

**IN THE MATTER OF AN OPPOSITION  
by Les Fromages Saputo s.e.n.c. / Saputo  
Cheese G.P. to application No. 1170350 for  
the trade-mark SAVUTO filed by Frank  
Marrello**

---

On March 12, 2003, Frank Marrello (the “Applicant”) filed an application for the registration of the trade-mark SAVUTO (the “Mark”) based on use of the Mark in Canada since November 1, 1978 in association with the following services: “Operation of a club, association, and restaurant including take-out services and off-premise catering services” (the “Services”).

The application was advertised for opposition purposes in the Trade-marks Journal issue of July 7, 2004.

On November 25, 2004, Les Fromages Saputo s.e.n.c. / Saputo Cheese G.P. (the “Opponent”) filed a statement of opposition against the application. The grounds of opposition can be summarized as follows:

1. The application does not comply with the requirements of s. 30(b) of the *Trade-marks Act* (R.S.C. 1985, c. T-13, as amended) (the “Act”), as the Applicant has not used the Mark in Canada in association with the Services since the claimed date of first use of the Mark;
2. The application does not comply with the requirements of s. 30(i) of the Act in that the Applicant could not have been satisfied that it was entitled to use the Mark in Canada having regard to the allegations contained in the statement of opposition;
3. The Mark is not registrable pursuant to s. 12(1)(d) of the Act because it is confusing with the registered trade-marks of the Opponent listed in Schedule “A” attached hereto to my decision;
4. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(a) of the Act in that as of the filing date of the application, the Mark was confusing with the Opponent’s trade-mark SAPUTO which has been previously used in Canada by the

Opponent or its predecessors in title in association with food products including cheeses and other dairy products since at least as early as July 1959 and in association with wares sold to restaurants and pizzerias for the preparation of prepared food since at least as early as 1980;

5. The Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(c) of the Act in that as of the filing date of the application, the Mark was confusing with the Opponent's trade-name Giuseppe Saputo & Figli Limitée, now Les Fromages Saputo Limitée;
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 Services of the Applicant having regard to the Opponent's use of the trade-marks and trade-names referred to hereinabove;
7. The Opponent further specifies that it has always used and never abandoned the aforementioned trade-marks and trade-names.

By counter statement dated April 25, 2005, the Applicant denied each and every one of the allegations made in the statement of opposition.

In support of its opposition, the Opponent filed the solemn declaration of David Lynn (who identifies himself as Senior Vice-President of Marketing of the Opponent). In support of its application, the Applicant filed an affidavit sworn by himself, wherein he identifies himself as the owner of "Savuto's", an Italian restaurant, as discussed below.

Only the Opponent filed a written argument. Only the Opponent requested and attended at an oral hearing.

### Onus

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. The presence of a legal onus on the Applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be resolved against the Applicant [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.)].

### Section 30(b) ground of opposition

As indicated above, the Opponent contends that the application does not comply with the requirements of s. 30(b) of the Act, as the Applicant has not used the Mark in Canada in association with the Services since the claimed date of first use of the Mark.

The relevant date for considering the circumstances in regard to this ground of opposition is 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.)]. The Opponent may meet its burden by reference to the Applicant's evidence, provided that the Applicant's evidence is clearly inconsistent with the claims set forth in its application [see *Labatt Brewing Co. v. Molson Breweries, A Partnership* (1996), 68 C.P.R. (3d) 216 (F.C.T.D.)]. The Opponent's evidential burden is lighter respecting the issue of non-conformance with s. 30(b) of the Act, because such facts are more readily available to the Applicant than to the Opponent [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd.* (1986), 10 C.P.R. (3d) 84 (T.M.O.B.)].

The Opponent's evidence concerning this ground of opposition consists of the following statement made at paragraph 34 of David Lynn's solemn declaration:

*“For the preparation of this SOLEMN DECLARATION, I have tried to find the Applicant's business on the Internet Using the Internet Search Tool at <http://Canada411.pagesjaunes.ca> I could not find the Applicant's Business by using the keyword “SAVUTO”. However, the search tool suggested to me to use the key word “SAPUTO”, which I did. Now shown to me and marked as Exhibit “J” to this my Solemn Declaration is the printout of the search results.”*

The remaining paragraphs of David Lynn's solemn declaration address, quite extensively, the

issues of use and first use of the SAPUTO trade-marks and trade-names by the Opponent or its predecessors in title in Canada.

The Applicant's evidence, which consists of the Applicant's affidavit, addresses the questions of use and first use of the Mark by the Applicant as follows:

1. *I am the owner of Savuto's, an Italian restaurant which I founded with my brother Sesto Marrello (sic) in Ottawa.*
2. *That from November 1, 1978 we operated a restaurant named SAVUTO'S at 705 Gladstone Avenue, Ottawa, Ontario serving fine Italian cuisine and wines.*
3. *Attached as EXHIBIT "A" is a copy of page 52 from The Ottawa Citizen dated January 21, 1983 showing our advertisement for the restaurant. The advertisement was reproduced from a review which first appeared in The Ottawa Citizen on June 5, 1981.*
4. *Attached as EXHIBIT "B" is a copy of the building plans for an addition to our restaurant dated June 1980 and July 1980.*
5. *Attached as EXHIBIT "C" is a copy of a print-out (sic) from the Canadian Trade Marks (sic) Office database showing my original trade mark (sic) registration for the mark SAVUTO which was filed on December 12, 1980 and registered on May 22, 1981. The trade mark (sic) registration inadvertently lapsed due to my failure to respond to the renewal notice which was sent on June 22, 1996.*
6. *After about five years, my brother left the business and I carried on business in my own name.*
7. *On March 12, 2003, I re-filed the present application for the trade mark (sic) SAVUTO.*

I wish to add that the above quotation reproduces the entirety of the Applicant's evidence. Commenting on the Marrello affidavit, I find that it raises more questions than it provides evidence of use of the Mark. The Applicant's evidence of use of the Mark is tenuous and vague in that:

- As I read the statements made in paragraphs 1, 2 and 6, from 1978 until approximately 1983, the SAVUTO Mark was owned by the Applicant, Frank Marrello, and his brother Sesto Marrello. I note that the printout attached as Exhibit "C" identifies "FRANK MARRELLO and SESTO MARRELLO trading as SAVUTO RESTAURANT" as the registrant and owner of the SAVUTO Mark.
- The sole and only evidence of use of the Mark consists in Exhibit "A", that is an advertisement for the restaurant SAVUTO that ran on January 21, 1983. Indeed, the building plans attached as Exhibit "B" do not constitute proper evidence of use of the

Mark;

- The Applicant's statements of use and evidence of use are totally silent as to the "take-out services" and "off-premise catering services" claimed in the application. The same comment applies to the services described as "Operation of a club, association";
- The Applicant's statements of use and evidence of use do not make it clear that there has been continuous use of the applied for Mark in the normal course of trade to the date of filing of the application. It is noteworthy that the Applicant has elected not to file any kind of evidence of contemporary use of the Mark – while not particularly compelling, the fact that the Opponent could not find the Applicant's business on the Internet as indicated above further renders such lack of evidence of use questionable; and
- While the Applicant states in paragraph 6 that after about five (5) years, his brother left the business and that he carried on business in his own name, the affidavit is silent as to any kind of assignment of trade-mark rights unto the Applicant. I also note that the Applicant did not rely upon a predecessor in title in his application even though his sworn statements and its earlier trade-mark registration indicate that the Mark was first used by a partnership.

In view of all of the foregoing, the Opponent has satisfied the evidential burden on it to establish that the application does not conform to s. 30(b) of the Act since there is no clear evidence of use of the Mark by the Applicant in association with the Services as claimed in the application. The Applicant having failed to establish on the balance of probabilities that its application complies with s. 30(b) of the Act, the s. 30(b) ground of opposition therefore succeeds.

#### Remaining grounds of opposition

In view of the foregoing, and keeping in mind that the Applicant's participation in this proceeding has been minimal, it is unnecessary to consider 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 22th DAY OF January 2009.

Annie Robitaille  
Member  
Trade-marks Opposition Board

Schedule "A"

<b>Trade-mark</b>	<b>Reg. No / Reg. Date</b>
SAPUTO & DESIGN	TMA301,512 / April 4, 1985
SAPUTO	TMA322,426 / January 2, 1987
SAPUTO & DESIGN	TMA401,432 / August 14, 1992 (I note that this registration was expunged on March 27, 2008 for failure to renew)
SAPUTO & DESIGN	TMA401,431 / August 14, 1992 (I note that this registration was expunged on March 27, 2008 for failure to renew)
SAPUTO & DESIGN (CIRCLE)	TMA427,645 / May 20, 1994
SAPUTO & DESSIN (RECTANGLE)	TMA427,646 / May 20, 1994
SAPUTO AU GRATIN	TMA490,921 / March 5, 1998
SAPUTO LE CHOIX DES PIZZERIAS & DESIGN	TMA527,598 / May 11, 2000
SAPUTO ONE STOP PIZZA SHOP & DESIGN	TMA536,978 / November 9, 2000
SAPUTO FRIGO	TMA546,695 / June 18, 2001
SAPUTO (DESIGN)	TMA601,364 / February 4, 2004
SAPUTO INGREDIENTS	TMA603,831 / March 2, 2004
SAPUTO (ELLIPSE DESIGN)	TMA604,108 / March 4, 2004