



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2012 TMOB 249
Date of Decision: 2012-12-17

**IN THE MATTER OF AN OPPOSITION
by Maple Leaf Foods Inc. to application
No. 530,221 for the certification mark
PROSCIUTTO DI PARMA in the name
of Consorzio del Prosciutto di Parma**

The Proceedings

[1] On October 19, 1984, Consorzio del Prosciutto di Parma (the Applicant) filed an application to register PROSCIUTTO DI PARMA (the Mark) as a certification mark for “ham”. This application was assigned serial number 530,221.

[2] When application No. 530,221 was advertised for opposition purposes in the *Trade-marks Journal* on January 24, 2007, it was based on use and registration of the Mark in Italy in association with “uncooked ham that has been preserved through a process of salting, aging and air-curing, also known as prosciutto”. The Applicant has disclaimed the right to the exclusive use of the word PROSCIUTTO apart from the Mark. Regarding the particulars of the defined standard that the Mark is intended to indicate, the application states:

The hams are prepared in a region which includes the valleys, hills and mountain areas of the Province of Parma, to a distance of not less than 5 kilometers South of the Via Emilia and to an altitude of not more than 900 meters. The zone is geographically bounded at the East by the River Enza and West by the Torrent Stirone and includes completely or in part, observing the aforesaid geographical and attitudinal limits, the territory of the following communes: in the valley Parma and Montechiarugolo; in the hills Salsomaggiore Terme, Fidenza, Noceto, Pellegrino, Medesano, Collecchio, Varana Melegari, Fornovo Taro,

Felino, Sala Baganza, Langhirano, Lesignano Bagni, Traversetolo, Neviano Arduini, Calestano, Terenzo; in the mountains Varsi, Bardi, Bore, Solignano, Bedonia, Compiano, Tornolo, Albareto, Borgataro, Valmozzola, Berceto, Corniglio, Tizzano Val Parma, Monchio delle Corti, Palanzano. The mode of production and the characteristics of the product are set out in the attached translations of the statute, regulations and statutory instruments.

[3] On June 26, 2007, Maple Leaf Foods Inc. (the Opponent) filed a statement of opposition against the application. The Opponent has pleaded grounds of opposition pursuant to sections 38(2)(a), (b), (c) and (d) of the *Trade-marks Act*, RSC 1985, c T-13 (the Act).

[4] The Applicant filed and served a counter statement denying the Opponent's allegations. In addition, the Applicant denied that paragraphs 7, 10 and 12 of the statement of opposition pleaded any valid ground of opposition (those paragraphs refer to sections 30(f), 16(1)(a) and 16(3)(a) of the Act).

[5] Pursuant to section 41 of the *Trade-marks Regulations*, SOR/96-195 (the Regulations), the Opponent filed an affidavit of Adam Grogan. Mr. Grogan was cross-examined and a copy of the transcript is of record.

[6] Pursuant to section 42 of the Regulations, the Applicant filed affidavits of Stefano Fanti, Robert T. Brockbank, James Neil Pollock, Joan Brehl, Jean-Charles Vincelette, Odysseas Goulanakis, Debbie Heatherington and Michael Stephan. Although orders were obtained for the cross-examination of each of these affiants with the exception of Ms. Heatherington, transcripts of cross-examination were filed only with respect to Mr. Fanti and Mr. Goulanakis. Answers to certain undertakings given during the Fanti cross-examination are also of record.

[7] Pursuant to section 43 of the Regulations, the Opponent filed a second affidavit of Adam Grogan, plus affidavits of Raymond Robitaille and Jennifer Harper.

[8] Both parties filed a written argument. The Opponent subsequently requested leave to amend its statement of opposition; leave was denied by letter dated January 3, 2012.

[9] An oral hearing was held in which both parties participated.

Rulings Made at Oral Hearing

[10] At the beginning of the oral hearing, it was brought to my attention that the Applicant intended to have two different trade-mark agents make oral submissions; one who is part of the firm that is the Applicant's agent of record and one who is not.

[11] Sections 8 and 10 of the Regulations read in part:

8. (1) Subject to subsections (2) and (4), correspondence relating to the prosecution of an application for the registration of a trade-mark shall be with the applicant.

(2) Subject to subsection (3) and sections 9 and 11, correspondence referred to in subsection (1) shall be with a trade-mark agent, where the trade-mark agent has been authorized to act on behalf of the applicant in one of the following ways:

(a) the trade-mark agent filed the application with the Registrar as the agent of the applicant;

(b) the trade-mark agent is appointed as the agent of the applicant in the application or an accompanying document; or

(c) the trade-mark agent is appointed as the agent of the applicant after the application is filed.

(3) Where a trade-mark agent referred to in subsection (2) appoints another trade-mark agent as associate or substitute agent, correspondence shall be with the associate or substitute agent.

...

10. Sections 8 and 9 apply, with such modifications as are necessary, to parties to oppositions.

[12] Regarding the foregoing, the Registrar considers correspondence relating to an opposition to include appearance at an oral hearing.

[13] Reference is also made to the Trade-marks Opposition Board's Practice Notice entitled *Practice in Trade-mark Opposition Proceedings* that has been in effect since March 31, 2009. It states in section III, "An opponent, whether a single person or several persons, may only appoint a single trade-mark agent."

[14] I see no reason why an applicant ought to be allowed to have more than one trade-mark agent represent it if an opponent may not. Where a party is represented, it has been the Board's practice to only allow representations at an oral hearing from the party's appointed agent.

[15] As an administrative tribunal, the Trade-marks Opposition Board is master of its own procedure, subject to any restrictions or requirements imposed by legislation or the principles of fairness [*Knight v Indian Head School Division No 19*, [1990] 1 SCR 653 (SCC) at 685].

[16] In the present case, I ruled that the individual who was not the applicant's appointed agent could not make oral submissions. However, I indicated that I would entertain a request from the appointed agent to appoint the other trade-mark agent as associate or substitute agent if it was desired to have the second individual make all of the oral submissions.

[17] Natural justice's guaranty of a right to be heard dictates that agencies must ensure that their hearings provide parties with ample opportunity:

- 1) to know the case made against them;
- 2) to dispute, correct or contradict anything which is prejudicial to their positions; and
- 3) to present arguments and evidence supporting their own case.

Robert Macaulay & James Sprague, *Hearings before Administrative Tribunals*, 4th ed (Scarborough, Ont.: Thomson Carswell, 2010) at 12-12

[18] In the circumstances of this case, I do not accept that the Applicant's right to be heard has been compromised by my ruling. Trade-mark opposition proceedings allow for the filing of written submissions in addition to an oral hearing, but neither is mandatory. The Applicant filed thorough written submissions in this case, numbering 57 pages in length. Moreover, it is the practice at opposition oral hearings to have the opponent make its oral submissions first and I informed the Applicant's agent that we would recess after the Opponent made its submissions for as long as it reasonably wished, bearing in mind that the hearing was scheduled to conclude at 4:30 pm. The Applicant's oral submissions lasted approximately 2.5 hours (which was slightly longer than the Opponent's oral submissions) and I note that the second trade-mark agent remained available to assist the presenting agent at all times.

[19] The Applicant requested that, given my ruling restricting it to one agent, the hearing ought to have been postponed. Section X.6 of the above-mentioned Practice Notice states, “The Registrar will generally **not** grant any postponements of scheduled hearing dates.” In the circumstances of this case, I advised the Applicant that I would only postpone the hearing with the Opponent’s consent, which was not forthcoming. I note that it appeared that it would not be possible in any event to have the hearing rescheduled to a date in the immediate future.

Preliminary Comments

[20] A key issue in this proceeding is the likelihood of confusion between the Mark and the Opponent’s trade-mark PARMA, which is the subject of registration No. TMA179,637 for various meats. This issue has haunted the Applicant for at least 27 years when the first Examiner’s report issued against its application, citing registration No. TMA179,637 as the basis for the Mark being unregistrable pursuant to section 12(1)(d) of the Act. For 22 years the Applicant attempted to overcome the Examiner’s objection. It commenced section 45 proceedings, not once but twice, in an effort to have registration No. TMA179,637 expunged on the basis that the subject mark was not in use; it was successful only in having some of the specific meats originally listed in the Opponent’s statement of wares removed from the registration. It also unsuccessfully pursued an expungement action in the Federal Court pursuant to section 57 of the Act [*Consorzio Del Prosciutto Di Parma v Maple Leaf Meats Inc* (2001), 11 CPR (4th) 48 (FCTD), aff’d 18 CPR (4th) 414 (FCA)]. In the section 57 expungement action, the Applicant submitted that the registration should be expunged because i) the PARMA mark was not registrable when its registration issued in 1971 because it was deceptively misdescriptive and ii) the PARMA mark was not distinctive when the expungement action was commenced in 1997. The Court held that the Applicant did not discharge its onus and registration No. TMA179,637 was maintained. Of course, the validity of the Opponent’s registered trade-mark is not in issue in the present proceeding [see *Molson Canada 2005 v Anheuser-Busch, Incorporated* (2010), 82 CPR (4th) 169 (FC) at paragraph 61].

[21] At the oral hearing, the Opponent directed some comments to a letter dated September 15, 2003 submitted by the Applicant in the prosecution of its application, which resulted in the Examiner withdrawing the section 12(1)(d) objection on August 18, 2005 after having

maintained it for decades. The Opponent submits that the argument submitted by the Applicant in its September 15, 2003 letter was based on allegations of fact that are not supported by the evidence in the present proceeding and goes so far as to submit that the submissions were misleading. Concerning this, I think it is sufficient to note that a decision by the examination section of the Trade-marks Office is not binding on this Board and does not have precedential value for this Board. As stated in *Interdoc Corporation v Xerox Corporation*, (November 25, 1998 TMOB (unreported), application No. 786,491):

This Board is not in a position to explain findings by the examination section of the Trade-marks Office. Further, the examination section does not have before it evidence that is filed by parties in an opposition proceeding: see the Board decisions in *Thomas J. Lipton Inc v Boyd Coffee Co* (1991), 40 CPR (3d) 272 (TMOB) at 277 and *Procter & Gamble Inc v Morlee Corp* (1993), 48 CPR (3d) 377 (TMOB) at 386.

Onus

[22] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential 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 Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

Preliminary Issues

[23] Two issues have been raised by the Applicant based on the fact that the Mark is a certification mark. First, the Applicant submits that section 12(1)(d) does not apply to certification marks. Second, the Applicant submits that an analysis of confusion that considers whether the Mark would result in confusion as to source is not appropriate because a certification mark indicates character/quality, not source. As noted by the Applicant, there is not a large body of case law concerning certification marks to assist in addressing these issues.

applicability of section 12(1)(d) to certification marks

[24] The Opponent has pleaded that the Mark is not registrable pursuant to section 12(1)(d) of the Act because it is confusing with the trade-mark PARMA registered under No. TMA179,637,

but the Applicant has submitted that section 12(1)(d) does not support a valid ground of opposition with respect to a certification mark, in view of section 25 of the Act. I reproduce in the Appendix those sections of the Act that are relevant to the following discussion.

[25] Section 2 of the Act provides definitions of “trade-mark”, “certification mark” and “confusing”. Although “certification marks” are defined as marks that are used to distinguish wares/services of a defined standard, “trade-marks” are defined broadly to include both certification marks and marks that are used to distinguish wares/services of a single source.

[26] Sections 23 to 25 of the Act specifically relate to “certification marks” and discuss “Registration of certification marks”, “Registration of trade-mark confusing with certification mark”, and “Descriptive certification mark”, respectively. The Applicant submits that because section 25 refers to registrability, section 12(1)(d), which discusses “Registrability of Trade-marks”, does not apply to certification marks. In support, it relies upon *Sanna, Inc v Chocosuisse Union des Fabricants Suisses de Chocolat* (1986), 14 CPR (3d) 139 (TMOB). In particular, the Applicant relies upon the following paragraphs from page 142 of that decision:

Section 25 is clearly applicable in this present situation. The certification marks SWISS, SUISSE and SWITZERLAND are all in my view without question descriptive of the place of origin of wares from Switzerland and the Kuster affidavit establishes that the applicant is a commercial association having an office or representative in Switzerland.

Having regard to the presence of the words "and not confusing with any registered trade mark" in s. 25, I consider that it must have been intended that a certification mark registrable under s. 25 not be subject to being held unregistrable because of the provisions of s. 12. If it had been intended that such marks be subject to s. 12, they would necessarily have been subject to s. 12(1)(d) and the words "and not confusing with any registered trade marks" in s. 25 would not have been necessary.

[27] However, I consider the *Sanna* decision to be distinguishable. In *Sanna*, the applicant was applying to register marks that the Registrar stated were “without question descriptive of the place of origin of wares”; here it cannot be said that the Mark as a whole describes a place of origin. It is therefore not apparent that section 25 even applies to the Mark. In *Sanna*, the opponent was relying in part on section 12(1)(b) and it was appropriate that section 25 would apply as section 25 appears to carve out an exception to section 12(1)(b) for certification marks that are descriptive of a place of origin.

[28] *Fox on Canadian Law of Trade-marks and Unfair Competition* says:

[Section 25] has merely given a right to a minor and very limited type of registration. It did not conflict with s. 26(1)(c) or s. 29 of the old Act, nor does the present comparable provision conflict with s. 12(2) of the *Trade-marks Act*, under which a trader may obtain registration and the exclusive right to use a geographical trade-mark that is *prima facie* unregistrable in view of s. 12(1)(b). Section 25 merely permits registration of a trade-mark that is effective only to prevent its use by others outside the territorial area of which the mark is descriptive.

[Kelly Gill and Scott Jolliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition*, 4th ed (Carswell, 2001) at 5-76]

[29] I note that the Opponent referred to three cases that postdate *Sanna*, including a Federal Court of Appeal decision, which applied section 12(1) grounds of opposition against certification marks: *The Ministry of Commerce and Industry of the Republic of Cyprus v International Cheese Council of Canada* (2011), 93 CPR (4th) 255 (FCA), aff'ing 84 CPR (4th) 421 (FC); *Flowers Canada/Fleurs Canada Inc v Maple Ridge Florist Ltd* (1998), 86 CPR (3d) 110 (TMOB); and *Groupe Conseil Parisella, Vincello Associés Inc v CPSA Sales Institute* (2003), 31 CPR (4th) 308 (TMOB).

[30] Given that “trade-mark” includes “certification mark”, it seems reasonable to apply all sections that deal with trade-marks to certification marks, unless they are specifically contradictory to sections 23 to 25. In the present case, I see no contradiction that would prevent section 12(1)(d) from applying.

[31] The Opponent noted that the Applicant did at one point of time during the examination of the present application raise its section 25 argument; the Examiner did not respond to such argument and the Applicant continued to argue against the Examiner’s section 12(1)(d) objection on the basis that the Applicant considered confusion to not be likely.

[32] In addition, the Opponent has pointed out that in its counter statement, although the Applicant challenged the validity of some of the pleaded grounds, the Applicant did not challenge the validity of the section 12(1)(d) ground; instead the Applicant merely denied that the marks are confusing and pled that the Mark is registrable pursuant to section 12(1)(d). This also distinguishes the present case from *Sanna* since there the applicant’s counter statement

clearly indicated that it considered the section 12(1)(d) pleading to be deficient on the basis that section 25, not section 12(1)(d), applied.

[33] The Applicant directed me to *Fox* as well as the *Trade-marks Examination Manual* in support of its position that section 12 does not apply to certification marks. However, I do not consider either of those reference materials to support the Applicant's position. *Fox* discusses section 25 as an exception to the general proposition that geographical trade-marks are not *prima facie* registrable and states at page 5-76, "Opposition to registration [of a certification mark] proceeds on the same basis as opposition to an ordinary application." The *Manual* states at section 11.7.5.3 under the heading *Descriptive of Place of Origin – Section 25*, "An application for registration of a certification mark must satisfy essentially the same registrability requirements under section 12 as an application for an ordinary trade-mark."

confusion test re certification marks

[34] The Applicant has failed to convince me that the test of confusion set out in section 6 of the Act does not apply to certification marks. That section discusses when a trade-mark is confusing with a trade-mark, and a trade-mark includes a certification mark. I see nothing in the Act that suggests that confusion has a different meaning or test when one of the two trade-marks in question is a certification mark. I note that owners of certification mark registrations are entitled to oppose an application for a trade-mark relying on grounds of opposition that allege confusion such as section 12(1)(d) [*Wool Bureau of Canada, Ltd v Queenswear (Canada) Ltd* (1980), 47 CPR (2d) 11 (FCTD) at 16] and that section 25 concerning geographically descriptive certification marks refers to "confusing with any registered mark". "Confusing" has a single definition in the Act and nothing suggests that this definition does not apply to certification marks. I will add that this does not seem inappropriate given that a potential consumer may very well not be aware that a certification mark indicates a standard rather than a source.

Summary of Evidence and Objections Raised regarding the Reply Evidence

[35] The Applicant has submitted that the evidence filed by the Opponent pursuant to section 43 of the Regulations is not proper reply evidence. In order to assess this objection, I will first summarize the section 41 and 42 evidence.

section 41 evidence

[36] The affidavit that Mr. Grogan swore on July 16, 2008 explains that he is the Vice-President of Maple Leaf Consumer Foods Inc., a company that manufactures and sells PARMA meat products pursuant to a written license agreement from the Opponent. Mr. Grogan states that the Opponent exercises direct or indirect control of the character or quality of the wares sold by his company in association with the PARMA mark.

[37] Mr. Grogan attests that the Opponent's PARMA mark has been continuously used since as early as September 1958. He states that PARMA meat products are sold to numerous local and national retailers across Canada and that these retailers sell PARMA meat directly to consumers through their retail stores. He further states that the national retailers include most of the major grocery and supermarket chains in Canada, such as Metro, A & P, Sobey's, Safeway, and Loblaws, and that PARMA meat is also sold to various other independent retailers across Canada such as Dr. Deli and Sam's Club.

[38] Mr. Grogan provides current samples of labels and plastic wrapping bags for PARMA branded meat products, including sliced prosciutto (ham). He provides the volume of Canadian sales by kilograms of PARMA meat products for each of the years 2004 through 2007: 789,000; 792,000; 753,000; and 698,000 respectively.

[39] As shown in the certified copy of registration No. TMA179,637 (Exhibit A, Grogan affidavit), the PARMA mark was originally registered by Parma Food Products Limited in 1971; in 1982, the registration was assigned to Primo Foods Limited; in 1994, it was assigned to Principal Marques Inc.; and in 1997, it was assigned to Maple Leaf Meats Inc., which company was amalgamated into the Opponent in 2001. Mr. Grogan attests that most records of early sales by the Opponent's predecessors-in-title no longer exist. However, as Exhibit C Mr. Grogan provides a document that he says is a record of the use of the PARMA mark by the predecessor Parma Foods Limited, which he submits shows sales of PARMA meat products in Canada from 1978 to 1981. However, such document is merely a one-page annex typed on letterhead of Parma Food Products Ltd., which lists annual production weights of various meats; it does not show that the PARMA mark was used in accordance with section 4 of the Act.

[40] Mr. Grogan states that sample labels for PARMA meat products sold in Canada by another predecessor, Primo Foods Limited, are attached as exhibits to an affidavit of Anton T. Donkers, which was filed in 1991 in one of the section 45 proceedings initiated against registration No. TMA179,637. Mr. Grogan states that copies of the Donkers affidavit and exhibits are found in the certified file copy of the file history for the PARMA registration, which he attaches as Exhibit E. However, for reasons that are unclear, the certified copy contains the Donkers affidavit, but not its exhibits.

[41] I do not consider the rest of Mr. Grogan's affidavit to be noteworthy as he simply discusses the contents of the file histories of both the present application and the Opponent's registration No. TMA179,637, including the Applicant's attempts to expunge the Opponent's registration. I note however that in addition to the certified copy of the Trade-mark Office's file with respect to the Opponent's registration, he also provides a certified copy of the file with respect to the Applicant's application.

[42] The cross-examination of Mr. Grogan focused largely on the licensing of the PARMA trade-mark, the nature of the actual product associated with the PARMA mark, labels used in association with PARMA products, the channels of trade associated with the PARMA products, and Mr. Grogan's personal knowledge of certain facts that preceded his employment. I note that the Opponent refused to answer a number of questions on the basis that they sought confidential or irrelevant information.

section 42 evidence

[43] Mr. Fanti, a Director of the Applicant, divides his affidavit into 12 sections: introduction; special status of PROSCIUTTO DI PARMA under Italian law; recognition of PROSCIUTTO DI PARMA as a PDO ("Protected Designation of Origin"); Consorzio's legal mandates; essential requirements for PROSCIUTTO DI PARMA prosciutto; traceability standards; profile of PROSCIUTTO DI PARMA around the word; Consorzio's world-wide marketing efforts; Consorzio's U.S. marketing efforts; joint marketing efforts; Consorzio's world-wide enforcement efforts; and PROSCIUTTO DI PARMA prosciutto in Canada. In this summary, I will focus on the last section of his evidence, making reference to other sections now and later on only to the extent that I consider them to be significant.

[44] Mr. Fanti tells us that there is a City of Parma in the Province of Parma, Italy and that the Parma River flows through the City of Parma. He states that for at least his lifetime, the Province of Parma has been well-known within and outside Italy for a variety of food products including PARMIGIANO REGGIANO cheese and prosciutto.

[45] Mr. Fanti explains that the Applicant is an association of prosciutto producers, each of which is located in the Province of Parma in Italy. The Applicant was founded in 1963 and one of its earliest goals was to formalize the methodology of producing prosciutto in the province of Parma and to establish procedures for guaranteeing the quality thereof. It appears to have been very successful in that regard. It promulgated very specific rules for the production of prosciutto and permitted those prosciutti that complied with those rules to display the Mark. Use of the Mark is now governed and protected by Italian law and in 1996 the Mark was recognized as a PDO by the European Union. Prosciutto bearing the Mark has been sold in many countries and the Mark has been registered in many countries. For reasons that are not clear to me, the sale of Italian prosciutto was banned in the United States of America in the late 1960's [paragraph 67, Fanti affidavit] but importation into the U.S. resumed in September 1989. Since then the Mark has been used and promoted in the U.S. However, the Mark has not been used in Canada or directly promoted in Canada.

[46] Mr. Fanti attests at paragraph 97 that prosciutti sold to Canadians by the Applicant's members have never borne the Mark, apparently due to concerns that such use would result in an infringement action from the owner of the PARMA registration. There have been substantial Canadian sales of prosciutto that meet the standards set out in the present certification mark application starting in July 1997 but such prosciutti bear another mark owned by the Applicant, THE ORIGINAL PROSCIUTTO, plus the member's own mark(s). Caution must therefore be applied when reading some of Mr. Fanti's statements such as "Sales of PROSCIUTTO DI PARMA whole prosciutto commenced in Canada in July 1997" and "PROSCIUTTO DI PARMA prosciutto is the dominant Italian prosciutto in the Canadian market", as they must be interpreted in conjunction with his clear statement that prosciutto sold to Canadians has never borne the PROSCIUTTO DI PARMA mark.

[47] Mr. Fanti states in his affidavit that PROSCIUTTO DI PARMA is a premium product and that in markets in which it is sold, it is available at fine food retailers and restaurants (however, on cross-examination, he said that it is also sold to supermarkets and that the Applicant does not restrict where members sell the certified prosciutto).

[48] Mr. Fanti has expressed the view that a Canadian in the market for prosciutto will not think that the Mark has anything to do with the Opponent's PARMA products, but I cannot accord any weight to his opinion.

[49] The cross-examination of Mr. Fanti focused largely on the existence of other regions in Italy that make prosciutto and use marks (some of which are PDOs) owned by other consortiums, the lack of control by the Applicant on the channels of trade used by its members or the price at which their prosciutto is sold, the labels of the Applicant's members, and enforcement actions taken by the Applicant abroad.

[50] Mr. Goulanakis owns and operates a retail store that he believes has the largest selection of prosciutto in the Toronto area. He attests that they have sold prosciutto from Parma, Italy since 1997 and he identifies the trade-marks of five of such prosciutti, which he indicates have also born the mark THE ORIGINAL PROSCIUTTO. He attests that those five brands sell for \$5.50 or \$6.50 per 100 grams.

[51] Mr. Goulanakis' store also sells four brands of Canadian prosciutto, the price of which varies from \$2.99 to \$6.50 per 100 grams. Mr. Goulanakis did sell PARMA prosciutto at one point of time for several months and notes that it was not of high quality and was priced much lower than the Italian prosciutto.

[52] Mr. Goulanakis states that most of his customers are knowledgeable about foreign foodstuffs; his customers include consumers, hotel and restaurant chefs, caterers, foreign consulates and distributors. He states:

In my experience, purchasers of prosciutto are sophisticated shoppers. They know what they want. The key factors they are interested in are where the prosciutto was manufactured and how long it was aged. When they want to purchase Italian prosciutto they most frequently ask for PROSCIUTTO DI PARMA expressly. Sometimes they ask simply for "prosciutto" at which point I ask whether they

want Italian, Spanish or Canadian. If they want Italian, they respond “Prosciutto di Parma”.

[53] The last statement of Mr. Goulanakis above seems a bit curious as Mr. Fanti gave evidence that there are many prosciutti produced in Italy that are not PROSCIUTTO DI PARMA prosciutti.

[54] It is apparent from Mr. Goulanakis’ evidence, including his cross-examination, that his store offers a high level of service to its clients and that he and his staff interact a lot with their clientele.

[55] The cross-examination of Mr. Goulanakis focused largely on the differences between the retail experience customers encounter in his store as opposed to at a supermarket like Loblaws or a Costco wholesaler and the various brands of prosciutti that his store sells.

[56] Mr. Stephan, a licensed private investigator, provides the results of various electronic searches that he conducted including: a search of the Toronto Public Library’s collection for “Cookery, Italian”; a search of *www.chapter.indigo.ca* for “italian cooking”; a search of *www.cook-book.com* for “International-Italy” etc. Mr. Stephan also provided information obtained from Statistics Canada’s website concerning the number of Canadians who reported having Italian ethnic origin and the number of Canadians travelling to the U.S.A. As neither party has made submissions based upon such evidence, I shall not address those portions of his evidence further.

[57] Mr. Stephan also conducted searches for PROSCIUTTO DI PARMA on various websites. I do not consider these results to be useful to the Applicant for two main reasons: 1) the websites are not Canadian and there is no evidence that any Canadians have ever accessed them [see *Generation Nouveau Monde Inc v Teddy SPA* (2006), 51 CPR (4th) 385 (TMOB) at para 15]; and 2) the appearances of the words PROSCIUTTO DI PARMA are primarily in ingredient lists for recipes and might very well be interpreted generically, rather than as a trade-mark, e.g. “5 thin slices of prosciutto di Parma, roughly sliced...”.

[58] Mr. Stephan also attended at two retail stores in Ontario in 2009 and reports on the brands and prices of various prosciutti that he saw there, none of which bore either of the marks at issue.

[59] Mr. Pollock, a private investigator, attended at certain retail establishments in Calgary in 2009 (including a Sobeys and Safeway) and attests that he did not see any PARMA meat.

[60] Mr. Brockbank, a private investigator, visited various grocery stores in Ontario in 2009 and looked for PARMA products. Stores where he was unable to find such products, and was told that they did not carry PARMA products, included Metro, Sobeys, Sam's Club, and Loblaws. However, he did confirm that six different Safeway stores carried the Opponent's PARMA prosciutto.

[61] Mr. Vincelette, a private investigator, purchased the Opponent's PARMA meat products at three stores in Quebec in 2009: Metro Plus Marche Depatie Inc; Intermarche Palumbo; and IGA Marché Joannette. However, he also visited 19 other stores where he was not able to find PARMA meat, including three Metro stores and two Loblaws stores.

[62] Ms. Brehl, a vice-president of Audit Bureau of Circulations, provides Canadian circulation figures for a number of the foreign magazines that Mr. Fanti stated contained "advertisements featuring PROSCIUTTO DI PARMA prosciutto and PARMIGIANO REGGIANO cheese" in 2006, 2007 and 2008.

[63] Ms. Hetherington's affidavit is merely an affidavit of service.

section 43 evidence

[64] Mr. Grogan's reply affidavit was sworn on September 8, 2010.

[65] He begins by saying that the Brockbank, Vincelette and Pollock affidavits appear to suggest that the Opponent's PARMA meat products are not widely distributed or available in Canada. He states that in reply, and in order to provide direct and clear evidence on the issue, he is providing greater detail concerning the nature and extent of the sales and distribution of the PARMA products in Canada. He then provides updated sales volume figures (for 2008-2010),

confirms that the mode of sale and distribution has not changed (although he now lists additional national retailers), informs us that the Opponent does not sell PARMA meat through Costco (but does sell another brand of meat there), and provides numerous invoices, all dated 2009, for sales of PARMA product to various grocery stores, in Quebec, Ontario, Alberta and Saskatchewan. He states that the invoices demonstrate that PARMA products are sold in many of the regions and cities visited by the private investigators. I will accept this evidence as proper reply evidence. I agree with the Opponent that the investigators' evidence appeared to demonstrate that there was not much of a market presence of the Opponent's PARMA products in 2009, suggesting either that the section 41 evidence was misleading or that the Opponent's market activity had changed by 2009. As the investigators' evidence related to a date after the section 41 evidence, it was not possible for the Opponent to have dealt with this issue as evidence in chief.

[66] Mr. Grogan then states that it is relevant that the Applicant has made a third attempt to expunge the PARMA registration. He provides a copy of the affidavit that he swore on May 27, 2008 in response to the notice issued under section 45 on September 28, 2007, but I do not see how a copy of that affidavit can be proper reply evidence. (I note however that the Grogan affidavit of May 27, 2008 also appears as part of the certified copy of the Trade-mark Office's file provided as Exhibit E to the affidavit that Mr. Grogan filed pursuant to section 41.)

[67] In reply to the evidence of Mr. Stephan and Mr. Goulanakis concerning the price of various prosciutti, Mr. Grogan provides the typical retail price of PARMA prosciutto. The Applicant's position is that Mr. Grogan could have provided this evidence in chief and it points out that when it asked for the prices of the Opponent's products during the cross-examination of Mr. Grogan, such requests were refused. I tend to agree with the Applicant that this evidence is not proper reply evidence, but as will be discussed further later, I do not consider the price of the Opponent's product to be significant. I am disregarding paragraph 11 of Mr. Grogan's second affidavit.

[68] Mr. Grogan also provides evidence directed in reply to a statement by Mr. Fanti concerning the cancellation of the Opponent's registration for MAPLE LEAF PARMA in Japan. Although I do not consider the Japanese action to be particularly significant to the issues at hand, I accept Mr. Grogan's evidence regarding same as proper reply evidence.

[69] I also accept paragraph 17, Mr. Grogan's response to the Heatherington affidavit, as proper reply evidence.

[70] The final paragraph of Mr. Grogan's affidavit refers to his cross-examination on his section 41 affidavit. It reads: "The examination was conducted on June 1, 2009. The Applicant filed the transcripts on June 14, 2009, not giving us sufficient time to provide our answers to undertakings and to provide our position on questions taken under advisement. A copy of my answers to those questions and undertakings is attached as Exhibit N hereto." The Applicant has submitted that, at the very least, the Opponent should have provided these answers to the Applicant well prior to the deadline for submission of the Applicant's section 42 evidence, namely October 14, 2009.

[71] It is not apparent why the Applicant filed the transcript and did not request an extension of time to receive and file the answers to undertakings *etc.* In accordance with section 44(4) of the Regulations, the answers *etc.* could be filed only by the Applicant. On June 23, 2009, the Opponent did write to the Board and indicated that it was unable to prepare the answers in the short period of time that was available prior to the Applicant's deadline of June 14, 2009, but that Mr. Grogan was working on compiling the answers *etc.* It went on to state that the Opponent intended to fully respond to the undertakings and questions taken under advisement, and that if the Applicant had approached it for consent to extend the deadline for filing the answers, it would have consented. Finally, the Opponent stated that "we will file our response as soon as the answers are compiled and will request leave to file the answers in the form of a supplementary affidavit if necessary." Section 44(4) precluded the Opponent from merely filing the answers, but it is unclear why the Opponent did not proceed with an affidavit under section 44(1) of the Regulations; it may well have succeeded in having the answers form part of the record if it had taken that approach. However, as the answers are not proper reply evidence, I am disregarding them. That said, in the circumstances of this case, I am not prepared to draw any negative inferences based on the failure of the Opponent to provide answers to undertakings.

[72] The Applicant also objected to the Robitaille and Harper affidavits as improper reply evidence.

[73] Mr. Robitaille, an employee of the Opponent, states that his affidavit is in reply to Mr. Vincelette's affidavit. However, the main focus of the Robitaille affidavit seems to be to demonstrate that the Opponent's PARMA products have been sold "alongside prosciutto products that are made in Italy and elsewhere, including prosciutto from producers who are members of the [Applicant]." I do not see how this is in response to Mr. Vincelette's evidence and therefore am disregarding the Robitaille affidavit.

[74] Ms. Harper, a licensed private investigator, reports on her visits to two stores in Ontario where she purchased presliced prosciutto from refrigerator sled displays, that did not require a customer to speak with or obtain the assistance of an employee to take and purchase one of the pre-prepared packages. Some of this prosciutto bore the trade-mark THE ORIGINAL PROSCIUTTO and a statement that it was authorized by the Applicant. While it is true that Ms. Harper has not identified the specific evidence to which she is replying, it is clear to me that she is addressing the issue introduced by the Applicant's evidence to the effect that the nature of its wares are such that assistance is generally given to a purchaser at the point of sale. Contrary to the Applicant's written submissions, I do not see how this is evidence that ought to have been provided in chief. I therefore find it to be admissible.

Grounds of Opposition Based on a Likelihood of Confusion Between the Parties' Marks

[75] The Opponent has pleaded grounds of opposition that turn on the issue of confusion between the Mark and the Opponent's PARMA trade-mark under sections 30(i), 12(1)(d), 16(1), 16(2), 16(3) and 38(2)(d)/2, as summarized below:

- contrary to section 30(i), the Applicant's statement of entitlement was not substantively justifiable as the Applicant could not have been satisfied, at the date of filing of the application, that it was entitled to use the Mark in Canada since the Mark was confusing with the registered PARMA trade-mark owned and previously used in Canada by the Opponent's predecessor-in-title
- contrary to section 12(1)(d), the Mark is confusing with the Opponent's registered PARMA trade-mark, registration No. TMA179,637

- contrary to section 16(1)(a), the Applicant is not a person entitled to register the Mark because at the date of first use of the Mark, the Mark was confusing with the Opponent's PARMA trade-mark, which had been previously used in Canada by the Opponent's predecessor-in-title in association with "meats, namely salami, capicollo, pepper butts, pepperoni, dry sausage, mortatella, ham"
- contrary to section 16(2)(a), the Applicant is not a person entitled to register the Mark because as of the date of the application, the Mark was confusing with the Opponent's PARMA trade-mark, which had been previously used in Canada by the Opponent's predecessor-in-title in association with "meats, namely salami, capicollo, pepper butts, pepperoni, dry sausage, mortatella, ham"
- contrary to section 16(3)(a), the Applicant is not a person entitled to register the Mark because as of the date of the application, the Mark was confusing with the Opponent's PARMA trade-mark, which had been previously used in Canada by the Opponent's predecessor-in-title in association with "meats, namely salami, capicollo, pepper butts, pepperoni, dry sausage, mortatella, ham"
- the Mark is not distinctive within the meaning of section 2 because, in light of the prior use of the Opponent's PARMA trade-mark by the Opponent and its predecessors-in-title, the Mark cannot actually distinguish the wares in association with which it is proposed to be used from the wares of the Opponent and its predecessors-in-title, nor is it adapted so to distinguish them.

[76] I am dismissing the section 30(i) ground because the Applicant has provided the statement required by section 30(i) and there is no evidence of bad faith on the part of the Applicant [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155].

[77] I am also dismissing the sections 16(1)(a) and 16(3)(a) grounds on the basis that they do not plead valid grounds of opposition. Section 16(1) concerns applications based on use or making known in Canada and section 16(3) concerns application based on proposed use. As the present application is currently based solely on use and registration of the Mark abroad, sections 16(1)(a) and 16(3)(a) do not apply.

[78] In order to meet its initial burden under section 16(2)(a), the Opponent must evidence that it or a predecessor used its PARMA mark in Canada prior to October 19, 1984 and had not abandoned it as of January 24, 2007 (section 16(5)). To that end, I will consider Mr. Grogan's evidence.

[79] Mr. Grogan provides a bald statement that the PARMA mark has been used in Canada by the Opponent or its predecessors continuously since as early as September 1958. He has filed a certified copy of the PARMA registration which contains that same use claim, but the mere filing of a certificate of registration of a trade-mark is not sufficient to meet the initial onus on an opponent to prove prior use of its trade-mark under a section 16 ground of opposition [see *Roos, Inc v Edit-SRL* (2002), 23 CPR (4th) 265 (TMOB)].

[80] As Exhibit C, Mr. Grogan provides a document that he states shows sales by the predecessor Parma Foods Products Limited of various meat products in Canada in association with the PARMA trade-mark from 1978 to 1981. However, as discussed earlier, that document does not show that the PARMA mark was being used at that time in accordance with section 4 of the Act.

[81] As the Opponent's evidence does not enable me to conclude that there was use of PARMA in Canada in accordance with section 4 of the Act prior to October 19, 1984, the section 16(2)(a) ground is also dismissed.

[82] The Opponent's initial burden is satisfied regarding its section 12(1)(d) ground of opposition if the pleaded registration is extant as of the date of my decision. I have exercised the Registrar's discretion to check the Register and confirm that registration No. TMA179,637 is extant. Its statement of wares currently reads: "meats namely salami, capicollo, pepperoni, mortatella, ham." I will therefore now assess the likelihood of confusion between the marks as of today's date, pursuant to the section 12(1)(d) ground of opposition.

[83] 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. The test for confusion is one of first impression and imperfect recollection.

[84] In applying the test for confusion, the Registrar must have regard to all the surrounding circumstances, including those specifically enumerated in section 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. [See, in general, *Mattel, Inc v 3894207 Canada Inc* (2006), 49 CPR (4th) 321 (SCC), *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée* (2006), 49 CPR (4th) 401 (SCC) and *Masterpiece Inc v Alavida Lifestyles Inc* (2011), 92 CPR (4th) 361 (SCC).]

[85] In *Masterpiece*, the Supreme Court began its consideration of the section 6(5) factors by considering the degree of resemblance between the marks and I shall follow its approach.

the degree of resemblance between the marks

[86] At paragraph 64 of *Masterpiece*, in his analysis of the degree of resemblance between the marks MASTERPIECE LIVING and MASTERPIECE THE ART OF LIVING, Rothstein J. stated:

While the first word may, for purposes of distinctiveness, be the most important in some cases, I think a preferable approach is to first consider whether there is an aspect of the trade-mark that is particularly striking or unique. Here there is nothing striking or unique about the word "Living" or the words "the Art of Living". "Masterpiece" is the word that distinguishes Alavida and Masterpiece Inc. from other sources of retirement residence services. It is a reasonable conclusion that "Masterpiece" is the dominant word in these trade-marks, and it is obviously identical as between Alavida and Masterpiece Inc. By the same token, in the context of the retirement residence industry, the idea evoked by the word "Masterpiece", high quality retirement lifestyle, is the same for both Alavida and Masterpiece Inc. Finally, the word "Living" is identical as between the Alavida and Masterpiece Inc. trade-marks.

[87] Following his approach to first consider whether there is an aspect of the trade-mark that is particularly striking or unique, I find that it is the word PARMA that is most striking in the

Mark, given that the word PROSCIUTTO cannot be particularly striking with respect to the wares “prosciutto” and DI is not a dominant element of the Mark.

[88] I note that the Opponent submits that the Applicant’s own evidence/activities support the conclusion that PARMA is the significant portion of the Mark because outside of Canada the Applicant has relied on the Mark to object to the use of trade-marks that include the word PARMA [page 87, Fanti cross-examination]. I do not find it necessary to rely on such evidence to reach my conclusion about the most striking aspect of the Mark, but I acknowledge the Opponent’s point that elsewhere in the world, the Applicant may have taken a position contrary to that taken in Canada.

[89] At paragraph 104 of *Masterpiece*, Rothstein J. stated:

Without repeating the findings above, there is no doubt that there is a strong resemblance between Masterpiece Inc.'s trade-mark, "Masterpiece the Art of Living" and Alavida's trade-mark, "Masterpiece Living". In my opinion, a casual consumer observing the Alavida trade-mark and having no more than an imperfect recollection of Masterpiece Inc.'s trade-mark would likely be confused into thinking that the source of the services associated with the Alavida trade-mark was one and the same as the source of the services associated with the Masterpiece Inc. trade-mark. The question now is whether any of the other circumstances reduce this likelihood of confusion to the point that confusion is not likely to occur.

[90] I have similarly concluded that there is a strong resemblance between PARMA and PROSCIUTTO DI PARMA and that on such basis a casual consumer observing the Mark and having no more than an imperfect recollection of the Opponent’s mark would likely be confused into thinking that the source of the prosciutto associated with the Mark was the same as the source of the prosciutto associated with the Opponent’s mark. Therefore, according to the Supreme Court, the question now is whether any of the other circumstances reduce this likelihood of confusion to the point that confusion is not likely to occur.

inherent distinctiveness of the marks

[91] Neither mark is inherently distinctive. As submitted by the Applicant, the following entries appear in *The Canadian Oxford Dictionary*:

Parma 1. a province of N Italy, south of the Po River in Emilia-Romagna. 2. its capital

Parma ham *noun* a type of smoked ham which is eaten uncooked.

[92] That dictionary also contains the following entry:

prosciutto *noun* Italian cured ham, usu. served raw and thinly sliced as an hors d'oeuvre.

the extent to which each mark has become known

[93] The distinctiveness of a trade-mark can be enhanced through its use or promotion in Canada. Use of a trade-mark is defined in section 4 of the Act.

[94] The Mark has not been used in Canada. However, the Applicant has introduced some evidence of spill-over advertising.

[95] As part of a joint campaign that took place in the U.S. from 2006 to 2008, advertisements featuring both PROSCIUTTO DI PARMA prosciutto and PARMIGIANO REGGIANO cheese were placed in certain magazines and newspapers. Copies of ads used in the course of the campaign were provided as Mr. Fanti's Exhibits W and X. Mr. Fanti also provided lists of publications in which advertisements were placed in each of the years 2006, 2007 and 2008; however, I cannot tell from the evidence if each publication contained an ad only once or multiple times in each year. Ms. Brehl has provided Canadian circulation figures for some of the publications in which the ads appeared. For example, she provides Canadian circulation figures for 2006 editions of *Food & Wine*, *Bon Appétit*, *Real Simple*, *Cookie*, and *Conde Nast Traveler* magazines, namely approximately 14,000, 40,000, 60,000, 2,000, and 20,000, as well as similar information for the years 2007 and 2008. I also note that in 2006, at least one ad was placed in the *New York Times* newspaper and I can take judicial notice that there is some Canadian circulation of famous U.S. newspapers, such as the *New York Times* [see *H-D Michigan Inc v MPH Group Inc* (2004), 40 CPR (4th) 245 at 256 (TMOB)].

[96] Based on the foregoing, it appears that the Mark has acquired some reputation in Canada through spill-over advertising.

[97] In excess of 3 million kilograms of the Opponent's PARMA branded meat products were sold in Canada in the years 2004-2007 (approximately 700,000 kg per year) and the labels provided by Mr. Grogan show that the PARMA mark has been used in accordance with section 4 of the Act. There is no evidence that the Opponent has advertised its mark in Canada but use of the PARMA mark on 3 million kilograms of meat products is sufficient for me to conclude that the PARMA mark has acquired some reputation in Canada. The section 41 evidence enables me to reach this conclusion but of course the reputation can be considered to be greater if one also considers the sales evidenced in the section 43 evidence.

[98] Overall, I find that both parties' marks are known to some extent in Canada.

the length of time the marks have been in use

[99] According to the certified copy of registration TMA179,637, the PARMA mark has been used in Canada since at least as early as September 18, 1958, but such evidence allows me to assume only *de minimis* use of the Opponent's trade-mark [see *Entre Computer Centers, Inc v Global Upholstery Co* (1991), 40 CPR (3d) 427 (TMOB)]. It is true that Mr. Grogan states that the PARMA mark has been used since as early as September 1958 but that is a bald statement which does not enable me to reach a conclusion that the PARMA mark has been used since September 1958 in accordance with section 4 of the Act. There is however evidence concerning sales of the Opponent's PARMA wares from 2004.

[100] This factor necessarily favours the Opponent as the Applicant has not used the Mark in Canada.

the nature of the wares, services, business and trade

[101] 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 registration that govern in respect of the issue of confusion arising under section 12(1)(d) [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); *Miss Universe, Inc v Dale Bohna* (1984), 58 CPR (3d) 381 (FCA)].

[102] Both parties' marks are associated with meat, in particular ham. Moreover, the type of ham associated with both parties' marks is prosciutto. Although the Applicant has introduced extensive evidence concerning the requirements that prosciutto must meet in order to qualify to display its Mark, the fact remains that "ham" in the statement of wares in the Opponent's registration is an unrestricted term that could include the type of prosciutto that meets the Applicant's standards.

[103] The Applicant has also put in extensive evidence concerning where and how the two parties' wares are sold, but the fact remains that their wares could be sold side by side in an environment where there is no one standing by to explain their differences. The application does not restrict where prosciutto bearing the Mark may be sold and Mr. Fanti testified that the Applicant does not control its licensees' channels of trade. Moreover, Mr. Goulanakis' evidence is that he has sold both parties' wares in his store.

[104] At paragraph 48 of its written argument, the Applicant states that Mr. Goulanakis' customers "are sophisticated shoppers who are knowledgeable about foreign foodstuffs." The Applicant has emphasized that many food specialists are familiar with the Applicant's Mark, but that does not preclude the likelihood of the average Canadian consumer who has an imperfect recollection of PARMA from being confused upon first seeing PROSCIUTTO DI PARMA. In this regard, I note that the Supreme Court in *Masterpiece* reiterated at paragraph 40 an earlier statement of the Supreme Court in *Veuve Cliquot*, namely: "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] at a time when he or she has no more than an imperfect recollection of the [prior trade-mark], and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks." (my underlines)

[105] The Applicant has emphasized that its prosciutto is of a high quality and demands a higher price than the Opponent's prosciutto but I do not accept that such differences are a significant factor with respect to the issue of confusion. In addition, I note the Opponent's submission that focusing on price is contrary to the first impression test set out in *Masterpiece*.

other surrounding circumstances

[106] As a further surrounding circumstance, the Applicant has submitted that a negative inference should be drawn from the lack of evidence of confusion “despite 14 years of sales of prosciutto certified by the Consorzio” (paragraph 174, Applicant’s written argument). In support thereof, the Applicant submits that there have been substantial sales of whole leg prosciutto hams sold in Canada that have been literally branded with a brand that consists of a crown over the word Parma (the Ducal Crown brand), because every leg that meets the Applicant’s standards in Italy is so branded.

[107] I do not see the Ducal Crown brand on any of the materials provided with respect to Canada. I acknowledge that prosciutto certified by the Applicant is sold both pre-sliced and as whole legs and that sales of such whole prosciutto in Canada has been significant. However, as submitted by the Opponent at the oral hearing, there is no evidence showing the Ducal Crown brand appearing on prosciutto sold in Canada; the Opponent further submitted that if it is present on the legs, then there is no evidence that purchasers see the Ducal Crown brand when they purchase the prosciutto. The Opponent submits that prosciutto legs are wrapped when they are sold and bear labels such as those provided by Mr. Fanti as Exhibit AA, which the Opponent submits would cover the leg. I note that Mr. Goulanakis makes no mention of the Ducal Crown brand, nor does Mr. Stephan in his discussion of various brands of prosciutto that he observed in Canadian stores.

[108] Overall, I find that the evidence concerning the use or reputation of the Ducal Crown brand in Canada is limited. In any event, the Ducal Crown brand cannot be the basis of an argument that a negative inference should be drawn from the lack of evidence of confusion. The Ducal Crown brand is not one of the marks at issue in this proceeding and an adverse inference based on a lack of evidence of confusion may only be drawn where there is extensive concurrent use of the marks at issue, which is not the case at hand [*Christian Dior SA v Dion Neckwear Ltd* (2002), 20 CPR (4th) 155 (FCA) at para. 19].

conclusion re section 12(1)(d) ground

[109] Having considered all of the surrounding circumstances, I have concluded that the Applicant has not satisfied me that there is not a reasonable probability of confusion between the marks at issue. In particular, as directed by *Masterpiece*, I have concluded that none of the other circumstances reduce the likelihood of confusion predicated on section 6(5)(e) to the point that confusion is not likely to occur.

[110] As impressive as the history and reputation of the Mark may be elsewhere in the world, the fact remains that in Canada the Opponent owns a mark that has not only been registered for more than 40 years but is currently in active use, whereas the Applicant has not yet used the Mark in Canada. The parties' wares overlap, as do their channels of trade, and the Applicant's Mark contains the Opponent's mark in its entirety. While I might agree that the Opponent's registered mark should not be given a broad scope of protection, I have concluded that the Mark is insufficiently distinguished from the Opponent's registered mark to fall outside the registered mark's scope of protection.

[111] For all of the foregoing reasons, the section 12(1)(d) ground of opposition succeeds.

section 38(2)(d)/2 Ground of Opposition

[112] The Opponent has pleaded that the Mark is not distinctive because, in light of the prior use of the Opponent's PARMA mark, the Mark cannot actually distinguish the wares in association with which the Mark is proposed to be used by its licensees from the wares of the Opponent, nor is it adapted so to distinguish them.

[113] The material date for assessing confusion under this ground is the filing date of the opposition, June 26, 2007 [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 34 CPR (4th) 317 (FC)]. In order to meet its initial burden under this ground, the Opponent's PARMA mark must have been known in Canada to some extent at least as of June 26, 2007 [*Bojangles' International LLC v Bojangles Café Ltd* (2006), 48 CPR (4th) 427 (FC)]. Mr. Grogan's details of the volume of PARMA branded meat products sold in Canada during each of the years 2004, 2005 and 2006 satisfies the Opponent's initial burden.

[114] I have concluded that the distinctiveness ground should succeed for reasons similar to those discussed with respect to the section 12(1)(d) ground of opposition. In fact, the Opponent's distinctiveness ground is stronger than its section 12(1)(d) ground. In *Consortio Del Prosciutto Di Parma* at paragraph 28, the Federal Court, Trial Division stated:

...MacGuigan J.A. made reference to the irrelevancy of the "spillover" effect in *Philip Morris Inc. v. Imperial Tobacco Ltd. (No. 1)* (1987), 17 C.P.R. (3d) 289 (F.C.A.). At 296, he cites Tomlin J.'s enunciation of the law in *Imper Electrical Ltd. v. Winbaum* (1927), 44 R.P.C. 405 at 410:

"For the purpose of seeing whether the mark is distinctive, it is to the market of this country alone that one has to have regard. For that purpose foreign markets are wholly irrelevant, unless it be shown by evidence that in fact goods have been sold in this country with a foreign mark on them, and that the mark so used has thereby become identified with the manufacturer of the goods."

[115] Thus it appears that any spill-over evidence is irrelevant in assessing the distinctiveness of the Mark. Even if this was not the case, the Opponent's case would still have been stronger because I would not have considered under this ground any ads which spilled over after 2006 given that it is not clear if such predated the material date of June 26, 2007.

Section 38(2)(a)/30(f) Ground of Opposition

[116] The Opponent has pleaded that the application contravenes section 30(f) of the Act for two reasons: i) the allegation that the Applicant has used the Mark in Italy is inconsistent with the requirement that the Applicant not be engaged in the manufacture, sale, leasing or hiring of wares such as those in association with which the certification mark is used; and ii) the application does not contain a statement that the Mark has been in use in Canada as required.

[117] Section 30(f) reads:

30. An applicant for the registration of a trade-mark shall file with the Registrar an application containing ...

(f) in the case of a certification mark, particulars of the defined standard that the use of the mark is intended to indicate and a statement that the applicant is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used;

[118] I am dismissing the section 30(f) ground of opposition in its entirety. The application specifically states that the Applicant is not engaged in manufacturing *etc.* and it is clear that the reference to the Applicant's use in Italy is referring to the use by others in accordance with the set standards. Also, contrary to the Opponent's claim, section 30(f) does not require a certification mark to have been used in Canada. I note that the Applicant in fact pleaded that the second arm of the pleading did not present a valid ground of opposition.

Disposition

[119] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application pursuant to section 38(8) of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Appendix

Sections of the Act:

2. Definitions - In this Act,

“certification mark” means a mark that is used for the purpose of distinguishing or so as to distinguish wares or services that are of a defined standard with respect to

- (a) the character or quality of the wares or services,
- (b) the working conditions under which the wares have been produced or the services performed,
- (c) the class of persons by whom the wares have been produced or the services performed, or
- (d) the area within which the wares have been produced or the services performed,

from wares or services that are not of that defined standard;

“confusing”, when applied as an adjective to a trade-mark or trade-name, means a trade-mark or trade-name the use of which would cause confusion in the manner and circumstances described in section 6;

...

“trade-mark” means

- (a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish wares or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others,
- (b) a certification mark,
- (c) a distinguishing guise, or
- (d) a proposed trade-mark;

...

“use”, in relation to a trade-mark, means any use that by section 4 is deemed to be a use in association with wares or services;

...

4. When deemed to be used - (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

...

6. When mark or name confusing - (1) For the purposes of this Act, a trade-mark or trade-name is confusing with another trade-mark or trade-name if the use of the first mentioned trade-mark or trade-name would cause confusion with the last mentioned trade-mark or trade-name in the manner and circumstances described in this section.

(2) The 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.

(3) The use of a trade-mark causes confusion with a trade-name if the use of both the trade-mark and trade-name in the same area would be likely to lead to the inference that the wares or services associated with the trade-mark and those associated with the business carried on under the trade-name are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(4) The use of a trade-name causes confusion with a trade-mark if the use of both the trade-name and trade-mark in the same area would be likely to lead to the inference that the wares or services associated with the business carried on under the trade-name and those associated with the trade-mark are manufactured, sold, leased, hired or performed by the same person, whether or not the wares or services are of the same general class.

(5) In determining whether trade-marks or trade-names are confusing, the court or the Registrar, as the case may be, shall have regard to all the surrounding circumstances including

- (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 the trade-marks or trade-names have 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.

12. When trade-mark registrable - (1) Subject to section 13, a trade-mark is registrable if it is not

(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

(c) the name in any language of any of the wares or services in connection with which it is used or proposed to be used;

(d) confusing with a registered trade-mark;

...

CERTIFICATION MARKS

23. Registration of certification marks - (1) A certification mark may be adopted and registered only by a person who is not engaged in the manufacture, sale, leasing or hiring of wares or the performance of services such as those in association with which the certification mark is used.

(2) *Licence* - The owner of a certification mark may license others to use the mark in association with wares or services that meet the defined standard, and the use of the mark accordingly shall be deemed to be use thereof by the owner.

(3) *Unauthorized use* - The owner of a registered certification mark may prevent its use by unlicensed persons or in association with any wares or services in respect of which the mark is registered but to which the licence does not extend.

(4) *Action by unincorporated body* - Where the owner of a registered certification mark is an unincorporated body, any action or proceeding to prevent unauthorized use of the mark may be brought by any member of that body on behalf of himself and all other members thereof.

24. Registration of trade-mark confusing with certification mark - With the consent of the owner of a certification mark, a trade-mark confusing with the certification mark may, if it exhibits an appropriate difference, be registered by some other person to indicate that the wares or services in association with which it is used have been manufactured, sold, leased, hired or performed by him as one of the persons entitled to use the certification mark, but the registration

thereof shall be expunged by the Registrar on the withdrawal at any time of the consent of the owner of the certification mark or on the cancellation of the registration of the certification mark.

25. Descriptive certification mark - A certification mark descriptive of the place of origin of wares or services, and not confusing with any registered trade-mark, is registrable if the applicant is the administrative authority of a country, state, province or municipality including or forming part of the area indicated by the mark, or is a commercial association having an office or representative in that area, but the owner of any mark registered under this section shall permit the use of the mark in association with any wares or services produced or performed in the area of which the mark is descriptive.