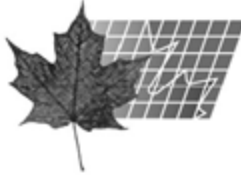


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 144

Date of Decision: 2020-12-31

IN THE MATTER OF AN OPPOSITION

2441674 Ontario Inc.

Opponent

and

**Hotline International Pizza Systems
Ltd.**

Applicant

1,765,695 for STONE-FIRE'D

Application

INTRODUCTION

[1] On January 29, 2016, Hotline International Pizza Systems Ltd. (the Applicant) filed application No. 1,765,695 (the Application) to register the trademark STONE-FIRE'D (the Mark). The Application is based on use of the Mark in Canada since at least January 31, 2015 in association with the following goods and services (Goods and Services):

Goods:

- (1) Household goods and glass, namely, coffee mugs
- (2) Clothing, namely, baseball caps, T-shirts, sweatshirts, shorts and pants
- (3) Sports equipment, namely, golf balls
- (4) Food, namely, fresh and frozen prepared entrees, namely, meat and vegetable dishes, salads, chicken wings, chicken dishes, meat pies, hors d'oeuvres


- (5) Pizza; spaghetti; lasagna; pastas; sauces, namely tomato sauce, barbeque sauce, cream sauce and Italian white sauce

Services:

- (1) Transport, namely restaurant delivery services
- (2) Restaurant services, namely dine-in and delivery services

[2] The Application was advertised for opposition purposes in the *Trademarks Journal* on October 18, 2017. On December 18, 2017, 2441674 Ontario Inc. (the Opponent) filed a statement of opposition against the Application pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019. All references in this decision are to the Act as amended, with the exception of references to the grounds of opposition which refer to the Act as it read before it was amended (see section 70 of the Act which provides that section 38(2) of the Act as it read prior to June 17, 2019 applies to applications advertised prior to that date).

[3] The Opponent raises grounds of opposition based on registrability under section 12(1)(d), entitlement under section 16(1)(a), distinctiveness under section 2, and non-compliance with sections 30(b) and 30(i) of the Act. With respect to the registrability, entitlement and distinctiveness grounds, the Opponent relies on its use and registration of the following trademarks, all of which include or are comprised of the term STONEFIRE or STONE FIRE (collectively, the STONEFIRE Trademarks):

Trademark	Registration No.	Goods
STONEFIRE	TMA927,808	Crackers; Crisp bread; Flour-based chips; grain-based chips; Pita chips
	TMA875,030	Flatbread
STONEFIRE	TMA833,318	Flatbread
STONE FIRE	TMA862,176	Flatbread

[4] The Applicant filed a counter statement on March 5, 2018, denying the allegations set out in the statement of opposition.

[5] Both parties filed evidence. Only the Opponent filed written representations and neither party requested a hearing.

EVIDENCE

[6] The evidence filed by the parties is briefly summarized below and is discussed further in the analysis of the grounds of opposition.

Opponent's evidence

[7] The Opponent filed the affidavits of James Gibson (the Gibson affidavit), sworn July 4, 2018, and the affidavit of Kristie-Ann Yamane (the Yamane affidavit), sworn July 3, 2018.

The Gibson affidavit

[8] Mr. Gibson is the Vice President, Marketing and Category Management for FGF Brands Inc. ("FGF") and has held this position since October 1, 2016 (para 1). His responsibilities include overseeing FGF's global marketing efforts, the trademark portfolio, and maintaining current and historical records associated with the use of FGF's marks in product development, advertising, marketing, sponsorship, and sales activities (para 1). Mr. Gibson explains that FGF is a licensee in Canada of the STONEFIRE trademark owned by the Opponent (para 2).

[9] Mr. Gibson provides the particulars of the registrations for the STONEFIRE Trademarks owned by the Opponent in Canada (as well as other jurisdictions) (paras 5,6). He explains how the Opponent's marks are used in association with its goods, and provides information on the distribution channels, advertising, and promotion of the Opponent's goods (paras 7-10, 13-18). Sales information from goods bearing the STONEFIRE Trademarks in Canada from 2012-2018 (June) is also provided (paras 11-12).

The Yamane affidavit

[10] Kristie-Ann Yamane is employed as an intellectual property investigator with Marksmen Inc. (para 2). On March 12, 2018, she was instructed by her supervisor to investigate the use of

the trademark “STONE FIRE’D” by the Applicant (para 4). A copy of her final report, dated March 27, 2018, is attached to her affidavit (para 5, Exhibit A).

Applicant’s evidence

[11] The Applicant filed the affidavit of Antonio Cianflone (sworn November 5, 2018), the Vice President of the Applicant. Mr. Cianflone was initially employed part-time as a student starting in 2011 and has been actively involved in the day-to-day corporate operations of the Applicant as a full-time employee since May 2017 (paras 1, 2). In the course of preparing his affidavit, he reviewed the business records of the Applicant (para 3).

[12] Mr. Cianflone provides information on the background and business of the Applicant in Canada (paras 4-12). He also provides evidence relating to the use of the Mark in Canada, sales information, and promotional/marketing information (paras 13-23).

Reply evidence

[13] In reply, the Opponent filed the affidavit of Sarah D’Ambrosio (sworn December 5, 2018), who at the time of swearing of the affidavit was employed as an articling student for the agent for the Opponent (para 1). Ms. D’Ambrosio was asked to conduct and print the results of various Google searches including for: a) pizza restaurants in Canada that advertise pizzas and pizza doughs for sale on their respective websites; b) pizza restaurants in Canada that advertise “ready to bake” or “take and bake” pizzas for sale on their respective websites; and c) pizza restaurants in Canada that promote pizzas on their menu using flat bread as a crust (paras 2-5, 8-9). Ms. D’Ambrosio was also asked to visit and print pages from the websites of various pizzerias and restaurants in the Greater Toronto Area that also sold grocery products (paras 6, 7).

ONUS AND MATERIAL DATES

[14] The Applicant bears the legal onus of establishing, on a balance of probabilities, that its application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD) at 298].

[15] The material dates that apply to the grounds of opposition pleaded are:

- Sections 38(2)(a)/30 – the filing date of the application [*Georgia-Pacific Corp v Scott Paper Ltd* (1984) 3 CPR (3d) 469 (TMOB) at 475];
- Section 38(2)(b)/ 12(1)(d) – the date of my decision [*Park Avenue Furniture Corporation v Wickes/Simmons Bedding Ltd and The Registrar of Trade Marks* (1991), 1991 CanLII 11769 (FCA), 37 CPR (3d) 413 (FCA)];
- Sections 38(2)(c)/16(1)(a) – the claimed date of first use [16(1) of the Act]. However, if this date of first use is successfully challenged, the material date becomes the filing date of the application [*Everything for a Dollar Store (Canada) Inc v Dollar Plus Bargain Centre Ltd* (1998), 86 CPR (3d) 269 (TMOB)]; and
- Sections 38(2)(d)/2 – the date of filing of the opposition [*Metro-Goldwyn-Mayer Inc v Stargate Connections Inc* (2004), 2004 FC 1185 (CanLII), 34 CPR (4th) 317 (FC)].

ANALYSIS OF THE GROUNDS OF OPPOSITION

Ground of opposition under section 30(b)

[16] The Opponent has pleaded that the Application does not comply with sections 38(2)(a) and 30(b) of the Act because the Applicant did not use as a trademark the Mark in Canada with any or all of the Goods and Services as of January 31, 2015, the claimed date of first use in the Application.

[17] The initial burden on an opponent is light respecting the issue of non-conformity with section 30(b) of the Act, because the facts regarding an applicant's first use are particularly within the knowledge of an applicant [*Tune Masters v Mr P.'s Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB)]. This burden can be met by reference not only to the opponent's evidence but also to the applicant's evidence [*Labatt Brewing Co Ltd v Molson Breweries, A Partnership* (1996), 68 CPR (3d) 216 (FCTD)]. However, an opponent may only successfully rely on the applicant's evidence to meet its initial burden if the opponent shows that the applicant's evidence puts into issue the claims set forth in the applicant's application [*Corporativo de Marcas GJB, SA de CV v Bacardi & Company Ltd*, 2014 FC 323 at paras 30-38].

[18] 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 [*Masterfile Corporation v Mohib S Ebrahim*, 2011 TMOB 85].

[19] In this case, the Opponent relies primarily on the Cianflone affidavit filed by the Applicant. As discussed below, I find the Opponent to be successful in discharging its initial burden in respect of some of the Goods.

[20] Section 4 of the Act sets out what constitutes “use” of a trademark in association with goods and services. Section 4(1) and (2) read 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.

(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.

[21] In his affidavit, Mr. Cianflone attests to the following:

- The Applicant is a family owned operator and franchisor of restaurants in Canada, and has carried on business in Manitoba under the business names “Pizza Hotline” since 1993, and “Café 22” since 1999, providing restaurant services which include both dine-in and delivery options. Although pizza was the primary food item, the restaurants also prepared and sold lasagna, pastas, meat and vegetable dishes, salads, chicken wings, chicken dishes, meat pies, hors d’oeuvres and sauces, namely tomato sauce, barbeque sauce, cream sauce and Italian white sauce (para 4). Currently, the Applicant operates or franchises 24 restaurant locations across Manitoba (para 5).
- Initially, the Pizza Hotline locations were take-out and delivery only, and the Café 22 locations provided dine-in services. However, there are currently a number of locations operating as both Pizza Hotline and Café 22, and providing both dine-in and take-out/delivery services (para 6).

- By November 2012, the Applicant opened a corporately owned Pizza Hotline location in Winnipeg Square Concourse, and started operating under the trademark “PIZZA HOTLINE STONE FIRED PIZZERIA”. This was the first Pizza Hotline location to use a stone oven to cook pizzas. It also provided dine-in restaurant services (para 7).
- By January 1, 2015, three additional Pizza Hotline franchise restaurants using a stone oven and also providing dine-in restaurant services and operating under the trademark “PIZZA HOTLINE STONE FIRED PIZZERIA” were opened in Manitoba (all of the Applicant’s restaurants using a stone oven to cook pizzas are collectively referred to as the “Pizzeria Restaurants”) (paras 9, 10).
- On or about January 1, 2015, the Applicant began rebranding to use the Mark (STONE-FIRE’D) separate from and primarily above the words PIZZA HOTLINE. The Mark began appearing on menus, restaurant signage and other printed materials associated with casual dining (para 12). Exhibit B is a copy of the menu that the Pizzeria Restaurants commenced using in January 2015, bearing the Mark (para 13).
- As early as January 31, 2015, the Applicant also started using the Mark on disposable cups, cardboard pizza boxes and disposable paper sheets used to line trays and cardboard pizza boxes. These items were provided to Pizzeria Restaurant customers when they dined-in or ordered take-out or delivery items (para 14). Exhibits C, E, and D, respectively, contain images of these items, which display the Mark (para 15).
- The Applicant has used the Mark on baseball caps since January 2015, which are worn by employees who serve customers at the Pizzeria Restaurants (para 16, Exhibit F).
- Since January 2015, the Applicant was “distributing and has distributed glasses, mugs, articles of clothing, such as t-shirts and baseball caps, and golf balls bearing the Mark as promotional items to customers and potential customers but has not tracked the number or value of these goods” (para 17).
- In February and April 2017, the Applicant opened Pizza Hotline franchise restaurants at locations in Selkirk and Winnipeg, respectively. Exhibits G and H are images of exterior

restaurant signage displaying the Mark. The Mark has also been displayed on interior restaurant signage (para 20, Exhibit I).

- All the Pizzeria Restaurants provide home and/or business delivery services for their food products (para 21).
- The Applicant has displayed promotional brochures and photographs displaying the Mark on its social media sites namely Facebook and Instagram (para 22, Exhibits J, K).

Analysis

Goods (1), (2), (3) – coffee mugs, clothing, sports equipment

[22] As noted by the Opponent in its written representations, in paragraph 17 of his affidavit, Mr. Cianflone states that “by January, 2015 and since, Hotline was distributing and has distributed glasses, mugs, articles of clothing, such as T-shirts and baseball caps, and golf balls bearing the STONE-FIRE’D trademark as promotional items to customers and potential customers yet provides no assertion or proof that these same items were actually sold to customers, or that the distribution of these goods led to eventual sales. While the Federal Court has indicated that the free distribution of goods can, depending on the circumstances, constitute a step in the normal course of trade in the industry where the owner of the trademark is seeking to develop a market [*ConAgra Foods, Inc v Fetherstonhaugh & Co*, 2002 FCT 1257, 23 CPR (4th) 49 (FCTD)] in this case, Mr. Cianflone expressly states that since January 2015 these goods have been and continue to be distributed for promotional purposes. As a result, I find that this distribution cannot be regarded as a transaction involving a transfer in the normal course of trade.

[23] Mr. Cianflone also states that baseball caps bearing the Mark have been worn by employees serving customers since January 2015. However, the mere provision of uniforms or gifts of clothing displaying a trademark does not constitute use in the normal course of trade [*Dial Corp et al v Fiorucci SpA* (1996) 74 CPR (3d) 105 at 114 (TMOB)]. Further, there is no indication from Mr. Cianflone that the baseball caps or any other items of clothing are sold to its employees, such that they cannot be considered to be objects of trade [*Cosmetic Warriors Limited v Riches, McKenzie & Herbert LLP* (2019) 164 CPR (4th) 97 (FCA)].

[24] Accordingly, I find that the Applicant's evidence is sufficient to put into issue the claimed date of first use in respect of the goods "Household goods and glass, namely, coffee mugs; clothing, namely, baseball caps, T-shirts, sweatshirts, shorts and pants; sports equipment, namely golf balls". In view of this, the burden shifts to the Applicant to show that the Mark has been used in association with these goods from the date claimed, up to the filing date of the application [*Labatt Brewing Co, supra* at 262]. It has not done so.

Goods (4), (5) and Services – food, pizza, restaurant delivery and restaurant services

[25] For ease of reference, a list of the Goods (4) and (5) and the Services are set out below:

(4) Food, namely, fresh and frozen prepared entrées, namely, meat and vegetable dishes, salads, chicken wings, chicken dishes, meat pies, hors d'oeuvres

(5) Pizza; spaghetti; lasagna; pastas; sauces, namely tomato sauce, barbeque sauce, cream sauce and Italian white sauce

Services:

(1) Transport, namely, restaurant delivery services

(2) Restaurant services, namely, dine-in and delivery services

[26] The Opponent points out that while Mr. Cianflone makes a "bald statement" regarding the Applicant's sale of "lasagna, pastas, meat and vegetable dishes, salads, chicken wings, chicken dishes, meat pies, hors d'oeuvres and sauce, namely tomato sauce, barbeque sauce, cream sauce and Italian white sauce", the copy of the menu that the Applicant's Pizzeria Restaurants started using in January 2015 bearing the Mark does not feature all these items but is instead limited to "pizzas", "salads", "calzone", "dessert" and "drinks". While the menu is limited to these categories of goods, I note that it also highlights various sauces under the "Build your own Pizza" – "Sauces" and "Finishes" section, including classic vine ripened sauce, San Marzano style, white sauce, and BBQ sauce. The Opponent further submits that all printouts and photographs supplied by the Applicant in the Cianflone affidavit and in the Yamane affidavit suggest that the Mark had only been associated with pizza, an observation with which I generally agree.

[27] In view of the foregoing, and considering that there is no indication of any other menus introduced in January 2015 (as Mr. Cianflone simply refers to "the menu"), I find that the evidence creates uncertainty as to whether there was use of the Mark in association with all of

these foods as of the material date, with the exception of pizza, salad, and sauces, namely tomato sauce, barbeque sauce, and Italian white sauce. Accordingly, I find that this evidence is sufficient to put into issue the claimed date of use with respect to “food, namely fresh and frozen prepared entrées, namely meat and vegetable dishes, chicken wings, chicken dishes, meat pies, hors d’oeuvres; spaghetti; lasagna; pastas; sauces, namely cream sauce”. In view of this, the burden shifts to the Applicant to show that the Mark has been used in association with these goods from the date claimed, up to the filing date of the application [*Labatt Brewing Co, supra* at 262]. It has not done so.

[28] In its written representations, the Opponent points out that the investigator’s searches (Yamane affidavit) indicate that the Applicant’s social media and internet presence do not include reference to the Mark as of January 31, 2015. However, I do not consider this to put the claimed date of first use into issue with respect to any of the Goods or Services as there is nothing requiring the Applicant to have displayed the Mark online as of January 31, 2015.

[29] The Opponent also points out that while Mr. Cianflone asserts use of the Mark on disposable cups, cardboard pizza boxes, disposable paper sheets used to line trays and pizza boxes, restaurant signage, and social media, and provides exhibits showing this use, that the earliest referenced date in these attachments is July 22, 2016, and that it is not clear whether these photographs were taken on or prior to January 31, 2015. The Opponent submits that other than a mere assertion that the Mark began appearing on the menu and other materials associated with casual dining on or about January 1, 2015, there is no showing by the Applicant that the Mark was in fact used by the Applicant with restaurant delivery or dine-in services as of the claimed first use date. However, and as noted above, the Applicant is under no obligation to evidence its claimed date of first use if this date is not first put into issue by the Opponent, and I do not find that the Opponent has done so in respect of restaurant delivery or restaurant dine-in services.

[30] Accordingly, the section 30(b) ground of opposition is only successful with respect to the following goods: “Household goods and glass, namely, coffee mugs; clothing, namely, baseball caps, T-shirts, sweatshirts, shorts and pants; sports equipment, namely golf balls” and “food, namely fresh and frozen prepared entrées, namely meat and vegetable dishes, chicken wings,

chicken dishes, meat pies, hors d'oeuvres; spaghetti; lasagna; pastas; sauces, namely cream sauce.”

Ground of opposition under section 30(i)

[31] The Opponent has pleaded that contrary to sections 38(2)(a) and 30(i) of the Act, the Applicant could not have been satisfied of its entitlement to use the Mark in Canada in association with the Goods and Services due to its knowledge of the Opponent's use and registration in Canada of the STONEFIRE Trademarks.

[32] Where an applicant has provided the statement required by section 30(i), this ground should only succeed in exceptional cases such as where there is evidence of bad faith on the part of the applicant [*Sapodilla Co v Bristol-Myers Co* (1974), 15 CPR (2d) 152 (TMOB) at 155]. The application for the Mark contains the requisite statement and there is no evidence that this is an exceptional case. Accordingly, this ground of opposition is summarily rejected.

Ground of opposition under section 12(1)(d)

[33] The Opponent has pleaded that the Mark is not registrable pursuant to sections 38(2)(b) and 12(1)(d) of the Act as the Mark was, and is, confusing with one or more of the Opponent's STONEFIRE Registrations (set out above in paragraph 3).

[34] I have exercised my discretion and checked the Register to confirm that these registrations are extant [*Quaker Oats of Canada Ltd/La Compagnie Quaker Oats du Canada Ltée v Menu Foods Ltd* (1986), 11 CPR (3d) 410 (TMOB)]. Therefore, the Opponent has met its initial burden with respect to this ground. As a result, the Applicant bears the legal burden of demonstrating on a balance of probabilities that there is no likelihood of confusion between the Mark and the Opponent's registrations for the STONEFIRE Trademarks.

[35] In considering the issue of confusion, I will focus my analysis on the Opponent's registrations for the word trademark STONEFIRE as in my view this represents the Opponent's best case. That said, I also consider use of the Opponent's design mark covered by registration No. TMA875,030 to constitute use of the word mark STONEFIRE, as it comprises the dominant

element of the mark [*Nightingale Interloc Ltd v Prodesign Ltd*, (1984), 2 CPR (3d) 535 (TMOB)].

Test for confusion

[36] The test for confusion is one of first impression and imperfect recollection. Section 6(2) of the Act indicates that 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.

[37] In making such an assessment, I must take into consideration all the relevant surrounding circumstances, including those listed in section 6(5) of the Act: the inherent distinctiveness of the trademarks and the extent to which they have become known; the length of time the trademarks have been in use; the nature of the goods and services or business; the nature of the trade; and the degree of resemblance between the trademarks in appearance, or sound or in the ideas suggested by them. These criteria are not exhaustive and different weight will be given to each one in a context specific assessment [*Mattel, Inc v 3894207 Canada Inc*, 2006 SCC 22, [2006] 1 SCR 772 (SCC) at para 54].

[38] The test for confusion is assessed as 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 trademark, and does not pause to give the matter any detailed consideration or scrutiny, nor to examine closely the similarities and differences between the marks [*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltee*, 2006 SCC 23 at para 20].

Inherent distinctiveness

[39] I find both parties' trademarks to be inherently weak as they are both highly suggestive of the cooking or baking method of their respective goods (in ovens built with stone and heated with fire), particularly pizzas and flatbread. Mr. Cianflone refers to the use of a "stone oven",

and the Applicant's menu indicates that its "pizzas are stone-fire'd in 180 seconds" (Exhibit B, Cianflone affidavit). The Applicant's promotional materials also depict pizza being placed into a fire-burning oven (Exhibit J, Cianflone affidavit). Similarly, the Opponent's packaging materials include a description of its flatbread as "stone oven baked" (Exhibit C, Gibson affidavit).

[40] I further note that I do not consider the addition of a hyphen and an 'apostrophe d' to the "fire" element of the Applicant's Mark to materially affect the inherent distinctiveness of the Mark.

[41] Overall, this factor favours neither party.

Extent known and length of time in use

[42] The Gibson affidavit indicates that the STONEFIRE Trademarks have been in use in Canada by the Opponent and/or its licensee, FGF, since at least as early as 2010. I note that the Opponent's registration Nos. TMA833,318 and TMA875,030 for the word mark STONEFIRE and the STONEFIRE design mark claim use in Canada since at least as early as May 1, 2010 and May 1, 2011, respectively, in association with flatbread.

[43] Mr. Gibson attests that:

- FGF is a licensee in Canada of the STONEFIRE trademark owned by the Opponent. Pursuant to the license, the Opponent has control over the character and quality of the goods and services manufactured, sold, and distributed in Canada by FGF under the STONEFIRE trademark (para 2).
- The STONEFIRE Trademarks appear directly on packaging of the goods sold by FGF. Copies of photographs of product packaging for the Opponent's goods, including flatbread, displaying the STONEFIRE trademark are attached (Exhibit C). These photographs are representative of how the STONEFIRE Trademarks appeared on the Opponent's goods sold in Canada since at least as early as 2010 continuously to the present (para 7).

- The STONEFIRE Trademarks also appear on point-of-purchase display racks in supermarkets, grocery stores, and bakery sections of wholesalers where the Opponent's goods are sold. Exhibit D consists of photographs of shelving and product displays displaying the STONEFIRE Trademarks. These photographs are representative of how the Opponent's STONEFIRE Trademarks have appeared on such point-of-purchase display racks since at least as early as 2010 continuously to the present (para 8).
- The goods bearing the STONEFIRE Trademarks are distributed and sold both at the retail and wholesale level. FGF under license from the Opponent contracts with major food distributors in Canada to supply goods bearing the STONEFIRE Trademarks to restaurants, food service providers, and grocery stores, including IGA, Metro, Food Basics, Colemans, Save on Foods, FreshCo, and Loblaws, who then market and sell the Opponent's goods to customers. FGF, under license by the Opponent, also sells the Opponent's goods directly to customers through wholesale and retail outlets and meal-kit companies (para 9). Customers may also purchase the goods bearing the STONEFIRE Trademarks online through grocery ecommerce websites, such as *iga.net* and *colemans.ca* (para 10).
- Between 2012 and June 2018, the total revenue received in Canada from goods bearing the STONEFIRE Trademarks through retail, wholesale and online channels was in excess of \$48 million (para 12).
- Goods bearing the STONEFIRE Trademarks have been advertised, under license by the Opponent, through various channels including supermarket and grocery store flyers. FGF has spent in excess of \$3.5 million to advertise goods with the STONEFIRE Trademarks on these flyers, as well as place these goods on supermarket shelves. Copies of grocery store flyers promoting the Opponent's goods (including naan and artisan flatbread) and displaying the STONEFIRE trademark are provided (Exhibit G), and Mr. Gibson states that these flyers are representative of how the STONEFIRE Trademarks have been advertised in Canada with these goods since at least as early as 2010 (para 13).
- The Opponent's goods bearing the STONEFIRE Trademarks have also been promoted, under license, on FGF's websites at *www.fgfbrands.com* and *www.stonefire.com*. Copies

of screen captures from these web pages showing the Opponent's marks with the goods are also provided (Exhibit J), and are stated to be representative of webpages from these sites since at least 2010 (para 16). Website traffic information (with data for Canada) for the *www.stonefire.com* website is also provided (para 17).

- FGF under license from the Opponent also advertises the STONEFIRE Trademarks on its social media websites, including FGF's STONEFIRE Facebook profile page (which has over 195,000 subscribers) and Instagram account (with over 5,200 followers). Mr. Gibson states that between 1-5% of these subscribers/followers are Canadian (para 18, Exhibit K).
- The STONEFIRE Trademarks have also appeared in print and online trade magazines that are available and accessible to Canadians, including *Pizza Magazine Quarterly* and *Specialty Food Magazine* (para 14). Exhibit H contains a copy of one article from each publication, dated June 2014 and July/August 2013 respectively, which references the STONEFIRE brand along with a number of other brands in discussing the general popularity of flatbreads. In addition, goods bearing the STONEFIRE Trademarks have appeared on television shows broadcasted in Canada, for example in 2011 on the reality television series *Hell's Kitchen* (airing on the CityTV network) and the daily lifestyle program *Rachel Ray* (broadcasted on Global TV), and in 2014 on an episode of the cooking show *The Pioneer Woman* (broadcasted on Food Network Canada) (para 15, Exhibit I). However, I note that no corresponding Canadian magazine subscription/readership or television viewership information is provided.

[44] Based on the foregoing, I am satisfied that the Opponent's trademark STONEFIRE has become known to a fair extent in Canada.

[45] The Applicant has claimed use of its Mark in association with the Goods and Services since January 31, 2015, but as shown above, the Opponent successfully challenged the claimed date of first use with respect to the bulk of the listed Goods. The Applicant has provided "global" sales figures (broken down by month) for Pizzeria Restaurants from September 2012 to October 2018, though I am somewhat uncertain to what extent these figures reflect the sale of the Goods and Services in association with Mark given that use of the Mark only commenced in January

2015. The Applicant has also provided some evidence of promotion of the Mark in association with pizza and its restaurant services through its social media, though it does not provide specific information such as the number of Canadian social media subscribers which would assist in providing some indication of how many consumers were exposed to the advertising.

[46] While the Applicant's Mark has likely also become known to some extent, given the longer duration of use of the Opponent's mark and the broader scope of its promotion, in my view, the Opponent's trademark is likely known to a greater extent than the Applicant's Mark.

[47] Accordingly, these factors favour the Opponent.

Nature of the goods, services or business; and nature of the trade

[48] When considering the goods and services of the parties, it is the statement of goods and services in the parties' trademark application and registrations that govern the issue of confusion arising under section 12(1)(d) [*Mr Submarine Ltd v Amandista Investments Ltd* (1987), 19 CPR (3d) 3 (FCA); and *Miss Universe Inc v Bohna* (1994), 58 CPR (3d) 381 (FCA)]. However, those 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. In this regard, evidence of the actual trades of the parties can be useful, particularly where there is an ambiguity as to the goods or services covered in the application or registration at issue [*McDonald's Corp v Coffee Hut Stores Ltd* (1996), 68 CPR (3d) 168 (FCA); *Procter & Gamble Inc v Hunter Packaging Ltd* (1999), 2 CPR (4th) 266 (TMOB)].

[49] The Opponent's registrations cover goods including flatbread (TMA833,318 for STONEFIRE; TMA862,176 for STONE FIRE; TMA875,030 for STONEFIRE Design); and crackers; crisp bread; flour-based chips; grain-based chips; pita chips (TMA927,808 for STONEFIRE). Mr. Gibson attests that FGF, under license from the Opponent, contracts with major food distributors in Canada to supply the Opponent's goods bearing the STONEFIRE trademarks to restaurants, food service providers, and grocery stores, who then market and sell these goods to customers. The Opponent's goods are also sold online through grocery ecommerce websites and stores, and as part of "meal kits" such as HelloFresh. I note that the Opponent's product packaging suggests potential uses for the products, for example, its artisan

flatbread is promoted as “perfect for pizzas, appetizers, and sandwiches” (Gibson affidavit, Exhibit C, at page 11).

[50] Mr. Cianflone’s affidavit establishes that the Applicant operates and/or franchises restaurants, some of which (defined above as the Pizzeria Restaurants) use a stone oven to cook pizzas. The record before me indicates that the Pizzeria Restaurants, which feature the STONE-FIRE’D trademark, primarily sell pizza and feature a system where a consumer can start with the dough base, and then select their own pizza toppings (“building their own masterpiece” or selecting a signature pizza). That pizza is then cooked in a stone oven. (Exhibits B, J, K).

[51] In view of the above, I consider there to be an overlap between the Opponent’s flatbread and the Applicant’s pizza. However, with respect to the remaining food items cited in the application (food, namely fresh and frozen prepared entrees, namely meat and vegetable dishes, salads, chicken wings, chicken dishes, meat pies, hors d’oeuvres; spaghetti; lasagna; pastas; sauces, namely tomato sauce, barbeque sauce, cream sauce and Italian white sauce), notwithstanding that they belong to the general class of “food products” along with the Opponent’s flatbread and other goods, this is not sufficient to lead to a finding that the parties’ goods are similar [*Level Ground Trading Ltd. v. San Miguel Corporation* 2011 TMOB 39].

[52] There is also potential for at least some overlap in the parties’ respective channels of trade for the parties’ goods. In this regard, I note that Mr. Cianflone states that none of the Pizzeria Restaurants sell grocery items, including flatbread items, nor are any Pizzeria Restaurant products sold in grocery stores (para 24, Cianflone affidavit). However, the statement of goods in the Application for the Mark does not preclude the sale of the Goods through this channel [*Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD) at 73; *Eminence SA v Registrar of Trade-marks* (1977), 39 CPR (2d) 40 (FCTD) at 43.]. In its representations, the Opponent also submits that the D’Ambrosio affidavit demonstrates that restaurants in Canada that specialize in selling prepared pizzas “commonly” sell pizza dough and/or grocery items. However, notwithstanding the hearsay issues associated with the D’Ambrosio affidavit (which is limited to printouts of third party websites), I do not find this evidence to be of particular significance given the relatively small number of printouts provided.

[53] The Opponent's evidence also indicates that while its goods, including flatbread, are primarily marketed to end consumers through grocery flyers (Mr. Gibson states that over \$3.5 million has been spent on grocery store flyers and supermarket shelving exposure), they are also marketed and distributed to restaurants (Gibson affidavit, Exhibit H). That said, with respect to the Services, while it is possible that the Opponent's flatbread could be sold in the Applicant's restaurants, based on the Opponent's evidence of use to date it is unlikely that the parties' channels would overlap.

[54] Accordingly, these factors favour the Opponent, albeit only to an extent.

Degree of resemblance

[55] In most instances, the degree of resemblance between the trademarks in appearance or sound or in the ideas suggested is the dominant factor and other factors play a subservient role in the overall surrounding circumstances [*Beverly Bedding & Upholstery Co v Regal Bedding & Upholstery Ltd* (1980), 47 CPR (2) 145, conf. 60 CPR (2d) 70 (FCTD)]. This principle was upheld by the Supreme Court of Canada in *Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27, 92 CPR (4th) 361.

[56] In this case, the parties' marks are nearly identical in appearance and sound but for the addition of an 'apostrophe d' at the end of the Applicant's Mark and a hyphen in the Applicant's Mark (which has no auditory effect and a negligible visual effect). In terms of ideas suggested, as noted above in the analysis of the inherent distinctiveness of the marks, the parties' marks are highly similar. Accordingly, this factor strongly favours the Opponent.

Surrounding circumstance – Applicant's prior registration for PIZZA HOTLINE STONE FIRED PIZZERIA

[57] The Applicant owns registration No. TMA951,010 for the trademark PIZZA HOTLINE STONE FIRED PIZZERIA covering similar goods and services to those in the subject Application (Cianflone affidavit, para 11, Exhibit A). However, it is well-established that section 19 of the Act does not give the owner of a registration an automatic right to obtain a further registration no matter how closely it is related to the prior registration [*Groupe Lavo Inc v*

Proctor & Gamble Inc (1990), 32 CPR (3d) 533 at 538 (TMOB)]. Accordingly, I do not consider this to be a surrounding circumstance assisting the Applicant.

Conclusion on the likelihood of confusion

[58] Having considered all of the surrounding circumstances, I find that the Applicant has not met its legal burden with respect to the goods “pizza”. I reach this conclusion due to the high degree of resemblance between the marks, the extent to which the Opponent’s mark has become known, the length of time the Opponent’s mark has been in use, and the overlap in respect of this good with the Opponent’s flatbread. However, on consideration of the remaining Goods and Services set out in the application, I find that there is not a reasonable likelihood of confusion given that the nature of the Opponent’s goods differs significantly from the restaurant dine-in, take-out and delivery services of the Applicant as well as the following goods:

- (1) Household goods and glass, namely, coffee mugs
- (2) Clothing, namely, baseball caps, T-shirts, sweatshirts, shorts and pants
- (3) Sports equipment, namely, golf balls
- (4) Food, namely, fresh and frozen prepared entrees, namely, meat and vegetable dishes, salads, chicken wings, chicken dishes, meat pies, hors d’oeuvres
- (5) Spaghetti; lasagna; pastas; sauces, namely tomato sauces, barbeque sauce, cream sauce and Italian white sauce

[59] The Opponent’s evidence has not established that it is entitled to a scope of protection that extends significantly beyond the specific types of goods which it has been used. Accordingly, the section 12(1)(d) ground is successful only with respect to “pizza”. This ground of opposition is rejected with respect to the remaining Goods and Services.

Section 16(1) ground of opposition

[60] The Opponent has pleaded that the Applicant is not the person entitled to registration of the Mark because, as of the claimed date of first use of the Mark, namely January 31, 2015, and at all material times, the Mark was confusing with the STONEFIRE Trademarks, which had been previously used in Canada by the Opponent.

[61] In view of the Opponent's partial success under its section 30(b) ground of opposition, the material date for assessing the section 16(1)(a) ground of opposition is the filing date of the application for the Mark (January 29, 2016) for all of the goods with the exception of "pizza, salad, and sauces, namely tomato sauce, barbeque sauce, and Italian white sauce pizza" and for the Services, for which the material date for this ground remains as the claimed date of first use, namely January 31, 2015.

[62] However, in the circumstances of this case, the date at which the issue of confusion is assessed does not materially affect my conclusion under the section 12(1)(d) ground of opposition discussed above. Accordingly, to the extent that the Opponent has met its burden - and I find that it has done so with respect to the Opponent's STONEFIRE Trademarks in association with the Opponent's goods discussed above, as well as with pizza crusts (Exhibit C of the Gibson affidavit includes photographs of the Opponent's mark on packaging for goods including pizza crust, which are stated to be representative of use since 2010) – for reasons similar to those expressed in the above analysis, I reach the same conclusion regarding the likelihood of confusion as under the 12(1)(d) ground of opposition. Accordingly, this ground of opposition is successful only with respect to "pizza". This ground of opposition is rejected with respect to the remaining Goods and Services.

Section 2 ground of opposition

[63] The Opponent has pleaded that the Mark is not distinctive pursuant to section 38(2)(d) and 2 of the Act, in that it does not distinguish and is not adapted to or capable of distinguishing the Goods and Services of the Applicant from the Opponent's goods, because of the Opponent's earlier use of the STONEFIRE Trademarks.

[64] To meet its evidential burden, the Opponent must show that at least one of its STONEFIRE Trademarks had become sufficiently known to negate the distinctiveness of the Mark [*Bojangles' International, LLC v Bojangles Café Ltd* 2006 FC 657 at paras 33-34].

[65] I find that the Opponent's evidence as discussed above is sufficient to meet the Opponent's burden. The Applicant is therefore required to show that its Mark is adapted to

distinguish or actually distinguish the Goods and Services from the goods of the Opponent [*Muffin Houses Incorporated v The Muffin House Bakery Ltd.* (1985), 4 CPR (3d) 272 (TMOB)].

[66] I consider that the difference in material dates does not materially affect my conclusion under the section 12(1)(d) ground of opposition discussed above. Accordingly, for reasons similar to those expressed in the above analysis, I reach the same conclusion regarding the likelihood of confusion as under the 12(1)(d) ground of opposition. Accordingly, this ground of opposition is successful only with respect to “pizza”. This ground of opposition is rejected with respect to the remaining Goods and Services.

DISPOSITION

[67] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the application with respect to the following goods: “(1) Household goods and glass, namely, coffee mugs; (2) clothing, namely, baseball caps, T-shirts, sweatshirts, shorts and pants; (3) sports equipment, namely golf balls; (4) Food, namely fresh and frozen prepared entrées, namely meat and vegetable dishes, chicken wings, chicken dishes, meat pies, hors d’oeuvres; (5) Pizza, spaghetti; lasagna; pastas; sauces, namely cream sauce”, and I reject the opposition with respect to the goods “salads; sauces, namely tomato sauce, barbeque sauce, and Italian white sauce” and with all the services, namely: “(1) Transport, namely, restaurant delivery services; (2) restaurant services, namely, dine-in and delivery services”, pursuant to section 38(12) of the Act.

Jennifer Galeano
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENT(S) OF RECORD

Bereskin & Parr LLP

FOR THE OPPONENT

Coastal Trademark Services Limited

FOR THE APPLICANT