

IN THE MATTER OF AN OPPOSITION by Food Service Products Company to application No. 606,744 for the trade-mark DOLMI filed by Effem Foods Ltd.

On May 6, 1988, Effem Foods Ltd. filed an application to register the trade-mark DOLMI based upon proposed use of the trade-mark in Canada in association with "Italian style packaged dinner mixes; and frozen pizza and frozen components for pizza, namely frozen dough, frozen crusts and frozen cheese".

The opponent, Food Service Products Company, filed a statement of opposition on February 13, 1989. In its statement of opposition, the opponent alleged that the applicant's trade-mark is not registrable in that it is confusing with the opponent's registered trade-mark DOMANI, registration No. 338,466 covering eggplant parmigiana, pasta products and Italian dishes, namely ravioli, cannelloni, tortellini, ziti, manicotti, stuffed shells, lasagna and lasagna sheets. As its second ground, the opponent alleged that the applicant is not the person entitled to registration in that, as of the applicant's filing date, the applicant's trade-mark DOLMI was confusing with the opponent's trade-mark DOMANI previously made known in Canada by the opponent and in respect of which an application for registration had been previously filed in Canada by the opponent. As its final ground, the opponent alleged that the applicant's trade-mark is not distinctive since the trade-mark DOLMI is confusing with the opponent's trade-mark DOMANI.

The applicant filed a counter statement in which it denied the allegations of confusion between its trade-mark DOLMI and the opponent's trade-mark DOMANI.

The opponent filed as its evidence two affidavits of Kim Kurata dated January 18, 1990 and February 20, 1990 and two affidavits of Koert Koelman dated January 22, 1990 and February 20, 1990. Both of the opponent's affiants were cross-examined on their affidavits, the transcripts of the cross-examinations forming part of the record in this proceeding. The applicant filed as its evidence the affidavit of Carol Godby. As evidence in reply, the opponent submitted the affidavit of Lynn Cassan.

The applicant requested that it be granted leave pursuant to Rule 46(1) of the Trade-marks Regulations to file additional evidence in this opposition by way of the affidavits of Janis E. Caruana and Linda Thibeault. However, the applicant's Rule 46(1) request was refused by the Opposition Board by way of the Office letter of August 21, 1992.

Both parties submitted written arguments and both were represented at an oral hearing.

The first ground of opposition is based on Section 12(1)(d) of the Trade-marks Act, the opponent alleging that there would be a reasonable likelihood of confusion between the applicant's trade-mark DOLMI and its registered trade-mark DOMANI. In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Trade-marks Act. Further, the Registrar must bear in mind that the legal burden is on the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks at issue as of the date of my decision, the material date with respect to the Section 12(1)(d) ground (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA) and Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

While the opponent has not filed a copy of its registration as evidence, the Registrar does have the discretion to check the register in order to confirm the existence of the registration relied upon by the opponent (see Quaker Oats of Canada Ltd./ La Compagnie Quaker Oats du Canada Ltée v. Menu Foods Ltd., 11 C.P.R. (3d) 410). In doing so, I noted the registration No. 338,466 covering the trade-mark DOMANI is still in force and covers wares identified as "eggplant parmigiana, pasta products and Italian dishes, namely ravioli, cannelloni, tortellini, ziti, manicotti, stuffed shells, lasagna and lasagna sheets".

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark DOLMI as applied to the wares covered in the present application and the opponent's registered trade-mark DOMANI as applied to the wares covered in the opponent's registration are inherently distinctive.

No evidence has been furnished by the applicant that its trade-mark DOLMI has become known to any extent in Canada. On the other hand, the opponent's evidence establishes that its trade-mark DOMANI has become known to some extent in this country by way of advertising in printed publications which have circulated in Canada, as well as by way of television broadcasts received in Canada. Thus, the extent to which the trade-marks have become known weighs in the opponent's favour to some extent in this proceeding.

No evidence has been furnished by either party that its trade-mark has been used in Canada.

As a result, the length of time that the trade-marks at issue have been in use is not a relevant factor in this opposition.

The applicant's "Italian style packaged dinner mixes; and frozen pizza and frozen components for pizza, namely frozen dough, frozen crusts and frozen cheese" are similar to the opponent's "pasta products and Italian dishes, namely ravioli, cannelloni, tortellini, ziti, manicotti, stuffed shells, lasagna and lasagna sheets". In particular, the wares of both parties are food products which would be considered by the average consumer as being Italian. In this regard, the applicant's statement of wares includes "Italian style packaged dinner mixes" while the opponent's registration covers "Italian dishes". Additionally, the opponent's wares covered in its registration could include frozen ravioli, cannelloni, tortellini, manicotti and stuffed shells and Exhibits 2 to 4 of the Koelman affidavit confirm that the opponent actually sells fresh frozen pasta products in the United States in association with its trade-mark DOMANI. Further, the channels of trade associated with these wares would overlap.

The only remaining criterion for consideration under Section 6(5) of the Trade-marks Act is the degree of resemblance between the trade-marks at issue in appearance, sounding and ideas suggested. In this regard, the trade-marks DOLMI and DOMANI, when considered as a matter of immediate impression and imperfect recollection, bear some similarity in appearance and a somewhat lesser degree of similarity in sounding while the trade-marks do not suggest any ideas in common.

As a further surrounding circumstance in respect of the issue of confusion, the applicant sought to rely upon the state of the register referred to in its written argument. While the request for leave to file evidence of the state of the register pursuant to Rule 46(1) of the Trade-marks Regulations was refused by the Board, the applicant argued that the Registrar has the discretion to review the register prior to deciding the outcome of an opposition and further is obliged to do so even if evidence thereof has not been adduced during the opposition proceeding. In support of its position, the applicant relied upon the decision of the Federal Court of Appeal in Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA). However, I do not consider that the Park Avenue decision is authority for the proposition that the parties to an opposition can rely upon the state of the register without evidence thereof being made of record in the opposition by way of affidavit, statutory declaration, or by filing certified copies of the relevant registrations, pursuant to Rules 43 to 46(1) of the Trade-marks Regulations.

In the Park Avenue case, Desjardins, J., at page 424 of the published reasons for judgment, states as follows:

"The relevant date, in the case at bar, was the day the Registrar disposed of the opposition **on the evidence adduced**, i.e. December 31, 1987."

In view of the above, I consider that the Park Avenue decision is authority for the proposition that once evidence of the state of the register has been properly adduced by one or other of the parties, the Registrar must consider that evidence in deciding the outcome of the opposition. Further, unlike the situation where the Registrar, acting in the public interest to maintain the purity of the register, may check the register to confirm the existence of a registration or pending application referred to in a statement of opposition, I do not consider there to be any public interest in seeking to assist an applicant to register its trade-mark by checking Office records and thereby doing what the applicant ought to have done by filing evidence in the opposition (see, in this regard, John Labatt Ltd./ John Labatt Ltée v. W.C.W. Western Canada Water Enterprises Inc., 39 C.P.R. (3d) 442, at pages 445-446).

Having regard to the above and, in particular, to the degree of resemblance in appearance between the trade-marks DOLMI and DOMANI as applied to similar wares travelling through the same channels of trade, and bearing in mind that the applicant's application is based upon proposed use and that no evidence has been furnished by the applicant that it has commenced use of its mark DOLMI in Canada, I have concluded that the applicant has failed to meet the legal burden upon it of satisfying me that there would be no reasonable likelihood of confusion between the applicant's trade-mark and the registered trade-mark DOMANI. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC THIS 29th DAY OF December, 1993.

G.W.Partington,
Chairman,
Trade Marks Opposition Board.