

IN THE MATTER OF AN OPPOSITION
by Mandair Distributors Ltd. to
application No. 588,462 for the
trade-mark PIZZA 249 & Design
filed by 249 Pizza & Pasta Inc.

On July 24, 1987, the applicant, 249 Pizza & Pasta Inc., filed an application to register the trade-mark PIZZA 249 & Design (illustrated below) for "pizza and pasta restaurant services" based on proposed use in Canada. The application was amended to include a disclaimer to the word PIZZA and was subsequently advertised for opposition purposes on June 29, 1988.

The opponent, Mandair Distributors Ltd., filed a statement of opposition on July 29, 1988, a copy of which was forwarded to the applicant on September 12, 1988. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the opponent's trade-mark PIZZA 222 registered under No. 313,854 for "pizza" and "take-out restaurant and pizza delivery services." The second ground is that the applicant is not the person entitled to registration because its trade-mark is confusing with the trade-mark PIZZA 222 previously used in Canada by the opponent. The third ground is that the applied for trade-mark is not distinctive in view of the foregoing.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Brian E. Kreiter and Karen M. Fandrey. The applicant filed the affidavits of Louis Criebardis and Gay J. Owens. As evidence in reply, the opponent filed a second affidavit of Brian E. Kreiter. The opponent was subsequently granted leave pursuant to Rule 46(1) of the Trade-marks Regulations to file a third affidavit of Brian E. Kreiter. Both parties filed written arguments but no oral hearing was conducted.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the filing of the opposition. Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion. Finally, in applying the test for confusion set forth in Section 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in Section 6(5) of the Act.

The marks of both parties are inherently weak, each being comprised of the non-distinctive word PIZZA and a three digit number. The opponent has evidenced well over ten million dollars of sales and \$1.5 million in advertising expenditures in the Vancouver

area for the four year period prior to the filing of the opposition. Thus, I am able to conclude that the opponent's mark PIZZA 222 had become known in Vancouver and the surrounding region. The applicant's evidence, on the other hand, is insufficient to allow me to ascribe any significant reputation for its mark as of the material time.

The length of time the marks have been in use favors the opponent. The services and trades of the parties are identical; both parties operate take-out pizza restaurants. The applicant sought to differentiate the two operations by the particular marketing method used. However, no such restriction appears in the applicant's statement of services or in the statement of services appearing in the opponent's registration. Thus, the particular method of business used by each party is irrelevant in this case: see Mr. Submarine Ltd. v. Amandista Investments Ltd. (1987), 19 C.P.R.(3d) 3 at pgs. 10-11 (F.C.A.) and Henkel Kommanditgesellschaft v. Super Dragon (1986), 12 C.P.R.(3d) 110 at pg. 112 (F.C.A.).

As for Section 6(5) (e) of the Act, the marks of the parties bear a fair degree of resemblance in all respects. Both are essentially comprised of the word PIZZA followed by a three digit number commencing with the number 2. Thus, it would be relatively easy for a consumer having only an imperfect recollection of the opponent's mark to assume that the applicant's mark is somehow connected to the opponent.

The applicant submitted that the state of the register evidence contained in the Owens affidavit mitigates the effect of any resemblance between the marks at issue. I disagree. The Owens affidavit evidences only a few registrations for marks which include the word PIZZA and numerals. Of those few marks, only one includes the word PIZZA and a three digit number, the three digit number in that case preceding the word PIZZA and being a numerical representation of the phrase "two for one." Thus, the state of the register evidence is of no effect in the present case.

The applicant also submitted that the absence of any evidence of incidents of actual confusion between the marks at issue is a further relevant surrounding circumstance. Again, I disagree. In view of the fact that the opponent's use has been restricted to the Vancouver area, the fact that the applicant's use has been restricted to parts of Alberta and Saskatchewan and the fact that the applicant has not evidenced any significant use of its mark, the absence of actual confusion is not surprising.

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my conclusions above, and particularly in view of the similarities between the services, trades and marks of the parties, I find that the applicant has failed to satisfy the onus on it to show that its mark is not confusing with the opponent's registered mark. The first ground of opposition is therefore successful and the remaining grounds need not be considered.

In view of the above, I refuse the applicant's application.

DATED AT HULL, QUEBEC, THIS 28th DAY OF March, 1991.

David J. Martin,
Member,
Trade Marks Opposition Board.