

TRADUCTION/TRANSLATION

**IN THE MATTER OF THE OBJECTION by
McCain Foods Limited to the application for
registration no. 800,549
for the trade-mark NAPOLINA & Design
belonging to Les produits d'alimentation Bologna
cie ltée**

On January 17, 1996, Les produits d'alimentation Bologna cie ltée. ("the Applicant") filed an application for registration for the mark illustrated below bearing the number 800,549:



(hereinafter "the Mark") used in
Canada since at least as early as November 1994 in association with the following wares:

[Translation] Pasta products, pizza sauces, spaghetti sauces, tomato sauces; dried pastas, pastas and pasta crusts, stuffed, frozen, and in particular stuffed pasta products. ("Wares")

The application for registration was published in the Trade-Marks Journal, edition of April 2, 1997. McCain Foods Limited ("the Objector") filed a statement of objection on August 25, 1997, raising the following grounds:

- (a) pursuant to paragraph 38(2)(a) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (“the Act”), the application for registration does not comply with the provisions of paragraph 30(b) of the Act in that the Applicant, itself or its licensees, has not used the Mark in Canada since at least as early as November 1994;
- (b) pursuant to paragraph 38(2)(a) of the Act, the application for registration does not comply with the provisions of paragraph 30(i) of the Act in that the Applicant could not be and cannot be satisfied that it was entitled to use the Mark in Canada in association with the Wares;
- (c) pursuant to paragraph 38(2)(b) of the Act, the Mark is not registrable under the provisions of paragraph 12(1)(d) of the Act in that the Mark is confusing with the registered trade-marks belonging to the Objector, namely :

NAPOLI, application for registration no. 387,052

filed June 20, 1975, and registered October 1, 1976, in association with frozen pizzas

NAPOLI OLD ITALIAN application for registration no. 387,053

filed June 20, 1975, and registered August 25, 1978, in association with frozen pizzas;

- (d) pursuant to paragraph 38(2)(c) of the Act, the Applicant is not the person entitled to registration of the trade-mark in Canada under paragraph 16(1)(a) of the Act, in that as of the presumed date of first use alleged in the application for registration, November 1994, the Mark was confusing with the trade-marks hereinafter listed and used previously in Canada by the Objector in association with frozen pizzas and the said trade-marks had not been abandoned by the Objector as of the date of publication of the present application for registration, April 2, 1997:

NAPOLI OLD ITALIAN

NAPOLI

- (e) pursuant to paragraph 38(2)(d) of the Act, the Mark is not distinctive within the meaning of section 2 of the Act in that it does not distinguish or is not used to distinguish or not capable of distinguishing the wares of the Applicant described in the application for registration no. 800,549 from the wares of third parties and more particularly the wares in association with which the Objector’s marks are and have been used in Canada and more particularly the Objector’s family of

marks identified in subparagraph (c) above and including the Objector's trade-mark NAPOLI PIZZA POCKETS, registered August 21, 1997, under no. 481,105 in association with frozen bread stuffed with a pizza garnish (pizza ingredients).

The Applicant filed a counter-statement essentially denying the allegations contained in the Objector's statement. The latter filed the affidavit of Mark McCauley while the Applicant filed the affidavits of Régent Gaudreau, Pierre-Emmanuel Moyse and Isabella D'Ovidio.

Only the Applicant filed a written argument. It also requested a hearing, although the Objector gave notice of its intention not to participate in this phase albeit remaining interested in its objection. Accordingly, a hearing was scheduled for October 26, 2001, but had to be cancelled at the request of the Registrar. Meanwhile, on October 24, 2001, the Applicant's agents informed the Registrar that their retainer had been revoked by the Applicant. No other agent was designated to represent the Applicant.

A second hearing was then scheduled for May 27, 2003. The Objector's agents informed the Registrar of their intention to be present at this hearing. Noting subsequently that the Applicant was no longer represented by an agent, the Objector's agents notified the Registrar that they no longer intended to appear at the hearing. The hearing was therefore cancelled and the file was put on the list of files awaiting a decision.

Mr. McCauley has been Vice-president, Marketing, since June 1, 1998, with the McCain Foods (Canada) division of the Objector. Before that he was a sales representative with the company. He says he is familiar with the various aspects of the marketing, sale, distribution and advertising related to the frozen products sold by the Objector. Through his contacts in the industry and reading specialized magazines in the food industry, he regularly follows the activities of the company's competitors in Canada and the United States. Based on the Objector's archives, he claims he can state that since its formation in 1956, the Objector has become a multinational. A folder containing some documentation on the Objector's activities was produced as exhibit C. The probative value of the content of these publications is doubtful. And the relevance of these documents is more than debatable since none of the documents in this folder refers to the Objector's trade-marks cited in its statement of opposition and identified above.

The Objector and its subsidiaries produce french fries, vegetables, juice, pizza and products derived from potatoes. According to the affiant, the Objector is very well known in Canada and the world in the food industry. It is the major producer of french fries in Canada and one of the major producers in the world. He describes briefly the world-wide activities of the Objector. Apart from the production of pizzas, evidence that will be analyzed in greater detail later, it must be noted that these allegations bear little relevance to the grounds of opposition described in its statement of opposition.

Mr. McCauley produced as exhibit B to his affidavit a computerized copy of the certificates of registration no. 216,471 for the mark NAPOLI and 230,013 for the mark NAPOLI OLD ITALIAN. These documents show that the Objector would not have had to withdraw the word Napoli apart from the trade-mark taken as a whole.

A sample of cardboard packaging was filed as exhibits D-1 and D-2 for the frozen pizzas sold by the Objector under the trade-marks NAPOLI OLD ITALIAN and NAPOLI respectively. At paragraphs 14 and 15 of his affidavit, Mr. McCauley discloses the number of units of frozen pizzas bearing the marks NAPOLI OLD ITALIAN and NAPOLI sold between 1994 and 1999 (up to the approximate date of the affidavit, March 17, 1999) in each region of Canada.

Mr. McCauley states in paragraph 16 of his affidavit that during its fiscal year ending June 30, 1997, the Objector spent \$369,000 in advertising to promote the sale of its frozen pizzas and other frozen food products in Canada. However, he was unable to specify the sums spent for the promotion of the frozen pizzas bearing the trade-marks NAPOLI and NAPOLI OLD ITALIAN.

The affiant alleges that he has no knowledge of sales in Canada of products sold by the Applicant bearing the Mark or trade-mark NAPOLINA.

Finally, he argues that the NAPOLI mark is distinctive and is capable of distinguishing the Objector's products. Because of the association between the word Napoli and the Objector, he says, the consumer will confuse the food products sold in association with the Mark or the mark NAPOLINA with those sold by the Objector in association with the marks NAPOLI and NAPOLI OLD ITALIAN. In *Cadbury Schweppes Inc. v. Najm*, [*41 C.P.R. \(3d\) 122*](#) this kind of statement was declared inadmissible, as argument and self-serving evidence.

Mr. Régent Gaudreau describes himself as a computer technician employed by Robic, the firm acting as agents of the Applicant at the time of this affidavit. Using the 'CD-NameSearch' software designed by CDNameSearch Corp., he conducted a search of all the marks registered in Canada composed of the word 'Napoli'. This software reproduces the pages from the Trade Marks Register. The search he conducted was updated to October 1999. He identified 13 trade-marks incorporating the word 'Napoli' and filed as exhibit RG-1 a copy of the summary of this search and the full text for each of these marks. It should be noted that the Objector's three marks referred to above are included in the result of this search. However, there is no evidence in the record of any use of the marks appearing in this report other than the evidence of use of the marks NAPOLI and NAPOLI OLD ITALIAN filed by the Applicant and described above.

Mr. Pierre-Emmanuel Moyse describes himself as a student employed by the Robic firm. He briefly describes what is commonly referred to as the web in the field of informatics. He conducted a search on the web using the 'Alta Vista' search engine looking for sites referring to the word 'Napoli'. He filed as exhibit PEM-1 the result of this search. He states that he also consulted the tourist site of Italy and found some information concerning Napoli (Naples). He located a map of the south of Italy that identifies Naples (Napoli). He also found and filed some aerial photos of this region of Italy.

Ms. Isabella D'Ovidio has been employed by the Applicant since 1991 and was, as of the date of signature of her affidavit, October 19, 1999, the director of sales and exports with the Applicant. She had access to all the relevant documentation in the possession of the Applicant in relation to this file. She describes the Applicant's commercial activities as follows:

'preparation, distribution and sale of various food items including pasta, pizza sauce, spaghetti sauces, tomato sauce; dry pasta, pasta and pizza crust, quick-frozen stuffed foods, namely stuffed pasta'.

She filed as exhibit 1 a photocopy of a sample of packaging used by the Applicant since November 1994 in association with pizza crusts including pizza sauce. The Mark can be clearly seen on this sample. There is no evidence of use of the mark since the date of first use alleged by the Applicant concerning the other wares identified in the application for registration. Ms. D'Ovidio states that the Applicant's sales since 1995 to Price Costco of

wares bearing the Mark have never been less than \$300,000. She filed, as exhibit 2, two invoices to confirm the sale of wares bearing the Mark. The first invoice, to Club Price Canada Inc, dated September 29, 1994, makes no reference other than to some pizza crusts. The second invoice, sent to Price Costco, dated June 16, 1999, refers to the Mark in relation to some of the Wares. All of this evidence is uncontradicted by the Objector, either by cross-examination of the affiant or by the production of rebuttal evidence.

The burden of proof in objection proceedings can be summarized briefly as follows: the Objector must present sufficient evidence concerning the grounds of objection on which it is relying that it is apparent there are some facts that support the grounds of objection. Once this is done, the burden then shifts to the Applicant, who will have to convince the Registrar that the grounds of objection should not prevent the registration of its trade-mark (*Joseph Seagram & Sons Ltd. v. Seagram Real Estate Ltd. (1984), 3 C.P.R. (3d) 325*).

The relevant date for analyzing the various grounds of objection varies according to the particular ground that is raised. For example, the relevant date for grounds of objection based on paragraphs 30(b) and (i) of the Act is the date the application was filed (in this case, January 17, 1996) [see *Dic Dac Holdings (Canada) Ltd v. Yao Tsai Co. (1999), 1 C.P.R. (4th) 263*]. For a ground of objection based on paragraph 12(1)(d) of the Act, the relevant date is the date of the decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R. (3d) 413 (C.A.F.)*]. When the ground of objection is based on subsection 16(1) of the Act, the date of first use alleged in the Applicant's registration application is the date of reference as stipulated in that paragraph (in this case, November 30, 1994). Finally, the relevant date for analyzing the ground of objection based on the lack of distinctiveness of the Mark is generally held to be the date of filing of the objection (here, August 25, 1997). [See *Andres Wines Ltd. and E&J Gallo Winery (1975), 25 C.P.R. (2d) 126 (C.A.F.)* at page 130 and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd., op. cit.*]

The evidence contained in Mr. McCauley's affidavit in relation to the lack of use of the Mark after November 30, 1994, in association with the Wares, as alleged in the Applicant's registration application, is sufficient to reverse the burden of proof toward

the Applicant. The evidence contained in Ms. D'Ovidio's affidavit, described above, leads me to find that the Applicant has used the Mark since at least as early as November 1994 in association with pizza crusts and pizza sauces, but there is no evidence of use of the Mark in association with pasta products, spaghetti sauces, tomato sauces, dried pastas, pizza pastas and stuffed pastas. Consequently, I must allow this ground of objection in part and uphold the application for registration solely in regard to pizza crusts and pizza sauces, subject to my analysis of the other grounds of objection that will follow. [See *Produits Ménagers Coronet Inc. v. Coronet Werke Heinrich SCH*, 10 C.P.R. (3d) 482.]

The second ground of objection, based on paragraph 30(i) of the Act, that the Applicant could not be satisfied that it is entitled to use the trade-mark in Canada in association with the Wares, is closely linked to the issue of whether the Mark is confusing with the Objector's trade-marks. Indeed, I am unable, from the evidence on the record, to find that the Applicant is acting in bad faith, so success on this ground of Objection will depend on the analysis of the possibility of confusion between the Mark and the Objector's trade-marks. [See *Sapodilla Co. v. Bristol-Myers Co. (1974)*, 15 C.P.R. (2d) 152 at page 155.] To determine whether the Mark is capable of causing confusion with the Objector's trade-marks identified in its statement of objection, I must follow the procedure prescribed in section 6 of the Act, which reads as follows:

6. (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.
- (2) The 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.
- (3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured,

sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

- (4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.
- (5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including
 - (a) the inherent distinctiveness of the trade-marks or trade-names and the extent to which they have become known;
 - (b) the length of time the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them.

The burden of proof is on the Applicant, who must satisfy the Registrar that there is no reasonable possibility of confusion between the trade-marks of the parties, within the meaning of section 2 of the Act, on the relevant dates described above [see *Sunshine Biscuits Inc. v. Corporate Foods Ltd. (1982)*, 61 C.P.R. (2d) 53]. It is well established that the list of circumstances enumerated in subsection 6(5) of the Act is not exhaustive and that it not necessary to assign equal weight to each of these criteria (see, for example, *Clorox Co. v. Sears Canada Inc. (1992)*, 41 C.P.R. (3d) 483 (C.F. 1^{re} instance) and *Gainers Inc. v. Marchildon (1996)*, 66 C.P.R. (3d) 308 (C.F. 1^{re} instance)].

It is worth noting, before analyzing the question of confusion, the following passage taken from the judgment *Christian Dior, S.A. and Dion Neckwear Ltd., [2002] 3 C.F. 405*:

The Registrar must therefore be reasonably satisfied that, on a balance of probabilities, the registration is unlikely to create confusion; he need not be satisfied beyond doubt that confusion is unlikely. Should the “beyond doubt”

standard be applied, applicants would, in most cases, face an unsurmountable burden because certainty in matters of likelihood of confusion is a rare commodity. At best, it is only where the probabilities are equal that a form of doubt may be said to arise, which is to be resolved in favour of the opponent. But the concept of doubt is a treacherous and confusing one in civil proceedings and a registrar should avoid resorting to it.

- Distinctiveness

The evidence on file discloses that the word 'Napoli' is the name of a city situated in Italy, while 'Napolina' is a neologism. Moreover, the design portion adds to the inherent distinctiveness of the Mark.

The Objector's mark NAPOLI OLD ITALIAN includes the word 'Napoli' and the words 'old italian'. Overall, this mark is, to say the least, highly suggestive of the place of origin of the wares sold in association with this mark.

It goes without saying that a weak mark, like those of the Objector, will be much less protected than a mark including a new word. [See *Park Avenue, op. cit. and Laurentide Chemicals Inc. v. Les Marchands Deco Inc. et al. (1985), 7 C.P.R. (3d) 357.*]

- Period of use of the marks

Mr. McCauley states in his affidavit that the Objector has used the marks NAPOLI and NAPOLI OLD ITALIAN for a number of years without specifying a precise date for the commencement of the use of these marks. The only evidence in the record comes down to the sales figures for units of frozen pizza sold by the Objector that have had the said trade-marks since 1994. Ms. D'Ovidio states in her affidavit that the Applicant began using the Mark in November 1994, and says the annual sales figures of products bearing the Mark have never been less than \$300,000. Apart from these statements on either side, there is no evidence on file of continued use of the Objector's marks and the Applicant's Mark since 1994. Assuming that the evidence on the record is sufficient to determine which of the parties is favoured by this criterion, there is a slight advantage in favour of the Objector.

- Nature of wares

The evidence described above indicates that the Applicant's Wares are similar in nature to the products sold by the Objector in association with the trade-marks NAPOLI and NAPOLI OLD ITALIAN.

- Nature of the trade

Although the evidence placed on file by the Objector is fairly perfunctory, it is sufficient to find that the Applicant's trade is similar in nature to that of the Objector, albeit of lesser scope.

- Degree of resemblance between the trade-marks

The Applicant's Mark is distinguished from the Objector's trade-marks in that it includes a design. The marks must be analyzed as a whole and not by dissecting them to find similarities or differences. The test remains that of the average consumer with imperfect recollection [*Canadian Schenley Distilleries Ltd. v. Canada's Manitoba Distillery Ltd. (1975), 25 C.P.R. (2d) 1*]. Applying this test, I find that there is no resemblance between the Mark and those of the Objector.

The Objector presented some evidence to reflect, as a further factor, the notoriety of its undertaking. The notoriety of a company should not be confused with that of its marks. There is not enough evidence on file to allow me to find that the trade-marks NAPOLI and NAPOLI OLD ITALIAN are notorious.

The Applicant has discharged its burden of proof and satisfied me on a balance of probabilities that there is no reasonable possibility of confusion between the Mark and the trade-marks identified in the Objector's statement of objection. The Mark is therefore distinctive within the meaning of section 2 of the Act. The Applicant is therefore entitled to obtain registration of the Mark in association with pizza crusts and pizza sauces. I therefore dismiss the grounds of objection b, c, d and e described above.

Under the powers delegated to me by the Registrar of Trade-marks pursuant to subsection 63(3) of the Act, I dismiss in part the Objection of the Objector and I therefore uphold the application for registration of the Applicant's Mark, solely in relation to pizza crusts and pizza sauces, in accordance with the provisions of subsection 38(8) of the Act.

DATED AT MONTRÉAL, THE 3rd DAY OF NOVEMBER 2003.

Jean Carrière
Objections Commissioner