominent PITA PAZZAZ signage in all of my fast food restaurants and food distribution outlets…" and that "in 1994, over 1,750,000 customers were served in my locations bearing PITA PAZZAZ signage". He makes no statement at all as to the activities of the applicant, 517577 Ontario Ltd. Accordingly, I have my doubts as to whether the applicant itself has used the applied-for trade-mark.

The length of time the marks have been in use favours the opponent.

The services of the parties are essentially the same, or are closely related, as are their trades.

The trade-marks in issue resemble each other a lot. The first, key word is identical and the second words, while not identical, are extremely similar, with the overall combined effect being quite similar in appearance and sound. The idea suggested by each mark may be slightly different given the dictionary definition of PIZZAZZ and the lack of meaning of PAZZAZ but I do not consider this to be significant as I think that PAZZAZ is as likely to be mistaken for PIZZAZZ as not.

I have concluded that the applicant has failed to meet the onus on it to show that there was not a reasonable likelihood of confusion between the applicant's PITA PAZZAZ trade-mark and the opponent's PITA PIZZAZZ trade-mark as of December 18, 1991. I reached this conclusion largely as a result of the great similarities between the trade-marks at issue and their associated services. The first ground of opposition therefore succeeds.

The material date with respect to the distinctiveness ground is September 14, 1993. In order for this ground to succeed, the opponent need only show that its trade-mark has become known sufficiently to negate the distinctiveness of the applied for mark [see Motel 6, Inc. v. No. 6 Motel Ltd.(1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.)]. In my view, the opponent's evidence is sufficient to show that. The opponent's ground based on non-distinctiveness therefore succeeds.

Having been delegated by the Registrar of Trade-marks by virtue of Section 63(3) of the Trade-marks Act, I refuse the applicant's application in view of the provisions of Section 38(8) of the Act.

DATED AT TORONTO, ONTARIO, THIS 9th DAY OF JULY, 1998.

Jill W. Bradbury
Hearing Officer
Trade-marks Opposition Board

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