

IN THE MATTER OF AN OPPOSITION by
Mastro Foods Limited to application No. 621,041
for the trade-mark MASTRO LORENZO filed by
Kraft Jacobs Suchard SA (Kraft Jacobs Suchard AG)
(Kraft Jacobs Suchard Ltd.) (successor in title to the
original applicant namely, Jacobs Suchard Ltd.)

On December 9, 1988, the original applicant namely, Jacobs Suchard Ltd., filed an application to register the mark MASTRO LORENZO based on proposed use of the mark in Canada in association with the following wares:

Coffee products namely roasted and unroasted coffee
both caffeinated and decaffeinated, coffee extracts and
coffee substitutes.

The subject application was advertised for opposition purposes on August 2, 1989. The opponent, Mastro Foods Limited, filed a statement of opposition retroactively on November 29, 1989: see the Office letter dated March 21, 1990. A copy of the statement of opposition was forwarded to the applicant on March 29, 1990. The file record shows that the present applicant "Kraft" was recorded as owner of the subject application on August 10, 1994.

The grounds of opposition are summarized below:

(a) the applied for mark MASTRO LORENZO is not registrable because it is confusing with the opponent's mark MASTRO & Design, regn. No. 220,306, illustrated below, covering "cooked meats",

(b) the applicant is not the person entitled to registration because, at the date of filing of the subject application, the applied for mark MASTRO LORENZO was confusing with

(i) the opponent's mark MASTRO that the opponent had previously used in Canada in association with cooked meats,

(ii) the opponent's trade-name Mastro Foods Limited that the opponent had previously used in Canada in association with foods products,

(c) the applied for mark is not distinctive of the applicant's wares.

The applicant filed, and served, a counter statement generally denying the opponent's allegations, and pleading the applicant's ownership of trade-mark regn. No. 280, 076 for the mark MAESTRO LORENZO covering the wares coffee.

The opponent's evidence consists of the affidavit of Italo Rosati, President of the opponent company and of a related company namely, Santa Maria Foods Limited. Santa Maria was recorded as a registered user (for an indefinite period of time) of the opponent's mark MASTRO & Design at the time that these proceedings commenced. For the purposes of this proceeding, I will assume that Santa Maria was licensed to use the mark MASTRO & Design in conformity with Section 50(1) of the Act at all relevant times.

The applicant's evidence consists of the affidavit of Eileen Woodside-Gmiterek, an employee of the firm representing the applicant. Her affidavit serves to introduce into evidence (i) extracts from the Metropolitan Toronto Telephone Directory (dated April 1991-1992) and from the Montreal Telephone Directory (dated 1990-1991), and (ii) a certified copy of the applicant's trade-mark regn. No. 280,076 for the mark MAESTRO LORENZO.

Neither party conducted cross-examinations on the evidence filed. Both parties filed a written argument, however, only the applicant was represented at an oral hearing.

Mr. Rosati's evidence is that the opponent, through Santa Maria, has been using its mark MASTRO & Design in association with cooked meats since 1975, and in association with other food products including olive oil, tuna, cheese, beans, jams, and pasta products, since prior to November 29, 1989. The opponent's sales of "food products" under its registered mark were \$4.5 million for the year ending May 1986, increasing steadily to \$8.7 million for the year ending May 1990. Expenditures for advertising and promotion were about "\$300,000 annually, for the past several years." I interpret that as covering a three year period beginning in November 1987 and ending on the date of execution of Mr. Rosati's affidavit namely, November 12, 1990. On a fair reading of Mr. Rosati's affidavit, and without the benefit of cross-examination, I assume that the majority of the opponent's sales and advertising relate to cooked meat products (which include capocollo, prosciuttocotto, pancetta, prosciuttini, roast beef, pastrami, corned beef, and old fashioned ham). There is no evidence showing that the opponent has used its trade-name in association with its business of selling food products. In this regard, the exhibits attached to Mr. Rosati's affidavit show Santa Maria Foods Limited as the source of the opponent's wares. The opponent uses its mark in its registered form, however, I consider that such use is also use of the mark MASTRO *per se*: see Nightengale Interloc Ltd. v. Prodesign Ltd. (1984), 2 C.P.R.(3d) 535 at 538, under the heading *Principle 1* (TMOB).

With respect to the ground of opposition denoted by (c) above, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its wares from those of others throughout Canada: see Muffin Houses Inc. v. The Muffin House Bakery Ltd. (1985), 4 C.P.R.(3d) 272 (TMOB). The presence of a legal burden means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant. The material time for considering the circumstances respecting the issue of distinctiveness is as of the filing of the opposition, in this case November 29, 1989: see Re Andres Wines Ltd. and E. & J. Gallo Winery (1975), 25 C.P.R.(2d) 126 at 130 (F.C.A.); Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd. (1991), 37 C.P.R.(3d) 412 at 424 (F.C.A.). Further, I am permitted to take into account evidence of all the surrounding circumstances including, for example, the parties' sales and advertising under their respective marks up to the material date: see Castle & Cooke, Inc. v. Popsicle Industries Ltd. (1990), 30 C.P.R.(3d) 158 (TMOB).

In the circumstances of this case, the issue of distinctiveness turns on whether the applied for mark MASTRO LORENZO is confusing with the opponent's mark MASTRO. In determining whether there would be a reasonable likelihood of confusion, within the meaning of Section 6(2) of the Act, regard must be had to all the surrounding circumstances, including those enumerated in Section 6(5).

With respect to Section 6(5)(a), the applicant's position is that MASTRO is a surname, and "is not therefore possessed of a degree of inherent distinctiveness which would allow it to be registered a word mark." While I agree that the applicant's evidence establishes that MASTRO is a surname, I disagree that MASTRO necessarily lacks inherent distinctiveness (I note in passing that the subject application for MASTRO LORENZO does not disclaim MASTRO). What matters is whether the public would perceive MASTRO as a surname or as a trade-mark, that is, is MASTRO primarily merely a surname? In my view, the average consumer would be more likely to perceive MASTRO as an invented word rather than by thinking of it as a family name: see Galanos v. Registrar of Trade-marks (1982), 69 C.P.R.(2d) 144 (F.C.T.D.) In view of the above, I consider that the marks MASTRO and MASTRO LORENZO both possess a fair degree of inherent distinctiveness as they have no suggestive connotation in relation to the respective parties' wares apart, perhaps, from a vague connection to Italy. Further in this regard, LORENZO would likely be perceived either as a Christian name or as a surname, and would therefore add little to the inherent distinctiveness of the applicant's mark.

The opponent's mark MASTRO would have acquired some reputation in Canada by the material date November 29, 1989, as a result of extensive sales under the mark beginning in June

1985, and as a result of advertising and promotion in the period November 1987 to the material date. There is no evidence that the applied for mark became known to any extent by the material date.

With respect to Section 6(5)(b), the length of time that the marks have been in use favours the opponent but only to a limited extent. In this regard, I do not consider that the length of time that a mark has been in use is relevant in the absence of evidence of use above the *de minimus* level. As the opponent has not shown use of its mark above the *de minimus* level prior to June 1985, the opponent's advantage under Section 6(5)(b) is limited to about a four and one-half year period of use prior to the material date.

With respect to Sections 6(5)(c) and (d), the parties' wares namely, cooked meats and coffee (and coffee substitutes), are intrinsically different. Nevertheless, the parties' wares are related in that both are processed products intended for human consumption. In the absence of evidence to the contrary, I expect that the parties' channels of trade would overlap with respect to making their products available to consumers through the same types of retail outlets including, for example, independent grocery stores and grocery chain stores. The applicant's position is that the opponent "is engaged in supplying food products to the ethnic Italian market" while coffee products "are sold in all manner of grocery outlets" and not "confined to a particular ethnic element..." As there is no evidence to support the submission that the opponent markets to a restricted clientele, I have disregarded that submission as conjecture. Even if the applicant's submission was true, I would have concluded that there must be a substantial ethnic Italian population in Canada supporting the opponent's sales, and I likewise would have concluded that there must be a substantial number of retail outlets serving that population through which the applicant would also market its coffee products.

With respect to Section 6(5)(e), I consider that there is a fair degree of resemblance between the parties' marks. In this regard, the applicant has taken the distinctive element which comprises the opponent's mark namely, MASTRO, and has added to that the weakly distinctive component LORENZO. The fact that the applicant is the owner of the registered mark MAESTRO LORENZO is not, by itself, a relevant circumstance in this proceeding: see Realestate World Services v. Realcorp Inc. (1993), 48 C.P.R.(3d) 397 at pp. 402-403, paragraphs g,h (TMOB).

In view of the above, and keeping in mind that the test for confusion is one of first impression and imperfect recollection, I find that the applied for mark is confusing with the opponent's mark at the material date November 29, 1989. It follows that the applied for mark is not distinctive of the applicant's wares at the material date. The opponent therefore succeeds on its ground of opposition denoted by (c) above and consequently it is not necessary for me to consider the remaining grounds

of opposition.

The applicant's application is refused.

There is one further matter that arose at the oral hearing. The agent for the applicant advised me that the opponent's former registered user namely, Santa Maria Foods Limited, was recorded as the registered owner of the mark MASTRO & Design, regn. No. 220,306 on August 24, 1994, that is, about three weeks prior to the oral hearing. Presumably, the change in ownership would have occurred shortly before August 24, 1994. The applicant's agent observed that the opponent of record was the owner of the registered mark as of November 29, 1989 but not as of the date of the oral hearing; however, the agent for the applicant did not indicate that the applicant was prejudiced by the alleged change of ownership. I would first note that relevant matters arising late in opposition proceedings may be introduced as evidence pursuant to Rule 46(1) of the Trade-marks Regulations, and that I cannot (with limited exceptions) have regard to matters which are not established by evidence. Even if I did have regard to the alleged change of ownership, it would not affect the substantive issues raised by the grounds of opposition denoted by (a) and (c) above because an opponent may rely on a third party's trade-mark registration, and on a third party's use of a mark, respectively, and because Section 38(1) of the Act permits "any person" to file a statement of opposition.

DATED AT HULL, QUEBEC, THIS 30th DAY OF SEPTEMBER ,1994.

Myer Herzig,
Member,
Trade-marks Opposition Board