

**IN THE MATTER OF AN OPPOSITION by
Multi-Marques Inc. to application No. 1,157,992
for the trade-mark NAT'S NEW YORK
PIZZERIA & Design in the name Nat's Ah Pizza
Ltd. trading as Nat's New York Pizzeria.**

[1] On November 1, 2002, Nat's New York Pizzeria filed an application to register the trade-mark NAT'S NEW YORK PIZZERIA & Design (the Mark) as reproduced below:



based on use in Canada since April 15, 1992 in association with the wares: *pizza, sandwiches, salads, soup, garlic bread, meatballs and pasta; namely spaghetti, lasagna and penne* and in association with the services *restaurant services, take out services and delivery services*.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 3, 2003.

[3] On April 30, 2004, Multi-Marques Inc. (the Opponent) filed a statement of opposition against the application setting out grounds based on s. 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act).

[4] An amended application was filed on July 15, 2004 seeking to change the name of the Applicant from *Nat's New York Pizzeria* to *Nat's Ah Pizza Ltd. trading as Nat's New York Pizzeria*. It appears that this request to amend was inadvertently never resolved; I will therefore now confirm that such amendment has been accepted on behalf of the Registrar and is hereby made of record. Accordingly, *Nat's Ah Pizza Ltd. trading as Nat's New York Pizzeria* will hereafter be referred to as the "Applicant".

[5] The Applicant filed and served a counter statement generally denying the allegations

against it.

[6] The Opponent filed as its evidence the affidavit of Jean-Pierre Galardo sworn April 14, 2005 together with Exhibits JPG-1 through JPG-4. Mr. Galardo is the Opponent's director of marketing and his testimony serves to introduce into evidence use of the Opponent's registered trade-marks.

[7] As its evidence the Applicant filed the affidavit of Natalino Bastone, sworn on October 5, 2005 appending Exhibits NB-1 through NB-9. Mr. Bastone was cross-examined on his affidavit, the transcript of which forms part of the record. Mr. Bastone is the Applicant's president, and his testimony serves to introduce into evidence use of the Mark in association with the applied-for wares and services.

[8] The Opponent did not file reply evidence. Only the Opponent filed a written argument, and only the Applicant requested and was present at a hearing.

Grounds of Opposition

[9] The grounds of opposition may be summarized as follows: the Applicant's application does not conform to the requirements of s. 30(b) and s. 30(i) of the Act, the Applicant is not the person entitled to registration of the Mark pursuant to s. 16(1)(b), the Mark is not registrable pursuant to s. 12(1)(d), and the Mark is not distinctive.

[10] Except for the first ground, each of the remaining grounds of opposition is based on confusion with the Opponent's registered trade-marks NEW YORK NEW YORK (registration No. TMA518,030) and NEW YORK NEW YORK Design (registration No. TMA540,596).

Decision

[11] Upon careful consideration of the evidence of record and of the representations of the Opponent and of the Applicant, I hereby reject the opposition pursuant to s. 38(8) of the Act, for the reasons detailed below.

Onus and Material Dates

[12] 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 [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.) at 298; *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

[13] The material dates that apply to the grounds of opposition are as follows:

- s. 30(b) s. 30(i) - 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.) at 475];
- s. 16(1) - the date of first use [see s. 16(1)];
- s. 12(1)(d) - the date of my decision [see *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks* (1991), 37 C.P.R. (3d) 413 (F.C.A.)];
- non-distinctiveness - the date of filing of the opposition [see *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)].

Ground of opposition based on s. 38(2)(a) and s. 30(b)

[14] The Opponent has pleaded that the Applicant has not used the Mark in association with the wares and services covered in the application. Alternatively, the Opponent alleges that even if the Mark has been used, it has not been used in association with each of the wares and services, nor has it been used continuously since the claimed date of first use namely April 15, 1992.

[15] The initial burden on an opponent is lighter respecting the issue of non-conformance with s. 30(b), because the facts regarding an applicant's first use are particularly within the knowledge of the applicant [see *Tune Masters v. Mr. P's Mastertune Ignition Services Ltd* (1986), 10 C.P.R (3d) 84 (T.M.O.B.)]. This burden may therefore be met by reference

not only to the Opponent's evidence but also to the Applicant's evidence [see *Labatt Brewing Co. v. Molson Breweries, a Partnership* (1996), 168 C.P.R. (3d) 216 (F.C.T.D)]. However, while an opponent may rely upon an applicant's evidence to meet its evidential burden in relation to this ground, the Opponent must show that the Applicant's evidence is "clearly inconsistent" with the Applicant's claim as set forth in its application.

[16] In the present case, I am not satisfied that the Opponent has met its initial burden. In this regard, the Opponent has not led any evidence that the Applicant has not used the Mark in association with the applied-for wares and services. Further, the Applicant's evidence is not clearly inconsistent with its claim to have used the Mark in Canada since April 15, 1992 in association with the applied-for wares and services.

[17] Accordingly, this ground of opposition is dismissed.

Ground of opposition based on s. 38(2)(a) and s. 30(i)

[18] Pursuant to s. 30(i), the Opponent alleges the Applicant could not have been satisfied as to its entitlement to use the Mark in Canada in association with the wares and services described in the application.

[19] I am of the opinion that where an applicant has provided the statement required by s. 30(i), a s. 30(i) ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [see *Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]. As this is not such a case, I am dismissing this ground of opposition.

Ground of opposition based on s. 38(2)(c) and s. 16 (1)(b)

[20] The Opponent alleges that the Applicant is not the person entitled to registration pursuant to s. 16(1)(b), because the Mark is confusing with the Opponent's previously filed applications for the trade-marks NEW YORK NEW YORK (application No. 869,536) and NEW YORK NEW YORK Design (application No. 869,537).

[21] The s. 16(1)(b) ground fails because the Opponent's applications were not filed prior to the Applicant's claimed date of first use, and furthermore, s. 16(4) requires that applications relied upon be pending as of the advertisement date of the opposed application. As each of the Opponent's marks was registered prior to December 3, 2003, there is no basis for the s. 16(1)(b) ground of opposition [see *Governor and Co. of Adventurers of England trading into Hudson's Bay, commonly called Hudson's Bay Co. v. Kmart Canada Ltd.* (1997), 76 C.P.R. (3d) 526 (T.M.O.B.) at 528].

Ground of opposition based on s. 38(2)(b) and s. 12(d)

[22] The Opponent alleges that the Mark is not registrable because it is confusing with its registered trade-marks:

NEW YORK NEW YORK
(registration No. TMA518,030)

covering:

(1) produits de boulangerie, nommément pain et petits pains. (2) Produits de boulangerie nommément biscuits, muffins anglais, tortillas, pitas, bagels, et brioches nommément cromptettes



(registration No. TMA540,596)

covering

(1) produits de boulangerie, nommément pain et petits pains. (2) Produits de boulangerie et de pâtisserie, nommément pain biologique, beignes, brioches, gâteaux, biscuits, galettes, pâtisseries, tartes, muffins, muffins anglais, croissants, pâte à pizza, tortillas, pitas, bagels, breadsticks et kaisers

[23] The Opponent did not file certified copies of its registrations. Nevertheless, I have exercised my discretion to verify the register and I confirm that the Opponent's registrations are in good standing as of today's date [see *Quaker Oats Co. of Canada*

Ltd./Cie Quaker Oats du Canada Ltée v. Menu Foods Ltd. (1986), 11 C.P.R. (3d) 410 (T.M.O.B.)]. Accordingly the Opponent's initial burden with respect to this ground has been met.

[24] The Applicant therefore has the legal onus of establishing on a balance of probabilities that its Mark is registrable and that there is no reasonable likelihood of confusion with the Opponent's registered trade-marks.

[25] The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in s. 6(2) of the Act, consideration is to be given to all of the surrounding circumstances including those specifically set forth in s. 6(5) of the Act namely: a) the inherent distinctiveness of the trade-marks and the extent to which they have become known; b) the length of time each has 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 in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

s. 6(5)(a) - inherent distinctiveness of the trade-marks and the extent to which each trade-mark has become known

[26] With respect to the Mark, although the Applicant has disclaimed the words NEW YORK and PIZZERIA as being clearly descriptive of the wares and services, I am of the view that the Mark in totality is somewhat distinctive owing to its design components and the name NAT'S, which as evidenced by the Applicant is a diminutive of Natalino, the owner's name.

[27] As for the Opponent's trade-marks, they consist of the duplication of the geographic name NEW YORK in block letters or stylised version, which in my view would be recognized by the average Canadian consumer as describing the internationally renowned city within the state sharing the same name. In this respect, geographic locations are not inherently distinctive and consequently do not deserve a wide ambit of protection [see *California Fashion Industries Inc. v. Reitmans (Canada) Ltd.* 38 C.P.R. (3d) 439].

[28] The strength of a trade-mark may be increased by means of it becoming known through promotion or use. The Applicant's evidence establishes use of the Mark in association with the applied-for wares and services since April, 1992. Sales figures have been provided showing a steady increase over the years from approximately \$140,000 in the first year of operation to over \$1,350,000 in 2005. The Applicant invests approximately \$2,500 yearly in publicity and marketing. On this basis, I find that the Mark has become known to a limited extent in Canada.

[29] The Opponent's affiant, Mr. Galardo, states that the Opponent's trade-marks have been used in Canada since May, 1997. He also provides a chart illustrating a steady increase in sales of its products between the years 1997 to 2005. The Opponent invests approximately \$100,000 per annum in the marketing of its products. Mr. Galardo further indicates that the Opponent's products are sold and distributed through various service sectors such as grocery stores, supermarkets, convenience stores as well as to restaurants, cafeterias and the like.

[30] Based on the foregoing information, I conclude that the Opponent's trade-marks have become known to a certain extent in Canada.

s. 6(5)(b) - the length of time each trade-mark has been in use

[31] The Applicant has used its Mark since April, 1992 whereas the Opponent commenced use in May, 1997.

s. 6(5)(c) and (d) - the nature of the wares, services or business; the nature of the trade

[32] When considering the wares, services and trades of the parties, it is the statement of wares or services in the parties' trade-mark application and registrations that govern in respect of the issue of confusion arising under s. 12(1)(d) [*Henkel Kommanditgesellschaft auf Aktien v. Super Dragon Import Export Inc.* (1986), 12 C.P.R. (3d) 110 (F.C.A.); *Mr. Submarine Ltd. v. Amandista Investments Ltd.* (1987), 19 C.P.R. (3d) 3 (F.C.A.); *Miss Universe Inc. v. Bohna* (1994), 58 C.P.R. (3d) 381 (F.C.A.)].

[33] Furthermore, when assessing the nature of the wares and services of the parties in this particular case, I find the decision in *Clorox Co. v. Sears Canada Inc.* (1992) 41 C.P.R. (3d) 483 (Fed. T.D.) particularly relevant. The Court considered the likelihood of confusion between the mark K.C. MASTERPIECE & Design for barbecue sauce with the registered mark MASTERPIECE for cakes and chocolates. In arriving at its conclusion that the marks were not confusing, the Court made the following comments which I consider applicable in this case:

[16] Firstly, it is admitted that the mark "Masterpiece" is a common dictionary word which should only be given a narrow measure of protection (...)

[18] Thirdly, if the mark "Masterpiece" itself is deserving of limited protection, the law is clear, on the strength of the *General Motors case* (op.cit.) that its user cannot be allowed unfairly to monopolize the word. "[C]omparatively small differences", the Court quoted in that case [at page 691], are deemed "sufficient to avoid confusion."

[19] Fourthly, I should observe that in my view, the "narrow protection" doctrine applies equally when dealing with the similarity of the wares test. It is quite true that fruitcake and barbecue sauce may be said to belong to the general category of foodstuffs, but the test cannot be applied on a black or white basis. One only needs to look at the thousands of different foods, meats, condiments, confectioneries, cereals and what-not found in some supermarkets to be wary of giving too much weight in some circumstances to the "same general class" test. Otherwise, in the case of a weak mark like "Masterpiece", the effect of the test standing alone would be to grant a monopoly over a particular dictionary word, a status which the courts have historically challenged.

[34] In the present case; the only items in the Applicant's statement of wares which I consider to overlap with the Opponent's wares are pizza and garlic bread. And although the remaining wares and services are related to the extent that they fall under the broad category of the food industry, the specific wares of the parties are significantly different. The Applicant's wares such as spaghetti, lasagna, sandwiches and soup can be categorized as meals, whereas the Opponent's remaining wares are either bakery products or pastries.

[35] Although there could be an overlap in the trades of the parties since the wares at issue could potentially all be sold through grocery stores, they would not likely be sold in the same sections of such stores.

s. 6(5)(e) - the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them

[36] The resemblance between the marks is often the most significant factor in determining the issue of confusion [see *Beverley Bedding & Upholstery Co. v. Regal Bedding & Upholstery Ltd.* (1980), 47 C.P.R. (2d) 145 (F.C.T.D.) at 149, affirmed 60 C.P.R. (2d) 70].

[37] The Opponent submits that the Mark has a high degree of resemblance with its registered marks because it encompasses the word NEW YORK.

[38] Although the word NEW YORK is common to the marks at issue, I am of the view that it is a weak element of the marks due to its descriptive nature, both in terms of geographical significance and in terms of the character of the wares, i.e. New York style pizza. In such cases, small differences in the marks will serve to distinguish them [see *General Motors Corp. v. Bellows* (1949) 10 C.P.R. 101 (S.C.C.)].

[39] Furthermore, the first word or syllable in a trade-mark is more important for the purposes of distinction than those that follow [see *Conde Nast Publications Inc. v. Union des Éditions Modernes* (1979) 46 C.P.R. (2d) 183 (F.C.T.D.)].

[40] In applying these principles to the facts, I am of the view that there is little resemblance between the marks in terms of appearance. The Mark's first component is NAT'S whereas the Opponent's is NEW YORK. Additionally, the Mark consists of several design components, such as the silhouette of the Statue of Liberty holding what appears to be a pizza pan, in the forefront of a city skyline, all of which are enclosed in an oblong frame.

[41] The marks would be sounded differently, Nat's New York Pizzeria vs. New York New York.

[42] The ideas suggested by the marks are dissimilar; on the one hand the Mark evokes the idea of a New York style Pizzeria owned by Nat, whereas the Opponent's marks convey a geographic name.

[43] The marks must be considered in their totality and it is the effect of the marks on the potential consumer that is to be considered. The combination of the elements which form the Mark, would in my view, create an impression in the mind of the consumer which would be different than the effect created simply by the words NEW YORK NEW YORK.

conclusion re likelihood of confusion

[44] The issue is whether a consumer who has a general and not precise recollection of the Opponent's trade-marks in association with the wares, will, upon seeing the Mark for similar wares and services, be likely to think that the wares or services are manufactured or sold, by the same person. I find that a consideration of all the surrounding circumstances leads me to conclude that, on a balance of probabilities, there is no reasonable likelihood of confusion between the marks.

[45] The s. 12(1)(d) ground is accordingly dismissed.

Distinctiveness ground of opposition

[46] The Opponent has pleaded that the Mark is not distinctive and is not capable of distinguishing the Applicant's wares and services from the wares and services of others.

[47] It would appear that this ground is not sufficiently pleaded in that it lacks specificity, particularly because it does not identify the "others", nor does it identify the wares and services of these others.

[48] However, considering the statement of opposition as a whole as well as the evidence filed in the record, I interpret this pleading as contending that the applied for Mark is not distinctive and is not capable of distinguishing the Applicant's wares and services from the wares of the Opponent.

[49] In order to meet its evidential burden with respect to this ground, the Opponent must show that as of the filing of the opposition, the Opponent's marks had become known sufficiently to negate the distinctiveness of the Mark [*Motel 6, Inc. v. No. 6 Motel Ltd.* (1981), 56 C.P.R. (2d) 44 at 58 (F.C.T.D.); *Re Andres Wines Ltd. and E. & J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.); and *Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 412 at 424 (F.C.A.)]. While Mr. Galardo's evidence of use of its marks may arguably satisfy the Opponent's initial burden, for reasons similar to those set out above with respect to the s. 12(1)(d) ground of opposition, I find that the Applicant has met its legal burden that there is no likelihood of confusion between the marks at issue. Accordingly, this ground also fails.

Disposition

[50] Pursuant to the authority delegated to me under s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8) of the Act.

DATED AT GATINEAU, QUÉBEC, THIS 31st DAY OF DECEMBER 2009.

Lynne Pelletier
Member
Trade-marks Opposition Board