

IN THE MATTER OF AN OPPOSITION  
by Pizza Pizza Limited to application no.  
723,731 for the trade-mark HEALTH-SMART  
filed by Gilbert Martin Haynen

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On March 1, 1993, the applicant, Gilbert Martin Haynen filed an application for the trade-mark HEALTH-SMART based on proposed use. The wares and services were amended following an office action to read as follows:

Wares: Vitamins, minerals, herbs and health food supplements

Services: the operation of a business dealing in mail order, direct marketing and media advertising.

The mark was advertised for the purposes of opposition in the *Trade-marks Journal* dated February 2, 1994 and on March 4, 1994 a statement of opposition was filed by Pizza Pizza Limited, the opponent in this matter.

The opposition was based on two grounds. The first was that the trade-mark was not registrable pursuant to section 12(1)(b) of the Trade-marks Act (hereinafter referred to as the "Act" ) because it was either clearly descriptive or deceptively misdescriptive of the character or quality of the applicant's wares. The second ground of opposition claimed that the trade-mark was not registrable pursuant to section 12(1)(d) of the Act because the trade-mark was confusingly similar to the opponent's trade-mark HEALTHSMART, registered in November 1993 for use in association with various wares including pizza pies, sandwiches and salads, and the services of operating a restaurant and food take-out and delivery services.

The applicant filed a counter statement on May 3, 1994 claiming that the wares were not confusing and on December 4, 1995, the opponent filed its evidence consisting of the affidavit of Pat Finelli, Vice-President of Sales for the opponent. The Finelli affidavit stated that the opponent operated 250 restaurant and food take-out locations throughout Canada and that the trade-mark HEALTHSMART had been marked on pizza boxes containing "Twins" pizzas sold from all these outlets since August, 1993. Between January and November, 1995, 2,250,000 pizza boxes bearing the trade-mark had been ordered for use in Canada.

On February 29, 1996, the applicant filed its evidence consisting of the affidavit of the applicant himself. Mr. Haynen's affidavit alleged that food, as marketed by the opponent, is different from the herbal remedy type products the applicant will be selling as exemplified by the

fact that the products are regulated by different bodies with regard to packaging, labelling and advertising. He also questioned the validity of the opponent's trade-mark registration on various grounds but it is well established law that the applicant cannot question the validity of the opponent's mark as part of an opposition proceeding (see Sunshine Biscuits, Inc. v. Corporate Foods Ltd. (1982) 61 C.P.R. (2d) 53 (F.C.T.D.)).

The applicant's written argument was filed on May 6, 1996 and the opponent's was filed on September 6, 1996. Neither party requested an oral hearing.

With regard to the first ground of opposition based on section 12(1)(b) of the Act, the relevant date for determining this matter is the date of my decision (see the Federal Court of Appeal decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers, 41 C.P.R. (3d) 243). While the onus is on the applicant to prove that its mark is registrable, the opponent has an initial evidential burden to adduce sufficient evidence to support the truth of the allegation. In considering this ground of opposition, it is necessary to approach it from the point of view of the average consumer or user of the wares. Also, in determining whether the mark is clearly descriptive or deceptively misdescriptive of the wares, the mark must not be dissected into its component elements but rather must be considered in its entirety as a matter of immediate impression. (See Wool Bureau of Canada Ltd. V. Registrar of Trade-marks, 40 C.P.R. (2d) 25, at pgs. 27 - 28 and Atlantic Promotions Inc. v. Registrar of Trade-marks, 2 C.P.R. (3d) 183 at 186.)

In this case, although the opponent has presented no evidence in support of its assertion that the mark HEALTH-SMART is clearly descriptive or deceptively misdescriptive of the wares in association with which it is proposed to be used, the Registrar has the discretion to have regard to standard dictionary definitions in considering whether a mark may be in violation of section 12(1)(b). In the case of a coined word, such as the mark HEALTH-SMART, where the word as a whole would not be found in a dictionary, the Registrar can look up the meanings of the component parts of the trade-mark. (C.K.R. Inc. v. Proctor & Gamble Inc. (1986) 14 C.P.R. (3d) 231 (T.M.O.B.)). However, a trade-mark will not offend the provisions of section 12(1)(b) unless the combination of the component parts provides a readily understandable meaning that is clearly descriptive of the character or quality of the wares.

In *Webster's New World Dictionary*, Second College Edition, the word "health" is described in part as "physical and mental well-being; freedom from disease, pain or defect; normality of physical and mental functions". The word "smart" is described in part as "intelligent, alert, clever, capable, witty". In this case, given the definitions for the words which make up the trade-mark, the first impression an average consumer would get would be that smart people use these wares to be healthy. Since the wares themselves, namely vitamins, minerals, herbs and health food supplements, are designed to assist people in becoming or staying healthy, or free from disease, and since one of the wares, namely "health food supplements", even uses the word "health" in its definition, it appears to me that the mark does clearly describe an intrinsic quality of the wares, namely that their purpose is to make you healthy. Also, the word "health" is one that other people are likely to want to use in association with the type of wares listed in the applicant's application so the applicant should not be allowed to monopolize it. Since the applicant has lead no evidence to show that the mark is not clearly descriptive of the wares, I find that the applicant has not met the onus upon it in this instance and refuse the application in relation to the wares.

The statement of opposition also alleged that the mark was not registrable pursuant to the provisions of section 12(1)(d) of the Act as it is confusing with their registration for HEALTHSMART. Since I have already refused the application in relation to the wares I will only consider this ground as it relates to the applicant's services. The legal burden is on the applicant to prove that there would be no reasonable likelihood of confusion between the trade-marks at issue. The material date for considering the issue of confusion with a registered trade-mark is the date of my decision [see **Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade-marks**, 37 C.P.R. (3d) 413 (F.C.A.)]. Furthermore, in assessing whether there would be any reasonable likelihood of confusion between the trade-marks in question within the scope of section 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in Section 6(5) of the Act.

With regard to the inherent distinctiveness of the marks, the mark HEALTH-SMART is inherently distinctive in relation to the services in association with which it is applied to be registered and the opponent's mark too is inherently distinctive in relation to its wares and

services. With regard to the extent to which they have become known, the applicant's mark is based on proposed use whereas the opponent's has been used on almost 5 million pizza boxes throughout Canada since 1993. Therefore, the opponent's mark is better known.

With regard to the nature of the wares, services or business, the opponent's wares are comprised of "pizza pies, sandwiches, lasagna, spaghetti, ravioli, salads and T shirts". The services are "restaurant and food take-out and delivery services". The opponent's services are the "operation of a business dealing in mail-order, direct marketing and media advertising". I find the opponent's description of services somewhat vague as it does not specify whether the business will be advising others how to improve their mail order business, or whether the applicant will be operating a mail order business himself, and if so, in what area. Conceivably, the area could be one which overlaps with the opponent, such as the provision of pizzas by the mail. A consideration of the nature of the trade is also difficult given the many possibilities posed by the applicant's description of services.

With regard to the degree of resemblance between the marks in appearance, sound or in the ideas suggested by them, the marks are practically identical except for the hyphen used in the applicant's mark which does nothing to distinguish it.

Therefore, given the fact that the marks are almost identical, and the applicant's services are worded in such a way that the applicant could operate a mail order or direct marketing business in any area including one which might be directly related to the opponent's wares and services, and given the fact that the opponent has already made use of its mark whereas the applicant's is based on proposed use, I find that the applicant has not met the onus of proving that there is no reasonable likelihood of confusion between its mark and the opponent's and I therefore refuse the application in relation to services on the basis that the mark is not registrable pursuant to the provisions of section 12(1)(d) of the Act.

Having been delegated by the Registrar of Trade-marks pursuant to section 63(3) of the Act, I therefore find that the opposition is successful and the application is refused in

accordance with section 38(8) of the Act.

DATED AT HULL, QUEBEC, THIS 24th DAY OF FEBRUARY, 1997.

S. Groom  
Trade-marks Opposition Board