



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 94

Date of Decision: 2020-07-31

IN THE MATTER OF AN OPPOSITION

SD Pero Holdings Inc.

Opponent

and

Cannoli Queens Inc.

Applicant

1,761,781 for Cannoli Queens

Application

[1] SD Pero Holdings Inc. (the Opponent) opposes application no. 1,761,781 (the Application) for registration of the trademark “Cannoli Queens” (the Mark) filed by Cannoli Queens Inc. (the Applicant).

[2] For the reasons that follow, I reject the opposition.

THE RECORD

[3] The Application was filed on December 22, 2015. It is based on use of the Mark in Canada since July 17, 2014 in association with the following goods (the Goods):

Cannoli, pastries, baked pastries that consist of tube-shaped shells of fried pastry dough filled with sweet creamy filling usually containing ricotta cheese, baked pastries, pastry desserts, Italian style pastries, Italian style baked pastries, Italian style pastry desserts, dough, cake, cookies, ice-cream. Italian style ice-cream called gelato, coffee, Italian style coffee called espresso, cappuccino, Italian styled coffee and hot milk called cappuccino, tea, hot chocolate, soft drinks, juices;

and the following services (the Services):

(1) Restaurant, fast-food restaurant, sit-down restaurant, take-out restaurant, operation of restaurant, restaurant services for others, establishing of franchise operations and franchises for restaurants, franchise consulting negotiating and preparing franchising agreements maintaining and supervising franchises for restaurants, and all other professional consultancy services in relation to franchising for restaurants;

(2) Bakery, take-out bakery, Italian style bakery, establishing of franchise operations and franchises for bakeries franchise consulting negotiating and preparing franchising agreements maintaining and supervising franchises for bakeries, and all other professional consultancy services in relation to franchising for bakeries;

(3) Delicatessen, Italian style delicatessen.

[4] The Application contains a disclaimer of the right to the exclusive use of the word “queens” apart from the Mark.

[5] The Application was advertised in the *Trademarks Journal* on October 26, 2016 for the purposes of opposition.

[6] On March 24, 2017, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). Numerous amendments to the Act came into force on June 17, 2019. All references to the Act in these reasons are to the Act as amended on June 17, 2019, with the exception of references to the grounds of opposition and to the circumstances considered in assessing confusion, which are references to the Act as it read immediately before it was amended (in accordance with the transitional provisions in section 70 of the Act, which provide that sections 38(2) and 6(5) of the Act as it read prior to June 17, 2019 apply to applications advertised before that date).

[7] The grounds of opposition are based on sections 30(a), (b) and (i) (compliance), sections 12(1)(b) and (d) (registrability), sections 16(1)(a) and (c) (entitlement), and section 2 (distinctiveness) of the Act as it read immediately before June 17, 2019. The Applicant filed a counter statement on June 7, 2016, denying each of the grounds of opposition.

[8] The Opponent filed as its evidence the affidavit of its Director, President, Secretary and sole Shareholder, Sam Pero, dated December 10, 2017 (First Pero Affidavit or SPA1). The Applicant filed as its evidence the affidavit of its director, President and shareholder, Silvana Mior, dated April 13, 2018 (Mior Affidavit or SMA). In reply, the Opponent filed a further

affidavit of Sam Pero, dated May 24, 2018 (Second Pero Affidavit). Neither Mr. Pero nor Ms. Mior was cross-examined. Only the Applicant filed written arguments; an oral hearing was not requested.

[9] I note that, in her affidavit, Ms. Mior expresses numerous opinions and conclusions. However, as she has not established herself as an expert in trademark law and is not independent of the parties, I have disregarded her opinions on the questions of fact and law to be decided in this proceeding.

EVIDENTIAL BURDEN AND LEGAL ONUS

[10] The legal onus is on the applicant to show that its application complies with the provisions of the Act. However, for each ground of opposition, 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 that ground of opposition exist. For a ground of opposition to be considered at all, the opponent must meet its evidential burden [*Joseph E Seagram & Sons Ltd v Seagram Real Estate Ltd* (1984), 3 CPR (3d) 325 (TMOB); *John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

[11] If this initial burden is met, then the applicant must satisfy the Registrar, on a balance of probabilities, that the ground of opposition pleaded should not prevent the registration of the trademark at issue. The legal onus being on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in then the issue must be decided against the applicant [*Seagram, supra*; *John Labatt, supra*].

COMPLIANCE WITH SECTION 30(A) OF THE ACT

[12] The Opponent pleads that the Application does not conform to the requirements of section 30(a) of the Act in that the Application does not contain a statement in ordinary commercial terms of the specific goods and services in association with which the Mark has been used. More specifically, the Opponent pleads that (i) the term “Italian style” is ambiguous “as there are several distinctive Italian styles of baking” and (ii) the term “all other professional consultancy services...” is ambiguous.

[13] The material date for considering a ground of opposition based on section 30(a) of the Act is the filing date of the application. However, it is the statement of goods and services as last amended that is assessed [see *Eaton Williams (Millbank) Ltd v Nortec Air Conditioning Industries Ltd* (1982), 73 CPR (2d) 70 (TMOB) at 77].

[14] An opponent's evidential burden under section 30(a) is a lighter one and may be met through sufficient argument [see *McDonald's Corp v MA Comacho-Saldana International Trading Ltd* (1984), 1 CPR (3d) 101 at 104 (TMOB)]. However, the Registrar has held that, in the absence of evidence from the opponent, there should be "a very clear legal or logical argument that a given description is not sufficiently specific or in ordinary commercial terms such that the description is far too broad to provide certainty in the marketplace as to the scope of the applicant's rights" [*Chartered Professional Accountants of Ontario v American Institute of Certified Public Accountants*, 2019 TMOB 86 at para 123].

[15] In the present case, the Opponent has not furnished any evidence or made any written or oral representations to support a finding that the terms "Italian style" and "all other professional consultancy services..." are not ordinary commercial terms for specific goods and services. The Opponent's only arguments in this regard are found in its pleadings, namely the pleaded allegations that the term "Italian style" is ambiguous "as there are several distinctive Italian styles of baking" and that "all other professional consultancy services..." is also ambiguous. However, even if I consider these allegations as arguments, I am not satisfied that the Opponent has met its evidential burden.

[16] First, the mere fact that a good listed in an application may encompass a number of individual products does not automatically mean that it is too broad for the purposes of section 30(a) of the Act. In the present case, the fact that "there are several distinctive Italian styles of baking" does not demonstrate that the term "Italian style" is not customarily used in the trade to refer to a specific sub-set of baked goods. The Opponent has not furnished any evidence of the alleged several distinctive styles nor explained how they render the term "Italian style" ambiguous. Although Ms. Mior's evidence seeks to distinguish between Sicilian and Venetian cannoli, the manner in which an affiant seeks to differentiate the parties' goods in an opposition proceeding does not necessarily reflect the level of specificity required to provide certainty in the marketplace as to the scope of an applicant's rights.

[17] Second, even if the phrase “all other professional consultancy services...”, is ambiguous on its own, that is not how it appears in the Application. Rather, it appears as part of the following two statements: “all other professional consultancy services *in relation to franchising for restaurants*” and “all other professional consultancy services *in relation to franchising for bakeries*” (emphasis added). Thus the Applicant has provided both the type of service (*i.e.* professional consultancy) and the field of use (*i.e.* in relation to franchising for restaurants and bakeries). The Opponent has provided no evidence or argument to support the position that these statements, read in their entireties, are ambiguous or overly broad for the purposes of section 30(a) of the Act.

[18] Indeed, the *Trademarks Examination Manual*—published by CIPO as a reference guide on how examiners will interpret and apply legislation—explains that certain services may be specifically defined by stipulating the field of use [section 2.4.5.2]. By way of example, the manual indicates that “consulting in the field of workplace safety” is considered to be a specific service stated in ordinary commercial terms [*ibid.*]. Although the manual is not binding in an opposition proceeding, it can provide guidance as to the level of specificity that it would be reasonable to expect. The Opponent has provided no evidence or argument as to why the statements “all other professional consultancy services in relation to franchising for restaurants” and “all other professional consultancy services in relation to franchising for bakeries” are not equally specific ordinary commercial terms.

[19] In view of the foregoing, I dismiss the section 30(a) ground of opposition for the Opponent’s failure to meet its evidential burden.

COMPLIANCE WITH SECTION 30(B) OF THE ACT

[20] The Opponent also pleads that the Application was not filed in compliance with section 30(b) of the Act, as follows:

The Application does not comply with the requirements of section 30(b) for at least the reason(s) that the Applicant has not used, in Canada, the Applicant’s Mark in association with the corresponding listed services:

“(1) ...establishing of franchise operations and franchises for restaurants, franchise consulting negotiating and preparing franchising agreements maintaining and supervising franchises for restaurants, and all other professional consultancy services in relation to franchising for restaurants (2) ...establishing of franchise operations and franchises for bakeries franchise consulting negotiating and preparing franchising

agreements maintaining and supervising franchises for bakeries, and all other professional consultancy services in relation to franchising for bakeries (3) delicatessen, Italian style delicatessen.”

[21] For convenience, I will refer to the above-listed services as the Franchising and Delicatessen Services.

[22] Section 30(b) of the Act reads as follows:

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

...

(b) in the case of a trade-mark that has been used in Canada, the date from which the applicant or his named predecessors in title, if any, have so used the trade-mark in association with each of the general classes of goods or services described in the application;

[23] The relevant definitions of “use” are set out in section 4 of the Act as follows:

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

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[24] With respect to services, the display of a trademark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trademark owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[25] Compliance with section 30(b) is assessed at the application’s filing date [*Georgia-Pacific Corporation v Scott Paper Ltd* (1984), 3 CPR (3d) 469 (TMOB)]. An opponent’s initial burden under this ground is also a lighter one, given that the relevant information regarding use is more readily available to the applicant [*Tune Masters v Mr P’s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. Moreover, the opponent’s evidential burden can be met by reference not only to the opponent’s evidence but also to the applicant’s evidence [see *Labatt Brewing Co v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. If an opponent succeeds in discharging its initial burden, then the applicant must, in response,

substantiate its use claim. However, an applicant is under no obligation to do so if its use claim is not first put into issue by the opponent meeting its initial burden [see *Masterfile Corporation v Mohib S Ebrahim*, 2011 TMOB 85].

[26] The only evidence filed by the Opponent that has a bearing on this question consists of Exhibits K and L to the First Pero Affidavit:

- Exhibit K is a printout of the Applicant’s corporate particulars, which Mr. Pero states is from “the online database maintained by the Government of Canada” (para 14).
- Exhibit L contains photocopies of the Application, as originally filed and as amended on June 24, 2016 and July 19, 2016, with their cover letters.

[27] There is no indication of when or how these materials were obtained and Mr. Pero makes no further comment on them. In the circumstances, and in the absence of any submissions from the Opponent, the purpose of this evidence is unclear. I would note, however, that if it was the Opponent’s intention to question the accuracy of the date of first use claimed in the Application—on the basis that the Applicant appears to have been incorporated at a later date and no predecessor in title is listed in the Application—then such an allegation cannot be considered as it falls outside the scope of the pleadings.

[28] In this respect, the Registrar has no jurisdiction to deal with an issue not found in the statement of opposition. Where an opponent has pleaded that the application fails to comply with a section of the Act based on a particular set of circumstances, it is not permissible to refuse it on the basis that it does not comply with that section of the Act for reasons different than those pleaded [see *Massif Inc v Station Touristique Massif du Sud (1993) Inc* (2011), 2011 FC 118, 95 CPR (4th) 249; and *Procter & Gamble Inc v Colgate-Palmolive Canada Inc*, 2010 FC 231, 364 FTR 288].

[29] In the present case, the only allegation with respect to section 30(b) in the statement of opposition is that the Application does not comply because the Applicant has not used the Mark in Canada in association with the Franchising and Delicatessen Services. Although non-compliance is pleaded “for at least the reason(s)” that the Applicant has not so used the Mark, no additional potential reasons emerge from the statement of opposition. The allusion to the possibility of there being other, unspecified “reason(s)” cannot, in itself, broaden the scope of the statement of opposition.

[30] I appreciate that, once evidence is filed, the Registrar must take it into account when interpreting the pleadings [per *Novopharm Ltd v AstraZeneca AB*, 2002 FCA 387, 21 CPR (4th) 289]. However, Mr. Pero gives no indication in his affidavit as to what Exhibits K and L purport to show. It is an elementary condition of fairness that each party be adequately informed of the case it has to meet [*Carling Breweries Ltd v Molson Companies Ltd.* (1984), 1 CPR (3d) 191 (FCTD)]. This is not a case where a broad or ambiguous pleading is clarified by the opponent's evidence. The scope and meaning of the pleading are clear on its face: the allegation is that the Applicant has not used the Mark in association with certain services. There is no indication of a possible allegation that the Applicant has used the Mark but from a later date or that the Mark has been used from the date claimed but not by the Applicant. On the contrary, the fact that the pleading is expressly applied to only certain services suggests that the allegation is not one that would apply to *all* the services.

[31] If, after the statement of opposition was filed, the Opponent wished to add an allegation based on the particulars of the Applicant's incorporation or on aspects of the Application not mentioned in the statement of opposition, then the Opponent was required to seek and obtain leave to amend its statement of opposition.

[32] As for the ground as pleaded, the Opponent did not file any evidence nor make any submissions in support of its allegation that the Applicant has not used the Mark in Canada in association with the Franchising and Delicatessen Services. The question therefore becomes whether the Opponent is able to meet its burden by relying on the Applicant's evidence. To do so, an opponent must show that the applicant's evidence is "clearly inconsistent" with or "casts doubt" on the claims set forth in the application [see *Ivy Lea Shirt Co v Muskoka Fine Watercraft & Supply Co* (1999), 2 CPR (4th) 562 (TMOB), *aff'd* (2001), 2001 FCT 252, 11 CPR (4th) 489; and *Bacardi & Co v Corporativo de Marcas GJB, SA de CV*, 2014 FC 323 at 33, 50 and 54].

[33] As noted above, the Applicant's evidence pertaining to use of the Mark is found in the affidavit of Silvana Mior. Ms. Mior states that the Applicant, or she herself as the Applicant's predecessor operating under the style "Cannoli Queens", has since July 17, 2014 used the Mark in association with the Goods—which she lists individually—and "the general class of services comprising a restaurant, bakery, and delicatessen" (paras 6–7). She also expressly confirms that the Applicant has used the Mark in connection with each of the Franchising and Delicatessen

Services, which she states are “in use in association with each of the general classes of services described in the application since July 17, 2014 and continuously since then” (para 73).

[34] I note that Ms. Mior lists the individual Goods in association with which the Mark has been used since July 17, 2014, while only asserting use in association with general classes of Services since that date. Further, while she provides specific evidence with respect to restaurant and bakery services, there is no specific mention of the franchising services, other than the foregoing bare assertion of use, which simply reiterates the list of services from the 30(b) ground, without reference to the Applicant’s filing date (para 73). There is also no indication in her affidavit or in the attached exhibits that the Applicant’s business involves franchises or that any services related to franchising are available. For example, there is no evidence that any of the retail stores or caterers through which the Applicant’s goods are distributed operate as franchises of the Opponent’s business or that any of the Opponent’s customers are franchisees.

[35] However, in my view, this lack of particulars is more akin to a gap in the evidence than it is to an inconsistency or an ambiguity. The mere fact that an applicant’s evidence is silent or only makes bare assertions with respect to certain services does not mean that the evidence is clearly inconsistent with the mark having been used in association with such services. An applicant is under no obligation to evidence use of its mark in compliance with section 30(b) of the Act until the opponent has met its evidential burden.

[36] With respect to the delicatessen services, I also note Ms. Mior statement that the Applicant’s goods and services consist of “same day sales to the public from a restaurant/bakery/deli and packaged products to supermarkets and other delicatessens” (para 66). The Opponent has not filed any evidence nor made any submissions to suggest that a retail establishment offering prepared food in the nature of Italian-style cannoli desserts cannot be characterized as a delicatessen, particularly when Ms. Mior specifically refers to the Applicant’s establishment as such.

[37] In the absence of cross-examination, I find that Ms. Mior’s evidence regarding use of the Mark in association with restaurant and bakery services does not contradict or cast doubt on the Applicant’s claim to have also used the Mark in Canada in association with the Franchising and Delicatessen Services. I am therefore unable to conclude that the Opponent has met its initial evidential burden.

[38] Accordingly, the ground of opposition based on section 30(b) of the Act is dismissed, as the Opponent has failed to meet its evidential burden.

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(B)

[39] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(b) of the Act because “the Applicant has disclaimed the right to the exclusive use of the component ‘Queens’ apart from [the Mark], leaving ‘Cannoli’ as the distinguishing feature” and “‘Cannoli’ is clearly descriptive of the character or quality of the Applicant’s goods and services in association with which it is used”.

[40] The material date to assess this ground of opposition is the date of filing the application [*Fiesta Barbeques Ltd v General Housewares Corp*, 2003 FC 1021, 28 CPR (4th) 60].

[41] The word “clearly” in section 12(1)(b) means “easy to understand, self-evident or plain”; the word “character” means “a feature, trait, or characteristic of the product” [*Drackett Co of Canada Ltd v American Home Products Corp* (1968), 55 CPR 29 at 23 (Ex Ct)]. For a word or phrase to be clearly descriptive of the “character or quality” of a good or service, it must be material to the composition of the good or service and refer to an intrinsic quality or characteristic of the product [*Provenzano v Registrar of Trade-marks* (1977), 37 CPR (2d) 189 (FCTD), *aff’d* (1978) 40 CPR (2d) 288 (FCA)].

[42] In determining whether a trademark is clearly descriptive, the mark must not be dissected into its component elements and carefully analyzed but must be considered in its entirety, as a matter of immediate impression, from the point of view of the average consumer or user of the associated goods or services [see *Wool Bureau of Canada Ltd v Canada (Registrar of Trade Marks)* (1978), 40 CPR (2d) 25 (FCTD); *Atlantic Promotions Inc v Canada (Registrar of Trade Marks)* (1984), 2 CPR (3d) 183 (FCTD)]. This consideration includes any words that may be the subject of a disclaimer, since the disclaimed portion still forms an integral part of the trademark [see *Cafe Supreme F & P Ltée v Registrar of Trade Marks*, 4 CPR (3d) 529 (FCTD)].

[43] In the present case, the Opponent has not provided any evidence or argument with respect to the meaning of the particular phrase “cannoli queens” and how it would relate to the character or quality of the Goods and Services. Nor has the Opponent provided any evidence or argument as to how the fact that “the Applicant has disclaimed the right to the exclusive use of the

component ‘Queens’” affects the meaning of the Mark as a whole or its immediate impression on the average consumer.

[44] Since the opponent has not adduced any evidence or made any arguments to establish the facts pleaded in support of its section 12(1)(b) ground of opposition, I am unable to conclude that the Opponent has met its evidential burden. The section 12(1)(b) ground is therefore dismissed.

GROUND OF OPPOSITION BASED ON CONFUSION WITH THE OPPONENT’S TRADEMARK AND TRADE NAME

[45] The remaining grounds of opposition are based primarily on the Opponent’s allegation that the Mark is confusing with its trade name CANNOLI KING (the Opponent’s Trade Name) and its registered trademark CANNOLIKING & Design (the Opponent’s Trademark), reproduced below:

Cannoliking

[46] The Opponent’s Trademark is registered under no. TMA954,046 (the Opponent’s Registration). The registration particulars are set out in Schedule A hereto. The Opponent’s Trademark is described in the registration as “The words ‘CANNOLIKING’ in a stylized font with a jeweled crown over the letter ‘g’” (emphasis added). The “stylized font” is simple, narrow, sans-serif lettering. The registration includes a colour claim, which reads as follows:

Colour is claimed as a feature of the trade-mark. The words ‘CANNOLIKING’ are black, the crown is gold, and the three jewels in the crown are, from left to right, green, white, and red. (emphasis added)

[47] I note that the above description and colour claim are somewhat ambiguous in that they spell the word element “CANNOLIKING” as a single word, while referring to it in the plural, as “The words” (emphasis added). Moreover, the uneven spacing between the letters makes it difficult to tell whether they make one word or two. For convenience, I will generally refer to the word element as two words, since, in my view, two words are easily recognizable regardless of whether they are perceived as two distinct words or as a single, coined, compound word. However, I consider the ambiguous spacing, suggesting a compound word coined from two separate words, to be a feature of the trademark.

GROUND OF OPPOSITION BASED ON COMPLIANCE WITH SECTION 30(i)

[48] The Opponent pleads that the Application does not conform to the requirements of section 30(i) of the Act because the Applicant cannot be satisfied that it is entitled to register the Mark in Canada in view of the prior use in Canada and/or making known in Canada by the Opponent of the Opponent's Trademark. More specifically, the Opponent pleads that the Applicant should have been aware that the Mark was and is confusing with the Opponent's Trademark.

[49] The requirement under section 30(i) of the Act is to include, in the application, a statement that the applicant is satisfied that it is entitled to use the mark in Canada in association with the goods and services described in the application. The existence of an allegedly confusing trademark does not preclude an applicant from making the required statement, since the applicant may nevertheless be satisfied of its own entitlement. Accordingly, where, as here, the required statement is provided, an opponent may only rely on section 30(i) in specific cases, such as where bad faith or fraud on the part of the applicant is alleged, or where federal legislation arguably prevents the registration of the mark [see *Sapodilla Co Ltd v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB); and *Interprovincial Lottery Corp v Western Gaming Systems Inc* (2002), 25 CPR (4th) 572 (TMOB)].

[50] In the present case, there are no allegations of that nature in the statement of opposition and there is no evidence in the record to that effect. Consequently, the ground of opposition based on section 30(i) of the Act is dismissed, as the Opponent has failed to meet its initial burden.

GROUND OF OPPOSITION BASED ON REGISTRABILITY UNDER SECTION 12(1)(D)

[51] The Opponent pleads that the Mark is not registrable pursuant to section 12(1)(d) of the Act because, at the Application's filing date and at all other times, the Mark was confusing and is likely to cause confusion with the Opponent's Trademark. More specifically, but without limitation, the Opponent pleads to similarity in the appearance and ideas suggested by the parties' respective trademarks; similarity in the parties' goods, services and trades; the Opponent's Trademark being "well known, if not famous, at least in British Columbia in the

catering industry”; and the Opponent’s Trademark being “used extensively by the Opponent in the marketplace before any third parties adopted ‘cannoli’ as a component of a trademark”.

[52] The material date for the analysis of a section 12(1)(d) ground of opposition is the date of the Registrar’s decision [see *Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd* (1991), 37 CPR (3d) 413 (FCA)]. The Opponent’s initial burden is met if the registration upon which it relies is in good standing at this date. The Registrar has discretion to check the register in this respect [see *Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Having exercised that discretion, I confirm that the Opponent’s Registration is extant and stands in the name of the Opponent.

[53] The Applicant argues that Mr. Pero’s affidavit “openly contradicts” the date of first use claimed in the Opponent’s Registration and that the Opponent’s Trademark should therefore “not have been registered as a ‘past use’.” However, the validity of the opponent’s registration is not at issue in an opposition proceeding [see *Molson Canada 2005 v Anheuser-Busch, Incorporated*, 2010 FC 283]. Moreover, an opponent need not show “use” of its mark to satisfy its evidential burden under section 12(1)(d).

[54] The Applicant further submits that registration of a design mark does not explicitly protect the text, for which a word mark registration would have to be obtained (paras 117–118). However, the Applicant provides no support for this proposition, which would appear contrary to the approach adopted by the Supreme Court of Canada for determining the degree of resemblance between trademarks, discussed below.

[55] The Opponent having met its evidential burden, the onus is now on the Applicant to satisfy the Registrar, on a balance of probabilities, that the Mark is not likely to cause confusion with the Opponent’s Trademark.

The test for confusion

[56] The test for confusion is outlined in section 6(2) of the Act, which stipulates 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 (an international system used to classify goods and services for trademark registration purposes).

[57] This test does not concern confusion of the trademarks themselves, but rather confusion as to whether the goods and services associated with each of the trademarks come from the same source. It is described in the following terms by Justice Binnie in *Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23, at paragraph 20:

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 [applicant's mark], at a time when he or she has no more than an imperfect recollection of the [opponent's] trademarks, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks.

[58] Some of the surrounding circumstances to be taken into consideration when determining whether trademarks are confusing are set out in section 6(5) of the Act: (a) the inherent distinctiveness of the trademarks and the extent to which they have become known; (b) the length of time the trademarks have been in use; (c) the nature of the goods, services, or business; (d) the nature of the trade; and (e) the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested by them. These criteria are not exhaustive and it is not necessary to give each one of them equal weight [see *Veuve Clicquot, supra*; *Mattel USA Inc v 3894207 Canada Inc*, 2006 SCC 22; *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27].

Degree of resemblance between the trademarks

[59] As indicated by the Supreme Court of Canada in *Masterpiece, supra*, in most instances, the degree of resemblance between the trademarks is the most important factor in assessing the likelihood of confusion. The preferable approach is to begin by determining whether there is an aspect of each trademark that is “particularly striking or unique” [*Masterpiece, supra*, at para 64]. It is not the proper approach to set the trademarks side by side and carefully examine them to find similarities and differences; each trademark must be considered as a whole [see *Veuve Clicquot, supra*]. However, as noted in *United Artists Pictures Inc v Pink Panther Beauty Corp* (1998), 80 CPR (3d) 247 (FCA), at 263,

While the marks [at issue] must be assessed in their entirety (and not dissected for minute examination), it is still possible to focus on particular features of the mark that may have a determinative influence on the public's perception of it.

[60] The first portion of a trademark is often considered to be the most important for the purpose of distinction [see *Conde Nast Publications Inc v Union des Éditions Modernes* (1979), 46 CPR (2d) 183 (FCTD)]. However, when the first portion of a trademark is a common descriptive or suggestive word, its importance diminishes [see *Merial LLC v Novartis Animal Health Canada Inc* (2001), 11 CPR (4th) 191 (FCTD); *Sky Solar Holdings Co v Skypower Global*, 2014 TMOB 262, 139 CPR (4th) 363 (TMOB); and *Phantom Industries Inc v Sara Lee Corp* (2000), 8 CPR (4th) 109 (TMOB)]. In the present case, each of the trademarks at issue begins with the word CANNOLI, and the marks are similar to that extent. However, given that CANNOLI is the name of an Italian pastry dessert and, as such, suggests the type of food sold under the trademark, there would be a tendency to discount the importance of the word CANNOLI, both in the Opponent’s Trademark and in the Applicant’s Mark.

[61] In my view, the more striking aspect of the Opponent’s Trademark is the word KING and the way this word closely follows CANNOLI so as to suggest a single coined word—“Cannoliking”—with two distinct elements, “Cannoli” and “king”.

[62] Similarly, I consider QUEENS to be the more striking aspect of the Applicant’s Mark. In this case, the mark is applied for as two separate words, CANNOLI and QUEENS, with no restriction as to how the two words might be displayed. Although the exclusive right to use the word QUEENS apart from the Mark has been disclaimed, the disclaimed portion of a trademark still forms an integral part of the mark and can still serve as a dominant or distinguishing feature [see *Cafe Supreme, supra*; and *American Cyanamid Co v Record Chemical Co* (1972), 7 CPR (2d) 1 (FCTD)].

[63] When considering the trademarks as a matter of first impression and imperfect recollection, I find that the different suffix components result in trademarks which have a different appearance and sound, because the word “king” is visually and aurally different from the word QUEENS. Although I do not consider the addition of a small king’s crown to be a particularly striking or unique addition on its own, the crown’s presence as an accent topping off the letter “g” in “king” draws attention to the “king” element, and contributes to the visual difference in the second half of the parties’ trademarks. Therefore, despite the shared element CANNOLI, the two trademarks considered as a whole differ in appearance and sound.

[64] As for the ideas suggested, the words KING and QUEENS both refer to monarchs, although QUEENS can also refer to kings' wives. Moreover, in the context of the trademarks as a whole, both KING and QUEENS may impart a laudatory connotation. In this respect, I note that the *Concise Canadian Oxford Dictionary* (Toronto: Oxford University Press, 2005) includes the following relevant definitions for "king" and "queen" [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65, 92 CPR (4th) 408 with respect to the Registrar's discretion to take judicial notice of dictionary definitions]:

King:

2 a person or thing pre-eminent in a specified field or class (*railway king*).

3 a large (or the largest) kind of plant, animal, etc. (*king penguin*).

Queen:

3a a woman, country, or thing pre-eminent or supreme in a specified area or of its kind (*tennis queen*).

b a belle or mock sovereign on some occasion (*beauty queen; queen of the fair*).

[65] Thus the ideas suggested by the two trademarks in this case can also be considered somewhat similar to the extent that both marks suggest reigning supreme in the field of cannoli. However, the ideas suggested by the two marks are also different to the extent that the Opponent's Trademark evokes the image of a sole male sovereign whereas the Applicant's Mark evokes the image of a group of regal women.

[66] On balance, I find that the two trademarks at issue are slightly more different than they are alike, given the visual, aural and conceptual differences in their more striking elements. As the points of similarity between the two trademarks are in their descriptive and laudatory aspects, I consider the more striking features in each trademark to be more likely to have a determinative influence on the public's perception of each mark, as a matter of first impression and imperfect recollection. Thus, in my view, although it is a close case, the degree of resemblance slightly favours the Applicant.

Inherent distinctiveness of the trademarks and the extent to which they have become known

[67] Both parties' trademarks possesses a relatively low degree of inherent distinctiveness. The first portion of each trademark—generally considered to be the most important for the purpose of distinction—describes the nature of at least some of the parties' goods and the focus

of their services, and suggests the type of food sold under the mark. Each of the trademarks, considered in its totality, has a somewhat laudatory connotation, evoking the concept of reigning supreme in the field of cannoli.

[68] I consider the design elements and colours in the Opponent's Trademark to increase its level of inherent distinctiveness only slightly, given their subtlety and their tendency to reinforce the word elements, in particular, the idea suggested by the word KING and the Italian character imparted by the word CANNOLI.

[69] I consider the running together of "Cannoli" and "king" to be quite subtle, although this construction does lend some added interest.

[70] I also consider the fact that the word QUEENS is plural in the Applicant's Mark to add a degree of interest, to the extent that one would expect a single sovereign, whereas the Applicant's Mark evokes a mental image of multiple monarchs. Indeed, in her affidavit, Ms. Mior explains that she chose the name "Cannoli Queens" for her business because, "it reflected the 3 women in the family company, being me and my 2 daughters, and our confidence in the high quality, production and sale of the products" (para 38). While consumers may not know the derivation of the Mark, the idea of a group of regal women working with cannoli may still come to mind. Again, the disclaimer of the exclusive right to use the word QUEENS does not, in itself, affect how consumers will perceive the word QUEENS within the Mark as a whole.

[71] The degree of distinctiveness of a trademark can be enhanced through use and promotion in Canada [see *Sarah Coventry Inc v Abrahamian* (1984), 1 CPR (3d) 238 (FCTD); *GSW Ltd v Great West Steel Industries Ltd* (1975), 22 CPR (2d) 154 (FCTD)]. Both parties filed evidence in this respect.

The Opponent's Trademark

[72] The Opponent's evidence consists of the two affidavits of its Director, President, Secretary and sole Shareholder, Sam Pero. However, use and promotion of the Opponent's Trademark is also addressed in the affidavit of the Applicant's director, President and shareholder, Silvana Mior.

Preliminary Matter: Hearsay

[73] In its written argument, the Applicant submits that “those portions of the Opponent’s evidence is [*sic*] inadmissible hearsay evidence as the Opponent failed to prove the necessity and reliability of the evidence in issue” (para 67). It is not clear to which portions of the evidence the Applicant refers; however, the submission appears to target evidence relating to use of the Opponent’s Trade Name and the trade name Cannoli King Vancouver, such as the webpage and sign at Exhibits C and F. To the extent that such documentary evidence providing information on the Opponent is furnished for the truth of its contents, the evidence is reliable as the materials are akin to business records and the Opponent itself is the source of the materials. Furthermore, when Mr. Pero states that the webpage at Exhibit C is “containing the history of the Opponent” or that the sign at Exhibit F is “containing a brief history of the Opponent”, I consider him to be adopting the contents of these materials. Accordingly, I find such evidence to be admissible, both as examples of the Opponent’s advertising and promotion and for the truth of its contents.

Preliminary Matter: Deviation

[74] None of the evidence shows the Opponent’s Trademark displayed exactly as it is registered but rather shows a number of different variations. Much of the Applicant’s submissions are devoted to arguing that the Opponent’s Trademark is not used as registered (and therefore as pleaded), and the Applicant’s own evidence provides numerous additional examples of the variation.

[75] I note in particular the following departures from the registered trademark:

- The word VANCOUVER in small capital letters is always printed under the words “Cannoli King”, centred either under “Cannoli” or under both words.
- Upon close inspection, the crown design has four additional, smaller, red jewels—two on either side of the three central jewels that are mentioned in the colour claim. (Some of the exhibits to Ms. Mior’s affidavit contain close-up views of the Opponent’s Trademark with handwritten notes to show the four additional jewels.)
- Sometimes the crown design is larger and centered above “Cannoliking”. In one instance, the larger crown design is centred between “Cannoliking” and

“VANCOUVER”. In another variation, displayed on vertical banners, the word elements are printed sideways under a large crown design.

- In some cases, there is a large design resembling a spike of wheat to the left of the word elements.
- The word elements are typically either maroon on a light background or white on a dark red background (the wheat design also being white)..

[76] In applying the principles set out by the Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie International pour l’informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), as well as the principles set out in *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), I find that the Opponent’s Trademark has not lost its identity and remains recognizable in spite of these differences between the form in which it was registered and the form in which it was used.

[77] In particular, I find that the dominant features of the Opponent’s Trademark— being the combination of the phrase CANNOLI KING with the particular crown design —have been preserved and stand out from the word VANCOUVER—which is considerably smaller, in a different style of lettering, and descriptive of the business’s location—and from the decorative wheat motif [for a similar conclusion, see for example *Pain & Ceballos LLP v Diamond Foods, Inc*, 2013 TMOB 143]. I consider the differences in the overall size, position and details of the crown design to be of minor importance [for similar conclusions with respect to deviations in the relative positions of elements, see *Aird & Berlis LLP v Sonaco SARL*, 2014 TMOB 37; and *Gowling Lafleur Henderson LLP v Coalision Inc*, 2011 TMOB 134; and *W&L Giraffebaby Group Ltd v Sophie la Girafe SAS, une société anonyme*, 2020 TMOB 12]. I also find there to be little difference between the colours black and dark maroon for the word elements and I do not consider what is essentially a reversal of the colours (white on a dark background) to be a significant deviation.

[78] Thus, I find that the foregoing variations of the Opponent’s Trademark constitute acceptable deviations from that mark as registered, such that, for the purposes of this proceeding, the Opponent’s Trademark can acquire distinctiveness through use and promotion of these

variations. I will therefore refer to these variations collectively as the “Opponent’s Trademark” in my analysis of the evidence that follows.

The First Pero Affidavit

[79] In his first affidavit, Mr. Pero states that the Opponent was incorporated under the laws of British Columbia on November 1, 2006 (para 4; certificate of incorporation at Exhibit A) and is in the business of “creating, developing and producing handcrafted cannoli and cannoli cakes of the Sicilian origin in Vancouver” (para 6). Mr. Pero explains that the Opponent provides fast local delivery of cannoli products through its fleet of vehicles and food trucks and also provides onsite birthday, wedding and special event catering (para 7).

[80] Mr. Pero provides an excerpt from the Opponent’s website at *cannoliking.ca* to show the “history of the Opponent” (para 6, Exhibits C and I). Titled “About Cannoli King”, the webpage states that Cannoli King Vancouver “was born” in 2013. However, it also states that “Cannoli King Vancouver has been locally handcrafting Sicilian Cannoli for over 35 years”. Further, it indicates that this product is available at a bakery purchased by Mr. Pero’s family in 2005 called Italia Bakery Vancouver (for which the Opponent’s address is given) and also through a ‘PIPER’ -Cannoli King Vancouver food truck that is brought to various markets, events and other community locations.

[81] Although Mr. Pero does not explain the relationship between the Opponent and Cannoli King Vancouver, it would appear, on a fair reading of the affidavit as a whole, that the Opponent uses Cannoli King Vancouver as a trade name. Yet Mr. Pero does not explain how Cannoli King Vancouver has been operating for over 35 years when it was not “born” until 2013 and when the Opponent was not incorporated until 2006. It may be that the exhibited references to Cannoli King Vancouver are meant to include the Opponent operating under a previous name, as well as predecessors of the Opponent run by Mr. Pero’s family. In this respect, I note that some of the signage and packaging depicted in his affidavit bears the notice, “From a little town of Nicosia, Sicily to Vancouver, BC, Cannoli King Vancouver has continued our family tradition for over 35 years” (Exhibits F, G). In the circumstances, I am only prepared to infer that the Opponent has been using Cannoli King Vancouver as a trade name since sometime in 2013.

[82] With respect to the Opponent's Trademark, Mr. Pero notes that it is displayed on packaging boxes and various signage, as well as on the body of the Opponent's fleet of vehicles and food trucks, which include the following:

- a white compact car that is “driven around town everyday for at least one hour each day, 7 days a week”, on which the mark was first used in 2013 (para 8);
- a food truck that is “driven once or twice weekly”, on which the mark was first used on “February 29, 2014” [*sic*] (para 8) (I am prepared to accept this as a reference to the last day of the month);
- a “cart”, on which the mark was first used on June 1, 2016 (para 9); and
- a van, on which the mark was first used on June 8, 2017 (para 9).

[83] To demonstrate how the Opponent's Trademark is displayed on these vehicles and other materials, notably signage and packaging, Mr. Pero attaches various photographs and printouts to his affidavit. This evidence shows the Opponent's Trademark displayed in the following locations:

- on the compact car and food truck as photographed on July 17, 2015 (para 8; Exhibit D);
- on the cart and van—the photographs showing these two vehicles are undated, but since Mr. Pero states the van first displayed the Opponent's Trademark on June 8, 2017, the photographs were presumably taken on or after that date (para 9; Exhibit E);
- on a sign in the Opponent's retail bakery promoting its Sicilian cannoli, as photographed in August 2017 (para 10; Exhibit F);
- on packaging boxes for “Vancouver's Original Sicilian Cannoli”, photographed in August 2017 (para 11; Exhibit G); and
- on a sticker applied to the piping bag in the “Cannoli Kit”, as shown on the Opponent's website (Exhibit I).

[84] The Opponent's Trademark is also prominently displayed in the header of the Opponent's website at www.cannoliking.ca (Exhibits C and I). The website promotes handcrafted Sicilian cannoli (i) prepared “while you wait” at Italia Bakery; (ii) available to order online for pick-up at the bakery or for local delivery by “[o]ur fun and fast little delivery car, ‘Frankie Fiat’”; and

(iii) provided through the “PIPER” food truck, which is also available for onsite catering. The website specifies that delivery and catering are available in the Greater Vancouver region only. The online shop features a variety of styles of cannoli, as well as “Cannoli-Cake” (a cake edged with cannoli) and a “Cannoli Kit”, consisting of cannoli shells and a filled piping bag. The exhibited webpages bear a 2015 copyright notice, but a print date of “11/7/2017”.

The Mior’s Affidavit

[85] Ms. Mior’s affidavit also contains various photographs and printouts showing how the Opponent’s Trademark is displayed in association with the Opponent’s goods and services. From Ms. Mior’s evidence, I note the following:

- Exhibit M is a March 29, 2018 printout from the Google Domains BETA website, showing the registration particulars for the domain name *cannoliking.ca*; the printout indicates that this domain name was created on January 14, 2015. However, hearsay issues aside, a domain name registration is not evidence of an active website, and the registration date will not necessarily coincide with the date on which the registrant began using any particular trademark, on the corresponding website or otherwise.
- Exhibit O contains printouts from the Opponent’s website showing products offered for sale online, with emphasis on a “Cannoliking Hat”, “Cannoliking Toque”, “Cannoliking Hoodie” and “Cannoliking T-Shirt”. The Opponent’s Trademark is prominently displayed on the front of each of these apparel items. Ms. Mior claims that the Opponent began selling this merchandise on its website “on or about April 11, 2018”, although it is not clear how she reached this conclusion, given that she only attests to having searched the Internet “[i]n or about March 16, 2018” (paras 34–36).
- Exhibits D, G, P and Q contain additional images Ms. Mior obtained from the Internet “[i]n or about March 16, 2018” (paras 34, 36), including the following:
 - Exhibit D: photographs of the Opponent’s Trademark displayed on the food truck; on additional signs atop and next to the food truck; on a food service cart; and on signage for Gratia Bakery & Café.

- Exhibit G: a photograph of the Italia Bakery Vancouver storefront, displaying an Italiabakery logo that resembles the Opponent’s Trademark, featuring the word “Italiabakery” and the wheat motif. I note, however, the well established principle that multiple trademarks may be used together in association with the same product or service [see *AW Allen Ltd v Warner Lambert Canada Inc* (1985), 6 CPR (3d) 270 at 272 (FCTD)]. As such, the Italia Bakery storefront sign would not detract from any use of the Opponent’s Trademark on signage and packaging within the bakery.
- Exhibit P: a printout from the Opponent’s website showing the Opponent’s Trademark in the header.
- Exhibit Q: two images that appear to be promotional shots—from *ottawacitizen.com* and *vancouver.sun.com*, according to the captions—featuring the food truck and a gentleman whose shirt displays another variation of the Opponent’s Trademark.
- Exhibits E, F, R and S contain over a dozen printouts of Cannoli King Vancouver posts with various promotional images on the Instagram website. The printouts are dated March 13, 2018 (Exhibit E, F) and April 13, 2018 (Exhibit R). The individual posts date from December 9, 2015 to October 3, 2017, and specify locations that include Italia Bakery Vancouver as well as markets, cafés, an exhibition, a festival, a theatre, a recreation complex, a cultural centre, and the set of a television series. The promotional images show variations of the Opponent’s Trademark on the food truck and its rooftop signs, on the food cart, on what appears to be the van hood, on a tent booth, on indoor and outdoor signage, on T-Shirts, and on a white fabric article.
- Exhibit F also contains images of indoor café signage displaying a CannoliBar logo that resembles the Opponent’s Trademark, featuring the word “CannoliBar”, the small crown design, and the wheat motif. Again, however, since there is nothing to prevent the Opponent from using more than one trademark at the same time [*AW Allen, supra*], I do not consider any use of this additional trademark to be relevant.

[86] The website printouts furnished by Ms. Mior are admissible as evidence that such promotional webpages existed and were accessible in Canada at the time they were printed and that the Opponent’s Trademark was displayed online at those times in the manner shown.

However, to the extent that Ms. Mior’s evidence is intended to show the nature of the

Opponent's activities offline and how the Opponent's Trademark has been displayed in the physical locations depicted, it constitutes hearsay. In general, hearsay evidence is *prima facie* inadmissible, unless it satisfies the criteria of necessity and reliability [*Labatt Brewing, supra*]. In the present case, reliance on hearsay appears to be necessary as there is no reason to expect the Applicant would have personal knowledge of the Opponent's activities. Moreover, the evidence is reliable to the extent that the Opponent is the source of the promotional images and, as a party to the proceeding, had the opportunity to refute the evidence. The Registrar has previously accepted evidence of this nature in situations where the affiant him or herself conducted the Internet searches, it was difficult for the party to find other evidence, and the other party had the opportunity to reply to the evidence [see *Home Hardware Stores Limited v 1104559 Ontario Ltd*, 2013 TMOB 210; see also *Effigi Inc v HBI Branded Apparel Limited, Inc* 2010 TMOB 160]. In the circumstances, I am prepared to give Ms. Mior's evidence regarding the manner in which the Opponent's Trademark is used some weight.

The Second Pero Affidavit

[87] As reply evidence, the Opponent furnished the Second Pero Affidavit, whose sole exhibit contains four photographs taken May 24, 2018, in direct response to an issue raised and emphasized in Ms. Mior's affidavit, namely, use of the Opponent's Trademark in a colour scheme that differs from the claim in the Opponent's Registration.

[88] The exhibited photographs depict packaging boxes that display the Opponent's Trademark with black lettering (in the simplest variation, adding only the small word "VANCOUVER"). Mr. Pero confirms that this packaging displays the Opponent's Trademark in the colours claimed in the Opponent's Registration. However, he adds that it is only used to package the "Cannoli Kit" product and "is not the most commonly used packaging box of the Opponent presently" (para 3). I accept that this evidence shows display of the Opponent's Trademark on packaging for the goods "Pastries" and "Cannoli" at the time of sale, notwithstanding the deconstructed nature of the product in this particular case.

[89] Two of the photographs also show a neon wall sign forming the words "Cannoli king" in white tubing, under the outline of a crown in yellow tubing, with three dots for jewels, being green, white and red, in that order. Mr. Pero does not comment on this neon sign.

[90] However, given my conclusion above that the colours claimed in the Opponent's Registration are not a dominant feature of the mark, and that the variations of the Opponent's Trademark discussed above constitute only minor deviations from the trademark as registered, it is not necessary for the Opponent to rely on the packaging boxes depicted in the Second Pero Affidavit. (For the same reasons, it is not necessary to consider whether the simple neon sign constitutes an acceptable deviation from the mark.)

Conclusion regarding the Opponent's Trademark

[91] In its written arguments, the Applicant submits that Mr. Pero's statements regarding the dates when the Opponent's Trademark was first displayed on the Opponent's car and food truck are uncorroborated by supporting evidence. The Applicant further submits that "the Opponent[']s website, cannoliking.ca, was registered on January 14, 2015", which "would indicate that [the] earliest possible date of use of the Opponent's Design Mark would be on or after January, 14, 2015" (para 79), and that the Opponent's website bears a copyright notice dated 2015, thereby "confirming that Opponent claimed no business or domain name to allegedly copyright until the 2015 year" (para 72). In her affidavit, Ms. Mior also states that she verily believes that "all evidence available, publicly on the [Opponent's] website, Facebook, Instagram and Twitter accounts, indicate[s] that Opponent's use of their Registered Design Mark was not until at least 2015..." (para 13).

[92] However, nothing in the Opponent's Registration restricts its goods and services to ones offered through a website. Accordingly, I disagree with the Applicant that the Opponent could not have used its trademark before registering its domain name. The Opponent does not require an Internet presence in order to use its trademark on vehicles and signage. Moreover, the Mior Affidavit does not specify how the Opponent's "website, Facebook, Instagram and Twitter accounts" are inconsistent with use of the Opponent's Trademark on vehicles as of 2013. Accordingly, there is nothing to contradict Mr. Pero's sworn statement that the Opponent's Trademark was first used on the white car in 2013.

[93] In its written arguments, the Applicant submits that such display is at most advertising and does not constitute use in association with any goods or services, since Mr. Pero merely states that the car is "driven around town" and since he gives no "supporting evidence" of the sale of goods or services (para 73). However, a trademark is deemed to be used in association

with services if it is displayed either in the performance of services or in advertising services that are available to be performed [see section 4(2) of the Act and *Wenward, supra*]. In this case, Mr. Pero's evidence is that the Opponent "owns a fleet of vehicles and food trucks which provides fast local delivery of cannoli products" (para 7). Although he does not specify that any vehicles used for delivery in 2013 included the white compact car depicted at Exhibit D, he furnishes a set of printouts from the Opponent's website that promote the following (Exhibit I):

Get fast local delivery of the one and only Cannoli King's delicious Cannoli. Order online and have fast delivery to your office or anywhere in the Greater Vancouver region. Our fun and fast little delivery car, "Frankie Fiat" will bring our locally handcrafted Sicilian Cannoli to you.

As there is no indication of there being any other car in the Opponent's fleet of vehicles, I accept that the "white compact car" depicted at Exhibit D (para 8) is the "fast little delivery car" referenced on the Opponent's website. Accordingly, giving a fair reading to Mr. Pero's affidavit as a whole, I accept that, since that 2013, the Opponent's delivery service was at least available to be performed through the car depicted at Exhibit D; that driving this "delivery car" served to advertise the Opponent's "providing bakery foods" service; and that display of the Opponent's Trademark during actual deliveries constituted display in both the advertising and performance of that service.

[94] The evidence of Mr. Pero and Ms. Mior taken together also provides numerous images of the Opponent's Trademark displayed subsequently, on vehicles, packaging, signage and clothing, as well as online. With respect to display on the food truck, notwithstanding the Applicant's arguments to the contrary (para 73), I am satisfied that it would provide the requisite notice of association between the Opponent's Trademark and the foods and beverages prepared in the food truck at the time of their transfer to customers in the normal course of trade. I am therefore satisfied that this display constitutes not only advertising but also use of the Opponent's Trademark in association with both "Food truck" services and the specific goods prepared in and sold through the food truck [for similar conclusions regarding goods sold in a restaurant context see *Goubuli Group Co, Ltd v Qiang Zhang*, 2017 TMOB 123; *Oyen Wiggs Green & Mutala v Aimers* (1998), 86 CPR (3d) 89 (TMOB)].

[95] That being said, the evidence concerning use and promotion of the Opponent's Trademark does not include any information on the volume of sales of branded goods and

services; nor does it include any access figures for the promotional webpages, or any other indication of the extent to which the advertising featuring the Opponent's Trademark may have reached Canadian consumers over the years. At best, the evidence is that, at the time of Mr. Pero's affidavit, the white delivery car displaying the Opponent's Trademark was "driven around town everyday for at least one hour each day, 7 days a week" and the food truck displaying the Opponent's Trademark was "driven once or twice weekly" since the end of February 2014 (para 8).

[96] In view of the foregoing, I am satisfied that the Opponent's Trademark is at least somewhat known in the Greater Vancouver region, based on the number of years the Opponent's bakery has been operating, and apparently posting on social media, and the evidence of an active website and fleet of branded food service and delivery vehicles. I find it reasonable to conclude that a bakery operating since 2013 through the various channels Mr. Pero describes would have had at least some sales by now. However, in the absence of information on the volume of such sales and advertising and on the advertising's reach, I cannot conclude that the Opponent's Trademark has become known to any significant extent.

The Applicant's Mark

[97] In her affidavit, Ms. Mior states that, since July 17, 2014, she with her two daughters commenced baking and selling Italian style cannoli desserts from their premises in Etobicoke, Ontario, to various wholesale and retail customers in the Greater Toronto Area (para 37). She states that she registered the business trade name "Cannoli Queens" with Ontario's Ministry of Consumer and Commercial Relations on that date as the Applicant's predecessor (paras 18, 39). She further states that the business has been operated, and the Mark used in connection with it, from that date to the date of her affidavit (para 41).

[98] Ms. Mior explains that, in 2015, "as a result of the business achieving greater notoriety and sales", she incorporated the Applicant as a Canadian corporation under the *Canada Business Corporations Act* "as the successor to my Ontario business style application of 'Cannoli Queens'" (paras 19, 40). She states that, on or about October 1, 2015, the Applicant opened a bakery, production kitchen, and retail store selling Italian style cannoli desserts at a location in Woodbridge, Ontario, just outside Toronto (paras 40, 45). She specifies that the Applicant operates its business from this kitchen and retail store "for Ontario retail stores, caterers, and

customers in the Greater Toronto area” (para 45) and that the goods and services currently provided in that area and the province consist of “same day sales to the public from a restaurant/bakery/deli and packaged products to supermarkets and other delicatessens” (para 66). She adds that the Applicant makes its products available “at various retail stores at caterers of the Applicant throughout the greater Toronto Area” (para 42).

[99] Ms. Mior states that the Applicant uses the Mark “in signs, packaging, menu boards, invoices, Canada Corporation Name, contracts, etc.” (para 63). In support, she attaches the following exhibits to her affidavit:

- Exhibit B is a copy of an Ontario Master Business Licence dated July 17, 2014, for a general partnership comprising Ms. Mior, Giulia Mior and Bianca Mior (the General Partnership), operating a “BAKED GOODS” business under the business name “Cannoli Queens”. Ms. Mior claims that the Applicant’s use of the Mark since July 17, 2014 is “verified” by the registration of this trade name (paras 18, 39).
- Exhibit C is a copy of the Applicant’s certificate of incorporation, dated January 29, 2015, naming Ms. Mior, Giulia Mior and Bianca Mior as the board of directors. Ms. Mior claims that this incorporation “shows our right to the use of the trade-mark ‘Cannoli Queens’ across Canada going back to January 29, 2015” (para 19).
- Exhibits H, I, K and L contain printouts made from the Applicant’s website at *cannoliqueens.com* on March 16, 2018, showing the following:
 - the About Us page, which briefly explains the inspiration for the business (para 37; Exhibit H);
 - the location of the Applicant’s Woodbridge retail store (identified as being in Vaughan) with a telephone number and e-mail address for “orders & inquiries” (para 40; Exhibit I); I note that images of the store’s signage are not provided;
 - the names and addresses of “various retail stores and caterers of the Applicant throughout the greater Toronto Area” (para 42, Exhibit K); and
 - information about the Applicant’s products—cannoli, cannoli cakes (cakes edged with cannoli), carousel cakes (cakes made entirely of cannoli), and other baked goods (zeppole, crostatas, cookies, and biscotti)—with images of the cannoli, but no option to order online (para 49; Exhibit L).

The first page of each printout features a burgundy logo that incorporates the Mark: “CANNOLI” is printed above “QUEENS” in simple, block capital lettering, with the words “ITALIAN PASTRIES” in fine print underneath, all within a decorative ring topped by a crown design (the CANNOLI QUEENS Logo). Ms. Mior describes this logo as being in the form of a round “seal” (para 64). The logo is also used as a placeholder for certain product images that are “COMING SOON” (Exhibit L).

- In addition, Exhibit L contains printouts made on March 16, 2018, from the Instagram website, which show photographs of the following:
 - a menu board prominently displaying the CANNOLI QUEENS Logo;
 - a clipping of an article titled CANNOLI QUEENS with a photograph of Ms. Mior and her two daughters sitting at a small table in front of the menu board;
 - Ms. Mior and her two daughters behind a bakery counter;
 - a mobile food service cart or stand displaying the CANNOLI QUEENS Logo on the cart itself and, in a repeating pattern, on a banner beside the cart;
 - a Christmas elf display incorporating the CANNOLI QUEENS Logo;
 - packaged cannoli labelled with the CANNOLI QUEENS Logo; and
 - cannoli (including cake arrangements), other desserts (including, cookies, cupcakes, and choux pastry desserts), packaged jars (whose contents are not identified), and mugs of hot beverage, occasionally superimposed with the CANNOLI QUEENS Logo and/or captioned with the logo and the tag “cannoliqueens”.
- Exhibit J contains copies of three redacted invoices from the Applicant addressed to clients in Toronto, Bolton, and Mississauga, dated August 4, 2015, January 23, 2016, and August 15, 2017, respectively, as well as an invoice dated November 26, 2014 from Cannoli Queens in Etobicoke to the Bolton client (para 41). Each invoice is for several hundred units of cannoli (billed to the shipping address). The 2017 invoice also includes a “Wagon Service”, although the nature of this service is not explained. The 2015 and 2016 invoices display a small CANNOLI QUEENS Logo above the Applicant’s name and address.

- Exhibit N is a March 29, 2018 printout from the Google Domains BETA website, showing the registration particulars for the *cannoliqueens.com* domain name, created on July 7, 2014 and registered in the name of Giulia Mior. The Mior affidavit treats this registration as evidence that the Mark was being used as of July 7, 2014 (para 16); however, Ms. Mior does not specify whether the website depicted at Exhibits H, I, J and K was launched on the same date and appeared the same at that time.

[100] I would first note that merely registering a trademark as a business name, corporate name or domain name does not constitute “use” of a trademark within the definitions in section 4 of the Act (reproduced above, under the section 30(b) ground of opposition). Nor does it create or confirm any rights to use the trademark; such rights are governed by the Act, not the *Canada Business Corporations Act* or the Ministry of Consumer and Commercial Relations.

[101] Second, although the earliest evidence of the Mark’s display in association with goods or services is arguably the November 26, 2014 invoice, that invoice was issued by the General Partnership and not the Applicant (which did not come into existence until January 29, 2015). Being a corporation, the Applicant is a separate legal entity from the partnership, regardless of any overlap in the two organizations’ principals. There is no evidence that the General Partnership ever assigned its rights in the Cannoli Queens trade name or corresponding trademark to the Applicant, and, even if it had, the Application does not claim the benefit of use of the Mark by any predecessor in title. Accordingly, only the evidence of the Mark’s use and promotion as of January 29, 2015, by the Applicant itself, can contribute to the Mark’s acquired distinctiveness in this case.

[102] The earliest evidence of that nature is the August 4, 2015 invoice for a cannoli sale by the Applicant. The Mark is displayed in a CANNOLI QUEENS Logo at the top of the invoice. In applying the principles set out in *CII Honeywell Bull, supra*, and *Nightingale, supra*, as well as in *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096, 2009 CarswellNat 3400, and *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB), I find that display of this composite trademark also constitutes a display of the Mark. I am satisfied that the Mark stands out sufficiently to have an identity that is distinguishable from the logo as a whole and that, as a matter of first impression, not only the logo would be recognized but also the Mark *per se*, distinct from the text in fine print and the decorative ring with a crown design.

[103] That said, with the exception of the four invoices at Exhibit J, Ms. Mior does not provide any sales figures for the Goods and Services over the years. Nor does she provide any access figures with respect to the Applicant's website or Instagram posts or any other indication of the extent to which the Applicant's advertising has reached Canadian consumers. Furthermore, the examples of the business being promoted online (Exhibits H, I, K and L) and of the Applicant's distribution channels (the stores and caterers at Exhibits I and K) are all from the Applicant's website and Instagram as accessed in 2018; Ms. Mior provides no further indication of the nature or extent of the Applicant's promotional activities or product distribution prior to that date.

[104] Since it appears the Applicant has been operating an active business in the Greater Toronto Area for several years and, at least in 2018, had an active website, I accept that the Mark has become at least somewhat known in that specific area of Canada. However, in the absence information on the volume of the Applicant's sales and distribution or the nature and extent of its advertising over the years—including any information on the website's reach—I cannot conclude that the Mark has become known to any extent.

[105] Even if I were able to factor in the 2014 invoice (which is to the same purchaser as the 2016 invoice) and considered the trade name Cannoli Queens on this invoice to also be a trademark, this single example of an earlier sale would not be sufficient to change my overall conclusion [see *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB) with respect to trademark and trade name use not being mutually exclusive].

Conclusion with respect to inherent and acquired distinctiveness

[106] Overall, it would appear that the Opponent has been operating using the Opponent's Trademark slightly longer than the Applicant has been using the Mark. The evidence also shows that the Opponent's Trademark has been promoted by several means over the years—including online, on packaging, on signage, and through the Opponent's fleet of delivery and food service vehicles—whereas the only evidence of the Mark's promotion is the set of website and Instagram printouts from 2018.

[107] One of the Applicant's webpages lists several retailers and caterers for the Applicant's products; however, in the absence of any information from Ms. Mior regarding the extent to

which the Mark has been used and promoted through these channels, this list is of limited assistance. Similarly, although the Instagram photographs depict the CANNOLI QUEENS Logo on a menu board, packaging, Christmas display, and food service cart and banner, Ms. Mior does not specify whether any of these images are representative of the manner in which the Applicant has displayed the Mark at any point in time and, if so, the extent of such display.

[108] On the basis of the evidence described above, I conclude that the Mark is at least somewhat known—specifically, in the Greater Toronto Area—but that there is more evidence to suggest that the Opponent’s Trademark has become known—specifically, in the Greater Vancouver region.

[109] Thus, overall, the section 6(5)(a) factor favours the Opponent, but only slightly.

Length of time the trademarks have been in use

[110] The earliest evidence of use of the Opponent’s Trademark is Mr. Pero’s statement to the effect that the Opponent’s Trademark was first displayed on the white delivery car in 2013, as discussed above. The earliest evidence of use of the Mark, by the Applicant, within the meaning of the Act, appears to be the August 4, 2015 invoice at Exhibit J, for a shipment of cannoli from the Applicant’s bakery. Thus the earliest use demonstrated by the Applicant is subsequent to the first use of the Opponent’s Trademark, albeit only by a couple of years.

[111] I note that, even if I were able to factor in the 2014 invoice from the General Partnership as the Applicant’s predecessor in title—or even Ms. Mior’s statement that she and her two daughters have been baking and selling Italian style cannoli desserts since July 17, 2014—the Applicant’s date of first use would still be subsequent to the first use demonstrated by the Opponent.

[112] Accordingly, the length of time the trademarks have been in use favours the Opponent, albeit only slightly.

Nature of the parties’ goods, services, and trades

[113] When considering the nature of the goods and services and the nature of the parties’ trades under section 12(1)(d) of the Act, it is the statement of goods and services as defined in the applicant’s application and the statement of goods and services in the opponent’s registration

that must be assessed, having regard to the channels of trade that would normally be associated with such goods and services [see *Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Henkel Kommanditgesellschaft auf Aktien v Super Dragon Import Export* (1986), 12 CPR (3d) 110 (FCA)]. The statements must be read with a view to determining the probable type of business or trade intended by the parties, rather than all possible trades that might be encompassed by the wording; evidence of the parties' actual trades is useful in this respect [see *McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd*, 1999 CarswellNat 3465 (TMOB)].

[114] From a plain reading of the statements of goods and services in the Application and in the Opponent's Registration, it appears that the nature of the parties' goods, services and trades is largely the same.

[115] The Opponent's Registration covers various baked goods and snack foods, including "cannoli" and "cannoli chips", as well as baking and dessert mixes, and coffee. The Opponent's Registration also covers bakery, bake shop, food truck, and mobile canteen services, including the operation of a business providing bakery foods, coffee and other beverages for consumption on and off premises. The full list of registered goods and services is set out at Schedule A hereto.

[116] Similarly, the Goods in the Application can be generally described as pastries and baked goods, including "cannoli", as well as dough, ice-cream, coffee, and other beverages. The Services can be generally described as restaurant, bakery and delicatessen services, as well as franchising services for restaurants and bakeries.

[117] Indeed, the evidence also shows that both parties operate bakery, food sale and food service establishments, with a similar focus on cannoli pastries, including cannoli cakes. According to the website, the Opponent's cannoli is sold online, for pick-up or delivery; fresh at the Opponent's bakery; and at various markets, events and locations through the Opponent's food truck, which also offers catering. The Applicant's website does not offer the ability to order online but invites visitors to call or e-mail the Applicant and also provides a list of retail vendors and caterers, including the Applicant's Woodbridge establishment.

[118] In her affidavit, Ms. Mior emphasizes that "the Applicant offers a Venetian style pastry that are cannoncini alla crema (small cannoli with cream)", which she claims are "completely different" from the Opponent's "Sicilian style pastries in ricotta in several flavours" (paras 49,

70). However, the Opponent's website references not only "authentic Sicilian Cannoli" but also "other flavours", and the Applicant's website advertises flavours that include a "Sicilian Ricotta" filled variety. Moreover, although the Opponent's product is advertised as being deep fried rather than oven baked, both parties' products appear to be handmade, cylindrical, cream-filled pastries. Accordingly, I disagree with Ms. Mior's characterization of the parties' products as being "completely different". In any event, the Goods covered by the Application include "baked pastries that consist of tube-shaped shells of fried pastry dough filled with sweet creamy filling usually containing ricotta cheese" (emphasis added). What is more, the Opponent's Registration includes "Pastries; Cannoli; Custard and cream filled pastries", which is broad enough to also cover "small cannoli with cream" and oven-baked, cream-filled puff pastry, with or without ricotta.

[119] I also note the Applicant submission that it is not the Opponent's Trademark but rather the names "Italiabakery" and "CannoliBar" that are used in association with the Opponent's bakery. However, one of the Opponent's webpages that displays the Opponent's Trademark in the header advertises, "Our cannoli are also available 7 days a week at Italia Bakery Vancouver..." (SPA1 Exhibit I). Furthermore, the sign displayed in the Opponent's retail bakery in 2017 advertises the following under the Opponent's Trademark: "We locally handcraft every single cannoli shell from scratch ... at our commissary" (SPA1 Exhibit F). I am therefore satisfied that the Opponent's Trademark was being used in advertising at least a portion of the services being provided by the Opponent's bakery and bake shop. In any event, the statement of goods and services in the opponent's registration includes "Retail ...bakery services" and "Bakery shop services", and there is no requirement for the Opponent to evidence use of its trademark in association with the goods and services in its registration.

[120] Finally, I note that the Applicant's services are offered only in the Greater Toronto Area whereas the Opponent's services are offered only in the Greater Vancouver region. However, nothing prevents the parties from operating in the same provinces and even in the same localities going forward. Indeed, a trademark registration grants an exclusive right to use the trademark throughout Canada and section 6(2) of the Act stipulates that trademarks are confusing if use of both trademarks *in the same area* would be likely to create confusion.

[121] Given the significant overlap in goods and services and the apparent overlap in the nature of the trades, these two factors favour the Opponent.

Additional surrounding circumstances

[122] In its written argument, the Applicant raises several additional surrounding circumstances, as follows.

Scope of protection afforded to trademarks incorporating descriptive industry terms

[123] The Applicant submits that trademarks comprising the name of a type or style of food are considered to be inherently weak marks, which are not entitled to a high degree of protection, and that the element naming the food cannot be monopolized by any one trader [citing *Boston Pizza International Inc v Boston Chicken Inc*, 2001 FCT 1024; *Boston Pizza International Inc v TCC Holdings Inc*, 2016 TMOB 70; and *Pizza Delight Corp v Weisheit* (1995), 61 CPR (3d) 472 (TMOB)] Although no definitions were cited by the parties, I note that the *Concise Canadian Oxford Dictionary* (Toronto: Oxford University Press, 2005) defines “cannoli” as “a dessert consisting of small deep-fried pastry tubes filled with sweetened ricotta cheese and pieces of chocolate etc.”.

[124] The Applicant further submits that any degree of resemblance in the ideas suggested by the parties’ trademarks in the present case is “basically limited to the word ‘cannoli’ which cannot be monopolized by any one trader in the restaurant business”. The Applicant cites *Ortho Pharmaceutical Cor v Mowatt & Moore Ltd*, (1972) 6 CPR (2d) 161 for the proposition that, where elements of a particular trademark are common to the trade, they cannot be appropriated to the exclusive use of one particular trader, because they cannot be said to have in them the vital element of distinctiveness.

[125] Distinctiveness has to be assessed in the context of the goods and services in question [*McDowell v Laverana GmbH & Co KG*, 2017 FC 327]. It is well established that trademarks comprised of descriptive words are not inherently distinctive [*Prince Edward Island Mutual Insurance Co v Insurance Co of Prince Edward Island* (1999), 86 CPR (3d) 342 (FCTD)]. Trademarks lacking in distinctiveness are only entitled to a narrow ambit of protection, in the sense that a greater degree of discrimination may fairly be expected from the public and relatively small differences between the trademarks may suffice to avert confusion [*ibid*; and *GSW, supra*].

[126] In the present case, the first portion of the Opponent’s trademark—generally considered to be the most important for the purpose of distinction—is the word CANNOLI, which clearly describes the nature of at least some of the Opponent’s goods and the focus of its services, and in general suggests the type of food sold under the mark. I find that the suffix KING increases the inherent distinctiveness of the Opponent’s Trademark, but only to a limited extent, given that it imparts a laudatory connotation. Furthermore, in my view, the design elements in the Opponent’s Trademark serve primarily to reinforce these descriptive and laudatory elements.

[127] In view of the foregoing, I find that the Opponent’s Trademark is not entitled to a particularly wide ambit of protection, and that relatively small differences may suffice to avert confusion.

[128] While distinctiveness acquired through extensive use and promotion may increase the scope of protection afforded to such trademarks [see *Sarah Coventry, supra*], the Opponent’s evidence in this case falls short of demonstrating such extensive use or promotion.

[129] Therefore, this factor favours the Applicant.

State of the register and state of the marketplace

[130] Attached as Exhibit J to Mr. Pero’s affidavit is a printout from CIPO’s online trademarks database showing the results of a search on the keyword “cannoli*” in the trademark lookup field. Mr. Pero does not specify who performed the search or when, although the printout itself indicates that the database was last updated on November 14, 2017. This search returned hits for the following five active trademark cases:

Application No.	Trademark	Status
1845290	HOLY CANNOLI	formalized
1849532	<i>Holy Cannoli</i> ~ (HOLY CANNOLI)	formalized
1849534	THERE CANNOLI BE ONE	formalized

Application No.	Trademark	Status
1794544	 <p>(SWEET CAPONE'S ITALIAN BAKERY AND CANNOLI SHOP & Design)</p>	searched
1798228	THE BIG CANNOLI	allowed

[131] I note that the goods and services associated with these trademarks are not included in the search results, and the Registrar does not consider it appropriate to exercise its own discretion to assist a party by consulting the register for the particulars of marks not pleaded in the statement of opposition; such particulars should be filed in evidence.

[132] Mr. Pero does not state the purpose of this search. However, the statement of opposition includes the allegation that the Opponent's Trademark "was used extensively by the Opponent in the marketplace before any third parties adopted 'cannoli' as a component of a trademark" (para 12). If the Opponent's state-of-the-register evidence is merely intended to show that the word "cannoli" is not a common component of registered trademarks, then I find it to be of limited relevance. The word "cannoli" is the name of some of the parties' goods and describes an aspect of their services, and generally suggests the type of food sold under the Opponent's Trademark; it will therefore add little to the distinctiveness of the Opponent's Trademark, even if *none* of the trademarks revealed in the search happen to be in the Opponent's field.

[133] The Applicant, for its part, submits that the state-of-the-register evidence constitutes an admission that "there are a multitude of traders using the word 'Cannoli' for the same goods and services" which "results in the inference that the Opponent does not have a monopoly over the use of the component 'cannoli' with respect to food and beverage goods" (para 164). However, as noted above, the state of the register evidence does not indicate the goods and/or services associated with any of the trademarks listed. Nor does the evidence indicate whether any of the few trademarks listed are actually in use. Accordingly the state-of-the-register evidence is also incapable of supporting the Applicant's argument.

[134] In the circumstances, I do not consider this factor to assist either party.

No instances of actual confusion

[135] In her affidavit, Ms. Mior states that, except for the current proceeding, the Applicant has “never heard of the Opponent or its Registered Design Mark, either directly, or with any customer or supplier” (para 43). She further states that the Applicant has “never been contacted by any customer or supplier of the Opponent” and has not “heard of any confusion with Opponent’s business or products, and the Applicant’s business or products” (para 44).

[136] However, neither party provides information on the extent of its sales or of its advertising and promotion. A low volume of sales and promotional activity could easily explain the absence of evidence of confusion. More importantly, as discussed above, the evidence is that the Mark has only been used in the Greater Toronto Area, whereas use of the Opponent’s Trademark has been limited to the Greater Vancouver region. Therefore, the absence of instances of actual confusion might well be explained by the fact that, to date, the parties have been using their respective trademarks in different regions of Canada.

[137] Consequently, I do not consider the absence of evidence of actual confusion to be a relevant factor in the present case.

Use of the Mark in design from

[138] The Applicant submits that it uses the Mark in a form that is “nothing like the Opponent’s Trade-Mark” (para 141), namely a burgundy logo wherein the words of the Mark are stacked and framed by a circular design with a crown at the top of the circle. Ms. Mior states in her affidavit that the Opponent has never “shown or complained about the Applicant’s designs or logos” (*ibid.*).

[139] However, when considering a section 12(1)(d) ground of opposition, it is the effect of the mark applied for *itself* that must be considered, not the effect of other indicia that may appear together with the trademark [see *Reno-Dépôt Inc v Homer TLC Inc*, 2010 COMC 11; *Groupe Fruits & Passion Inc*, 2007 CarswellNat 2319 (TMOB)]. Such contextual factors do not form part of the trademark the applicant seeks to register.

[140] Accordingly, this factor does not assist the Applicant.

Beginnings of a family of marks

[141] The Applicant also argues, as a surrounding circumstance, that the Opponent has not established “any ‘family of series of marks’ incorporating the concept of ‘cannoli’ and ‘royalty’”, or the beginnings of such a family. The concept of a “family” of marks refers to a *series* of trademarks having common characteristics, registered and used by the same owner. Where a party owns a family of marks, there is an increased likelihood of consumers assuming that a new trademark sharing that characteristic is simply another member of the family [*Air Miles International Trading BV v SeaMiles LLC* (2009), 76 CPR (4th) 369 (TMOB)]. However, in the present case, I agree with the Applicant that the concept of a family of trademarks does not apply. The evidence shows different variations of the Opponent’s Trademark as opposed to a series of different trademarks within a family.

Conclusion with respect to confusion

[142] For the Applicant to meet its legal burden, the Registrar must be reasonably satisfied that, on a balance of probabilities, the registration sought is unlikely to create confusion; the Registrar need not be satisfied beyond doubt that confusion is unlikely [*Christian Dior SA v Dion Neckwear Ltd*, 2002 FCA 29, 20 CPR (4th) 155].

[143] Following my analysis of all the relevant factors, I am reasonably satisfied that, on a balance of probabilities, the Mark is not likely to create confusion with the Opponent’s Trademark. Although it is a close case, I find that the differences between the two trademarks are sufficient to avoid a likelihood of confusion as to the source of the parties’ respective goods and services, as a matter of first impression and imperfect recollection, despite the overlap in the nature of the goods, services and trades, and the slightly greater evidence with respect to use and promotion of the Opponent’s Trademark.

[144] I reach this conclusion bearing in mind that the Opponent’s Trademark has a relatively low degree of inherent distinctiveness— which has not been enhanced by significant evidence of acquired distinctiveness—and as such is not entitled to a particularly wide ambit of protection. Where a party has reached inside the common trade vocabulary for its mark and seeks to prevent competitors from doing the same thing, the range of protection accorded is more limited than in the case of an invented, unique or non-descriptive word. A greater degree of discrimination may

fairly be expected from the public where a trademark consists wholly or in part of words descriptive of the articles to be sold or the services to be rendered, such that comparatively small differences between such trademarks will suffice to avert confusion [*General Motors Corp. v. Bellows* (1949), 10 CPR 101 (SCC), at 115 and 116].

[145] For these reasons, I dismiss the ground of opposition based on section 12(1)(d) of the Act.

GROUND OF OPPOSITION BASED ON ENTITLEMENT UNDER SECTIONS 16(1)(A) AND 16(1)(C)

[146] The Opponent pleads that the Applicant is not the person entitled to registration of the Mark under section 16(1)(a) of the Act because, at the date when the Applicant first used the Mark and at the Application's filing date, the Mark was confusing with the Opponent's Trademark, which the Opponent had previously used in Canada and/or made known in Canada. More specifically, but without limitation, the Opponent pleads to similarity in the appearance and ideas suggested by the parties' respective trademarks; similarity in the parties' goods, services and trades; the Opponent's Trademark being "well known, if not famous, at least in British Columbia in the catering industry"; and the Opponent's Trademark being "used extensively by the Opponent in the marketplace before any third parties adopted 'cannoli' as a component of a trademark".

[147] The Opponent also pleads that the Applicant is not the person entitled to registration of the Mark under section 16(1)(c) of the Act because, at the Application's filing date, the Mark was confusing with the Opponent's Trade Name, which the Opponent had previously used in Canada.

[148] The material date for a ground of opposition based upon section 16(1) of the Act is typically be the claimed date of first use, in accordance with the wording of this section.

[149] The Applicant argues that the pleadings under section 16(1)(c) of the Act should be struck for alleging confusion only at the Application's filing date. However, since it is clear that the material date for assessing a ground of opposition under section 16(1)(c) is set by the Act and related jurisprudence, I consider any inaccuracy in the material date pleaded to be merely a technical error which does not invalidate the ground. In any event, regardless of whether

confusion is assessed at the filing date (December 22, 2015) or at the alleged date of first use (July 17, 2014), the outcome of this ground of opposition will be the same.

[150] To meet its initial burden under these section 16 grounds, an opponent must evidence the prior use or making known of its trademark in accordance with section 16(1)(a) of the Act or the prior use of its trade name in accordance with section 16(1)(c) of the Act. In addition, the Opponent must demonstrate that its trademark or trade name had not been abandoned at the date of advertisement of the applicant's application, as stipulated in sections 16(5) of the Act. (I note that, in this case, the Opponent has only pleaded that its trademark and trade name were not abandoned at the Application's *filing* date; however, given the clear wording of section 16(5), I consider it readily apparent that this too is a mere technical error).

[151] If the Opponent meets its initial burden, the onus will then be on the Applicant to satisfy the Registrar, on a balance of probabilities, that there was no reasonable likelihood of confusion between the Mark and the Opponent's trademark or trade name.

Section 16(1)(a)

[152] Section 16 of the Act does not impose any requirements concerning the length or extent of use of trademarks; so long as the mark functions as a trademark, a single instance of use of a mark within the meaning of section 4 of the Act may suffice for an opponent to meet its burden [JC Penney Co v Gaberdine Clothing Co, 2001 FCT 1333].

[153] As discussed above under the section 12(1)(d) ground of opposition, the First Pero Affidavit provides evidence of use of the Opponent's Trademark in association with bakery food services since 2013, which is prior to both the Applicant's claimed date of first use and the Application's filing date. Furthermore, I am prepared to accept the July 2015 photographs of the Opponent's Trademark displayed on delivery and food service vehicles, followed by the August 2017 photographs of its display on product packaging and bakery signs, as evidence that the Opponent had not abandoned its trademark at the date of advertisement of the Application, namely October 26, 2016. (In this respect, I also note that Ms. Mior's evidence includes promotional Instagram posts by the Opponent dated September 21, 2016 and November 4, 2016 displaying the Opponent's Trademark.)

[154] Accordingly, I find that the Opponent has also met its initial burden under the section 16(1)(a) ground of opposition.

[155] With respect to the test for confusion according to the factors set out in section 6(5) of the Act, the earlier material date associated with the section 16(1)(a) ground of opposition does not significantly alter the results of the analysis performed under the previous ground. As neither party furnished evidence of the *extent* of its trademark's use and promotion, the reduced evidence of acquired distinctiveness at the earlier material dates does not change my finding that the section 6(5)(a) factor only slightly favours the Opponent. I would also note that, under section 16, it is the goods and services for which the Opponent has shown actual use rather than those defined in its registration that govern the analysis of the sections 6(5)(c) and (d) factors. However, although much of the parties' examples of use and promotion of their respective trademarks are from after December 22, 2015, there is no indication that the nature of the parties' respective bakeries or cannoli goods were different before that date, including at the material date. Moreover, to the extent that the Opponent's evidence of use is with respect to services rather than goods, I accept that use of a trademark in association with the sale and delivery of baked goods overlaps with use of a trademark in association with baked goods themselves.

[156] Consequently, the section 16(1)(a) ground of opposition is dismissed as well.

Section 16(1)(c)

[157] A trade name as defined in section 2 of the Act is the name under which a business is carried on. Accordingly, an opponent relying on prior use of a trade name must demonstrate its use in the normal course of a functioning business and in relation to the class or classes of persons with whom such business is to be conducted [*Mr Goodwrench Inc v General Motors Corp* (1994), 55 CPR (3d) 508 (FCTD)]. In accordance with the principles of section 4 of the Act, the display of a trade name in advertising services will suffice in this respect [*Pacific Carbon Trust Inc v Carbon Trust*, 2013 FC 946.].

[158] The First Pero Affidavit provides the following evidence of use of the Opponent's Trade Name:

- The words "Cannoli King" in a large, thick lettering are displayed on a banner over a crowd at a Vancouver event called "Italian Days", photographed on June 8, 2013

(Exhibit H). A smaller “VANCOUVER” is printed in a different, thinner font immediately below the words “Cannoli King” on the banner; however, given the difference in size and lettering style, I am satisfied that the Opponent’s Trade Name stands out. Mr. Pero was informed and verily believes that approximately 300,000 people attended the “Italian Days” event (para 12). This evidence will be discussed in more detail below.

- The Opponent’s Trade Name is displayed as the title of the Opponent’s “About”, “Shop”, “Cart”, and “Contact” webpages and is otherwise referenced throughout its website at *www.cannoliking.ca*, for example, in the phrases “Cannoli King’s delicious Cannoli”, “Cannoli King provides onsite catering”, and “Contact the Cannoli King!” (Exhibit I). However, this evidence postdates the material date, as well as the Application’s filing date. As mentioned above, the exhibited webpages bear a print date of “11/7/2017”. Although the webpages bear a 2015 copyright notice, it is not known whether they went live prior to December 22 of that year and, if so, whether the Opponent’s Trade Name was displayed in the same way at that time.

[159] The statement of opposition does not claim use of “Cannoli King Vancouver” as a trade name. However, even if I were to consider use of that trade name as use of the trade name “Cannoli King” followed by a specification of the business’s location, it would not assist the Opponent’s case. In this respect, I note the following from the First Pero Affidavit:

- The references to Cannoli King Vancouver on the exhibited excerpts from the Opponent’s website (Exhibit I) postdate the material date, as well as the Application’s filing date, for the reasons set out in the previous paragraph. Although the information provided on the site is that Cannoli King Vancouver “was born” in 2013 and has been handcrafting cannoli “for over 35 years”, there is no evidence as to whether or how this trade name would have been displayed in the course of business at those times.
- Similarly, although Mr. Pero provides photographs of cannoli packaging boxes and bakery signage displaying the inscription “... Cannoli King Vancouver has continued our family tradition for over 35 years” (Exhibit F), these photographs were taken in August 2017, which is after both the material date and the Application’s filing date.

[160] Accordingly, the only evidence of trade name use that predates the material date (or the Application's filing date) is the photograph of the banner at the Italian Days event on June 8, 2013 (Exhibit H). However, in the absence of any information on the nature of the event, I do not consider this photograph alone to be sufficient to meet the Opponent's initial burden of showing use of the trade name in the normal course of a functioning business. In this respect, I note the following:

- the Opponent's website at *www.cannoliking.ca* (Exhibit I) does not specify *when* in 2013 Cannoli King Vancouver was "born";
- the photograph of the banner at Exhibit H does not depict any of the Opponent's evidenced trade channels (food truck, delivery, or pick-up at bakery);
- the website address printed on the banner, although partially obscured, is not "*www.cannoliking.ca*" but rather appears to be for Italia Bakery; and
- the telephone number on the banner does not match the number provided for Cannoli King on the *www.cannoliking.ca* website.

[161] Mr. Pero has not explained the Opponent's relationship with Italia Bakery or the history of the Cannoli King trade name, or otherwise explained these apparent discrepancies. In the circumstances, it is not clear whether the display of "Cannoli King" on this banner back in mid-2013 was as the name of a functioning business or, for example, as a trade mark or promotional slogan for a business operating under the name Italia Bakery.

[162] Accordingly, the Opponent has failed to satisfy its initial burden with respect to its section 16(1)(c) ground of opposition.

[163] I wish to note that, even if I were to consider the photograph of the Cannoli King banner at Exhibit H sufficient to establish prior use of the Opponent's trade name, and the excerpts from the Opponent's website at Exhibit I sufficient to show that the trade name had not been abandoned when the Application was advertised, I would consider the Applicant to have satisfied its legal burden to show that confusion was unlikely. The Opponent's Trade Name does not feature the crown design or letter spacing that factored into my analysis of the Opponent's Trademark under section 6(5)(e). However, in weighing all the surrounding circumstances, I would not have found this to be sufficient to tip the balance in the Opponent's favour.

[164] In any event, this ground of opposition is dismissed, for the Opponent's failure to meet its initial burden.

GROUND OF OPPOSITION BASED ON DISTINCTIVENESS OF THE MARK UNDER SECTION 2

[165] The Opponent also pleads that the Mark is not distinctive within the meaning of section 2 of the Act, because the Mark does not actually distinguish and is not adapted to distinguish the goods and services with which it is used or intended to be used from the goods and services of the Opponent or others in Canada.

[166] In its written arguments, the Applicant submits that the absence of reasons or evidence as to why the Opponent's Trademark is not distinctive renders this pleading "defective, vague and frivolous". However, the scope of this ground of opposition must be determined by considering the statement of opposition as a whole. Bearing in mind that the Opponent has worded this ground to reference both its own goods and services and those of others in Canada, I find the Opponent's pleading to be that the Mark is (i) clearly descriptive in the manner alleged under the section 12(1)(b) ground of opposition and (ii) confusing with the Opponent's Trademark and the Opponent's Trade Name in the manners alleged under the sections 12(1)(d), 16(1)(a) and 16(1)(c) grounds of opposition.

[167] The material date to analyze a ground of opposition based on the absence of distinctiveness is generally considered to be the filing date of the statement of opposition [see *Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* 2004 FC 1185, 34 CPR (4th) 317].

[168] With respect to the allegation that the Mark is clearly descriptive, I have already found that the Opponent has failed to meet its evidential burden when assessed at the filing date of the Application, and there is no reason for me to conclude otherwise as of the filing date of the statement of opposition.

[169] With respect to the likelihood of confusion, an opponent relying on its own trademark or trade name must establish that, as of the material date, its mark or name had become sufficiently known in Canada to negate the distinctiveness of the applicant's mark [*Motel 6 Inc v No 6 Motel Ltd* (1981), 56 CPR (2d) 44 (FCTD); *Bojangles' International LLC v Bojangles Café Ltd*, 2006 FC 657]. Where, as here, an opponent's reputation is restricted to a specific area of Canada, the opponent has the initial burden to show that its trademark or trade name was well known in that

specific area at the relevant date [*Bojangles, ibid.*; *CEG License Inc v Joey Tomato's (Canada) Inc*, 2012 FC 1541]. An opponent may prove that the trademark or trade name had become well known by any means, but must present clear evidence to that effect [*Bojangles, ibid.*].

[170] Once the opponent's initial burden is met, the applicant has a legal onus to show, on a balance of probabilities, that its own trademark was adapted to distinguish or actually distinguished its goods and services from those of the opponent; in this respect, the applicant must establish that its trademark was not likely to create confusion with the opponent's trademark or trade name at the relevant date [see *Muffin Houses Incorporated v The Muffin House Bakery Ltd* (1985), 4 CPR (3d) 272 (TMOB)].

[171] In the present case, the evidence with respect to the Opponent's Trademark becoming known in Canada is summarized above under the section 12(1)(d) ground of opposition. The evidence with respect to the Opponent's Trade Name becoming known is summarized above under the section 16(1)(c) ground of opposition, including the evidence that postdates the material date for the entitlement ground but that can be considered at the later material date of the distinctiveness ground.

[172] Having reviewed this evidence, I find that it falls short of demonstrating that the Opponent's Trademark and/or the Opponent's Trade Name had become well known in the Greater Vancouver region at the material date of March 24, 2017, or had become known to any extent elsewhere in Canada at that date.

[173] As explained in *Bojangles*, a trademark owner cannot simply assert that its trademark or trade name is known in Canada; there must be clear evidence of the extent to which it is known. In this case, the evidence is that the Opponent's bakery, website with online store, and Instagram presence—as well as its branded delivery car, food truck and food cart—were operational at the material date. However, there is no confirmation as to whether the bakery and online store were branded in the same manner at that time as they were when the photographs and printouts furnished in support were taken, later in 2017. There is also no information on the volume of traffic to the bakery, website, or Instagram posts. Although Mr. Pero specifies the frequency with which the delivery car and food truck were driven at the time of his first affidavit, he does not confirm whether they were driven with the same frequency at the material date.

[174] Accordingly, the ground of opposition based on non-distinctiveness is rejected, as the Opponent has failed to meet its initial burden.

DISPOSITION:

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

Oksana Osadchuk
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

SCHEDULE A

Trademark:

Cannoliking 

Registration No.:

TMA954,046

Filed:

2015-06-09

Registered:

2016-11-02

Trademark description:

The words 'CANNOLIKING' in a stylized font with a jeweled crown over the letter 'g'.

Colour Claim:

Colour is claimed as a feature of the trade-mark. The words 'CANNOLIKING' are black, the crown is gold, and the three jewels in the crown are, from left to right, green, white, and red.

Goods

Pastries; Cannoli; Custard and cream filled pastries; Cookies; Pies; Muffins; Cakes; Cannoli chips; Cheese dips; Snack food dips; Coffee; Biscuit mixes; Bread mixes; Cake mixes; Dessert mixes.

Services

Retail, wholesale, and mobile bakery services; Food truck services; Mobile bakery services; Bakery shop services; Operation of a business providing bakery foods, coffee, and other beverages for consumption on and off premises; Provision of food and beverages in mobile canteen services.

Claims:

Used in CANADA since at least as early as June 09, 2012

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

No Hearing Held

AGENTS OF RECORD

Palmer IP Inc.

For the Opponent

Christian Piersanti

For the Applicant