

**IN THE MATTER OF AN OPPOSITION
by Consorzio Del Prosciutto Di Parma to
application No. 783,309 for the trade-mark
ITALEANA filed by Principal Marques Inc.**

On May 24, 1995, the applicant, Principal Marques Inc., filed an application to register the trade-mark ITALEANA based on proposed use in Canada with the following wares:

food products, namely pâté, roast beef, corned beef, smoked beef, pastrami, ham, bacon, sausage, Italian sausage, wieners, salami, pepperoni, sliced pepperoni, processed meats, smoked meats, cooked meats, pickled meats, cured meats, processed meats packaged in boilable plastic pouches, prepackaged delicatessen style meats, sliced processed meats, luncheon meats, prosciutto, bologna; cheese.

The application was advertised for opposition purposes on March 20, 1996.

The opponent, Consorzio Del Prosciutto Di Parma, filed a statement of opposition on August 20, 1996, a copy of which was forwarded to the applicant on August 28, 1996. The first ground of opposition is that the applicant's application does not conform to the requirements of Section 30(e) of the Trade-marks Act because the applicant did not have a genuine intention to use the applied for trade-mark. The opponent alleges that the application was made for the purposes of trafficking in trade-marks.

The second ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(b) of the Act because it is clearly descriptive or deceptively misdescriptive of the place of origin of the applied for wares. The opponent alleges that the trade-mark ITALEANA is a misspelling of the word "italiana" which is commonly recognized in the English and French languages as meaning "Italian."

The third ground of opposition is also based on Section 12(1)(b) of the Act. The opponent alleges that the applied for mark is "...phonetically the equivalent of the pidgin English 'EAT-A-LEAN-A' i.e. 'eat a leaner' form of prosciutto or pastrami etc." The opponent alleges that the applied for mark is therefore clearly descriptive of food products that are leaner or less fatty than the norm or it is deceptively misdescriptive of food products that do not have that characteristic.

The fourth 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 registered trade-marks:

<u>Registration No.</u>	<u>Trade-mark</u>	<u>Owner</u>	<u>Wares</u>
287,747	CORDON ITALIENNE	J.M. Schneider Inc.	frozen breaded veal and frozen breaded chicken
456,276	CUISINE ITALIENNE DE CAMPBELL	Campbell Soup Co.	entrees or side-dishes consisting primarily of meats or pastas or vegetables
TMDA37536	ITALIANA	Nabisco Ltd.	coffee
324,890	ITALIANO Design	Chr. Hansen Ltd.	bacterial cultures sold to cheese manufacturers etc.
386,433	ITALINI	McLane Company, Inc.	pizza
359,573	LA BELLE ITALIENNE	Creme Glacee Ital Gelati Inc.	dairy products and bakery products
418,605	MAGIE ITALIENNE	Loblaws Inc.	sauces

The applicant filed and served a counter statement. As its evidence, the opponent submitted an affidavit of Federico Soda. As its evidence, the applicant submitted an affidavit of Alan J. Booth. Only the applicant filed a written argument and no oral hearing was conducted.

As for the first ground of opposition, the legal burden is on the applicant to show that its application conforms to the requirements of Section 30(e) of the Act. However, there is an initial evidential burden on the opponent to adduce evidence in support of its allegations of fact. The opponent failed to file evidence on point and thus the first ground is unsuccessful.

As for the opponent's second ground of opposition, the material time for considering the circumstances respecting the issue arising pursuant to Section 12(1)(b) of the Act is the date of my decision: see the decision in Lubrication Engineers, Inc. v. The Canadian Council of Professional Engineers (1992), 41 C.P.R.(3d) 243 (F.C.A.). Furthermore, the issue is to be

determined from the point of view of an everyday user of the wares. Finally, the trade-mark in question must not be carefully analyzed and dissected into its component parts but rather must be considered in its entirety and as a matter of first impression: see Wool Bureau of Canada Ltd. v. Registrar of Trade Marks (1978), 40 C.P.R.(2d) 25 at 27-28 and Atlantic Promotions Inc. v. Registrar of Trade Marks (1984), 2 C.P.R.(3d) 183 at 186.

In his affidavit, Mr. Soda states that he is an articling student with the firm acting as the opponent's trade-mark agent. He states that he is fluent in the Italian language and that the word ITALEANA closely resembles the Italian word "italiana" which is the feminine form of the word Italian in English. He further states that ITALEANA suggests that what is being described is Italian or has Italian characteristics. Finally, he states that, according to the 1991 Canada Census, there are 701,910 Canadians who have a knowledge of the Italian language.

The Soda affidavit is insufficient to satisfy the opponent's evidential burden respecting the second ground. Section 12(1)(b) of the Act precludes the registration of a mark which is clearly descriptive or deceptively misdescriptive in the English or French language only. Mr. Soda does not identify ITALEANA as an English or French word. He does not even identify it as an Italian word. The most that he can say is that it resembles the Italian word "italiana." That fact, however, does not bring the applicant's mark within the prohibition set out in Section 12(1)(b).

At most, the applicant's mark suggests that the applied for wares are Italian-style or Italian in origin. Mr. Soda himself recognizes this fact when he states that ITALEANA suggests, rather than describes, an associated person or thing as being Italian or having Italian characteristics. Thus, the second ground of opposition is also unsuccessful.

As for the third ground of opposition, it, too, is based on Section 12(1)(b) of the Act. However, the opponent has failed to file any evidence in support of its allegations of fact for this ground. Thus, it is also unsuccessful.

As for the fourth 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 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.

The first registered mark relied on by the opponent is CORDON ITALIENNE. As for Section 6(5)(a) of the Act, CORDON ITALIENNE suggests that the wares “frozen breaded veal and frozen breaded chicken” are Italian cuisine. The mark is also somewhat laudatory since it suggests that the wares are award winners. Thus, it is inherently weak. Since there is no evidence of use, I must conclude that the registered mark has not become known at all in Canada.

As previously discussed, the applicant’s mark is suggestive of Italian characteristics or Italian origin in relation to the applied for wares and is therefore also inherently weak. There being no evidence of use, I must conclude that it, too, has not become known at all in Canada.

The length of time the marks have been in use is not a relevant circumstance in the present case. The applicant’s wares comprise cheese and various types of meats. The registered wares are frozen breaded veal and chicken. Thus, although the wares at issue are not the same, they are similar in that they are all food products. Presumably the trades of the parties could overlap.

As for Section 6(5)(e) of the Act, there is a fair degree of resemblance in all respects between the two marks. The second component of the registered mark is ITALIENNE and the applicant’s mark is suggestive of things Italian. However, no one trader should be entitled to a monopoly of that concept, particularly in the food industry.

As an additional surrounding circumstance, the applicant has relied on the state of the register as evidenced by the Booth affidavit. State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace: see the opposition decision in Ports International Ltd. v. Dunlop Ltd. (1992), 41 C.P.R.(3d) 432 and the decision in Del Monte Corporation v. Welch Foods Inc. (1992), 44 C.P.R.(3d) 205 (F.C.T.D.). Also of note is the decision in Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd. (1992), 43 C.P.R.(3d) 349 (F.C.A.) which is support for the proposition that inferences about the state of the marketplace can only be drawn from state of the register evidence where large numbers of relevant registrations are located.

In his affidavit, Mr. Booth identifies himself as a trade-mark searcher and states that he conducted a search of the Canadian trade-marks register to locate marks which include the element ITAL (except those that include the word ITALY) and are registered for food products. Mr. Booth located more than 100 such registrations including the seven third party registrations relied on by the opponent in its statement of opposition. Thus, I am able to conclude that a number of those registered marks are in active use and that it is common for traders in the food industry to adopt and use trade-marks comprising or including such words as ITALIAN, ITALIA, ITALIEN and ITALIENNE. It therefore follows that consumers are used to seeing such words used as components of food marks and would therefore be more likely to distinguish such marks on the basis of their other components or their differences. Given the number of such marks in use, it also follows that small differences between such marks will likely serve to distinguish them.

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 inherent weakness of the marks at issue and the common use of similar marks in the marketplace, I find that the applicant has satisfied the onus on it to show that its applied for mark is not confusing with the registered mark CORDON ITALIENNE.

Similar conclusions apply with respect to the issue of confusion between the applicant's mark and each of the six remaining registered marks relied on by the opponent. In those instances where the degree of resemblance between the marks at issue might be slightly greater, the wares at issue are less similar. Thus, I find that the applicant's mark is also not confusing with any of the additional registered marks relied on. The fourth ground of opposition 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 25th DAY OF NOVEMBER, 1998.

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