



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2022 TMOB 156**

**Date of Decision: 2022-08-15**

**IN THE MATTER OF AN OPPOSITION**

**Mastrandrea Commercial Bakeries  
Limited**

**Opponent**

**and**

**Les Industries Certico Inc.**

**Applicant**

**1,856,458 for FORNO MAGNIFICO &  
DESIGN**

**Application**

INTRODUCTION

[1] Mastrandrea Commercial Bakeries Limited (the Opponent) opposes registration of the trademark FORNO MANGIFICO & DESIGN (the Mark), which is the subject of application No. 1,856,458 by Les Industries Certico Inc. (the Applicant). The Mark is shown below:



[2] The Mark is applied for on the basis of use in Canada since December 31, 2013 in association with the following goods:

- (1) Pizza ovens;
- (2) Pizza crusts.

[3] The opposition is primarily based on an allegation that the Mark is confusing with trademarks previously registered and/or used in Canada in association with similar goods.

#### THE RECORD

[4] The application for the Mark was filed on September 8, 2017.

[5] The application includes the following foreign character translation: “The translation provided by the applicant of the word(s) FORNO MAGNIFICO is ‘magnificent oven’.”

[6] The application was advertised for opposition purposes on November 21, 2018. Numerous amendments to the *Trademarks Act*, RSC 1985, c T-13 (the Act) came into force on June 17, 2019. Pursuant to section 70 of the Act, the grounds of opposition will be assessed based on the Act as it read immediately before June 17, 2019, an exception being that, with respect to confusion, sections 6(2) to (4) of the Act as it currently reads will be applied.

[7] On December 19, 2018, the Opponent opposed the application by filing a statement of opposition under section 38 of the Act.

[8] Following an amended statement of opposition filed on June 20, 2019, the grounds of opposition are based on non-compliance with section 30(b) of the Act; non-registrability pursuant to section 12(1)(d); non-entitlement pursuant to section 16 of the Act; and non-distinctiveness within the meaning of section 2 of the Act.

[9] The Applicant filed a counter statement denying the grounds of opposition.

[10] In support of its opposition, the Opponent filed the following affidavits:

- Affidavit of Andrea Mastrandrea, sworn June 21, 2019 in Toronto (the Mastrandrea Affidavit); and
- Affidavit of Shelley Cherry, sworn June 19, 2019 in Toronto (the Cherry Affidavit).

[11] In support of its application, the Applicant filed the following solemn declarations:

- Declaration of Quintino Rico, sworn October 8, 2019 in Montreal (the Rico Declaration); and
- Declaration of Richard Levy, sworn October 7, 2019 in Montreal (the Levy Declaration).

[12] Mr. Rico was cross-examined and the cross-examination transcripts and undertakings were made of record. I note that, subsequent to Mr. Rico’s cross-examination, the Applicant requested leave to submit additional evidence in the form of a second declaration of Mr. Rico, which was refused by way of letter from the Registrar dated April 16, 2020.

[13] Only the Applicant submitted written representations and was represented at a hearing.

OVERVIEW OF THE OPPONENT’S EVIDENCE

[14] The Opponent is the owner of trademark registration No. TMA889214 for the trademark Square and Design (the Opponent’s Trademark), shown below:



[15] The registration includes the following foreign character translation: “The translation provided by the applicant of the words FORNO CULTURA is oven culture.”

[16] The Opponent’s Trademark was registered in November 2014 on the basis of use in Canada since October 27, 2011 in association with the following goods and services:

Goods: Italian artisan baked products, namely, biscotti, cakes, olive oil cakes, specially cream desserts, panetone, torrone, bread and taralli.

Services: (1) Production and sale of Italian artisan baked products namely, biscotti, cakes, olive oil cakes, specially cream desserts, panetone, torrone, bread and taralli. (2)

Preparation services and sale of Italian prepared and packaged food products namely, jams, chocolate, tomato sauce, soup, olive spreads and pickled vegetables and fruit. (3)

Catering services. (4) Culinary classes and demonstrations. (5) Operation of a website providing information in the field of production of Italian artisan bakery.

*Mastrandrea Affidavit*

[17] Mr. Mastrandrea is the President of the Opponent [para 1]. He states that, in addition to offering the aforementioned services (1), (2), (3) and (5) and selling the aforementioned “Italian artisan baked products”, the Owner also sells “prepared foods”, including pizza and pizza dough [paras 3 and 4]. He explains that the Opponent has operated a bakery in Toronto since October 2011, at which such goods and services are sold and provided in association with the Opponent’s Trademark. He states that four other locations, also offering some of the Opponent’s goods and services in association with Opponent’s Trademark, have opened in various locations in Toronto between December 2016 and May 2019 [para 8]. He confirms that the Opponent sells and provides its goods and services in association with the Opponent’s Trademark on both a retail and a wholesale basis [para 9]. In this respect, the Mastrandrea Affidavit evidences the following:

- Advertising of the Opponent’s goods and services in association with the Opponent’s Trademark and the FORNO CULTURA word mark, in particular through social media posts and a catering menu [para 10, Exhibits B to TT];
- Articles and blog posts published on the Internet that reflect “customer satisfaction or goodwill” with the Opponent’s goods and services [para 11, Exhibits UU to ZZ], such as an article entitled “Baker’s Intuition” published online in June 2018 at *edibletoronto.ediblecommunities.com* [Exhibit UU]; and
- Sales and representative invoices relating to the sale of the Opponent’s goods and services, having been in excess of \$10 million between October 2011 and 2018 [para 12 and 13, Exhibit AAA].

[18] In addition, Mr. Mastrandrea attests that, since October 2011, the Opponent has sold pizza and pizza dough in association with the Opponent’s Trademark. Mr. Mastrandrea explains that the Opponent sells “on average 35 pounds of pizza dough a month”, and further that sales of

pizza from October 2011 to the end of December 2018 were in excess of \$200,000 [para 14, exhibits I, GG and QQ].

### *Cherry Affidavit*

[19] Ms. Cherry is an employee of the Opponent's agent [para 1]. Ms. Cherry attests that she conducted Internet searches using the Google search engine for the words FORNO MAGNIFICO and "pizza crusts" in April 2019 [para 4]. Accordingly, attached to her affidavit are printouts of the following:

- Printouts from *Costco.ca* for the product "Forno Magnifico Electric Pizza Oven" [para 5, Exhibit A]; and
- Printouts from the Applicant's website, *fornomagnifico.com*, advertising four pizza crust products [Exhibit B], and a video "related to FORNO MAGNIFICO Pizza Crusts and was said to be published on November 2, 2017" [Exhibit C].

[20] Ms. Cherry also attests that, in May 2019, she conducted searches of the Wayback Machine Internet Archive at *web.archive.org* to view the history of the Applicant's website, *fornomagnifico.com* [para 7]. She states that the website "first appeared" on October 28, 2014, and that, in her review of website pages for the years 2014 to 2018, reference to pizza crusts did not appear until October 31, 2017 [Exhibits D and E].

[21] The Cherry Affidavit also includes a certified copy of registration No. TMA991845 for the trademark FORNO et dessin (the CTM Trademark), owned by third-party CTM Household Appliances Inc. (CTM) [para 8, Exhibit F]. The CTM Trademark was registered in March 2018 in association with the goods "Appareils électro-ménager nommément: four encastré, plaque de cuisson, hotte de cuisine" (translated as "Household appliances, namely: built-in ovens, stovetops, range hoods"), and is shown below:



## OVERVIEW OF THE APPLICANT'S EVIDENCE

### *Rico Declaration*

[22] Mr. Rico is the President of the Applicant [para 1]. He attests that the Applicant is a company “engaged in the research, production and distribution in Canada and the U.S. of ... portable pizza ovens and pizza crusts since 2009”, with its head office located in Saint-Laurent, Quebec [para 1]. He states that the Applicant began selling pizza ovens in association with the Mark in Canada in 2011 and expanded its products to frozen pizza crusts in 2013 [para 5]. In support, the Rico Declaration evidences the following:

- History of the Applicant’s business [para 4];
- History of the Applicant’s applications for the Mark in Canada and the U.S. [paras 6 to 8];
- Sales of the Applicant’s pizza ovens and pizza crusts in Canada and the U.S. [paras 9 to 12 and 15, Exhibits D and E]; and
- Advertising in relation to the Mark, including advertising material such as packaging, coupons, tradeshow, in-store demonstrations and promotional cards [paras 13 and 14, Exhibit F].

[23] In addition, Mr. Rico states that he has “never had a customer ask me or anyone of my employees for the opponent’s products” [para 16].

[24] As discussed below, the cross-examination of Mr. Rico largely focused on the Applicant’s website.

### *Levy Declaration*

[25] Mr. Levy is a trademark agent employed by Levy IP Law, located in Westmount, Quebec [para 1]. Mr. Levy attests that he conducted searches of the Canadian Trademark Register for references to the word FORNO in association with goods in Nice class 30, including Italian bread, pastry dough, pizza dough and various kinds of pasta, and in Nice class 11, including pizza ovens and other baking ovens [para 3]. Attached to his affidavit are the following:

- Search results for active registered trademarks and pending applications “that include the word FORNO or its equivalent in French, FOUR, in association with” goods in class 30 [para 3a, Exhibit A];
- Search results for active registered trademarks and pending applications that include the word FORNO or the English thereof, namely OVEN, in association with goods in class 11 [para 3b, Exhibit B]; and
- Extracts of the trademark registrations and applications listed in Exhibits A and B [para 3c, Exhibit C].

### EVIDENTIAL BURDEN AND LEGAL ONUS

[26] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd*, 1990 CarswellNat 1053 (FCTD)]. The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[27] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on an Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

SECTION 30(B) GROUND – NON-COMPLIANCE

[28] Pursuant to section 38(2)(a) of the Act, the Opponent pleads that the application does not comply with section 30(b) of the Act in that the Mark has not been used in Canada by the Applicant in association with each and every one of the goods set out in the application since December 31, 2013, as claimed in the application.

[29] With respect to a ground of opposition based on section 30(b) of the Act, to the extent that the relevant facts are more readily available to the applicant, the evidential burden on an opponent is not onerous [*Tune Masters v Mr P's Mastertune Ignition Services Ltd*, 1986 CarswellNat 1210 (TMOB)]. While an opponent can meet its initial burden by reference to its own evidence, its burden can in some cases be met with reference to the applicant's evidence [*Molson Canada v Anheuser-Busch Inc*, 2003 FC 1287; *Corporativo de Marcas GJB, SA DE CV v Bacardi & Company Ltd*, 2014 FC 323], and an opponent can rely upon cross-examination of an applicant's deponent to meet the evidential burden upon it [see *Coca-Cola Ltd v Compagnie Francaise de Commerce International Cofci, SA*, 1991 CarswellNat 1397 (TMOB)]. However, an opponent may only successfully rely upon the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claim set forth in the application [*Marcas* at paras 30 to 38].

[30] In this case, per the Cherry Affidavit, the Opponent's evidence appears to consist of search results from the Wayback Machine at [www.archive.org](http://www.archive.org), relating to the Applicant's website.

[31] However, as there was no apparent effort made to assess whether the goods were offered otherwise (*e.g.* through a different website or the Applicant's bakery locations), I do not find that the Opponent's evidence meets its initial burden.

[32] Furthermore, I agree with the Applicant that nothing in the Applicant's evidence or related to the cross-examination of Mr. Rico puts the claimed date of first use into issue. First, with respect to use of the Mark in association with pizza ovens, the Rico Affidavit includes one invoice for a sale of such from August 2011. While no such invoice pre-dating the claimed date of first use was evidenced with respect to "pizza crusts", I accept that the exhibited insert



identified as “Pizza crust inserts printed August 17, 2011 and included with every package of pizza crusts sold” [Rico Declaration at para 14 and Exhibit F] and the invoice relating to production of a “forno magnifico pizza crusts video” dated October 2013 [Undertaking U-3], are consistent with Mr. Rico’s statements regarding use of the Mark in association with pizza crusts since 2013 [paras 5 and 6]. Accordingly, in the absence of representations from the Opponent explaining their significance, I decline to draw any negative inferences based on the selective printouts from the Applicant’s website, as attached to the Cherry Affidavit.

[33] As the Opponent fails to meet its initial burden, the ground based on section 30(b) of the Act is rejected.

#### SECTION 12(1)(D) GROUND – CONFUSING WITH THE CTM TRADEMARK

[34] The Opponent pleads that the Mark is not registrable because it is confusing with registration No. TMA991845 for the trademark Forno et dessin (referred to herein as the CTM Trademark). While the Opponent is not the owner of this registration, an opponent may rely on third-party registrations for the purposes of a ground of opposition based on section 12(1)(d) of the Act [*USV Pharmaceuticals of Canada Ltd v Sherman and Ulster Ltd* (1974), 15 CPR (2d) 79 (TMOB)].

[35] The material date with respect to confusion with a registered trademark is the date of this decision [*Simmons Ltd v A to Z Comfort Beddings Ltd*, 1991 CarswellNat 1119 (FCA)]. As the CTM Trademark registration is extant on the register, the Opponent meets its initial burden.

[36] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the CTM Trademark.

#### *Test to determine confusion*

[37] The test to determine the issue of confusion is set out in section 6(2) of the Act which provides that the use of a trademark causes confusion with another trademark if the use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured, sold, leased, hired or performed by the same

person, whether or not the goods or services are of the same general class or appear in the same class of the Nice Classification.

[38] The test to be applied is a matter of first impression in the mind of a casual consumer “somewhat in a hurry” who sees the Mark in association with the applied-for goods at a time when they have no more than an imperfect recollection of the CTM Trademark and does not pause to give the matter any detailed consideration or scrutiny [see *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20].

[39] In making such an assessment, all the relevant surrounding circumstances must be taken into consideration, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods, services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them.

[40] The criteria or factors in section 6(5) of the Act are not exhaustive and different weight will be given to each one in a context-specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22 at para 54]. In *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, it was stated that section 6(5)(e), the resemblance between the trademarks, will often have the greatest effect on the confusion analysis [at para 49] and that, while the first word in the trademark may be the most important in some cases, the preferable approach is to consider whether there is an aspect of the trademark that is particularly “striking or unique” [at para 64].

[41] For the purposes of this ground, I consider it appropriate to focus on the applied-for goods (1), “Pizza ovens”, and will begin with the degree of resemblance analysis, given its overall importance in the assessment of the likelihood of confusion.

#### *Degree of Resemblance*

[42] In its representations, the Applicant largely emphasizes the differences in the nature of the Applicant’s goods and those of CTM, and the absence of evidence of actual confusion between the Mark and the CTM Trademark [see, for example, Applicant’s written

representations at paras 54 and 79]. Nevertheless, with respect to the degree of resemblance between the trademarks, the Applicant submits that the “dominant” portion of the Mark is the word MAGNIFICO “in prominent cursive which stands out to the consumer”, whereas the word FORNO in block letters is the dominant word in the CTM Trademark [paras 101 and 102].

[43] However, in my view, the subject trademarks have a high degree of resemblance in appearance and in ideas suggested, given not only the shared word FORNO but also and especially due to the similar arch with flame designs. The trademarks also have a significant degree of resemblance when sounded, given the shared word FORNO.

[44] Accordingly, this factor favours the Opponent.

#### *Inherent Distinctiveness and the Extent Known*

[45] In its representations, the Applicant submits that the word FORNO must be considered a common word [paras 41 to 49], such that the CTM Trademark has “little inherent distinctiveness” and should be restricted in its ambit of protection [para 49]. In this respect, consistent with the translation it provided in the application, the Applicant submits that, in Italian, the word FORNO “has many meanings including oven, furnace or kiln”. Indeed, I note that the word FORNO is disclaimed in the CTM Trademark registration.

[46] In contrast, the Applicant submits that the Mark is a unique combination of the words FORNO and MAGNIFICO in combination with a design consisting of a brick arch with a flame beneath, thus making it inherently distinctive. Furthermore, while the Opponent has not adduced evidence regarding the extent to which the CTM Trademark has become known, the Applicant submits that the Mark has acquired distinctiveness from sales of pizza ovens and pizza crusts in association with the Mark since 2011 and 2013, respectively [paras 51 and 53, citing the Rico Declaration at para 11].

[47] However, as noted above, an arch with flame design element is also found in the CTM Trademark, thus giving it a greater degree of inherent distinctiveness than suggested by the Applicant.

[48] Nevertheless, as there is no evidence with respect to the extent to which the CTM Trademark has become known, overall, this factor somewhat favours the Applicant.

*Length of Time in Use*

[49] The Applicant has evidenced use of its Mark since 2011 in association with pizza ovens. While the registration for the CTM Trademark indicates that a declaration of use was filed in March 2018, there is no evidence of use regarding the CTM Trademark.

[50] Accordingly, this factor favours the Applicant.

*Nature of the Goods or Business / Nature of the Trade*

[51] When considering the nature of the goods of the parties in respect of the issue of confusion, it is the statements of goods in the subject application and registration that govern [*Mr Submarine Ltd v Amandista Investments Ltd*, 1987 CarswellNat 749 (FCA); *Miss Universe Inc v Bohna*, 1994 CarswellNat 1443 (FCA)].

[52] In its representations, the Applicant submits that its goods “have a general appeal and are purchased by consumers directly and specifically interested in the making and cooking of home-prepared pizzas” [para 64]. Accordingly, the Applicant argues that even though the parties’ goods fall within the same class, “they can easily be distinguished from one another by the average consumer”, given that the parties “are targeting entirely different markets and consumers” [para 73]. In this respect, the Applicant submits that the appliance goods offered by CTM “are not purchased casually or without close inspection or careful reflection” [para 77].

[53] However, as the Opponent has met its initial burden under this ground, the onus is on the Applicant. While the nature of the parties’ goods may differ to some degree, at least some of the Applicant’s submissions appear to be speculative at best; in any event, both parties’ goods are in the nature of cooking appliances and the respective statements are not limited in terms of channels of trades.

[54] Accordingly, at a minimum, I accept there is the potential for overlap in the nature of the parties’ goods, businesses, and channels of trade to some extent. In my view, given the

shared elements, a consumer with imperfect recollection of the CTM Trademark may understand the pizza ovens sold in association with the Mark to be the “magnifico” variety of the Opponent’s line of cooking appliances.

[55] Accordingly, these factors favour the Opponent.

*Additional Surrounding Circumstance – State of the Register*

[56] In its representations, the Applicant submits that “the word FORNO is very common on the Register” in the relevant Nice classes, per the Levy Declaration [para 42]. However, state of the register evidence is only relevant insofar as one can make inferences from it about the state of the marketplace [*Ports International Ltd v Dunlop Ltd*, 1992 CarswellNat 1431 (TMOB); and *Welch Foods Inc v Del Monte Corp*, 1992 CarswellNat 178 (FCTD)]. Such inferences can only be drawn from state of the register evidence where large numbers of relevant registrations are located [*Maximum Nutrition Ltd v Kellogg Salada Canada Inc*, 1992 CarswellNat 124 (FCA)].

[57] In this case, while the word FORNO does appear in some of the relevant registrations identified by Mr. Levy (for example, TMA1006309 for FORNO VENETZIA in association with various types of ovens), it is not merely the word FORNO at issue under this ground. In this respect, the Applicant has not evidenced common usage of the distinctive arch and flame design, alone or in combination with the word FORNO.

[58] Accordingly, I do not consider this factor to favour the Applicant.

*Additional Surrounding Circumstance – No evidence of actual confusion*

[59] In its representations, the Applicant submits that “There have never been any instances of confusion between the Mark [and the CTM Trademark]”, noting that the Opponent has not adduced any proof of actual confusion [para 111]. However, again, as the Opponent has met its legal burden under this ground, the legal onus is on the Applicant. In this respect, while I consider it appropriate to give some weight to Mr. Rico’s aforementioned statement that he has “never had a customer ask me or anyone of my employees for the opponent’s products” [para 16], it is not clear whether this statement applies to CTM’s products as well. In any event, I note

that the CTM Trademark was only registered in 2018 and there is no evidence regarding the nature of CTM's goods or business before me.

[60] As such, while this factor tends to favour the Applicant, it is not to a significant extent.

*Conclusion – Confusion with the CTM Trademark*

[61] As mentioned above, the degree of resemblance between the parties' trademarks is the statutory factor that is often likely to have the greatest effect in deciding the issue of confusion.

[62] Having considered all of the surrounding circumstances, with respect to "pizza ovens", I find that the balance of probabilities regarding the likelihood of confusion as to the source of the parties' goods to be evenly balanced. I reach this conclusion due to the high degree of resemblance between the trademarks and the potential overlap in the nature of the relevant goods, businesses and trades, and notwithstanding the absence of evidence of actual confusion. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant with respect to goods (1), "pizza ovens".

[63] In view of the foregoing, this section 12(1)(d) ground of opposition, based on confusion with the CTM Trademark, is successful with respect to goods (1).

[64] With respect to goods (2), "Pizza crusts", I consider the differing nature of CTM's goods sufficient to shift the balance of probabilities in the Applicant's favour under this ground.

SECTION 16 GROUND – CONFUSING WITH THE PREVIOUSLY USED OPPONENT'S TRADEMARK

[65] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark pursuant to section 16(1)(a) of the Act in that, at the alleged date of first use, namely, December 31, 2013, the Mark was confusing with the Opponent's Trademark, used in association with prepared food products, namely, panini, tramezzini, pizza, pizza dough, salads, dolce and prepared food jars (the Prepared Food Products), and the production and sale of the Prepared Food Products, which had been previously used in Canada by the Opponent and which had not been abandoned at the date of advertisement of the application for the Mark.

[66] An opponent meets its evidentiary burden under a section 16(1)(a) ground if it shows that, as of the alleged date of first use of the applied-for trademark in Canada, its trademark had been previously used in Canada and had not been abandoned as of the date of advertisement of the applicant's application [section 16(5) of the Act].

[67] For purposes of this ground, I consider it appropriate to focus on the applied-for goods (2), "pizza crusts" and, of the Prepared Food Products, the Opponent's "pizza" and "pizza dough" goods.

[68] In this case, I find that the Mastrandrea Affidavit demonstrates use of the Opponent's trademark in association with pizza and pizza dough since October 2011 [Mastrandrea Affidavit at para 14, Exhibits I, GG and QQ]. As this use pre-dates the claimed date of first use in the application, the Opponent meets its initial burden under this ground.

[69] Accordingly, the Applicant must establish, on a balance of probabilities, that there is not a reasonable likelihood of confusion between the Mark and the Opponent's Trademark.

#### *Degree of Resemblance*

[70] In its representations, again, the Applicant largely emphasizes the differences in the nature of the parties' goods, and the absence of evidence of actual confusion between the Mark and the Opponent's Trademark [see, for example, Applicant's written representations at paras 54, 86 and 111]. Nevertheless, with respect to the degree of resemblance between the parties' trademarks, the Applicant submits that the "dominant" portion of the Mark is the word MAGNIFICO "in prominent cursive which stands out to the consumer", whereas the words FORNO CULTURA are dominant in the Opponent's Trademark [paras 101 and 102]. I also note that whereas the Mark includes a flame design element, the Opponent's Trademark instead includes an ears of wheat design element.

[71] Nevertheless, the subject trademarks have a significant degree of resemblance in appearance, when sounded, and in ideas suggested, given not only the shared word FORNO but especially when combined with the similar arch design.

[72] Accordingly, this factor favours the Opponent.

### *Inherent Distinctiveness and the Extent Known*

[73] Again, in its representations, the Applicant submits that the word FORNO must be considered a common word [paras 41 to 49], such that the Opponent's Trademark has "little inherent distinctiveness" and should be restricted in its ambit of protection [para 49]. As noted above, the Applicant submits that, in Italian, the word FORNO "has many meanings including oven, furnace or kiln" [para 41].

[74] In contrast, the Applicant submits that the Mark is a unique combination of the words FORNO and MAGNIFICO in combination with a design consisting of a brick arch with a flame beneath, thus making it inherently distinctive [para 50].

[75] With respect to the extent to which the parties' trademarks have become known, there is some evidence of sales and advertising of the Applicant's pizza crusts [Rico Affidavit at paras 11 and 13], as well as comparable evidence of sales and social media advertising and recognition of the Opponent's pizza products [Mastrandrea Affidavit at paras 11 and 14].

[76] However, as noted above, the arch design element is also found in the Opponent's Trademark, thus giving it a greater degree of inherent distinctiveness than suggested by the Applicant. Furthermore, to the extent that FORNO may have a low degree of inherent distinctiveness in association with ovens given its Italian translation, I consider FORNO to have greater inherent distinctiveness in association with pizza products.

[77] As such, overall, I find that this factor favours the Opponent.

### *Length of Time in Use*

[78] The Applicant has evidenced use of its Mark since 2013 in association with pizza crusts, whereas the Opponent has evidenced use of the Opponent's Trademark since 2011 in association with pizza and pizza dough.

[79] Accordingly, this factor favours the Opponent.

### *Nature of the Goods or Business / Nature of the Trade*



[80] In its representations, the Applicant submits that, even though the parties' goods fall within the same class, "they can easily and quickly be distinguished from one another by the average consumer" in part because of the parties serve different markets and are not direct competitors [para 83]. Indeed the evidence shows that the Applicant sells its pizza crusts through large retailers such as Costco, whereas the Opponent's sales of pizza and pizza dough appear limited to its bakery and retail locations in the Toronto area.

[81] Nevertheless, both parties' goods are in the nature of pizza products sold to the general public. A consumer looking to make their own pizza may be attracted to the Applicant's pizza crusts one day and to the Opponent's pizza dough on another day. In my view, given the shared elements, a consumer with imperfect recollection of the Opponent's Trademark may understand the pizza crusts sold in association with the Mark to be the "magnifico" variety within the Opponent's line of pizza products.

[82] As such, I find that there is overlap in the nature of the parties' goods, and potential for overlap in the businesses and channels of trade to some extent.

[83] Accordingly, these factors favour the Opponent.

*Additional Surrounding Circumstance – State of the Register*

[84] Again, while the word FORNO does appear in some of the relevant registrations identified by Mr. Levy (for example, TMA944188 for MI CASA FORNO in association with "pizza"), it is not merely the word FORNO at issue under this ground. In this respect, the Applicant has not evidenced common usage of the striking arch design and/or its combination with the word FORNO thereof.

[85] Accordingly, I do not consider this factor to favour the Applicant.

*Additional Surrounding Circumstance – No evidence of actual confusion*

[86] The Applicant emphasizes the absence of actual confusion in this case, given that the parties' pizza-related goods have co-existed in the marketplace since 2013 [Applicant's written

representations at para 111]. Indeed, as noted above, Mr. Rico states that he has “never had a customer ask me or anyone of my employees for the opponent’s products” [para 16].

[87] In the absence of representations from the Opponent, I accept that this factor tends to favour the Applicant.

*Conclusion – Confusion with the Opponent’s Trademark*

[88] Having considered all of the surrounding circumstances, with respect to “pizza crusts”, I find that the Applicant has not met its legal burden regarding the likelihood of confusion between the parties’ trademarks. At best for the Applicant, I find the balance of probabilities regarding the likelihood of confusion to be evenly balanced. I reach this conclusion due to the resemblance between the trademarks and the overlap in the nature of the goods, and notwithstanding the absence of evidence of actual confusion. As the onus is on the Applicant to show, on a balance of probabilities, that there is no reasonable likelihood of confusion, I must find against the Applicant with respect to goods (2), “Pizza crusts”.

[89] In view of the foregoing, the section 16 ground of opposition based on confusion with the Opponent’s Trademark is successful with respect to goods (2).

[90] With respect to goods (1), “Pizza ovens”, I consider the differing nature of the parties’ goods sufficient to shift the balance of probabilities in the Applicant’s favour under this ground.

SECTION 12(1)(D) GROUND – CONFUSING WITH THE REGISTERED OPPONENT’S TRADEMARK

[91] The Opponent pleads that the Mark is not registrable having regard to the provisions of section 12(1)(d) of the Act in that it is confusing with the Opponent’s Trademark (registration No. TMA889214), which has not been abandoned as of the date of advertisement of the application for the Mark.

[92] As the registration for the Opponent’s Trademark is extant, the Opponent meets its initial burden under this ground.

[93] However, in contrast to the section 16 ground of opposition based on prior use of the Opponent’s Trademark, I note that the subject registration does not include “pizza” or “pizza

dough”. In my view, while the registration does include baked goods, this difference in the nature of the parties’ goods is sufficient to shift the confusion analysis in the Applicant’s favour under this ground, including with respect to goods (2), “Pizza crusts”.

[94] Accordingly, the ground of opposition based on confusion with the Opponent’s Trademark registration pursuant to section 12(1)(d) of the Act is rejected.

#### SECTION 2 GROUND – NON-DISTINCTIVENESS

[95] The Opponent pleads that the Mark is not distinctive of the goods of the Applicant within the meaning of section 2 of the Act, in that it is not adapted to distinguish the goods in association with which it is proposed to be used from the goods and services of the Opponent, in that the applied-for Mark is confusing with the Opponent’s Trademark used in association with the Prepared Food Products and the production and sale of the Prepared Food Products.

[96] The material date for this ground is the filing date of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc*, 2004 FC 1185].

[97] Section 2 of the Act, as it then was, defined “distinctive” as follows:

distinctive, in relation to a trademark, means a trademark that actually distinguishes the goods or services in association with which it is used by its owner from the goods or services of others or is adapted so to distinguish them.

[98] A trademark “actually distinguishes” by acquiring distinctiveness through use, resulting in distinctiveness in fact. On the other hand, a trademark that is “adapted so to distinguish” is one that does not depend upon use for its distinctiveness because it is inherently distinctive [see *Astrazeneca AB v Novopharm Ltd*, 2003 FCA 57 at para 16].

[99] In its written representations, the Applicant relies on the reasons set out in its confusion analysis to argue that the Mark has inherent distinctiveness and has acquired sufficient distinctiveness through use and advertising of its pizza ovens and pizza crusts in association with the Mark [paras 120 and 121]. Importantly, the Applicant also notes that the Opponent has not adduced any evidence of actual confusion between the Mark and any other trademark, including the Opponent’s Trademark [para 122].

[100] Under a non-distinctiveness ground such as this, the initial burden is on the Opponent to prove that, as of the material date, its trademark i) was known to some extent in Canada in association with the relevant goods and services and ii) had a reputation in Canada that was “substantial, significant or sufficient” so as to negate the distinctiveness of the Mark [see *Bojangles’ International, LLC v Bojangles Café Ltd*, 2006 FC 657 at paras 33 and 34; and *Canadian Dental Association v Ontario Dental Assistants Association*, 2013 FC 266 at para 42, aff’d 2013 FCA 279]. In *Auld Phillips Ltd v Suzanne’s Inc*, 2005 FCA 429, albeit in the context of an expungement proceeding under section 57 of the Act, the Federal Court of Appeal stated that “Obviously, it will be a rare occurrence when one party is in a position to cause a mark to lose its distinctiveness, but nothing in principle prevents this result” [at para 7].

[101] In this case, while there is evidence of use of the Opponent’s Trademark as of the material date, I note that any use appears limited to the Toronto area. In any event, I do not find that the Mastrandrea Affidavit evidences substantial, significant or sufficient reputation in the Opponent’s Trademark so as to negate the inherent distinctiveness of the Mark or its acquired distinctiveness through the evidenced use.

[102] Accordingly, as the Opponent fails to meet its initial burden, the section 2 ground of opposition is rejected.

#### DISPOSITION

[103] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I refuse the application.

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Andrew Bene  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE:** 2022-05-19

**APPEARANCES**

No one appearing	For the Opponent
Howard Tatner	For the Applicant

**AGENTS OF RECORD**

John S. McKeown	For the Opponent
Selena Altro	For the Applicant