IN THE MATTER OF AN OPPOSITION by Pizza Delight Corporation Ltd. - La Corporation Pizza Delight Ltee to application No. 644,015 for the trade-mark PIZZA ONE STOP SUBS & Design filed by Mary Anne Weisheit trading as One Stop Pizza

On November 3, 1989, the applicant, Mary Anne Weisheit trading as One Stop Pizza, filed an application to register the trade-mark PIZZA ONE STOP SUBS & Design (illustrated below) for "pizza and subs" and for "operation of restaurant and take out delivery service" based on use in Canada since 1985. The application was amended to include a disclaimer to the words PIZZA and SUBS and was subsequently advertised for opposition purposes on October 2, 1991.

The opponent, Pizza Delight Corporation Ltd. - La Corporation Pizza Delight Ltee, filed a statement of opposition on February 3, 1992, a copy of which was forwarded to the applicant on March 20, 1992. The first ground of opposition is that the applied for trade-mark is not registrable pursuant to Section 12(1)(d) of the Trade-marks Act because it is confusing with the following registered trade-marks:

Trade-mark	Reg. No.	Wares/Services
	268,436	(1) pizza; sandwiches; donairs (2) pizza on bread; lasagna and spaghetti and steak restaurant services
	240,828	pizzas, pizza ingredients, spaghetti sauce, sandwiches and paper containers and promotional printed matter pertaining to take-out food services and to restaurant services restaurant services, namely the providing of food and beverages for consumption on the premises for take-out and by home delivery
STOP ONE	190,146	restaurant services

The first two registrations stand in the name of the opponent and the third registration is owned by Shato Holdings Ltd.

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to Section 16(1) of the Act because, as of the applicant's claimed date of first use, the applied for trade-mark was confusing with the opponent's two registered trade-marks previously used in Canada by the opponent in association with "restaurant services, food takeout and delivery services" and with "food products including pizza pies." The third ground is that the applicant's application does not comply with the provisions of Section 30(b)

of the Act because the applicant did not use the applied for mark since 1985 as claimed. The fourth ground is that the applied for mark is not distinctive because it is confusing with the opponent's trade-marks.

The applicant filed and served a counter statement. As its evidence, the opponent filed the affidavits of Tracey Orr and Bernard Imbeault. The applicant did not file evidence. Only the applicant filed a written argument and no oral hearing was conducted.

As a preliminary matter, the opponent objected to the applicant's counter statement because it did not deny the opponent's grounds of opposition and because it was not signed and filed by the applicant. I disagree with both of the opponent's contentions. Although the wording used by the applicant in her counter statement is not as direct and as clear as one might like, it does serve to deny the grounds of opposition by asserting that the marks at issue are not confusing and by reiterating her claim to have used the applied for mark since 1985. As for the opponent's second contention, the heading of the counter statement refers to the applicant as Mary Anne Weisheit trading as One Stop Pizza and the document is signed by the applicant herself. To the extent that there are references in the counter statement to the words One Stop Pizza alone, it is apparent that those references are to the applicant's trading style which is simply a shorthand reference to the applicant herself.

As for the first ground of opposition, the material time for considering the circumstances respecting the issue of confusion arising pursuant to Section 12(1)(d) of the Act 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.

The more relevant of the opponent's two registered trade-marks is registration No.

240,828 for the trade-mark PIZZA DELIGHT & Design. Thus, a consideration of the issue of confusion between that mark and the applicant's mark will effectively decide the first two bases of the first ground of opposition. The applicant's mark is inherently weak, the words PIZZA and SUBS having been disclaimed and the mark as a whole suggesting that the applicant's restaurant is a convenient "one-stop" location for obtaining both pizzas and subs. There being no evidence from the applicant, I must conclude that her mark has not become known at all in Canada.

The opponent's mark, too, is inherently weak since the words PIZZA DELIGHT are highly suggestive of the opponent's wares and services. However, the Imbreault affidavit establishes that the opponent's mark has been extensively used by its franchisees for a number of years in Ontario and Atlantic Canada. Thus, I am able to conclude that the opponent's mark has become known in those areas of the country.

The length of time the marks have been in use favors the opponent. The wares, services and trades of the parties are essentially the same. As for Section 6(5)(e) of the Act, I consider that there is a relatively low degree of resemblance between the marks at issue. The only phonetic resemblance between the marks is with respect to the non-distinctive word PIZZA which has been disclaimed by both parties.

When viewed, the background of the applicant's mark is an octagonal design in the form of a stop sign, presumably adopted to complement the words ONE STOP that appear in the mark. The design portion of the opponent's mark comprises two trapezoids arranged to form an overall octagonal shape. Thus, there is some resemblance in the design portions of the two marks. However, that resemblance is of limited significance since the words in each mark comprise the dominant feature. The design component in each mark is only a secondary feature at best. In fact, it is doubtful that consumers would view the use of the opponent's mark PIZZA DELIGHT & Design as also constituting use of the design mark registered under No. 268,436 as a separate and distinct mark. The degree of resemblance in the ideas suggested by the two marks is basically limited to the word PIZZA which cannot be monopolized by any

one trader in the restaurant business.

As an additional surrounding circumstance, I have considered the fact that the Imbeault affidavit evidences some examples of use of the opponent's registered mark in advertising flyers where the registered mark is encompassed by a lined octagonal border as shown below.

The use of the opponent's registered mark in this fashion increases the degree of resemblance with the applicant's mark. However, in paragraph 5 of his affidavit, Mr. Imbeault states that there have been some variations respecting the form in which the opponent's mark has been used over the years. The representative materials appended as Exhibit A to his affidavit which include the above-illustrated version of the opponent's mark appear to be fairly recent advertising flyers. In the absence of additional evidence on point, it is difficult to determine the extent to which this more recent version of the mark has been used and the extent to which consumers have been exposed to it. In any event, even if there has been extensive use of the opponent's mark with the new octagonal border, the degree of resemblance between that form of the mark and the applicant's mark is not significant. Even with the inclusion of the lined octagonal border, the opponent's mark does not readily suggest a stop sign as does the applicant's mark. In any event, as previously noted, the two marks are dominated by the word portions which are readily distinguishable.

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 low degree of resemblance between the marks at issue, I find that the applicant's mark is not confusing with the opponent's registered mark PIZZA DELIGHT & Design. Thus, the first two heads of the first ground of opposition are unsuccessful.

As for the third head of the first ground, the registered mark STOP ONE is perhaps somewhat laudatory of the registrant's restaurant services as being the first or best place to stop to eat. Thus, although that mark is inherently distinctive, it is not inherently strong. There being no evidence on point, I must conclude that the mark STOP ONE has not become known at all in Canada. In the absence of evidence on point, the length of time the marks have been in use does not favor either party. The services and trades of the parties are the same. As for Section 6(5)(e) of the Act, there is only a slight degree of resemblance between the mark STOP ONE and the applicant's mark PIZZA ONE STOP SUBS & Design. Although both marks contain the words "stop" and "one", they appear in a different order in each mark thereby imparting different visual, phonetic and conceptual impressions to the average consumer. Thus, as a matter of first impression and imperfect recollection and considering the low degree of resemblance between the two marks, I find that the applicant's mark is not confusing with the registered mark STOP ONE. Thus, the third head of the first ground of opposition is also unsuccessful.

As for the second ground of opposition, the opponent has met its initial evidential burden of showing use of its trade-mark PIZZA DELIGHT & Design prior to the applicant's claimed date of first use and non-abandonment of that mark as of the applicant's advertisement date. However, the opponent failed to show any use of its other registered mark by itself. Presumably, the opponent is of the view that use of its registered mark PIZZA DELIGHT & Design also constitutes use of the other registered design mark. However, as noted above, I doubt that consumers viewing the former mark would perceive its design component as being used as a separate trade-mark. Thus, use of the former mark does not constitute use of the included design as a trade-mark: see the decision in Nightingale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538 (T.M.O.B.).

In view of the above, the second ground remains to be decided on the issue of confusion between the applicant's mark and the opponent's mark PIZZA DELIGHT & Design as of the applicant's claimed date of first use which must be taken to be December 31, 1995. The opponent's case is, if anything, weaker than it was respecting its first ground since the acquired reputation for its mark was much less as of that earlier date. Thus, I find that the second ground is also unsuccessful.

As noted above, the opponent's registered trade-mark PIZZA DELIGHT & Design has more recently been used in a slightly different form where it appears within a lined octagonal border. However, the opponent failed to evidence any use of that mark prior to the applicant's claimed date of first use. More importantly, the opponent did not include any grounds of opposition based on prior use of that mark and I am precluded from considering unpleaded grounds: see Imperial Developments Ltd. v. Imperial Oil Ltd. (1984), 79 C.P.R.(2d) 12 at 21 (F.C.T.D.).

As for the opponent's third 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. Since the opponent has filed no evidence on point, the third ground is also unsuccessful.

The fourth ground of opposition is that the applicant's mark is not distinctive. It, too, turns on the issue of confusion between the applicant's mark and the opponent's mark PIZZA DELIGHT & Design although the material time for assessing the circumstances is the filing of the opposition. My conclusions respecting the first ground of opposition are equally

applicable respecting this ground and it, too, is therefore unsuccessful.

In view of the above, I reject the opponent's opposition.

DATED AT HULL, QUEBEC, THIS 31st DAY OF MARCH, 1995.

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