

IN THE MATTER OF AN OPPOSITION by Société des Produits Nestle S.A. and Perugina S.p.A. to application No. 595,703 for the trade-mark PATCHI & Design filed by Choucair Patchi Co.

On November 18, 1987, the applicant, Choucair Patchi Co., filed an application to register the trade-mark PATCHI & Design, a representation of which appears below, based upon use and registration of the trade-mark in Lebanon in association with "wedding party favours and boxes of sweets, drops and chocolate".

The applicant's application was advertised for opposition purposes in the Trade-marks Journal on May 24, 1989 and the opponents, Société des Produits Nestle S.A. and Perugina S.p.A., filed a statement of opposition on September 25, 1989. In their statement of opposition, the opponents alleged the following grounds of opposition:

(a) That the applicant's application does not comply with Section 30(a) of the Trade-marks Act in that the application does not contain a statement in "ordinary commercial terms" of the specific wares;

(b) That the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act in that the applicant's trade-mark is confusing with the following registered trade-marks of the opponent, Société des Produits Nestle S.A.:

| <u>Trade-mark</u> | <u>Registration No.</u> |
|---|-------------------------|
| PERUGINA BACIO PERUGIA ITALIA & Design | 137,989 |
| BACI PERUGINA & Design | 138,098 |

Regn. No. 137,989

Regn. No. 138,098

(c) That the applicant is not the person entitled to registration of the trade-mark in that, as of the applicant's filing date, the applicant's trade-mark was confusing with the registered trade-marks noted above, as well as with the trade-mark BACI. Each of the trade-marks was in use in Canada prior to the applicant's filing date by Perugina S.p.A.;

(d) That the applicant's trade-mark is not distinctive in that the applicant's trade-mark is confusing with the trade-marks of the opponents, referred to above.

The applicant served and filed a counter statement in which it denied the allegations set forth in the statement of opposition.

The opponents filed as their evidence the affidavits of Dr. Estevan Giannoni, Joseph Dattoli, Griffin Thompson, Pina Bucci and Elizabeth Bryson. Dr. Giannoni and Ms. Bryson were cross-examined on their affidavits, the transcripts of the cross-examinations together with the undertakings provided by the opponents forming part of the opposition record. Ms. Bucci failed to attend for cross-examination on her affidavit and her affidavit was subsequently withdrawn by the opponents.

The applicant filed as its evidence the affidavits of David Seed and Samir Murr. While the opponents requested and were issued an order for the cross-examination under oath of Messrs. Seed and Murr, the opponents did not pursue the cross-examinations. However, the opponents submitted an affidavit of Brian Hugh Edgar as evidence in reply to the affidavit of David Seed.

Both parties submitted written arguments and the opponents alone were represented at an oral hearing.

Considering initially the ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the opponents asserted that there would be a reasonable likelihood of confusion between the applicant's trade-mark PATCHI & Design and the registered trade-marks BACI PERUGINA & Design, registration No. 138,098 and PERUGINA BACIO & Design, registration No. 137,989. With respect to a ground of opposition based on Section 12(1)(d) of the Trade-marks Act, the material date would appear to be as of the date of my decision (see Park Avenue Furniture Corporation v. Wickes/Simmons Bedding Ltd. and The Registrar of Trade Marks, 37 C.P.R. (3d) 413 (FCA) and

Conde Nast Publications, Inc. v. The Canadian Federation of Independent Grocers, 37 C.P.R. (3d) 538 (TMOB)).

In determining whether there would be a reasonable likelihood of confusion between the trade-marks at issue within the scope of Section 6(2) of the Trade-marks Act, the Registrar must have regard to all the surrounding circumstances, including, but not limited to, those which are specifically enumerated in Section 6(5) of the Act. Further, the Registrar must bear in mind that the legal burden is upon the applicant to establish that there would be no reasonable likelihood of confusion between the trade-marks of the parties as of the date of my decision. As the registered trade-mark BACI PERUGINA & Design appears to be the more relevant of the opponents' trade-marks with respect to the Section 12(1)(d) ground, I will first consider the issue of confusion between the trade-marks PATCHI & Design and BACI PERUGINA & Design.

With respect to the inherent distinctiveness of the trade-marks at issue, both the applicant's trade-mark PATCHI & Design and the registered trade-mark BACI PERUGINA & Design are inherently distinctive.

The opponents' evidence establishes that the trade-mark BACI PERUGINA & Design has become known in Canada in association with "chocolates" and may even be well-known amongst those of Italian origin. In this regard, Ms. Bryson has provided documentation from Statistics Canada which indicates that there are more than 1,000,000 persons of Italian origin living in Canada. While the current use of the trade-mark BACI PERUGINA & Design on boxes of the chocolates distributed by Perugina S.p.A. (see Exhibit "B" to the Giannoni affidavit) differs from the trade-mark as registered, I consider the current use to be a mere variant of the registered trade-mark. In this regard, all the dominant features of the trade-mark BACI PERUGINA & Design as registered comprise elements of the trade-mark as presently used (see Promafil Canada Ltée v. Munsingwear Inc., 44 C.P.R. (3d) 59).

The Murr affidavit attests to sales in Canada of the applicant's PATCHI & Design products since 1988 exceeding \$250,000 annually. Thus, the applicant's trade-mark PATCHI & Design has become known at least to some extent in Canada in association with the wares covered in the present application.

The length of time that the trade-marks at issue have been in use also favours the opponents in this opposition in that the trade-mark BACI PERUGINA & Design has been used in Canada in

association with "chocolates" since 1956 whereas the applicant's use of its trade-mark PATCHI & Design in Canada commenced in 1988.

The applicant's "boxes of sweets, drops and chocolate" are closely related to the opponents' chocolates while the applicant's wares identified as "wedding party favours" could include "chocolates". Further, the channels of trade associated with these wares could overlap.

As for the degree of resemblance between the trade-marks at issue, I consider there to be a significant degree of similarity in appearance and a fair degree of similarity in sounding between the applicant's trade-mark PATCHI & Design and the registered trade-mark BACI PERUGINA & Design. Further, to the extent that the representation of a kissing couples in each of the trade-marks suggests the idea of romance, the marks of the parties convey similar ideas.

In view of the degree of resemblance between the trade-marks PATCHI & Design and BACI PERUGINA & Design as applied to closely related wares, I have concluded that the applicant has failed to meet the legal burden upon it of establishing that there would be no reasonable likelihood of confusion between its trade-mark and the registered trade-mark BACI PERUGINA & Design. As a result, the applicant's trade-mark is not registrable in view of the provisions of Section 12(1)(d) of the Trade-marks Act. I have therefore not considered the remaining grounds of opposition relied upon by the opponents.

I refuse the applicant's application pursuant to Section 38(8) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 30th DAY OF November, 1993.

G.W. Partington,
Chairman,
Trade Marks Opposition Board.