



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

Citation: 2013 TMOB 118
Date of Decision: 2013-07-04

**IN THE MATTER OF OPPOSITIONS by
Les Restaurants La Pizzaiolle Inc. to
application Nos. 1,416,446 and 1,416,447 for
the trade-marks PIZZAIOLO & Design and
PIZZAIOLO respectively in the name of
Pizzaiolo Restaurants Inc.**

[1] Les Restaurants La Pizzaiolle Inc. (the Opponent) opposes registration of the trade-marks PIZZAIOLO and PIZZAIOLO & Design (shown below) (sometimes collectively referred to as the Marks) that are respectively the subject of application Nos. 1,416,447 and 1,416,446 by Pizzaiolo Restaurants Inc. (the Applicant).



[2] Each application was filed on October 24, 2008 and is based on use of the trade-mark in Canada since November 13, 2000 in association with, among others, gourmet pizza and restaurant services. The detailed statement of wares and services covered by both applications, as revised on June 30, 2010, is attached as Schedule "A".

[3] The Opponent alleges that the Marks are not registrable under section 12(1)(d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) and not distinctive under section 2 of the Act, and

that the Applicant is not the person entitled to registration of the Marks under section 16 of the Act because each of the Marks is confusing with, among others, the Opponent's registered trade-mark LA PIZZAIOLLE that has been used before in Canada by the Opponent in association with restaurant services. The Opponent further alleges that the applications for the Marks do not comply with the requirements of section 30 of the Act for a number of reasons, one of which being that the Applicant has not used the Marks in association with each of the Wares and Services since the date of first use claimed in its applications.

[4] I find there are two determinative issues in these proceedings, namely:

- I. Has the Applicant used the Marks in association with each of the Wares and Services since the date of first use claimed in its applications?
- II. Is each of the Marks confusing with the Opponent's trade-mark LA PIZZAIOLLE as used or registered?

[5] For the reasons that follow, I find that issue No. I must be answered in the negative for some of the Wares and Services and that issue No. II must be answered in the affirmative with respect to the Applicant's PIZZAIOLO word mark.

The Record

[6] The statements of opposition were both filed by the Opponent on January 6, 2010. Each of them was denied by the Applicant by counter statement filed on May 12, 2010.

[7] As its evidence in each file, the Opponent filed a certified copy of registration No. TMA276,602 for its trade-mark LA PIZZAIOLLE, and the affidavit of Daniel Noiseux, President and Secretary of the Opponent, sworn September 13, 2010. Mr. Noiseux was cross-examined and the transcript of his cross-examination forms part of the record. As its evidence in each file, the Applicant filed the affidavits of Luigi Petrella, President and Chief Executive Officer of the Applicant, sworn October 28, 2011; and Mary P. Noonan, a trade-mark searcher employed by the law firm representing the Applicant, also sworn October 28, 2011.

[8] As the two affidavits filed by each witness in these proceedings are essentially identical, I will use the singular form to refer to them.

[9] Both parties filed a written argument in each case. The Opponent thereafter obtained leave from the Registrar to amend each of its statements of opposition to add to the non-entitlement grounds of opposition reference to its trade-mark PIZZAIOLLE, as well as reference to a few more of its trade-names. Both parties were represented by counsel at a hearing.

The parties' respective burden or onus

[10] The Applicant bears the legal onus of establishing, on a balance of probabilities, that each of its applications complies with the requirements of the Act. However, there is an initial evidentiary burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [see *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD); and *Dion Neckwear Ltd v Christian Dior, SA et al* (2002), 20 CPR (4th) 155 (FCA)].

Issue No. I: Has the Applicant used the Marks in association with each of the Wares and Services since the date of first use claimed in its applications?

[11] The Opponent has pleaded that the applications for the Marks do not comply with the requirements of section 30 of the Act for a few reasons, one of which being that the Applicant has not used the Marks in association with *each* of the Wares and Services since the date of first use claimed in its applications. As noted by the Applicant, this pleading does not expressly refer to section 30(b) of the Act. However, I am satisfied that it is sufficiently pleaded to enable the Applicant to reply to it.

[12] The relevant date for considering the circumstances concerning this ground of opposition is the filing date of the applications [see *Georgia-Pacific Corp v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. In this regard, section 30(b) of the Act requires that there be continuous use of the trade-mark applied-for since the date claimed [see *Labatt Brewing Co v Benson & Hedges (Canada) Ltd* (1996), 67 CPR (3d) 258 (FCTD)]. The Opponent's evidentiary burden respecting

the issue of non-conformity with section 30(b) of the Act has been characterized as a light one because the facts concerning this ground are more readily available to the Applicant than to the Opponent [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Furthermore, the Opponent may meet its burden by reference to the Applicant's evidence, provided that the Applicant's evidence is clearly inconsistent with the claims set forth in its applications [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)].

[13] In the present cases, the Opponent has not filed evidence on this particular issue. It relies instead on the Applicant's evidence. I agree with the Opponent that the Applicant's evidence introduced through the Petrella affidavit casts serious doubt as to the correctness of the claimed date of first use of the Marks with respect to some of the Wares and Services.

[14] This brings me to review the salient points of the Petrella affidavit concerning the use and/or advertising of the Marks in association with the Wares and Services.

The Petrella affidavit

[15] Mr. Petrella first goes over the history of the PIZZAIOLO brand. He states that the Applicant was incorporated on August 6, 1999 and that "The first PIZZAIOLO restaurant was opened for business [in Toronto] and began selling pizza and other food and beverage wares, as well as offering related services that included catering services, on November 13, 2000." [para 5 of his affidavit]

[16] Mr. Petrella states that "By 2005, the number of [the Applicant's] PIZZAIOLO restaurants had grown to at least 10. [The Applicant] has also offered catering and delivery services in conjunction with the PIZZAIOLO brand ever since the first PIZZAIOLO location opened in November 2000." [para 7 of his affidavit]

[17] Mr. Petrella states that there are currently 27 PIZZAIOLO restaurants operating in and around the Greater Toronto Area. He attaches as Schedule 1 a list of these locations. [para 8 of his affidavit]

[18] Further to his search of the Applicant's records, Mr. Petrella attaches to his affidavit as

Exhibit LP-1 a copy of the business license application filed with Toronto Municipal Licensing and Standards by the Applicant for the second PIZZAIOLO restaurant location that opened on October 1, 2001. Mr. Petrella states that this application was filed on September 11, 2001, and is the earliest document that he was able to find. Upon review of this exhibit, I note that the business license application is for “Continuous use, pizza parlour, refreshments” under the conditions “No seating accommodation; take out and delivery only”.

[19] Mr. Petrella then turns to the PIZZAIOLO trade-marks. He states that in addition to the two trade-mark applications that are the subject of the present oppositions, the Applicant owns the trade-mark PIZZAIOLO “THEE” PIZZA MAKER registered under No. TMA610,863. The particulars of this registration are attached as Exhibit LP-2 to his affidavit. Upon review of this exhibit, I note that the Applicant has claimed use of the trade-mark PIZZAIOLO “THEE” PIZZA MAKER since August 1999 in association with the following wares and services: “Italian food, namely pizza, panzerotti, sandwiches and salads; Restaurant, take-out food and food delivery services”. Mr. Petrella collectively refers to these three trade-marks as the PIZZAIOLO Trade-marks and I will do the same. [paras 10-12 of his affidavit]

[20] Mr. Petrella states that each of the PIZZAIOLO Trade-marks has been used in Canada since at least as early as November 13, 2000. He states that “In fact, each of the PIZZAIOLO Trade-marks has been used on or in all of the PIZZAIOLO restaurant locations that have operated in Canada, including on store signage, pizza boxes, napkins, menus, posters and fliers.” [para 13 of his affidavit]

[21] In support of his assertions of use of the PIZZAIOLO Trade-marks, Mr. Petrella attaches the following exhibits:

- Exhibit LP-3: representative copies of photographs of around 20 of the PIZZAIOLO restaurant locations showing the exterior and signage of those restaurants [para 14 of his affidavit]. Upon review of these photographs, I note that the exterior and signage of the restaurants prominently display the Marks;
- Exhibit LP-4: a representative copy of a photograph of one of the Applicant’s “A-frame” sign stationed outside the PIZZAIOLO restaurants depicting the registered trade-mark

PIZZAIOLO “THE” PIZZA MAKER. Mr. Petrella states that this “A-frame” sign is typical of other similar signs that have been used outside the various PIZZAIOLO restaurant locations depicting one of the PIZZAIOLO Trade-marks [paras 15-16 of his affidavit]. Upon review of this exhibit, I note that the ad reads “any slice (whole wheat slices) & any drink \$5.00 tax included” and includes photographs of three drinks bearing third parties’ trade-marks such as “BRIO”;

- Exhibit LP-5: photographs and copies of other materials depicting one of the PIZZAIOLO Trade-marks. Mr. Petrella states that these include a pizza box, take away bag (used for pizza slices), napkin, menu and wall posters, all of which have been used recently and feature the PIZZAIOLO & Design trade-mark, as well as a sample pizza bag which depicts the trade-mark PIZZAIOLO “THEE” PIZZA MAKER as shown in Exhibit LP-4. Mr. Petrella states that “Since November 2000, these materials, as well as other, [sic] similar materials depicting the PIZZAIOLO Trade-marks have been used by the Applicant in the sale of its food and beverage wares and to promote its related services. From time to time, each of the PIZZAIOLO Trade-marks have been featured or depicted on these materials.” [paragraph 17 of his affidavit] Upon review of this exhibit, I note that one of the sample menus refers to third party beverages.

[22] Mr. Petrella then turns to the PIZZAIOLO sales and revenues. He states that “The Applicant [...] has been selling food and beverage wares and providing related services, including catering and delivery services, in association with all of the PIZZAIOLO Trade-marks since at least as early as November 2000.” [para 18 of his affidavit]

[23] Mr. Petrella provides a table setting out the minimum gross sales revenue of the Applicant by fiscal year from 2000-2001 to 2009-2010. He states that the total gross sales revenue for the Applicant’s PIZZAIOLO brand is now more than \$45 million, with gross annual sales revenues increasing at the rate of more than \$2 million per year for the last three to four years. He further states that “All of the sales revenue set out above relates to wares sold and services provided in association with the PIZZAIOLO Trade-marks, including [PIZZAIOLO and PIZZAIOLO & Design] which form the basis of these opposition proceedings.” [paras 21-23 of his affidavit] However, no breakdown for each of the Applicant’s Wares and Services is

provided.

[24] Mr. Petrella also provides a table setting out the minimum estimated number of customers at PIZZAIOLO restaurants per fiscal year. He estimates that PIZZAIOLO locations actually had well over 2 million customers during the last fiscal year alone. [paras 24-26 of his affidavit]

[25] Mr. Petrella goes on to explain the advertising and promotion of the PIZZAIOLO brand. He states that “The PIZZAIOLO restaurants and associated wares and services, including catering and delivery services, have been advertised and promoted by the Applicant in conjunction with the PIZZAIOLO Trade-marks through numerous different mediums since at least as early as 2001.” [para 27 of his affidavit] He states that “These forms of advertisement and promotion include fliers and direct mail, radio and television advertisements, transit based advertising such as bus shelters, branded trucks and other vehicles and roadside billboards, taking part in annual parades and similar large scale events, working in association with well known charities, the PIZZAIOLO website and independent industry recognition.” [para 28 of his affidavit]

[26] In support of his assertions of advertising and promotion of the PIZZAIOLO brand, Mr. Petrella attaches the following exhibits:

- Exhibit LP-8: a business card that “was printed and distributed in 2000 bearing the PIZZAIOLO [w]ord [m]ark” and the address and telephone number of the first PIZZAIOLO restaurant location. At least a thousand of these business cards design were printed and distributed from November 2000 onwards [para 30 of his affidavit];
- Exhibit LP-9: a copy of one of the first fliers to promote the PIZZAIOLO brand. Mr. Petrella states that this flier was produced and distributed in 2001 and references both of the first two PIZZAIOLO restaurant locations that opened [para 31 of his affidavit]. Upon review of this exhibit, I note that the Applicant’s services are described as: “Two Locations to serve you better” “EAT WELL” “DINE IN & PICKUP”, “FOR FREE DELIVERY CALL (...);”

- Exhibit LP-10: a business card that was printed and distributed in 2007 depicting the PIZZAIOLO & Design trade-mark [para 32 of his affidavit]. However, upon review of this exhibit, I note that it consists of a white page displaying the PIZZAIOLO & Design trade-mark only. The outline of the business card is apparently missing. No other information such as a business address or phone number is provided;
- Exhibit LP-11: a flier advertising and promoting the PIZZAIOLO catering business in association with the PIZZAIOLO & Design trade-mark. Mr. Petrella states that this flier was produced and distributed in 2008 with at least 20,000 copies printed for distribution [para 33 of his affidavit];
- Exhibit LP-12: copies of sample venue specific menus for two current PIZZAIOLO restaurant locations. Mr. Petrella states that these sample menus both feature the PIZZAIOLO & Design trade-mark on every page and advertise the Applicant's catering, delivery and online ordering services [para 34 of his affidavit]. Mr. Petrella states that "These menus are representative of similar materials that the Applicant has produced and distributed in association with all of the PIZZAIOLO Trade-marks for its numerous PIZZAIOLO restaurant locations for many years, and since at least as early as November 2000." [para 34 of his affidavit];
- Exhibit LP-13: a sample copy of the branded menus relating to all of the current PIZZAIOLO restaurant locations. Mr. Petrella states that the Applicant produces and distributes these menus in addition to the location specific menus. He further states that over a million of these menus were produced and distributed in 2011, all of which depicted the PIZZAIOLO & Design trade-mark on every page and advertised the Applicant's catering, delivery and online ordering services. He adds that "These menus are representative of similar materials that the Applicant has produced and distributed in association with all of the PIZZAIOLO Trade-marks for its numerous PIZZAIOLO restaurant locations for many years, and since at least as early as 2001." [para 35 of his affidavit];

- Exhibit LP-14: copies of a recent Nutrition Guide as well as a “healthy choice” flier. Mr. Petrella states that more than 50,000 copies of the Nutrition Guide and more than 25,000 copies of the “healthy choice” flier have been produced and distributed during 2011. He further states that both of these items depicted the PIZZAIOLO & Design trade-mark and advertised the Applicant’s catering, delivery and online ordering services [paras 36-37 of his affidavit];
- Exhibit LP-15: a sample proposal from Canada Post to the Applicant from 2005. Mr. Petrella explains that the Applicant has paid independent third parties to distribute the various materials that it has produced to advertise and promote the PIZZAIOLO brand and associated wares and services. This has included paid distribution and direct mail services obtained through Canada Post as well as paid services through smaller, private companies that offer distribution and direct mail services [para 38 of his affidavit];
- Exhibit LP-16: a CD containing some of the radio advertisements promoting the PIZZAIOLO brand that have been aired since 2008. Mr. Petrella states that since at least as early as 2008, the Applicant has advertised and promoted the PIZZAIOLO brand and associated wares and services on well known radio stations. He further states that “The Applicant has also undertaken paid television advertising to promote the PIZZAIOLO Trade-marks. For example, from 2005 to 2006 paid commercials advertising PIZZAIOLO franchising opportunities were placed and aired on City TV on Sunday mornings.” [para 40-41 of his affidavit];
- Exhibit LP-17: sample photographs of one of the Applicant’s vehicles which prominently feature each of the PIZZAIOLO Trade-marks on them. Mr. Petrella states that “These vehicles have been used by the Applicant in and around Greater Toronto Area” since at least as early as 2003.” [para 44 of his affidavit];
- Exhibit LP-18: sample copies of billboard advertisements located close to major highways and roads displaying the PIZZAIOLO & Design trade-mark. Mr. Petrella explains that the Applicant has recently undertaken this paid digital billboard advertising [para 45 of his affidavit]; and

- Exhibit LP-19: a copy of an advertisement placed in the “Toronto Star” in November 2005 offering franchising opportunities in association with the PIZZAIOLO brand. Mr. Petrella states that “This particular advertisement ran for approximately six months and is representative of franchising opportunities that have been made known by the Applicant for many years.” [para 46 of his affidavit].

[27] Mr. Petrella then turns to “PIZZAIOLO on the Internet”. He states that “Since at least as early as July 2002, the Applicant has been the registrant of and maintained a website on the Internet located at *www.pizzaiolo.ca* (the PIZZAIOLO Website).” [para 55 of his affidavit] He attaches as Exhibit LP-20 printouts of the home page and sample other pages of the PIZZAIOLO Website. I note that this URL corresponds to the one depicted on Exhibits LP-12 to 14 discussed above. I further note that the beverages listed are third party beverages.

[28] The above evidence is clearly inconsistent with some of the Applicant’s claims set forth in its applications as explained below.

The reasons why the Petrella affidavit is clearly inconsistent with some of the Applicant’s claims set forth in its applications

[29] Section 4 of the Act provides that:

4. (1) A trade-mark is deemed to be used in association with wares if, *at the time of the transfer of the property in or possession of the wares, in the normal course of trade*, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the *performance or advertising* of those services. [my emphasis]

[30] As per the statement of Wares and Services reproduced in Schedule “A”, the Wares of the Applicant are divided into two categories. The first category covers, generally speaking, food items and non-alcoholic beverages. The second category covers merchandise used in the operation of restaurants. The Services also cover different categories, namely take-out and sit-down restaurant services; delivery services (namely delivery of prepared food); online food

ordering services; catering services; and franchising services (namely rendering technical assistance in the establishment and operation of restaurants).

[31] Considering first the Services, the Petrella affidavit is clearly inconsistent with the claimed date of first use of the Marks in association with the following categories of services:

Online food ordering services

[32] Mr. Petrella's testimony and accompanying exhibits evidence that the Applicant's online food ordering services have been advertised and performed through the PIZZAIOLO Website only. Yet, this website was only registered by the Applicant in or about July 2002, that is well after the claimed date of first use of November 13, 2000 (see para 55 of the Petrella affidavit discussed above as well as the oldest specimens of fliers [Exhibit LP-9] and business cards [Exhibit LP-8] that do not reference the PIZZAIOLO Website as opposed to the more recent specimens [for example, Exhibits LP-12 to 14]). Besides, I note that nowhere in his affidavit does Mr. Petrella expressly state that the Applicant has been offering online food ordering services since the very first date of November 13, 2000.

Catering services

[33] While Mr. Petrella baldly states that the Applicant has been offering catering services since November 13, 2000, that is on the very day of opening of the first PIZZAIOLO restaurant location, his testimony is somewhat contradicted by the following exhibits:

- Exhibit LP-1 that describes the Applicant's business at the time of opening the second PIZZAIOLO restaurant location as a pizza parlour under the conditions "no seating accommodation; take-out and delivery only"; and
- Exhibit LP-9 that advertises the Applicant's services as "DINE IN & PICKUP", "FOR FREE DELIVERY CALL" *only*.

[34] Furthermore, Mr. Petrella's testimony fails to provide *any* further information with respect to the *performance* of these services by the Applicant. The only supporting exhibits evidencing use of the Marks through *advertising* of the Applicant's catering services consist of Exhibits LP-11 (flier produced and distributed in 2008, that is well after November 13, 2000), and Exhibits LP-5, LP-12 to 14, and LP-20 that I am not prepared to consider representative of advertising made back to November 13, 2000 if only for the reason that they refer to the PIZZAIOLO Website.

Franchising services

[35] Nowhere in his affidavit does Mr. Petrella expressly state that the Applicant has been offering franchising services since the very first date of November 13, 2000. Furthermore, Mr. Petrella's testimony fails to provide *any* information with respect to the *performance* of these services by the Applicant. The only supporting exhibits merely evidencing use of the PIZZAIOLO word mark through *advertising* of the Applicant's franchising services consist of Exhibit LP-19 (copy of an advertisement placed in the "Toronto Star" in November 2005) and Exhibit LP-16 (radio advertisements aired since 2008). Again, these exhibits are dated well after the claimed date of first use of the Marks.

[36] Turning to the Wares, the Petrella affidavit is clearly inconsistent with the claimed date of first use of the Marks in association with the following wares:

Merchandise used in the operation of restaurants, namely menus, posters, pizza boxes and paper napkins

[37] Nowhere in his affidavit does Mr. Petrella expressly state that the Applicant has been selling in the normal course of trade the various menus, posters, pizza boxes, etc. depicted in Exhibit LP-5 *independently* from their contents and/or the offering of its take-out and sit-down restaurant services and delivery services, nor is there any evidence suggesting that this would be the case. Such free distribution of the Applicant's merchandise does not qualify as use under section 4 of the Act [see *Cordon Bleu International Ltd v Renaud Cointreau & Cie*, T-1029-93 2000-09-06 (FCTD) at para 14].

[38] At the hearing the Applicant's agent submitted that such merchandise is sold by the Applicant in the performance of its catering and franchising services. Besides the fact that this has not been asserted and evidenced by Mr. Petrella, the Applicant's evidence falls short of evidencing the performance of the Applicant's catering and franchising services dating as far back as November 13, 2000 as indicated earlier.

Non-alcoholic beverages, namely soft drinks, vegetable and fruit juices, coffee and bottled water

[39] While the Petrella affidavit evidences that the Applicant is offering non-alcoholic beverages at its restaurant locations, these beverages are sold under *third parties'* trade-marks as opposed to the Marks [see for example Exhibits LP-4, LP-5 and LP-20 discussed above].

Remaining food items

[40] Except for the wares described as “gourmet pizza”, the Petrella affidavit fails to establish that each of the wares described as “calzone; namely garlic bread and bruschetta; chicken wings; salads” in the Applicant’s applications have been sold in association with the Marks since November 13, 2000. The only specimens of containers or packaging bearing the Marks are for the Applicant’s pizzas.

Conclusion regarding the section 30(b) ground of opposition

[41] The section 30(b) ground of opposition succeeds in each file with respect to the following wares and services:

Wares: (1) [...] calzone; namely garlic bread and bruschetta; chicken wings; salads; non-alcoholic beverages, namely soft drinks, vegetable and fruit juices, coffee and bottled water.(2) Merchandise used in the operation of restaurants, namely menus, posters, pizza boxes and paper napkins.

Services: (1) [...] online food ordering services; catering services; franchising services, namely, rendering technical assistance in the establishment and operation of restaurants.

[42] It is otherwise dismissed with respect to the remaining wares and services.

Issue No. II: Is each of the Marks confusing with the Opponent’s trade-mark LA PIZZAIOLLE as used or registered?

[43] The Opponent has pleaded various grounds of opposition revolving around the issue of confusion between each of the Marks and either the Opponent’s trade-marks LA PIZZAIOLLE

(registered under No. TMA276,602) or PIZZAIOLLE that the Opponent has used before in Canada in association with restaurant services.

[44] The test for confusion is the same for each of the non-registrability, non-entitlement and non-distinctiveness grounds of opposition pleaded by the Opponent. However, as will become apparent going through my analysis, the initial evidentiary burden on the Opponent varies for each of them. And so does the material date to assess each of these grounds.

[45] I will start my analysis with the Opponent's non-entitlement ground of opposition based on section 16(1)(a) of the Act.

The non-entitlement ground of opposition based on section 16(1)(a) of the Act

[46] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Marks in view of the provisions of section 16(1)(a) of the Act because at the claimed date of first use of the Marks, that is November 13, 2000, each of the Marks was confusing with the Opponent's trade-marks LA PIZZAIOLLE and PIZZAIOLLE that the Opponent had previously used in Canada in association with restaurant services.

[47] In order to meet its evidentiary burden under this ground of opposition, the Opponent must show that as of the alleged date of first use of the Marks in Canada, the Opponent's trade-marks LA PIZZAIOLLE and PIZZAIOLLE had been previously used in Canada and had not been abandoned as of the date of advertisement of the Applicant's applications in the *Trade-marks Journal*, that is November 4, 2009 [section 16(5) of the Act]. As per my review below of the relevant parts of the Noiseux affidavit, the Opponent has met this burden.

The Noiseux affidavit

[48] Mr. Noiseux states that the Opponent opened its first restaurant location in Montreal in 1981. The Opponent was the first to introduce Montreal to pizza cooked in wood-burning stone ovens. Since that time, LA PIZZAIOLLE business of the Opponent has expanded to four restaurant locations in total, all of which are located in Montreal [paras 5-8 of his affidavit].

[49] Mr. Noiseux states that over 250,000 customers visit the Opponent's LA PIZZAIOLLE

restaurants each year [para 9 of his affidavit]. However, this includes repeat customers, including “very regular customers” that visit on a frequent basis [cross-examination transcript, Q. 35-39].

[50] Mr. Noiseux states that since 1990, the Opponent has had a minimum turnover amounting to around \$3 million per year. More particularly, for the years 2004 to 2010, this figure has been relatively static amounting to around \$4 million per year [para 13 of his affidavit].

[51] In support of his assertions of use of the trade-mark LA PIZZAIOLLE, Mr. Noiseux attaches the following exhibits:

- Exhibit DN-3: copies of the Opponent’s menus, gift certificates and letterhead used over the years that are representative of the restaurant services offered by the Opponent under the trade-mark LA PIZZAIOLLE [para 15 of his affidavit]. Upon review of this exhibit, I note that it displays the word mark LA PIZZAIOLLE as well as the variant PIZZAIOLLE depicted in different stylized signatures such as:

		
<p>(hereinafter referred to as PIZZAIOLLE Design No. 1)</p>	<p>(hereinafter referred to as PIZZAIOLLE Design No. 2)</p>	<p>(hereinafter referred to as PIZZAIOLLE Design No. 3)</p>

- Exhibit DN-4: a place mat used by the Opponent and which Mr. Noiseux states is representative of the type of place mats used over the years by the Opponent [para 16 of his affidavit]. Upon review of this exhibit, I note that it displays the trade-mark PIZZAIOLLE Design No. 3; and
- Exhibit DN-5: photographs of exterior signage which Mr. Noiseux states are representative of the type of signage used over the years by the Opponent [para 17 of his affidavit]. Upon review of this exhibit, I note that it displays the trade-mark PIZZAIOLLE Design No. 3.

[52] Mr. Noiseux states that the Opponent’s restaurants further provide a take out service. He

explains that customers may order and take-out the different food items found in the Opponent's menus such as appetizers, pastas and pizzas, and that the wares so sold are packaged in containers and bags bearing the trade-mark LA PIZZAIOLLE [paras 18-20 of his affidavit].

[53] Mr. Noiseux goes on to explain the advertising and promotion of the Opponent's restaurant services under the trade-mark LA PIZZAIOLLE. He states that around 1% of the Opponent's annual business revenues are directed towards promotional activities. He provides a few examples of advertising that were undertaken by the Opponent some 20 years ago. However, as noted by the Applicant, no examples of more recent advertising or promotion were provided [paras 21-25; Exhibits DN-6 to DN-8; cross-examination transcript Q. 76-119].

[54] As the Opponent has satisfied its evidentiary burden, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between each of the Marks and the Opponent's trade-mark LA PIZZAIOLLE and its variant PIZZAIOLLE as these marks have been used by the Opponent.

The test for confusion

[55] Section 6(2) of the Act provides 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 be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

[56] Thus, this section does not concern the confusion of the trade-marks themselves, but confusion of wares or services from one source as being from another source.

[57] The test for confusion is one of first impression and imperfect recollection. As noted by Mr. Justice Denault in *Pernod Ricard v Molson Breweries* (1992), 44 CPR (3d) 359 (FCTD) at 369:

The trade marks should be examined from the point of view of the average consumer having a general and not a precise recollection of the earlier mark. Consequently, the marks should not be dissected or subjected to a microscopic analysis with a view to assessing their similarities and differences. Rather, they should be looked at in their totality and assessed for their effect on the average consumer as a whole.

[58] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at section 6(5) of the Act, namely: (a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; (b) the length of time the trade-marks have been in use; (c) the nature of the wares, services or business; (d) the nature of the trade; and (e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them. This list is not exhaustive and all relevant factors are to be considered. Further, all factors are not necessarily attributed equal weight as the weight to be given to each depends on the circumstances [see *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC); *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC); and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC) for a thorough discussion of the general principles that govern the test for confusion].

Consideration of the section 6(5) factors

a) the inherent distinctiveness of the trade-marks and the extent to which they have become known

[59] Each of the trade-marks in issue possesses a low degree of inherent distinctiveness in the context of the parties' wares and/or services.

[60] Indeed, while the Opponent's trade-mark LA PIZZAIOLLE and its variant PIZZAIOLLE are coined words, the fact is that they remain highly suggestive, in the context of the Opponent's restaurant services, of a pizzeria.

[61] The same finding applies to each of the Applicant's Marks, especially the PIZZAIOLO & Design trade-mark given the addition of the descriptive phrase GOURMET PIZZA. While the Applicant's evidence is to the effect that the word PIZZAIOLO is the Italian word for a male pizza chef [see for instance, Exhibit LP-20 that provides the "history" of the Applicant], there is no evidence that the majority of Canadians, whether Anglophones or Francophones, would be aware of such meaning. Still, each of the Marks remains highly suggestive of a pizza parlour.

[62] Concerning the extent to which the trade-marks in issue have become known, there is evidence from the parties that each of their respective trade-marks has been used in

Canada so as to enhance to some extent their distinctiveness, especially the Applicant's. However, as indicated above, the material date to consider the acquired distinctiveness of the trade-marks in issue under section 16(1)(a) of the Act is the date of first use of the Marks claimed by the Applicant. In other words, all of the Applicant's evidence that follows the claimed date of first use of the Marks cannot be taken into consideration in the assessment of this particular ground of opposition.

[63] As a result, the extent to which each of the Applicant's Marks had become known as of the date of first use of November 13, 2000 is of no assistance to the Applicant in the present cases. By comparison, the Opponent's evidence introduced through the Noiseux affidavit leads me to conclude that the trade-mark LA PIZZAIOLLE and its variant PIZZAIOLLE had become known to some extent in the city of Montreal as of November 13, 2000, especially in view of the Opponent's sales figures, which amount to more than \$30 million dollars for the years 1990 to 2000.

[64] To sum up, the overall consideration of this first factor, which is a combination of inherent distinctiveness and acquired distinctiveness, favours the Opponent, although I remain of the view that the Opponent's trade-mark LA PIZZAIOLLE and its variant PIZZAIOLLE remain rather relatively weak marks given their highly suggestive connotation in the context of the Opponent's restaurant services.

b) the length of time the trade-marks have been in use

[65] For the reasons given above, this factor also favours the Opponent.

c) the nature of the wares, services or business; and d) the nature of the trade

[66] There is a clear overlap between the parties' wares and/or services, and trades.

[67] While the Applicant submits that none of the services described in its applications as "delivery services", "catering services", "online food ordering services" and "franchising services" is or has ever been offered by the Opponent, the fact remains that each of these services is ancillary to the Applicant's restaurant services that compete with the Opponent's restaurant

services and take out services. As noted by the Opponent at the hearing, the Applicant itself has acknowledged the relationship existing between these ancillary services and restaurant services. More particularly, at paragraph 5 of his affidavit, Mr. Petrella baldly states that “The first PIZZAIOLO restaurant was opened for business and began selling pizza and other food and beverage wares, *as well as offering related services that included catering services*, on November 13, 2000” [my emphasis]. At the hearing, the Applicant relied on this statement of Mr. Petrella to argue that it had evidenced use of the Marks in association with *all* of the Wares and Services since the very day of opening of the first PIZZAIOLO restaurant location.

[68] Furthermore, the fact that the *primary* business of the Opponent is that of “full service restaurants” provided by on-site waiting staff as opposed to take out and delivery establishments that do not typically provide any seating save for limited counter seating designed for short waiting periods, does not significantly assist the Applicant. The fact remains that the parties’ restaurants services and take-out services clearly overlap (as further evidenced by the similarities existing between the parties’ respective menus filed as Exhibits DN-3 and LP-12 referred to above) and are directed toward the same clientele that is the general public.

e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[69] There is a certain degree of resemblance between each of the Marks and the Opponent’s trade-marks LA PIZZAIOLLE and PIZZAIOLLE in that each of them is made up of the descriptive word PIZZA followed by a suffix that starts with the letters I-O-L.

[70] However, the parties’ marks, when considered in their totality, look and sound somewhat different. The Applicant’s suffix IOLO is clearly three syllables when sounded, whereas the Opponent’s IOLLE could be sounded in two syllables, especially when one considers the Opponent’s trade-mark LA PIZZAIOLLE, owing to the preceding element LA, which corresponds to a French feminine definite article.

[71] While each of the parties’ marks suggests a pizzeria in the context of their associated services, the ideas suggested somewhat differ in that the Applicant’s Marks evoke a masculine noun whereas the Opponent’s trade-marks LA PIZZAIOLLE and PIZZAIOLLE evoke a

feminine noun coined from the word PIZZA. These differences are more pronounced when considering the PIZZAIOLO & Design trade-mark as it includes the phrase GOURMET PIZZA, which further differentiates the Applicant's trade-mark from the Opponent's word mark LA PIZZAIOLLE, owing to its English grammatical construction.

Additional surrounding circumstances

Use of the PIZZAIOLLE trade-mark in special graphic form

[72] As a further surrounding circumstance, I note that the Opponent's trade-mark PIZZAIOLLE is always depicted in either one of the three above-described stylised signatures, especially the PIZZAIOLLE Design No. 3. (In fact, the PIZZAIOLLE Design Nos. 1 and 2 would appear to consist of old stylized signatures no longer in use). I am satisfied that use of each of these design marks may qualify as use of the Opponent's registered trade-mark LA PIZZAIOLLE. Likewise, I am satisfied that they constitute use of the trade-mark PIZZAIOLLE, as alleged by the Opponent. However, it remains that the Opponent is not using the word mark PIZZAIOLLE in isolation but rather always in a special graphic form which further adds to the distinctions existing between this trade-mark and the Applicant's PIZZAIOLO & Design trade-mark.

The Applicant's existing registration for the trade-mark PIZZAIOLO
"THEE" PIZZA MAKER

[73] The Applicant submits that it is already the owner of the registered trade-mark PIZZAIOLO "THEE" PIZZA MAKER referred to above. The Applicant submits that the situation with the Applicant's existing registration is analogous to the one in *Kellogg Salada Canada Inc v Maximum Nutrition Ltd et al* (1992), 43 CPR (3d) 349 (FCA). The applicant in that case already owned two prior registrations for NUTRI based marks. The Federal Court of Appeal found that this constituted an additional surrounding circumstance favouring the appellant, holding that:

It is noteworthy as well that the appellant is itself already the owner of two trade mark [sic] registrations which incorporate the word "nutri", "nutri-grain" and "nutri-grain and design". To that extent, the appellant is already entitled to use the prefix "nutri".

[74] However, contrary to the situation prevailing in the *Kellogg Salada* case, the Applicant does not own a “family” of registered trade-marks made up of the word PIZZAIOLO. Furthermore, while I agree with the Applicant that the word PIZZAIOLO constitutes the dominant element of its registered trade-mark PIZZAIOLO “THEE” PIZZA MAKER, it remains that this trade-mark also includes the phrase “THEE” PIZZA MAKER, which cannot be ignored. It is well-established by the jurisprudence that although section 19 of the Act gives the owner of a registration the exclusive right to the use of that mark with respect to the wares and services covered by the registration, it does not necessarily follow that the registered owner is given an automatic right to obtain any further registrations no matter how closely related they may be to the original registration [see *Coronet-Werke Heinrich Schlerf GmbH v Produits Ménagers Coronet Inc* (1984), 4 CPR (3d) 108 (TMOB) at 115].

The common use of PIZZA trade-marks and trade-names

[75] The Applicant submits that the Noonan affidavit shows that there are more than 650 PIZZA marks on the trade-marks register and this of itself must be taken to conclusively demonstrate that the element PIZZA has become commonly adopted in the pizza and related restaurant services trade. Further, the Applicant submits that in the city of Montreal alone, the only geographical area in which the Opponent has ever operated, more than 120 business names have been registered which include the element PIZZA. These trade-marks and business names include PIZZALINE (TMA427,482), PIZZALINO & Design (TMA487,623), PIZZARELLA (TMA766,715), PIZZAVILLE (TMA328,843), and VILLA PIZZA (TMA473,218), as well as PIZZA ALLO, PIZZA APOLLO, PIZZA BELLA, PIZZA BELLINI, PIZZA VILLA, and PIZZARELLA.

[76] State of the register evidence is introduced to show the commonality or distinctiveness of a mark or portion of a mark in relation to the register as a whole. Evidence of the state of the register is only relevant insofar as inferences may be made on it concerning the state of the marketplace, and inferences about the state of the marketplace can only be drawn when a significant number of pertinent registrations are located [see *Ports International Ltd v Dunlop Ltd.* (1992), 41 CPR (3d) 432 (TMOB); *Welch Foods Inc v Del Monte Corp* (1992), 44 CPR (3d) 205 (FCTD); and *Kellogg Salada, supra*].

[77] As noted by the Opponent, Ms. Noonan has failed to attach the particulars of the trade-mark registrations and applications revealed by her search. As a result, I cannot see the design marks listed by Ms. Noonan, nor determine the wares and services covered by the registrations so listed and whether these registrations were issued as of the material date. Also, I cannot determine the exact nature of the businesses listed in Exhibit MN-2, which Ms. Noonan describes as a print-out of the results of her search of “Select Phone Canada, a CD-ROM directory of white and yellow pages, owned by Infogroup, Info Canada, for entries that started with the element “Pizza” and that were located in Montreal” [para 6 of her affidavit], nor determine if they were active as of the material date.

[78] Regardless of these deficiencies, I find that it can reasonably be inferred that the word PIZZA has been commonly adopted in the pizza and related restaurant services trade given the large number of entries revealed by Ms. Noonan’s searches and the fact that many of these entries appear to be corroborated by Exhibit MN-3. Indeed, Exhibit MN-3, which Ms. Noonan describes as a print-out of the results of her search of the “*Business Directory*, a CD-ROM directory of business listings from across Canada, owned by Infogroup, Info Canada, for business names that included the element PIZZA and were located in Montreal” [para 8 of her affidavit], provides a detailed listing of businesses, including the nature of their activities (for instance “Full-service restaurants”), their location and the number of years they have been listed in the database, etc. In any event, I find it is only common sense to accept that the word PIZZA is commonly used in the pizza and related restaurant services trade.

The coexistence of the parties’ trade-marks

[79] The Applicant submits that the parties and their respective trade-marks and trade-names have coexisted peacefully in Canada for more than a decade without evidence of any actual or potential confusion.

[80] As explained before, the material date to consider the present ground of opposition is the claimed date of first use of the Marks. Thus, coexistence of the parties’ marks that occurred after this material date cannot be considered.

The conduct of the Opponent

[81] The Applicant submits that it has been using the PIZZAIOLO Trade-marks in Canada since November 2000 and has been the registered owner of a PIZZAIOLO trade-mark since May 2004. During that time, the Applicant has undertaken significant and numerous forms of advertising and promotion of the PIZZAIOLO Trade-marks, including the Marks, and has generated tens of millions of dollars in sales revenues in association with its PIZZAIOLO Brand. The Applicant submits that at no time during this decade and more of coexistence of the parties and use of the PIZZAIOLO Trade-marks has the Opponent ever sought to challenge or enjoin the Applicant's use of its PIZZAIOLO brand. The Opponent did not oppose the Applicant's existing registration when it was advertised and has not sought to expunge that mark from the register since. The Opponent has never identified any actual or potential incidents of confusion between its mark and the PIZZAIOLO Trade-marks, despite having ample opportunity to do so.

[82] However, one can only speculate as to the reason why the Opponent did not oppose or challenge the Applicant's registration for the trade-mark PIZZAIOLO "THEE" PIZZA MAKER. As each case must be decided on its own merits, I am not prepared to accord weight to this surrounding circumstance, which further postdates the material date.

Conclusion regarding the likelihood of confusion

[83] As indicated above, section 6(2) of the Act is not concerned with the confusion of the marks themselves, but confusion of wares and services from one source as being from another source. In the present cases, the question posed is whether an individual, who has an imperfect recollection of the Opponent's trade-marks LA PIZZAIOLLE and PIZZAIOLLE as used with the Opponent's restaurant services, would, as a matter of first impression and imperfect recollection, be likely to conclude that the Applicant's Wares and Services are manufactured, sold, performed or otherwise authorized by the Opponent.

[84] I find this is the case with respect to the Applicant's word mark PIZZAIOLO. While I acknowledge the fact that the marks in issue are not identical, I find that the differences existing between them are not sufficient to outweigh the overall consideration of the section 6(5) factors discussed above. Contrary to the situation prevailing with the Applicant's applied-for mark

PIZZAIOLO & Design, registration of the word mark PIZZAIOLO would permit use of the mark in any size and with any style of lettering, color or design. As reminded in *Masterpiece*, *supra* at para 59 “a subsequent use that is within the scope of a registration, and is the same or very similar to an existing mark will show how that registered mark may be used in a way that is confusing with an existing mark”.

[85] However, I find that the Applicant has satisfied its legal onus with respect to the PIZZAIOLO & Design mark owing to the more pronounced differences existing between this design mark and the Opponent’s LA PIZZAIOLLE word mark or its variant PIZZAIOLLE as depicted in the PIZZAIOLLE Design Nos. 1, 2 and 3.

[86] The non-entitlement ground of opposition based on section 16(1)(a) therefore succeeds in case No. 1,416,447 only.

Other grounds of opposition revolving around the likelihood of confusion

The non-registrability ground of opposition

[87] The Opponent has pleaded that each of the Marks is not registrable having regard to the provisions of section 12(1)(d) of the Act in that each is confusing with the Opponent’s registered trade-mark LA PIZZAIOLLE.

[88] The Opponent has satisfied its evidentiary burden under this ground by providing a certified copy of its registration. I have exercised the Registrar’s discretion to confirm that this registration is in good standing as of today’s date, which date is the material date to assess a section 12(1)(d) ground of opposition [see *Park Avenue Furniture Corp v Wickers/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)].

[89] As the Opponent’s evidentiary burden has been satisfied, the Applicant must therefore establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between each of the Marks and the Opponent’s registered trade-mark LA PIZZAIOLLE.

[90] Contrary to the situation prevailing under the section 16(1)(a) ground of opposition, all of the Applicant’s evidence has to be taken into consideration in the assessment of the non-

registrability ground of opposition given the later material date. This impacts the assessment of the section 6(5)(a) and (b) factors discussed above.

[91] Indeed, the Petrella affidavit establishes that the Applicant has produced and distributed in total, hundreds of thousands of fliers, direct mail and other similar materials per year since at least as early as 2001 and that this has grown to be well over a million such items per year in more recent years [paras 27 and 39 of his affidavit]. The Applicant has incurred significant amounts of expenditure in advertising and promotional activities in association with the PIZZAIOLO Trade-marks. These amounts have been in the region of hundreds of thousands of dollars a year since at least as early as 2007 and were in excess of half a million dollars during the fiscal year 2010-2011 alone [paras 66-68 of his affidavit]. These combined with the extensive sales figures and numbers of clients over the years provided by Mr. Petrella in paragraphs 21 to 26 of his affidavit discussed above, lead me to conclude that the overall consideration of the section 6(5)(a) factor favours the Applicant rather than the Opponent.

[92] Likewise, the overall consideration of the section 6(5)(b) factor does no longer significantly favour the Opponent as neither party is a recent start up. However, I am not prepared to draw a significant negative inference as to the likelihood of confusion between the marks in issue owing to the coexistence of the parties' marks over the last decade. Indeed, the absence of actual confusion is not surprising given that the parties have so far carried out their activities in different geographical areas, that is Toronto for the Applicant and Montreal for the Opponent.

[93] That said, I remain of the view that the Applicant has not discharged its legal onus to establish that there is no likelihood of confusion between the Applicant's word mark PIZZAIOLO and the Opponent's trade-mark LA PIZZAIOLLE. I find the balance of probabilities as to the likelihood of confusion as to the source of the parties' wares or services to be evenly balanced. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant.

[94] However, I remain of the view that the Applicant has satisfied its legal onus with respect to the PIZZAIOLO & Design mark owing to the more pronounced differences existing between this design mark and the Opponent's trade-mark LA PIZZAIOLLE.

[95] The non-registrability ground of opposition therefore succeeds in case No. 1,416,447 only.

The non-entitlement ground of opposition based on section 16(1)(c) of the Act

[96] The Opponent has pleaded that the Applicant is not the person entitled to registration of each of the Marks in view of the provisions of section 16(1)(c) of the Act because at the Applicant's claimed date of first use of the Marks, each of the Marks was confusing with the Opponent's trade-names LES RESTAURANTS LA PIZZAIOLLE; PIZZAIOLLE; RESTAURANT PIZZAIOLLE; RESTAURANT "LA PIZZAIOLLE"; RESTAURANTS PIZZAIOLLE; LES RESTAURANTS LA PIZZAIOLLE INC.; and RESTAURANTS LA PIZZAIOLLE,

[97] The Opponent has satisfied its evidentiary burden with respect to the trade-names RESTAURANT LA PIZZAIOLLE, RESTAURANTS PIZZAIOLLE, and LA PIZZAIOLLE.

[98] A detailed analysis of this ground of opposition is not necessary as the Opponent's case under this ground of opposition is not stronger than under the section 16(1)(a) ground of opposition discussed above. In other words, the Opponent cannot achieve a more favourable result with its trade-names.

[99] As my findings made above concerning the likelihood of confusion between each of the Marks and the Opponent's trade-marks LA PIZZAIOLLE and PIZZAIOLLE remain applicable to the Opponent's trade-names, I find that the non-entitlement ground of opposition based on section 16(1)(c) succeeds in case No. 1,416,447 only.

The non-distinctiveness ground of opposition

[100] The Opponent has pleaded that each of the Marks does not and cannot act to distinguish the Wares and Services from those of the Opponent, nor are they adapted so to distinguish them in view of the provisions of section 2 of the Act.

[101] An opponent meets its evidential burden with respect to a distinctiveness ground if it

shows that as of the filing of the opposition (in these cases, January 6, 2010) its trade-mark or trade-name had become known to some extent at least to negate the distinctiveness of the applied-for mark [see *Motel 6, Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD)]. The Opponent has met this burden with respect to its trade-marks LA PIZZAIOLLE and PIZZAIOLLE and its corresponding trade-names discussed above under the section 16(1)(c) grounds of opposition.

[102] The difference in relevant dates does not substantially affect my analysis above under the non-registrability ground of opposition. As a result, my findings under the non-registrability ground of opposition remain applicable. Accordingly, the non-distinctiveness ground of opposition succeeds in case No. 1,416,447 only.

Remaining grounds of opposition

The non-entitlement ground of opposition based on the introductory paragraph of section 16(1) of the Act

[103] The Opponent has pleaded under the introductory paragraph of section 16(1) of the Act that the applications do not conform to the requirements of section 30 of the Act, that the Marks that are the subject of the applications have not been used but rather consist of proposed use trade-marks, and that the Marks are not registrable or do not function as trade-marks. I am of the view that this pleading does not raise a valid ground of opposition. This pleading would be more appropriately raised under section 38(a) (non-compliance with section 30 of the Act) or 38(b) (non-registrability pursuant to section 12(1)(d) of the Act). I further note that the Opponent did not make *any* representation in its written arguments or at the hearing with respect to this pleading. Accordingly, this ground is dismissed in each file.

The other section 30 grounds of opposition

[104] The Opponent has pleaded other grounds of opposition under section 30 of the Act, namely that:

- the trade-marks for which use is alleged are not the Marks;

- alternatively or cumulatively, use of the Marks in association with each of the Wares and Services has been discontinued; and
- the Applicant could not have been satisfied that it was entitled to use the Marks in Canada knowing that it would violate the rights of the Opponent.

[105] These grounds of opposition appear to be “boilerplate” pleadings. As stated by Board Member Herzig in *3103-2964 Quebec Inc v Philhobar Design Canada Ltd*, 2009 CarswellNat 1688: “Such pleadings are to be discouraged because, among other things, they distract from a party’s legitimate concerns”.

[106] In any event, assuming that each of these grounds of opposition is properly pleaded, I find that the Opponent has failed to satisfy its evidentiary burden with respect to each of them. First, except for the ground that the trade-mark for which use is alleged is not the PIZZAIOLO & Design mark (discussed below), the Opponent did not make *any* representation in its written arguments or at the hearing with respect to these grounds. In the absence of any representation or argument, I fail to appreciate which of the facts evidenced by the Petrella and Noiseux affidavits support these “boilerplate” grounds of opposition.

[107] As for the ground that the trade-mark for which use is alleged is not the PIZZAIOLO & Design mark, the Opponent argues in its written argument that use of the PIZZAIOLO & Design mark as shown in Exhibits LP-3, LP-5 and LP-10 discussed above do not establish use of the PIZZAIOLO & Design mark as applied for. I disagree. Suffice it to say that while the phrase GOURMET PIZZA is depicted in some of these exhibits within the ellipse element forming part of the mark rather than below it, it does also appear in the same Exhibits LP-3 and LP-5, as well as Exhibits LP-12 to 14, and LP-20 as depicted in the Applicant’s application.

[108] Accordingly, each of these grounds is dismissed in each file.

Disposition

[109] In view of the foregoing and pursuant to the authority delegated to me under section 63(3) of the Act, I refuse application No. 1,416,447 for the PIZZAIOLO word mark in its entirety.

[110] I refuse application No. 1,416,446 for the PIZZAIOLO & Design mark in respect of the following wares and services:

Wares: (1) calzone; namely garlic bread and bruschetta; chicken wings; salads; non-alcoholic beverages, namely soft drinks, vegetable and fruit juices, coffee and bottled water.(2) Merchandise used in the operation of restaurants, namely menus, posters, pizza boxes and paper napkins.

Services: (1) online food ordering services; catering services; franchising services, namely, rendering technical assistance in the establishment and operation of restaurants.

and I reject the opposition with respect to the remainder of the wares and services, namely:

Wares: (1) Gourmet pizza;

Services: (1) Take-out and sit-down restaurant services; delivery services, namely, delivery of prepared food.

pursuant to section 38(8) of the Act [see *Produits Menagers Coronet Inc v Coronet-Werke Heinrich Schlerf GmbH* (1986), 10 CPR (3d) 492 (FCTD) as authority for a split decision].

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule“A”

Statement of wares and services covered by application Nos. 1,416,446 and 1,416,447:

Wares: (1) Gourmet pizza; calzone; namely garlic bread and bruschetta; chicken wings; salads; non-alcoholic beverages, namely soft drinks, vegetable and fruit juices, coffee and bottled water. (2) Merchandise used in the operation of restaurants, namely menus, posters, pizza boxes and paper napkins.

Services: (1) Take-out and sit-down restaurant services; delivery services, namely, delivery of prepared food; online food ordering services; catering services; franchising services, namely, rendering technical assistance in the establishment and operation of restaurants.

(Sometimes referred to as the Wares and Services)