

**IN THE MATTER OF AN OPPOSITION
by Little Caesar Enterprises, Inc. to application
No. 736,160 for the trade-mark VEGGIE WEDGIE
filed by The Flying Wedge Pizza Co. Ltd.**

On September 3, 1993, the applicant, The Flying Wedge Pizza Co. Ltd., filed an application to register the trade-mark VEGGIE WEDGIE for “pizza” based on use in Canada since October of 1989. The application was advertised for opposition purposes on May 10, 1994.

The opponent, Little Caesar Enterprises, Inc., filed a statement of opposition on November 18, 1994, a copy of which was forwarded to the applicant on January 23, 1995. The first ground of opposition is that the applicant’s application does not comply with the provisions of Section 30(b) of the Trade-marks Act since the applicant did not use its applied for mark in Canada since the date claimed.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Act because it is confusing with the following ten trade-marks standing in the name of the opponent and registered for pizza and/or restaurant services:

<u>Reg. No.</u>	<u>Trade-mark</u>	<u>Reg. No.</u>	<u>Trade-mark</u>
436,292	ALWAYS!ALWAYS!	417,559	BABY PAN!PAN!
437,658	BIG!BIG! CHEESE	409,769	CHEESER!CHEESER!
433,739	CRAZY!CRAZY!	424,200	MONDAY!MONDAY!
404,972	PEPPERONI!PEPPERONI!	380,572	PARTY!PARTY! PACK
429,590	SPAGHETTI!SPAGHETTI!	363,881	PAN!PAN!

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1)(a) of the Act because, as of the applicant’s claimed date of first use, the applied for trade-mark was confusing with the registered trade-marks noted above and the following trade-marks previously used or made known in Canada by the opponent in association with pizza and/or restaurant services:

**BIG!BIG!
BIG!BIG! SLICE
CRISPY!CRISPY!
LOTS!LOTS!
PICNIC!PICNIC!
SUB!SUB!
VEGGIE!VEGGIE!**

**BIG!BIG! DEAL
BONUS!BONUS!
HAWAIIAN!HAWAIIAN!
PARTY!PARTY!
RAVIOLI!RAVIOLI!
SUPREME!SUPREME!
ITALIAN SAUSAGE!SAUSAGE!**

**BIG!BIG! PEPPERONI
CHOCOLATE!CHOCOLATE!
HEALTHY!HEALTHY!
PASTA!PASTA!
SLICE!SLICE!
TEASER!TEASER!**

The fourth ground of opposition is that the applied for trade-mark is not distinctive because it is confusing with the various trade-marks of the opponent noted above. In this regard, the opponent alleges that it is the owner of a series of “repetitive” marks.

As its evidence, the opponent filed an affidavit of Herbert McPhail and two affidavits of Christopher P. Ilitch, the opponent’s Group Vice President. As its evidence, the applicant submitted an affidavit of its founder and principal owner, Harvey Chiang. Both parties filed a written argument and an oral hearing was conducted at which both parties were represented.

By its letter of November 17, 1995, the applicant objected to the exhibits appended to the two Ilitch affidavits because, unlike the affidavit, they appear to be unsworn. The applicant reiterated this objection in its written argument and at the oral hearing and relied on the opposition decision in Thomas J. Lipton v. Les Aliments Intergro Inc. (1989), 26 C.P.R.(3d) 278 at 280-281. As noted by the applicant, in general, the rules of evidence applicable in the Federal Court are also applicable in opposition proceedings. However, in the present case, the exhibits appended to the Ilitch affidavits are numbered and have been specifically identified by number by Mr. Ilitch in each of his affidavits. There is no apparent reason to doubt that they are, in fact, the exhibits identified by Mr. Ilitch and I have therefore considered them as being admissible in this proceeding: see the opposition decisions in Fiorucci S.p.A. v. Ferlucci Jeans (1982) Inc. (1986), 9 C.P.R.(3d) 509 at 511 and 114662 Canada Inc. v. Société Immobilière Place du Parc Inc. (1990), 29 C.P.R.(3d) 378 at 381-381. In the Thomas J. Lipton case, Chairman Partington had no regard to exhibits to an affidavit which were neither notarized nor identified as evidence in the proceeding. In the present case, I find that

the exhibits, although unnotarized, have been adequately identified and form part of, or are securely attached to, the respective affidavits.

The Ilitch affidavits establish that the opponent operates a large chain of pizza restaurants in association with the trade-mark LITTLE CAESARS. The restaurants are located primarily in the United States although there is an ever-growing number of Canadian-based outlets, some of which are company owned and many of which are operated by franchisees. Mr. Ilitch states that his company has adopted a practice over the years of using trade-marks formed by reduplicating words, particularly words that are generic or descriptive of food products.

In his first affidavit, Mr. Ilitch provides extensive sales figures and advertising expenditures by his company for a number of years. However, Mr. Ilitch did not provide a breakdown of those sales by country, restaurant location or by specific trade-mark. Mr Ilitch also refers to direct mail advertising campaigns conducted by all of the LITTLE CAESARS outlets, including those in Canada. Such campaigns have been extensive but, again, Mr. Ilitch has failed to evidence which, if any, specific marks relied on were featured in those campaigns. Thus, it is impossible to determine when any of the trade-marks relied on by the opponent were used in Canada or the extent to which they had become known in this country.

In his second affidavit, Mr. Ilitch refers to television advertising campaigns conducted by his company in Canada from December 1992 to August 1994. Appended as exhibits to Mr. Ilitch's second affidavit are copies of detailed campaign descriptions and advertising schedules. Unfortunately, however, Mr. Ilitch again failed to provide much information as to which trade-marks relied on in the statement of opposition were featured in the ad campaigns. The most I can infer from those materials is that the registered trade-marks CRAZY!CRAZY! and BIG!BIG! CHEESE acquired some reputation in Canada during those campaigns. Most notably, there is no evidence of any use or reputation in Canada at any time for the opponent's mark VEGGIE!VEGGIE!.

The Chiang affidavit evidences the history of the applicant's Vancouver-based pizza restaurant chain operating under the trade-mark FLYING WEDGE. The first restaurant opened in April 1989 and, as of June 1996, there were five outlets. According to Mr. Chiang, the applicant commenced using the mark VEGGIE WEDGIE in October 1989 to identify a particular type of pizza product sold through the applicant's outlets.

As for the opponent's first ground of opposition, the onus or legal burden is on the applicant to show its compliance with the provisions of Section 30(b) of the Act: see the opposition decision in Joseph Seagram & Sons v. Seagram Real Estate (1984), 3 C.P.R.(3d) 325 at 329-330 and the decision in John Labatt Ltd. v. Molson Companies Ltd. (1990), 30 C.P.R.(3d) 293 (F.C.T.D.). There is, however, an evidential burden on the opponent respecting its allegations of fact in support of that ground. That burden is lighter respecting the issue of non-compliance with Section 30(b) of the Act: see the opposition decision in Tune Masters v. Mr. P's Mastertune (1986), 10 C.P.R.(3d) 84 at 89. Furthermore, Section 30(b) requires that there be continuous use of the applied for trade-mark in the normal course of trade since the date claimed: see Labatt Brewing Company Limited v. Benson & Hedges (Canada) Limited and Molson Breweries, a Partnership (1996), 67 C.P.R.(3d) 258 at 262 (F.C.T.D.). Finally, the opponent's evidential burden can be met by reference to the applicant's own evidence: see Labatt Brewing Company Limited v. Molson Breweries, a Partnership (1996), 68 C.P.R.(3d) 216 at 230 (F.C.T.D.).

The opponent filed no evidence directed to its first ground of opposition. Instead, it relied on paragraphs 5 and 6 of the Chiang affidavit which are reproduced below.

5. Since at least as early as October 1989, Flying Wedge has sold pizza in association with the trade-mark VEGGIE WEDGIE through the FLYING WEDGE Restaurants. The trade-mark VEGGIE WEDGIE is associated with pizza sold in the FLYING WEDGE Restaurants by virtue of the identification of a particular pizza flavour as the VEGGIE WEDGIE pizza on menus, signage and verbally by FLYING WEDGE Restaurant staff. In a typical transaction, restaurant customers will ask for a VEGGIE WEDGIE pizza by name in conjunction with the sale of pizza slices or whole pizzas, after having seen the VEGGIE WEDGIE trade-mark in a menu or on signage.

6. Attached as Exhibit "A" to this Affidavit are specimens of the menus used in the FLYING WEDGE Restaurants since about November 1992, illustrating how the trade-mark VEGGIE WEDGIE has been used by Flying Wedge in association with pizzas.

It should be noted that Exhibit A to the Chiang affidavit comprises three different specimen menus, all of which include a reference to VEGGIE WEDGIE as a type of pizza. As noted by the opponent, the reference on the first menu is relatively minor. However, the references on the other two specimens give greater prominence to the words VEGGIE WEDGIE including the use of non-traditional script and an encircled R.

The opponent contends that the verbal identification of VEGGIE WEDGIE by the applicant's customers described in paragraph 5 of the Chiang affidavit does not constitute use of VEGGIE WEDGIE as a trade-mark. In this regard, the opponent relied on the decision of Mr. Justice Pinard in Playboy Enterprises Inc. v. Germain (No. 1) (1987), 16 C.P.R.(3d) 517 (F.C.T.D.) wherein it was held that a mere verbal description to customers of the trade-mark PLAYBOY by the trade-mark owner in association with hair pieces did not constitute use of the mark for the purposes of Section 4(1) of the Act. However, in the present case, there is also a visual element respecting a sale effected in association with the applicant's mark. When a transaction occurs, a customer views VEGGIE WEDGIE on a menu or on signage and then asks for it by name. Given the manner in which VEGGIE WEDGIE appears on the applicant's menus, I consider that such a transaction constitutes use of VEGGIE WEDGIE as a trade-mark for pizza within the meaning of Section 4(1) of the Act.

The opponent also contends that the menus in Exhibit A only date back to 1992 and thus do not support the claimed date of first use of October 31, 1989. Presumably, those menus are representative of the manner in which the applicant has used its trade-mark throughout. In any event, the applicant is not obliged to provide any such evidence in the absence of the opponent meeting its evidential burden. If the opponent had wished to pursue this point further, it could have cross-examined Mr. Chiang on his affidavit but it chose not to do so. Nothing in the Chiang affidavit is inconsistent with the applicant's claimed date of

first use of October 31, 1989. Thus, the opponent has failed to meet its evidential burden and the first ground of opposition is unsuccessful.

As for the second ground of opposition, the material time for considering the circumstances respecting the issue of confusion with a registered trade-mark is the date of my decision: see the decision in Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers (1991), 37 C.P.R.(3d) 538 at 541-542 (T.M.O.B.). Furthermore, the onus or legal burden is on the applicant to show no reasonable likelihood of confusion between the marks at issue. 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.

As for Section 6(5)(a) of the Act, the opponent's registered marks are, by the opponent's own admission, all inherently weak. As noted, there is only evidence of a reputation in Canada for the registered trade-marks CRAZY!CRAZY! and BIG!BIG! CHEESE. The opponent's evidence is too vague and unspecific to conclude that any of the other eight trade-marks have been used in Canada or have acquired a reputation in this country.

The applicant's mark VEGGIE WEDGIE is not an inherently strong mark since it suggests a pizza slice featuring vegetable toppings. The Chiang affidavit fails to evidence the extent to which that mark has become known in Canada.

Given the deficiencies in the evidence of both parties, the length of time the marks have been in use is not a material circumstance in this case. The applicant's wares are identical to the opponent's wares. The trades of the parties are the same since both operate chains of pizza restaurants.

As for Section 6(5)(e) of the Act, there is no resemblance between the applicant's mark and any of the opponent's ten registered marks.

The opponent has submitted that its family of trade-marks based on the reduplication of food-related or restaurant-related words increases the likelihood of confusion occurring in the present case. However, although the opponent has a number of registrations for such marks and pending applications for even more, it did not evidence any use of them. Furthermore, as noted by the applicant, the exhibits to the McPhail affidavit show that a number of the applications relied on by the opponent have either been abandoned or the applied for mark has not yet been used. The most that can be concluded from the opponent's evidence is that there is some reputation in Canada for the two registered trade-marks CRAZY!CRAZY! and BIG!BIG! CHEESE. Thus, in accordance with the decision in McDonald's Corp. v. Yogi Yogurt Ltd. (1982), 66 C.P.R.(2d) 101 (F.C.T.D.), the opponent has failed to establish its alleged family or series of marks.

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 absence of any acquired reputation for most of the registered marks and the absence of any resemblance between those marks and the applicant's mark, I find that the applicant's mark is not confusing with any of the opponent's ten registered marks. Thus, the second ground of opposition is also unsuccessful.

As for the third ground of opposition, the opponent has failed to evidence any use or making known of any of the marks relied on prior to the applicant's claimed date of first use. Thus, the third ground is also unsuccessful.

As for the fourth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from those of others throughout Canada: see Muffin Houses Incorporated v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (T.M.O.B.). Furthermore, the material time for considering the circumstances respecting this issue is as of the filing of the opposition (i.e. - November 18, 1994): 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.). Finally, there is an evidential burden on the opponent to prove the allegations of fact supporting its ground of non-distinctiveness.

As previously noted, the opponent's evidence is deficient in evidencing any reputation in Canada for most of the marks relied on in the statement of opposition. The most that can be concluded is that the opponent's house mark LITTLE CAESARS was known in Canada as of the material time and that the two registered marks CRAZY!CRAZY! and BIG!BIG! CHEESE had acquired at least some reputation in this country as of that date. As noted, there is no evidence of any use or reputation in Canada for the mark VEGGIE!VEGGIE!, the most relevant of the opponent's mark. As also noted, the opponent has failed to evidence the use of a series of marks in Canada formed by reduplicating food or restaurant-related words. Thus, the opponent has failed to meet its evidential burden and the fourth ground is therefore also unsuccessful.

In view of the above, and pursuant to the authority delegated to me under Section 63(3) of the Act, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 18th DAY OF MARCH, 1998.

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