

**IN THE MATTER OF AN OPPOSITION
by Pizza Pizza Limited to application No.
1,123,041 for the trade-mark GRECO
PIZZA & Chef Design filed by
Grinner's Food Systems Limited**

On November 22, 2001, Grinner's Food Systems Limited (the "Applicant") filed an application to register the trade-mark GRECO PIZZA & Chef Design (the "Mark"). The Mark is shown below:



Colour is claimed as a feature of the mark. The words GRECO and PIZZA are yellow. The background is blue. The chef's hat, hair and mustache are white. The chef's neckerchief is red. The chef's face is a beige skin colour.

The Applicant has disclaimed the right to the exclusive use of the word PIZZA apart from the trade-mark as a whole.

The application is based upon use of the Mark in Canada since at least as early as March 2001 in association with the following wares and services:

Wares: pizza, ready-to-bake pizza, donairs, submarine sandwiches, lasagne, garlic fingers (namely, garlic flavoured, thinly cut wedges of baked pizza dough), chicken wings, caesar salad, and sandwiches baked in pizza dough.

Services: fast food delivery services; take-out food services; restaurant services; pizza delivery services.

The application is also based upon proposed use of the Mark in Canada in association with pita bread; ready-to-bake donair sandwich kits (containing spiced donair meat, donair sauce, pita bread).

The application was advertised for opposition purposes in the Trade-marks Journal of April 2, 2003. On June 2, 2003, Pizza Pizza Limited (the “Opponent”) filed a statement of opposition against the application. In its statement of opposition, the Opponent indicated that it owns registrations for the following marks for pizza, restaurant services and the like.

1. Registration No. TMA247,836



2. Registration No. TMA269,761



3. Registration No. TMA390,897



4. Registration No. TMA403,371



The Opponent alleges that the Applicant's Mark is confusing with the four above-mentioned marks. On that basis, it has pleaded that the Mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the "Act"), the Applicant is not the person entitled to register the Mark pursuant to s. 16, the Mark is not distinctive and the application does not comply with s. 30(i).

The Applicant filed and served a counter statement in which it denied the Opponent's allegations and asserted that it owns a family of GRECO marks and that there are numerous marks on the register and in the marketplace that include the design of a chef for use in association with pizza, restaurant services, *etc.*

The Opponent's r. 41 evidence consists of the affidavit of Pat Finelli, the Opponent's Vice-President of Marketing. I have disregarded those portions of Mr. Finelli's affidavit that are argumentative or that express his opinion with respect to the likelihood of confusion.

The Applicant's r. 42 evidence consists of the affidavits of Michael R. Whittaker (the Applicant's President), Alan J. Booth (a trade-mark searcher), and Kendra E. Brett (a student). I

have disregarded those portions of Mr. Whittaker's affidavit that express his opinion with respect to the likelihood of confusion.

None of the affiants were cross-examined.

Only the Applicant filed a written argument; an oral hearing was not held.

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. [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.).]

Section 12(1)(d) Ground of Opposition

The material date with respect to this ground of opposition is 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.)].

As the pleaded registrations are in good standing, the Opponent has met its initial burden.

the test for confusion

The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that use of a trade-mark causes confusion with another trade-mark if the use of both trade-marks in the same area would be likely to lead to the inference that the wares or services associated with those trade-marks are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class. In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in s. 6(5) of the Act, namely: a) the inherent distinctiveness of the trade-marks or trade-names 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 or trade-names in appearance or sound or in the ideas suggested by them. These enumerated factors need not be attributed equal weight.

The Supreme Court of Canada has discussed the appropriate process for assessing all the surrounding circumstances to be considered in determining whether two trade-marks are confusing in the decisions in *Mattel, Inc. v. 3894207 Canada Inc.* (2006), 49 C.P.R. (4th) 321, [2006] 1 S.C.R. 772, and *Veuve Clicquot Ponsardin v. Boutiques Cliquot Ltée et al* (2006), 49 C.P.R. (4th) 401, [2006] 1 S.C.R. 824.

It is with these general principles in mind that I shall now assess all of the surrounding circumstances.

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

The Applicant's Mark is inherently more distinctive than is any of the Opponent's marks, because the Applicant's Mark includes the word GRECO.

A mark's distinctiveness may be enhanced through use or promotion. Although Mr. Finelli has attested to the success of the Opponent's PIZZA PIZZA restaurant business, the figures that he provides concerning sales volumes and the like are cumulative, *i.e.* they relate to the business as a whole and all of the "PIZZA PIZZA Trade-marks", which he says include the four pleaded marks. As I must assess the likelihood of confusion between each of the Opponent's pleaded marks and the Mark, the absence of evidence directed specifically to each of the pleaded marks weakens the Opponent's case.

Mr. Whittaker attests to the success of the Applicant's GRECO restaurant business and informs us that at least three versions of chef marks have been used over the years. Although the Mark is the "latest" chef design, all three chef designs remain in use. As a result, most of the evidence is not segregated, *i.e.* we cannot tell what portion of sales *etc.* has been associated with the Mark as opposed to one of the other chef marks.

Overall, I cannot tell which of the parties' marks has become known to the greater extent.

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

According to the Opponent's registrations, each of the Opponent's marks has been in use for a longer period of time than has the Applicant's Mark.

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

Both parties are in the restaurant industry and both include pizza as one of their major menu items. Accordingly, consideration of the s. 6(5)(c) and (d) factors favour the Opponent.

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

When sounded, the marks bear little resemblance to each other. In idea suggested, each of the marks might suggest the idea of a freshly made pizza, but the word GRECO in the Mark distinguishes it by suggesting that its pizzas are Greek in character.

Visually, the word GRECO also serves to distinguish the Applicant's Mark from each of the Opponent's marks. Also, the chef's designs differ both with respect to the portrayal of the chef's hats and the inclusion of hair and a neckerchief in the Applicant's Mark.

Overall, I find that when considering the marks as a whole, there is a moderate degree of resemblance, with the resemblance being greatest between the Mark and the mark registered under No. TMA269,761.

further surrounding circumstances

i) state of the register

Mr. Booth has provided copies of approximately 200 marks that include the design of a chef from the Trade-marks Office's database.

State of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace, and inferences about the state of the marketplace can only be drawn where large numbers of relevant registrations are located. [*Ports International Ltd. v. Dunlop Ltd.* (1992), 41 C.P.R. (3d) 432; *Del Monte Corporation v. Welch Foods Inc.* (1992), 44 C.P.R. (3d) 205 (F.C.T.D.); *Kellogg Salada Canada Inc. v. Maximum Nutrition Ltd.* (1992), 43 C.P.R. (3d) 349 (F.C.A.)]

Even though not every mark presented by Mr. Booth relates to pizza restaurants, I find that his evidence makes it clear that it is common to adopt pictures of a chef in association with food, restaurants and related items.

ii) state of the marketplace

Ms. Brett provides us with copies of numerous Canadian telephone directory advertisements that display a chef in association with restaurant services. This further supports the conclusion that Canadian consumers are used to distinguishing between one chef mark and another in the restaurant industry.

conclusion re likelihood of confusion

Based on the above analysis, I find that the Applicant has satisfied the onus on it to show that there is not a reasonable likelihood of confusion between its Mark and any of the Opponent's marks. In particular, I find that the degree of resemblance between the marks is insufficient to result in confusion given that similar marks are commonly used by others in the parties' field. The s. 12(1)(d) ground is accordingly rejected.

Remaining Grounds of Opposition

Each of the remaining grounds of opposition turns on the issue of the likelihood of confusion among the marks. In the circumstances of this case, little turns on the date at which the issue of confusion is determined and the Opponent's position is arguably at its strongest with respect to its s. 12(1)(d) ground.

The Applicant has raised some preliminary objections to the outstanding grounds, which I will

deal with below. I will first however state that to the extent that the Applicant is required to meet its legal burden with respect to each of the outstanding grounds, I reject each of the grounds of opposition for reasons similar to those set out with respect to the s. 12(1)(d) ground.

In its written argument, the Applicant submitted that the s. 30(i) and entitlement grounds are not proper and should be dismissed.

Regarding the s. 30(i) ground of opposition, I interpret this ground as pleading that the Applicant could not have been satisfied that it was entitled to use the Mark because the Mark is allegedly confusing with the Opponent's registered marks. As the Opponent did not allege, or prove, that the Applicant was aware of these allegedly confusing marks, this is another basis on which this ground cannot succeed. In addition, 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. [*Sapodilla Co. Ltd. v. Bristol-Myers Co.* (1974), 15 C.P.R. (2d) 152 (T.M.O.B.) at 155]

The pleading of the entitlement grounds is mixed up. The pleadings cite s. 16(1)(a) and (3)(a), which deal with the prior use of a confusingly similar mark, but the pleadings instead refer to applications that have been previously filed, which would fall under s. 16(1)(b) and (3)(b). The Applicant submits that the Opponent has not pleaded, or evidenced, the particulars of any previously filed applications, which would cause a s. 16(1)(b) or (3)(b) ground to be dismissed. I agree that this is a basis for dismissing a s. 16(1)(b) or (3)(b) ground. If the grounds are interpreted as relying on prior use of the three registered marks, then these grounds would also fail on the basis that the Opponent has not satisfied its initial burden because it has not provided any evidence that shows how any of its marks were used prior to the material dates of November 22, 2001 or March 2001.

Disposition

Having been delegated by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I reject the opposition pursuant to s. 38(8).

DATED AT TORONTO, ONTARIO, THIS 12th DAY OF JULY 2007.

Jill W. Bradbury
Member
Trade-marks Opposition Board