

**IN THE MATTER OF AN OPPOSITION
by Restaurants Pacini Inc. to application
No. 1190318 for the trade-mark PACHINO
filed by Aulcorp Food Marketers &
Distributors Inc.**

On September 10, 2003, Aulcorp Food Marketers & Distributors Inc. (the “Applicant”) filed an application for the registration of the trade-mark PACHINO (the “Mark”) based on proposed use of the Mark in Canada in association with the following wares: “Food and food products, namely, pizza, pasta, vegetables, fruits, pasta mixes, rice, rice mixes, noodles, noodles and sauces, olive oil, pizza sauces, olives, cookies, cakes, bread sticks, breadcrumbs, produce glazes, croutons, fruit juices, fruit nectars” (the “Wares”).





The application was advertised for opposition purposes in the Trade-marks Journal of September 1, 2004.



On October 15, 2004, Les Restaurants P & P Inc. (the predecessor in title of Restaurants Pacini Inc. (the “Opponent”)) filed a statement of opposition against the application, which statement was amended on December 22, 2004.

The grounds of opposition in the amended statement of opposition of record can be summarized as follows:

1. The application does not comply with the requirements of s. 30 of the *Trade-marks Act* (R.C.S. 1985, c.T-13, as amended) (the “Act”) since the description of wares in the application, in particular, “produce glazes, vegetables, fruits” does not constitute a description in ordinary commercial terms, nor is it possible to discern the use of such products, nor what their channels of trade may be;
2. The application does not comply with the requirements of s. 30 of the Act, as the Applicant did not, by itself, have an intention of using the Mark in Canada in association with all of the wares set forth in its application;

3. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the following trade-marks of the Opponent:

Trade-mark	Reg. No / Reg. Date	Wares/Services
PACINI	TMA312,775 March 28, 1986	Pastas, sauces, pizzas, condiments, confections, namely, chocolate candies, pastries, spreads, bread, soups and prepared meals, chocolate cherries, as well as the services relating to the operation of bars and restaurants.
	TMA318,885 September 26, 1986	Services relating to the operation of bars and restaurants.
	TMA463,305 September 13, 1996	Services relating to the operation of bars and restaurants; food take-out and delivery counters.
	TMA466,662 November 29, 1996	Pastas, sauces, pizzas, condiments, confections, namely, chocolate, candies, pastries, spreads, bread, soups and prepared meals, chocolate cherries.
	TMA585,702 July 22, 2003	Services relating to the operation of bars and restaurants; food take-out and delivery counters.

	<p>TMA582,005 May 21, 2003</p>	<p>Ready-to-cook foods, namely confections comprising cherries and chocolate, pastries, and restaurant services.</p>
	<p>TMA588,156 August 26, 2003</p>	<p>Restaurant services.</p>

4. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(a) of the Act in that as of the filing date of the application, the Mark was confusing with the Opponent's trade-marks listed above which have been previously used or made known in Canada by the Opponent;
5. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(3)(c) of the Act in that as of the filing date of the application, the Mark was confusing with the Opponent's trade names Pacini and Restaurants Pacini previously used in Canada by the Opponent; and
6. The Mark is not distinctive of the Applicant pursuant to s. 38(2) of the Act in that the Mark neither distinguishes nor is adapted to distinguish the products of the Applicant from those of the Opponent, nor the services performed by the Opponent, nor the business operated by the Opponent.

By counter statement dated December 3, 2004 and amended on February 25, 2005, the Applicant denied each and every one of the allegations made in the amended statement of opposition.

In support of its opposition, the Opponent filed the declarations of Pierre-Marc Tremblay (who identifies himself as President and Chief Director of the Opponent) and Marylène Gendron (who identifies herself as a secretary employed in the trade-marks department of the trade-mark agents

for the Opponent) (hereinafter referred to as the “first Tremblay declaration” and the “first Gendron declaration” respectively) as evidence pursuant to r. 41 of the *Trade-marks Regulations* (the “Regulations”). The Opponent also filed as evidence pursuant to r. 43 of the Regulations, a second declaration of Marylène Gendron. The Opponent further requested leave to file a second declaration of Pierre-Marc Tremblay (hereinafter referred to as the “second Tremblay declaration”) as evidence pursuant to r. 44 of the Regulations, which request was objected to by the Applicant. As the said request was made only a few days before the holding of the oral hearing, I advised the parties that I would address the Opponent’s request at the same time as rendering the present decision. The ruling is included below.

In support of its application, the Applicant filed the affidavit of Frank Aulino (who identifies himself as President of the Applicant) as evidence pursuant to r. 42 of the Regulations. No cross-examinations were conducted.

Each party filed a written argument. In its written argument, the Opponent annexed a printout from <http://fr.wikipedia.org> as well as a printout from Le Robert & Collins French-Italian Dictionary. The Applicant objected to the filing of the said printouts at the written argument stage. I will deal with the Applicant’s objection hereinafter in my decision when addressing the degree of resemblance between the marks in appearance or sound or in the ideas suggested by them.

Only the Opponent attended at an oral hearing.

Onus and material dates

The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. There is, however, an initial 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 C.P.R. (3d) 293 (F.C.T.D.); *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

The relevant dates for considering the circumstances in regard to each of the grounds of opposition in the present proceeding are the following:

- Grounds based on s. 30 of the Act: the filing date of the application [see *Georgia-Pacific Corp. v. Scott Paper Ltd.* (1984), 3 C.P.R. (3d) 469 (T.M.O.B.)];
- Ground based on s. 12(1)(d) of the Act: the date of my decision [see *Park Avenue Furniture Corp. v. Wickers/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- Grounds based on s. 16(3) of the Act: the filing date of the application; and
- Ground based on non-distinctiveness of the Mark: generally accepted as being the filing date of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.)].

I will now analyze the grounds of opposition in regard to the evidence filed in the record, without necessarily respecting the order in which they were raised in the statement of opposition.

Section 12(1)(d) ground of opposition

The Opponent has provided through the first Tremblay declaration, certified copies for each of the above-cited trade-mark registrations. The Opponent's initial burden with respect to this ground of opposition has been satisfied because each of these registrations is in good standing.

Because of this evidence by the Opponent, the Applicant must establish on a balance of probabilities that there is no reasonable likelihood of confusion between the Mark and the Opponent's marks.

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those listed at s. 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 different weight will be attributed to different factors according to the context [see *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321 (C.S.C.); and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824 (C.S.C.) for a thorough discussion of the general principles that govern the test for confusion].

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

The Mark consists of the word PACHINO whereas the Opponent's marks consist of the word PACINI used either alone or in combination with other words or design elements. Since the mark PACINI is more similar to the Applicant's Mark than are the marks PACINI LE VRAI GOÛT DE L'ITALIE & DESIGN, DÉLICERISE UN P'TIT PÉCHÉ DE PACINI & DESIGN and BUFFET PRONTO PACINI & DESIGN, I will focus my discussion on the PACINI word mark and stylized versions thereof, unless indicated otherwise.

While the words PACHINO and PACINI are not common words found in English and/or French dictionaries, the Aulino affidavit establishes that the Opponent's mark PACINI may correspond to a surname. Attached as Exhibit "D" to the Aulino affidavit, is a printout from Canada 411 online directory listing 36 references for individuals having the surname "Pacini" located for the most part in the provinces of Ontario and British Columbia. There is no indication that the PACHINO Mark is also a surname. While it is fair to say that the PACHINO and PACINI marks both possess an Italian connotation when associated with Italian-type cuisine, I consider the marks to be inherently distinctive, though to a weaker extent for the PACINI mark given also its surname connotation.

The strength of a trade-mark may be increased by means of it becoming known through promotion or use. There is however no evidence that the Applicant has used its proposed use Mark in Canada to date. The Aulino affidavit merely states that the Applicant is “an import/product developer dealing exclusively in customer private label and branded products, and deals with logistics such as factory to customer and has an intention to use the trade-mark PACHINO in association with the goods recited in the application”.



Turning to the Opponent’s use and promotion of the PACINI mark, the first Tremblay declaration establishes the following.

Mr. Tremblay states that the Opponent and its franchisees operate under the PACINI trade-mark, one of the most well-known chains of restaurants in the province of Québec. The first restaurant opened in 1980 under the name LA BOÎTE À SPAGHETTI, and other restaurants were later opened in Québec. The PACINI trade-mark was adopted in 1984 by Le Groupe Resto Inc. (the first predecessor in title of the Opponent). The affiant further provides a history of the Opponent, and indicates that, in 1989, the management team of Le Groupe Resto Inc. acquired and founded the company Les Restaurants Pacini Inc. (a predecessor in title of the Opponent) to which the PACINI marks and trade names were transferred. Les Restaurants Pacini Inc. later merged with another enterprise to form Les Restaurants P & P Inc. (former designation of the Opponent), which then acquired the PACINI marks and trade names. Les Restaurants P & P Inc. changed its designation on January 25, 2005 to be known as Restaurants Pacini Inc.

Mr. Tremblay states that the Opponent runs by itself or through franchisees, 24 restaurants under the PACINI marks and trade names in the province of Québec and provides as Exhibits “PT-1”, a list of the addresses of these restaurants. The affiant further provides an overview of the franchise system effected and administered by the Opponent, and indicates that the franchising contracts provide for a license to use the PACINI marks, subject to conditions governing their use. The contracts also provide for the character and quality of the products and services offered in association with the PACINI marks and trade names and the Opponent exercises control over such use.

Mr. Tremblay states that the Opponent offers in its various restaurants, restaurant services, and may offer bar services and take-away counter services. The restaurants run under the PACINI marks and the trade name PACINI offer Italian-type cuisine including pastas, pizzas, as well as a variety of other prepared dishes, following the recipes of the Opponent, and containing ingredients purchased from its suppliers.

Mr. Tremblay provides a list of the PACINI marks that are being used by the Opponent itself and/or its franchisees, that matches the above-cited list of trade-mark registrations. Mr. Tremblay states that except for the BUFFET PRONTO PACINI & DESIGN mark, all the said marks have been used extensively and continuously by the Opponent and/or its franchisees since their introduction into the marketplace (that corresponds to the dates of first use stated in the certificates of registration) in association with all the services listed in the certificates of registration except the delivery services. Mr. Tremblay explains that the Opponent does not offer delivery services, but is engaged in a project whereby they will be offered under the PACINI marks. Concerning the BUFFET PRONTO PACINI & DESIGN mark, Mr. Tremblay states that it has been used extensively and continuously, up to May 2005, in the city of Amos, Québec, by its franchisee since the date of first use stated in the certificate of registration and in association with all the services listed therein. Mr. Tremblay further states that the Opponent has, in the course of the year 2004, begun to use the following designs in association with the trade-mark PACINI, for which applications for registration were advertised on May 4, 2005, under Serial Nos. 1231398 and 1231393 (printouts from the Canadian Intellectual Property Office's STRATEGIS database concerning each of these applications having been attached as Exhibit MG-2 to the first Gendron declaration):

Serial No. 1231398 	Serial No. 1231393 
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While the Applicant has not objected to the Opponent referring to these two latter marks, I note that they have not been pleaded by the Opponent in its statement of opposition. Nevertheless, I find that these two PACINI logos qualify as use of the PACINI mark, since the word PACINI clearly stands out from the additional material [See *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984) 2 C.P.R. (3d) 535 (T.M.O.B.)]. In my view, despite the design elements, the trade-mark PACINI is clearly recognizable as the trade-mark *per se*. Accordingly, I shall regard the exhibits displaying the said logos that were filed as evidence by the Opponent, as acceptable specimens pertaining to the PACINI mark.

Mr. Tremblay states that the Opponent has used the PACINI mark and the PACINI & DESIGN mark (registration No. 466662) in Canada extensively and continuously in association with breads until 2003, and in association with pizzas until 2004, and provides as Exhibits “PT-3”, examples of specimens for pizza packaging. The affiant has not indicated where the Opponent’s breads and pizzas have been sold. He has not indicated whether these products are offered for sale in the Opponent’s restaurants, where customers of the restaurants may purchase these for home cooking, or whether they are sold in stores.

Mr. Tremblay states that the Opponent has used the mark DÉLICERISE UN P’TIT PÉCHÉ DE PACINI & DESIGN extensively and continuously since its introduction into the marketplace in association with cherry and chocolate-based confections, and that these products are offered as desserts in various PACINI restaurants, and provides as Exhibit “PT-4”, an example of the packaging for these cherry and chocolate-based confections.

Mr. Tremblay states in paragraph 18 that the Opponent has sold many assorted food products covered by the PACINI mark (registration No. 312775) and PACINI & DESIGN mark (registration No. 463305), and that the Opponent is currently working on a project to sell various food products under the PACINI marks. I will revert to this point when discussing the second Tremblay declaration objected to by the Applicant.

Mr. Tremblay provides approximate sales figures for the services provided in association with the PACINI marks in Canada. They vary between some 24 million dollars to some 28 millions

dollars per year for the years 2000 to 2004. While Mr. Tremblay provides these numbers for Canada, the overall consideration of the statements contained in Mr. Tremblay's first declaration and accompanying exhibits links these numbers to the province of Québec only.

Mr. Tremblay states that the PACINI marks are used extensively in the restaurants run by the Opponent and its franchisees on signs, menus, napkins, etc. The affiant provides specimens of use the PACINI marks in the normal course of business, in association with the services.

Mr. Tremblay states that the Opponent has invested considerable sums of money for the promotion in Canada of the services in association with the PACINI marks and the trade names PACINI, and has provided a marketing budget figure of \$617,700.00 for the year 2004-2005, which includes signage, television campaigns and radio, in-house publicity for the restaurants, public relations, multiple promotions, the YellowPages and WhitePages, menus and local publicity. The affiant attaches as Exhibit "PT-21", a promotional article referring to a publicity campaign where the PACINI mark was sung by the opera singer Nathalie Choquette in 2001, together with an excerpt from the marketing kit 2001-2002 intended for the Opponent's franchisees. As for the sales figures discussed above, these marketing figures and campaigns seem to be linked to the province of Québec only.

Mr. Tremblay states that the Opponent and its franchisees have decided to contribute to fundraising in a major charity and have engaged, through 2006, to contribute 1 million dollars to support the Foundation Sainte-Justine for the benefit of Sainte-Justine Hospital located in Montréal. Mr. Tremblay also indicates that in a similar campaign held in 2003-2004, the Opponent and its franchisees were among the principal supporters of a popular Québec show, "Star Académie". The affiant provides as Exhibits "PT-22", various specimens of material associated with the Opponent's fundraising efforts for the Foundation Sainte-Justine that also refer to the Opponent's sponsorship of "Star Académie". The affiant also provides as Exhibit "PT-23", the annual report for the year 2003-2004 of the Foundation Sainte-Justine that acknowledges the Opponent's 1 million dollars donation.

Mr. Tremblay states that the sponsorship of the television show “Star Académie” has contributed to increase the notoriety of the PACINI marks and trade names among the population in Québec. He attaches as Exhibit “PT-24”, a copy of an article published in “La Presse” newspaper on June 4, 2003. While that article refers to the significant impact that “Star Academie” has had for the Opponent at the time, it focuses on another chain of restaurants of the Opponent, namely “L’Adresse” and simply refers to the fact that the Opponent also owns the chain of restaurants PACINI.

Mr. Tremblay provides as Exhibits “PT-25” to “PT-27”, various publicity inserts in community newspapers and sponsorship, contests and promotional material in association with the Opponent and its franchisees.

Mr. Tremblay provides as Exhibit “PT-28”, printouts from the Opponent’s website, and states that the Opponent has promoted its services in association with the PACINI marks through its website at *www.pacini.com*. He further provides as Exhibit “PT-30”, an example of the marketing kit pamphlet for the year 2005, which the Opponent provides its franchisees each year to promote the services in association with the PACINI marks in their regions.

Mr. Tremblay provides as Exhibit “PT-31”, articles, which have appeared in Canada on the subject of the Opponent and its services in association with the PACINI marks. Some of the articles published in newspapers such as “La Presse”, “Le Soleil”, “Le journal de Québec” and the magazine “Le Chef”, tend to support the Opponent’s contention that the PACINI restaurants are well-established and well-known in Québec. I wish to add that I have no qualms about taking judicial notice of the fact that the majority of these newspapers have a certain circulation in Canada [see on this point *Northern Telecom Ltd. v. Nortel Communications Inc.* (1987), 15 C.P.R. (3d) 540 (T.M.O.B.)]. Furthermore, an excerpt dated July 26, 1997 from “La Presse”, mentions that “Pacini poursuit sa lancée dans la vente au détail”. It refers to the PACINI Bolognese sauce that would be sold through the “Club Price” stores and the PACINI bread that would be sold through the supermarkets “Provigo”, “Maxi” and “Maxi & Cie” in Québec.

Turning now to the second Tremblay declaration, and the objection made by the Applicant, I wish to rule as follows.

The Opponent takes the position that the second Tremblay declaration filed as additional evidence pursuant to r. 44 of the Regulations is relevant since it supports the plan for the retail sale of new food products under the PACINI trade-mark, indicated in paragraph 18 of the first Tremblay declaration. The agent for the Opponent indicates that this evidence was not adduced at the evidential stage because the Opponent's new line of oils and seasonings were only launched in late December 2007, with deliveries to "Metro" supermarkets and independent grocery stores intensifying during the months of January and February 2008. The agent for the Opponent also indicates that these new facts relating to the Opponent's new product line were not brought to counsel's attention until March 2008, hence the Opponent's request for leave to file additional evidence made on March 31, 2008, before the oral hearing set for April 8, 2008. While the Applicant acknowledges the fact that sales of the Opponent's products did not commence until late December 2007, the Applicant takes the position that if the Opponent had not thought it important enough to inform counsel of the sale of its new product line for three months, especially in light of these proceedings, then it stands to reason that the Opponent did not consider these changes to be of significant value in its opposition against the Applicant's application. Accordingly, the Opponent's own actions, or lack thereof, causes the Applicant to question the importance of the additional evidence.

While not without merits, I disagree with the Applicant's position. The Opposition Board Practice Notice states that leave to file additional evidence will only be granted if the Opposition Board is satisfied that it is in the interests of justice to do so having regard to all the surrounding circumstances including: 1) the stage the opposition proceeding has reached; 2) why the evidence was not filed earlier; 3) the importance of the evidence; and 4) the prejudice which will be suffered by the other party. As indicated above, the relevant date for considering the circumstances in regard to a ground of opposition based on s. 12(1)(d) of the Act is the date of my decision. The additional evidence adduced by the Opponent in the instant case is relevant since it confirms the plan for the retail sale of new food products under the PACINI trade-mark, indicated in paragraph 18 of the first Tremblay declaration. It could not have been introduced

earlier than the beginning of 2008 since, as acknowledged by the Applicant, the sales of the Opponent's products did not commence until late December 2007. Furthermore, as the said evidence merely confirms Mr. Pierre-Marc Tremblay's statement made in paragraph 18 of his first declaration as opposed to introducing unexpected and entirely new evidence, I consider that there is little, if any, prejudice suffered by the Applicant. Accordingly, I come to the conclusion that while it would have been better if that additional evidence had been filed about one or two months earlier, the balance of the surrounding circumstances tips in favor of the Opponent and it is in the interests of justice to grant the Opponent's request for leave to file the supplemental declaration of Mr. Tremblay as additional evidence pursuant to r. 44 of the Regulations.

That said, the second Tremblay declaration establishes that the Opponent has spent approximately 280 000 dollars in promoting its new line of oils and seasonings (that in my view may reasonably be interpreted to be encompassed by the description of the wares in registration No. 312775, at least as regard the Opponent's "seasonings" that may be encompassed by the dictionary definitions for "condiments" and/or "sauces"), under the PACINI trade-mark and the RESTAURANT PACINI INC. trade name at the retail level through supermarket/grocery stores and that sales amounting to approximately 204 618 dollars were made between the months of December 2007 and March 16, 2008. However, it is to be noted that while Mr. Tremblay provides these numbers for Canada, the overall consideration of the statements contained in Mr. Tremblay's second declaration and accompanying exhibits links these numbers to the province of Québec only.

Having regard to the foregoing evidence, I am satisfied that the Opponent's PACINI trade-mark has become known, if not well-known, in the province of Québec in association with restaurant services and to a lesser extent, with the Opponent's derivative food products.

However, I agree with the Applicant's position stated in its written argument that the Opponent's evidence does not support its assertion that its family of PACINI trade-marks and its PACINI trade name are very well-known *throughout Canada*. That said, I do not consider the fact that the Opponent's reputation and business be confined (so far) to the province of Québec, sufficient to

preclude me from concluding that the overall consideration of the factor set forth in s. 6(5)(a) of the Act favours the Opponent over the Applicant.

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

As there is no evidence that the Applicant has used its proposed use Mark in Canada to date, and given the reasons above, this factor also favours the Opponent.

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

Considering the type of wares and services and the nature of the trade, I must compare the Applicant's statement of wares and services with the statement of wares and services in the registration referred to by the Opponent [see *Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.)]. However, those statements must be read with a view to determining the probable type of business or trade intended by the parties rather than all possible trades that might be encompassed by the wording.

As indicated above, the Opponent's registrations cover a variety of wares and services including, restaurant services, that may offer bar services and take-away counter services, as well as wares such as pastas, sauces, pizzas, condiments, confections, namely, candies and chocolate, pastries, spreads, bread, soups and prepared meals, chocolate cherries. There is a clear overlap between the Opponent's wares and those of the Applicant. In the absence of evidence to the contrary, there are no reasons to believe that the nature of the trade would differ, especially given the fact that at least some of the Opponent's wares are sold not only in its restaurants but also at the retail level, in supermarkets and grocery stores. I wish to add that nothing prevents the Opponent to extend further this latter niche, not only in Québec but throughout Canada.

Accordingly, these third and fourth factors also favour the Opponent.

(e) the degree of resemblance between the trade-marks in appearance or sound or in the

ideas suggested by them

It is well-established by the jurisprudence that the likelihood of confusion is a matter of first impression and imperfect recollection. This principle has been reiterated by the Supreme Court in *Veuve Clicquot [supra]* as follows:

“20 The test to be applied is a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the name *Clicquot* on the respondents’ storefront or invoice, at a time when he or she has no more than an imperfect recollection of the VEUVE CLICQUOT trade-marks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks. As stated by Pigeon J. in *Benson & Hedges (Canada) Ltd. v. St. Regis Tobacco Corp.* (1968), [1969] S.C.R. 192 (S.C.C.), at p. 202:

It is no doubt true that if one examines both marks carefully, he will readily distinguish them. However, this is not the basis on which one should decide whether there is any likelihood of confusion.

...the marks will not normally be seen side by side and [the Court must] guard against the danger that a person seeing the new mark may think that it is the same as one he has seen before, or even that it is a new or associated mark of the proprietor of the former mark. (Citing in part *Halsbury’s Laws of England*, 3rd ed., vol. 38, para. 989, at p. 590.)”

Furthermore, it is a generally accepted principle in trade-mark law that the first portion or first syllable of a trade-mark is more important for the purposes of distinction [see *Conde Nast Publications Inc. v. Union des Éditions Modernes* (1979) 46, C.P.R. (2d) 183 (F.C.)].

Applying these principles to the instant case, there is a relatively fair degree of resemblance between the marks PACHINO and PACINI. While the word PACHINO does not appear to have any meaning known to the Canadian average consumer, it possesses, like PACINI, an Italian connotation when associated with Italian-type cuisine. Both marks share the same first syllable and have the same number of syllables. The addition of the letter “H” has no impact on pronunciation, and little if any, in appearance. Except for the “O” and “I” final vowel, both marks sound identical.

In its written argument, the Opponent submits that the Italian grammar provides that masculine nouns or adjectives ending with the final vowel “O” will, in the plural form, replace the final vowel “O” by “I”. In support of that argument, the Opponent has annexed to its written argument, a printout from <http://fr.wikipedia.org> as well as a printout from Le Robert & Collins French-Italian Dictionary. As indicated above, the Applicant objected to the filing of the said printouts at the written argument stage. The Opponent submits that I can take judicial notice of these dictionary excerpts. The Opponent further submits that I can take judicial notice of the fact that Canada has an important Italian community. The Opponent submits that members of the Italian community will accordingly perceive the PACHINO and PACINI marks as being identical. While I am prepared to take judicial notice of the fact that there are a number of Canadians who are fluent in the Italian language, I do not know what percentage of the Canadian population that number represents. In the absence of evidence in this opposition, I am not prepared to infer that a significant number of Italian-speaking Canadians would perceive the PACHINO and PACINI marks as being identical [*Roc International v. Rocbel Holdings Inc.* (1994), 53 C.P.R. (3d) 109 (T.M.O.B.)]. In any event, this does not change the finding made above that there is a relatively fair degree of resemblance between the marks PACHINO and PACINI. Accordingly, this fifth factor tends to favour the Opponent.

In concluding this fifth factor, I wish to address the Applicant’s contention that where the Opponent uses the trade-mark PACINI on its own, the mark is shown in script form, underlined and/or outlined and that such use reduces the likelihood of confusion between the said mark and the Applicant’s mark. As indicated above, the Opponent owns various trade-mark registrations for the trade-mark PACINI be it in stylized versions or for the word mark PACINI alone. The existence of this latter registration renders the Applicant’s contention irrelevant.

Surrounding circumstances

The Applicant has filed, through the Aulino affidavit, a certified copy of registration No. 452275 for the trade-mark PACHINO’S DESIGN in the name of Pachino’s Pizza Limited. In its written argument, the Applicant points out that this mark, registered on December 29, 1995, issued to registration after the Opponent’s marks PACINI, under registration No. 312775, registered on

March 28, 1986, and registration No. 318885 for the trade-mark PACINI DESIGN, registered in September 1986.

The Applicant, relying on Exhibits MG-2 attached to the first Gendron affidavit, further points out that the Opponent's applications 1231398 and 1231393, both filed on September 23, 2004 for the trade-marks PACINI & DESIGN, have been allowed to registration on July 22, 2005. The Applicant points out that the instant application for the Mark PACHINO was filed on September 10, 2003, a full year earlier than applications 1231398 and 1231393. The Applicant contends in paragraph 8.25 of its written argument that:

"8.25 [I]t stands to reason that, even if the [A]pplicant's application was cited by the examiner during examination of the [O]pponent's two trade mark applications, the examiner found the [A]pplicant's mark to not be confusing with the [O]pponent's applied-for marks under applications 1,231,393 and 1,231,398. Accordingly, it stands to reason that the [A]pplicant's mark PACHINO, filed under application 1,190,318, is also not confusing with the [O]pponent's family of PACINI trade marks."

Considering the Applicant's first argument, and as noted by the Opponent, registration No. 452275 for the trade-mark PACHINO'S & DESIGN was expunged for failure to renew on June 18, 2004. The fact that this registration may have coexisted for some time with the Opponent's PACINI marks on the register of trade-marks is not by itself binding on this Board in the instant case. Not only is the PACHINO'S & DESIGN mark more different from the Opponent's PACINI marks than is the Applicant's Mark, but each case must be decided on its own merits and in accordance with the evidence tendered. In this regard, I note that a decision was rendered by this Board in respect of an opposition filed by the predecessor in title of the Opponent against the application for registration of the said PACHINO'S & DESIGN mark, which opposition was rejected by this Board on October 30, 1992. As interesting as this decision may be, it can be distinguished from the instant case, if only because the applied-for mark in that case was not the same as in the instant case and there was no evidence filed by the opponent.

The same reasoning applies to the Applicant's second argument. The printouts attached as Exhibits MG-2 to the first Gendron affidavit simply indicate that an examiner's report was issued on February 2, 2005 in each of the Opponent's PACINI & DESIGN applications. The Applicant

failed to file evidence on that point. In any event, a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have a precedential value for this Board given that the examination section does not have before it evidence that is filed by the parties in an opposition proceeding. Furthermore, the burden on an applicant differs whether the application is at the examination stage or at the opposition stage. [See *Now Communications Inc. v. CHUM Ltd.* (2003) 32 C.P.R. (4th) 68 (T.M.O.B.); *Interdoc Corporation v. Xerox Corporation*, unreported decision of the Trade-marks Opposition Board dated November 25, 1998 re application s.n. 786,491; *Thomas J. Lipton Inc. v. Boyd Coffee Co.* (1991), 40 C.P.R. (3d) 272 at 277; *Procter & Gamble Inc. v. Morlee Corp.* (1993), 48 C.P.R. (3d) 377 at 386]

In light of the foregoing, I am not prepared to accord any significant weight to the additional circumstances put forward by the Applicant in the instant case.

Conclusion re likelihood of confusion

In applying the test for confusion, I have considered that it is a matter of first impression and imperfect recollection. In view of my findings above, I find that the Applicant has not met its legal onus to show, on a balance of probabilities, that there is no reasonable likelihood of confusion as to the source of the parties' wares and/or services in the consumer's mind. Accordingly, the issue of confusion must be decided against the Applicant and the s. 12(1)(d) ground of opposition succeeds.

Section 16(3)(a) and (c) grounds of opposition

As for the s. 16(3)(a) ground of opposition, the Opponent has met its initial burden by evidencing use of the PACINI mark in association with at least part of the wares and services specified in its aforementioned registrations (e.g. pizzas, breads, chocolate cherries and restaurant services), prior to the Applicant's filing date and showing non-abandonment of its mark as of the Applicant's advertisement date. The ground therefore remains to be decided on the issue of confusion between the marks as of the Applicant's filing date. My conclusions respecting the s. 12(1)(d) are equally applicable here. Thus, the s. 16(3)(a) ground is successful.

The same conclusions apply in respect of the s. 16(3)(c) ground of opposition; the Opponent having met its initial burden by evidencing use of its trade names Pacini and Restaurants Pacini prior to the Applicant's filing date and showing non-abandonment of those names as of the Applicant's advertisement date. Thus, the s. 16(3)(c) ground is also successful.

Non-distinctiveness ground of opposition

An opponent meets its evidential burden with respect to a distinctiveness ground if it shows that as of the filing of the opposition its trade-mark 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 C.P.R. (2d) 44 (F.C.T.D)]. The Opponent has met this burden. The fact that the Opponent's reputation and business be confined to the province of Québec, does not preclude me from concluding that the Opponent's PACINI mark has, in the circumstances of the instant case, become known sufficiently to negate the distinctiveness of the Applicant's applied-for Mark. In other words, the Opponent's PACINI mark need not be used and made known *throughout Canada* to successfully oppose the Applicant's application on the ground that the applied-for Mark is not distinctive of the Applicant, as stated by Mr. Justice Noël in *Bojangles' International LLC v. Bojangles Café Ltd.* (2006) 48 C.P.R. (4th) 427 (F.C.):

“26 In *Skipper's Inc. v. Skipper's Fish & Chips Ltd.*, [1980] F.C.J. No. 705 (Fed. T.D.), at para. 49, in *obiter*, Justice Cattanach stated that if a trade-mark is sufficiently well known in a specific area of Canada, this will negate another trade-mark's distinctiveness:

As I appreciate the decision of Thurlow, J. (as he then was) in *E. & J. Gallo Winery v. Andres Wines Limited* ([1976] 2 F.C. 3) it was, amongst other things, that it was not essential that a trade mark must become "well known in Canada" within section 5 but that if it is well known in an area of Canada that is sufficient to preclude a rival trader in that area from appropriating that trade mark because it could not be "adapted to so distinguish" that trader's wares or services [my emphasis].

This statement, in my view, is in line with the *Motel 6*, above, case. In *Motel 6*, above, the evidence presented was to the effect that the reputation of the trade-mark was essentially confined to British Columbia.”

As the analysis of the likelihood of confusion under this ground does not differ significantly from that under the s. 12(1)(d) ground of opposition, its outcome is accordingly the same, namely the distinctiveness ground of opposition also succeeds.

Remaining Grounds of Opposition

As I have already found in favour of the Opponent under more than one ground, I will not address the remaining grounds of opposition.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse the application, the whole pursuant to s. 38(8).

DATED AT Montréal, Québec, THIS 27th DAY OF August 2008.

Annie Robitaille
Member, Trade-marks Opposition Board