

Federal Court



Cour fédérale

Date: 20230901

Docket: T-2081-22

Citation: 2023 FC 1193

Ottawa, Ontario, September 1, 2023

PRESENT: The Honourable Madam Justice Tsimberis

BETWEEN:

LES INDUSTRIES CERTICO INC.

Applicant

and

**MASTRANDREA COMMERCIAL BAKERIES LIMITED AND
CTM HOUSEHOLD APPLIANCES INC.**

Respondents

JUDGMENT AND REASONS

I. Introduction

[1] This is an appeal under section 56 of the *Trademarks Act*, RSC 1985, c T-13 [the Act] by the Applicant, Les Industries Certico Inc. [Certico], from a decision of the Trademarks Opposition Board [TMOB] dated August 15, 2022. The TMOB refused Certico's trademark application No. 1,856,458 for the FORNO MAGNIFICO & DESIGN mark, in association with

“(1) pizza ovens; (2) pizza crusts”. The Respondents did not appear before the Court in this appeal.

[2] The TMOB refused the application because the applied-for mark FORNO MAGNIFICO & DESIGN was confusing with the registered trademark FORNO & DESIGN (TMA991845) with respect to “pizza ovens” and was confusing with the previously used trademark FORNO CULTURA SQUARE & DESIGN with respect to “pizza crusts”. The three respective aforementioned trademarks are depicted hereinafter:

FORNO MAGNIFICO & DESIGN (application No. 1,856,458)	FORNO & DESIGN (TMA991845)	FORNO CULTURA SQUARE & DESIGN (TMA889214)
		

[3] The TMOB held that the Applicant’s FORNO MAGNIFICO & DESIGN mark was unregistrable based on likelihood of confusion with the registered FORNO & DESIGN mark (s. 12(1)(d) of the Act) and that the Applicant was not entitled to registration based on likelihood of confusion with the previously used FORNO CULTURA SQUARE & DESIGN mark (s. 16(1)(a) of the Act).

II. Background

A. *Facts*

[4] The Respondent, Mastrandrea Commercial Bakeries Limited [Mastrandrea], owns registration No. TMA889214 for the FORNO CULTURA SQUARE & DESIGN trademark (depicted above), registered on November 3, 2014 based on use in Canada since October 27, 2011 in association with the goods and services reproduced below. The translation provided by the Applicant for the foreign character words FORNO CULTURA is “oven culture”.

Goods: (1) Italian artisan baked products, namely, biscotti, cakes, olive oil cakes, specially cream desserts, panetone, torrone, bread and taralli.

Services: (1) Production and sale of Italian artisan baked products namely, biscotti, cakes, olive oil cakes, specially cream desserts, panetone, torrone, bread and taralli. (2) Preparation services and sale of Italian prepared and packaged food products namely, jams, chocolate, tomato sauce, soup, olive spreads and pickled vegetables and fruit. (3) Catering services. (4) Culinary classes and demonstrations. (5) Operation of a website providing information in the field of production of Italian artisan bakery.

[5] The Respondent, CTM Household Appliances Inc. [CTM], owns registration No. TMA991845 for the FORNO & DESIGN trademark (depicted above), filed on March 12, 2015 based on proposed use in Canada in association with the goods “(1) Appareils électro-ménager nommément: four encastré, plaque de cuisson, hotte de cuisine” (translated as “(1) Household appliances, namely: built-in ovens, stovetops, range hoods”). The application was registered on March 5, 2018, the same date the Declaration of Use was filed. The right to the exclusive use of the word FORNO is disclaimed apart from the FORNO & DESIGN trademark.

[6] The Applicant, Certico, owns application No. 1,856,458 [the Application] for the FORNO MAGNIFICO & DESIGN trademark (depicted above) filed on September 8, 2017 based on use in Canada since December 31, 2013 in association with (1) pizza ovens and (2) pizza crusts. The translation provided by the Applicant for the foreign character words FORNO MAGNIFICO is “magnificent oven”.

[7] On December 19, 2018, Mastrandrea filed a Statement of Opposition that was amended on June 20, 2019, opposing Certico’s Application on a number of grounds. While CTM did not ultimately file an opposition, its registration No. TMA991845 for the FORNO & DESIGN trademark was the basis of one of Mastrandrea’s grounds of opposition.

B. *Record before the TMOB*

[8] In support of its opposition, Mastrandrea filed two affidavits as evidence:

- a. The affidavit of Andrea Mastrandrea, the President of Mastrandrea, is dated June 21, 2019 [Mastrandrea Affidavit]. The Mastrandrea Affidavit provided evidence on Mastrandrea’s history, sales, and advertising initiatives in relation to Mastrandrea’s FORNO CULTURA SQUARE & DESIGN mark; and
- b. The affidavit of Shelley Cherry, an employee of Mastrandrea’s trademark agent, is dated June 19, 2019 [Cherry Affidavit]. The Cherry Affidavit summarized Google search engine results for the words “FORNO MAGNIFICO” and “pizza crusts” conducted in April 2019 as well as searches in May 2019 from the Wayback Machine Internet Archive

for the Applicant's website *fornomagnifico.com*. The Cherry Affidavit also included a certified copy of CTM's registration No. TMA991845 for the FORNO & Design trademark.

[9] Certico's evidence before the TMOB consisted of two affidavits:

- a. The affidavit of Quintino Rico, the President of Certico, is dated October 8, 2019 [Rico Affidavit]. The Rico Affidavit provided evidence on Certico's history, sales, and advertising initiatives in relation to the FORNO MAGNIFICO & DESIGN trademark; and
- b. The affidavit of Richard Levy, a registered trademark agent, is dated October 7, 2019 [Levy Affidavit]. The Levy Affidavit summarized the search results from the Canadian trademarks database for the term "FORNO" (and its English and French translation) in association with goods in Nice class 30 (including Italian bread, pastry dough, pizza dough and various kinds of pasta) and Nice class 11 (including pizza ovens and other baking ovens).

[10] Only Mr. Rico was cross-examined on his affidavit.

C. *TMOB Decision*

[11] The TMOB dismissed two of Mastrandrea's four grounds of opposition against the Application, namely the ones based upon non-compliance (subsection 30(b) of the Act) and non-

distinctiveness (section 2 of the Act) (*Mastrandrea Commercial Bakeries Limited v Les Industries Certico Inc*, 2022 TMOB 156 [Decision]).

[12] As previously mentioned, the TMOB granted Mastrandrea's two grounds of opposition based on non-registrability pursuant to s. 12(1)(d) and non-entitlement pursuant to s. 16(1)(a) of the Act, which findings form the subject of the current appeal. The TMOB concluded that:

- A. Certico's FORNO MAGNIFICO & DESIGN mark is not registrable because it is likely confusing with CTM's FORNO & DESIGN registered mark; and
- B. Certico is not the person entitled to registration of Certico's FORNO MAGNIFICO & DESIGN mark because, as of the date of filing of the Application, it was likely confusing with Mastrandrea's FORNO CULTURA SQUARE & DESIGN mark, which had been previously used in Canada.
- D. *Non-registrability under s. 12(1)(d) of the Act*

[13] Under the non-registrability ground, the TMOB made the following relevant observations and findings as part of its confusion analysis and its consideration of each factor set out in ss. 6(5) of the Act:

- a. The test for confusion is one of first impression and the vague or imperfect recollection of a casual consumer "somewhat in a hurry" (*Veuve Clicquot Ponsardin v Boutiques Cliquot Ltée*, 2006 SCC 23 at para 20). While the factors listed in ss. 6(5) of the Act are non-

exhaustive and afforded different weights based on the specific context of a case, the TMOB noted that the resemblance between marks is often afforded the greatest weight when assessing confusion (*Masterpiece Inc v Alavida Lifestyles Inc*, 2011 SCC 27 at para 49).

- b. Degree of Resemblance: Certico's FORNO MAGNIFICO & DESIGN mark and CTM's FORNO & DESIGN mark have a high degree of resemblance in appearance, sound, and ideas suggested because they not only share the word FORNO but also and especially due to the similar arch with flame designs. The TMOB concluded that this factor favoured CTM.

- c. Inherent and Acquired Distinctiveness: CTM's FORNO & DESIGN mark had a greater degree of inherent distinctiveness since it also had the arch and flame design. Nevertheless, since CTM provided no evidence on the extent to which CTM's FORNO & DESIGN mark had become known in Canada, the TMOB concluded that this factor somewhat favoured Certico.

- d. Length of Time in Use: Certico evidenced use of its FORNO MAGNIFICO & DESIGN mark in association with pizza ovens since 2011, and there was no evidence of use of CTM's FORNO & DESIGN mark. The TMOB concluded that this factor favoured Certico.

- e. Nature of the Goods or Business/Nature of Trade: At a minimum, there was the potential for overlap in the nature of the parties' goods, businesses, and channels of trade since they both offered cooking appliances and were not limited in their channels of trade. The TMOB concluded that this factor favoured CTM.

- f. Additional Surrounding Circumstance - State of the Register Evidence: Although Certico provided some evidence demonstrating that the word FORNO does appear in some of the relevant registrations identified by Mr. Levy, it failed to evidence common usage of the distinctive arch and flame design, alone or in combination with the word FORNO. The TMOB held that this factor did not favour Certico.

- g. Additional Surrounding Circumstance - No Evidence of Actual Confusion: Although CTM's FORNO & DESIGN mark was registered in 2018, there was no evidence of actual confusion between it and Certico's FORNO MAGNIFICO & DESIGN mark. The TMOB held that this factor favoured Certico, but not to a significant extent.

[14] Having considered all of the factors, the TMOB found that the balance of probabilities regarding the likelihood of confusion between Certico's FORNO MAGNIFICO & DESIGN mark and CTM's FORNO & DESIGN mark to be evenly balanced with respect to "pizza ovens". Given the onus was on Certico to establish, on a balance of probabilities, that there is no reasonable likelihood of confusion between its mark and CTM's mark, the TMOB found against Certico and held Mastrandrea's ground of opposition under s. 12(1)(d) of the Act to be successful with respect to "pizza ovens."

[15] However, with respect to “pizza crusts”, the TMOB found the differing nature of CTM’s goods sufficient to shift the balance of probabilities in Certico’s favour that there is no reasonable likelihood of confusion.

[16] Similarly, the TMOB found, on a balance of probabilities, no likelihood of confusion between Certico’s FORNO MAGNIFICO & DESIGN mark and Mastrandrea’s FORNO CULTURA SQUARE & DESIGN mark with respect to “pizza ovens” and “pizza crusts” due to Mastrandrea’s differing goods. In addition, while the TMOB noted Mastrandrea’s FORNO CULTURA SQUARE & DESIGN mark is registered in association with baked goods, the baked goods do not include “pizza” or “pizza dough” and the TMOB found the difference in the nature of goods sufficient to shift the confusion analysis in Certico’s favour.

E. *Non-entitlement under s. 16(1)(a) of the Act*

[17] Under the non-entitlement ground, the TMOB made the following relevant observations and findings as part of its confusion analysis and its consideration of each factor set out in ss. 6(5) of the Act separately:

- a. Degree of Resemblance: Certico’s FORNO MAGNIFICO & DESIGN mark and Mastrandrea’s FORNO CULTURA SQUARE & DESIGN mark have a high degree of resemblance in appearance, sound, and ideas suggested given they share the word FORNO and especially when combined with the similar arch design. The TMOB concluded that this factor favoured Mastrandrea.

- b. Inherent and Acquired distinctiveness: The TMOB held Mastrandrea's FORNO CULTURA SQUARE & DESIGN mark had a greater degree of inherent distinctiveness because it also had an arch design, and the term FORNO had greater inherent distinctiveness in association with pizza products as compared to with pizza ovens. Both parties provided some comparable evidence on the extent to which their respective marks had become known. Overall, the TMOB concluded this factor favoured Mastrandrea.

- c. Length of Time in Use: Certico evidenced use of its FORNO MAGNIFICO & DESIGN mark in association with pizza crusts since 2013, and Mastrandrea evidenced use of its FORNO CULTURA SQUARE & DESIGN mark since 2011 in association with pizza and pizza dough. The TMOB concluded that this factor favoured Mastrandrea.

- d. Nature of the Goods or Business/Nature of Trade: There was an overlap in the nature of the parties' goods, and to some extent potential for overlap in the businesses and channels of trade. Both parties sold goods in the nature of pizza products to the general public. The TMOB concluded this factor favoured Mastrandrea.

- e. Additional Surrounding Circumstance - State of the Register Evidence: Although Certico provided some evidence that the word FORNO does appear in some of the relevant registrations, it is not merely the word FORNO that is at issue and the Applicant failed to evidence common usage of the striking arch design and/or its combination with the word FORNO. The TMOB held this factor did not favour Certico.

- f. Additional Surrounding Circumstance - No Evidence of Actual Confusion: There was no evidence of actual confusion despite the parties' pizza-related goods having co-existed in the marketplace since 2013. The TMOB held that this factor tended to favour Certico.

[18] In its assessment of the likelihood of confusion between Certico's FORNO MAGNIFICO & DESIGN mark and Mastrandrea's FORNO CULTURA SQUARE & DESIGN mark, the TMOB found it was "at best" evenly balanced with respect to "pizza crusts". Given the onus was on Certico to establish, on a balance of probabilities, that there was no reasonable likelihood of confusion with Mastrandrea's FORNO CULTURA SQUARE & DESIGN mark, the TMOB held Mastrandrea's ground of opposition under s. 16 of the Act was successful with respect to "pizza crusts".

[19] However, with respect to "pizza ovens", the TMOB found, on a balance of probabilities, that there was no likelihood of confusion due to the differing nature of Mastrandrea's goods.

[20] Overall, the TMOB refused Certico's Application in association with both "pizza ovens" under s. 12(1)(d) of the Act and "pizza crusts" under s. 16(3)(a) of the Act.

III. Issues

[21] This case raises the following two issues:

- A. *What is the applicable standard of review?*

- B. *Did the TMOB err in its findings that the Applicant's FORNO MAGNIFICO & DESIGN mark is unregistrable based on confusion with the registered FORNO & DESIGN mark (TMA991845) and that the Applicant is not entitled to registration based on confusion with the FORNO CULTURA SQUARE & DESIGN mark previously used in Canada?*

IV. **Analysis**

- A. *What is the applicable standard of review?*

[22] Generally, for a statutory appeal such as this one under s. 56 of the Act, the appellate standard of review applies (*Canada (Minister of Citizenship and Immigration) v Vavilov*, 2019 SCC 65 at para 37, citing *Housen v Nikolaisen*, 2002 SCC 33 [*Housen*]). For questions of law and mixed fact and law where a legal question is extricable, the standard is correctness (*Housen* at paras 8, 27). For questions of fact and questions of mixed fact and law without an extricable legal question, the standard is whether the decision maker made an overriding and palpable error (*Housen* at paras 10, 28).

[23] However, under subsection 56(5) of the Act, if new evidence presented on appeal would have had a material effect on the TMOB's decision - which has been interpreted to mean "sufficiently substantial and significant" (*Vivat Holdings Ltd. v. Levi Strauss & Co.*, 2005 FC 707 at para 27) and of "probative value" (*Tradition Fine Foods Ltd. v. Groupe Tradition'l Inc.*, 2006 FC 858 at para 58), the Court "may exercise any discretion vested in the Registrar". The Court may step into the shoes of the Registrar, reassess the evidence, and answer questions of fact and questions of mixed fact and law on a standard of correctness (*Clorox Company of Canada, Ltd v Chloretec SEC*, 2020 FCA 76 at paras 21-23).

[24] When determining whether the new evidence sufficiently warrants a *de novo* review of the TMOB's Decision, the Court must assess the nature, significance, probative value, and reliability of the new evidence, in the context of the record, and determine if it adds something of significance that would have materially affected the TMOB's decision (*Caterpillar Inc. v Puma SE*, 2021 FC 974 at para 36 citing *Seara Alimentos Ltda. v. Amira Enterprises Inc*, 2019 FCA 63 at paras 23-26).

[25] The question is thus: in the context of the confusion analysis in this case – could the new evidence lead to a different conclusion in respect of one or more of the factors set out in ss. 6(5) of the Act and alter the balance underpinning the conclusion as to whether confusion was likely?

[26] In this appeal, the Applicant's new evidence consists of an affidavit by Kelly J. Ramsay, manager of corporate operations at Certico, dated October 4, 2022 [Ramsay Affidavit]. The Ramsay Affidavit includes 2 exhibits, namely: (1) Exhibit KA-1 (misabeled Exhibit KA-2): a graphic artist invoice dated October 3, 2011 for "Graphic design of the Forno Magnifico product line logo"; and (2) Exhibit KA-2 (misabeled Exhibit KA-1): 38 sales receipts bearing Certico's FORNO MAGNIFICO & DESIGN trademark, for sales of pizza crusts sold by the Applicant from 2013-2017.

[27] First, the Applicant submits that the Ramsay Affidavit is material because it demonstrates that the Respondent Mastrandrea never sold ready-to-use preformed pizza crusts at any of its retail bakery locations. Specifically, the Ramsay Affidavit states:

That on or about September 23, 2022, I contacted the following Forno Cultura locations owned and operated by Respondent Mastrandrea Commercial Bakeries Inc.:

- a. Forno Cultura King located at 609 King Street West in Toronto and spoke with Paul, who confirmed to me that he was a representative of Forno Cultura and that they did not, nor had they ever sold ready-to-use preformed pizza crusts at that or any of its locations;
- b. Forno Cultura Queen located at 1056 Queen Street West in Toronto and spoke with Sophie, who confirmed to me that she was a representative of Forno Cultura and that they did not, nor never had sold ready-to-use preformed pizza crusts at that or any of its locations;
- c. Forno Cultura Biscotteria located at 65 Front Street West in Toronto and spoke with Andrew, who confirmed to me that he was a representative of Forno Cultura and that they did not, nor had they ever sold ready-to-use preformed pizza crusts at that or any of its locations;

[28] The Ramsey Affidavit evidence is not significant because it relates to non-sale of “ready-to-use preformed pizza crusts”, which Mastrandrea has never claimed to sell, and not to the relevant goods actually sold by Mastrandrea – pizza and pizza dough. Therefore, it does not aid in diminishing any overlap in the Applicant Certico’s and the Respondent Mastrandrea’s respective nature of goods under paragraph 6(5)(c) of the Act as held by the Registrar at para 81 of his Decision: *“Nevertheless, both parties’ goods are in the nature of pizza products sold to the general public. A consumer looking to make their own pizza may be attracted to the Applicant’s pizza crusts one day and to the Opponent’s pizza dough on another day. In my view, given the shared elements, a consumer with imperfect recollection of the Opponent’s Trademarks may understand the pizza crusts sold in association with the Mark to be the “magnifico” variety within the Opponent’s line of pizza products.”* Regardless, this new evidence likely would not have materially affected the TMOB’s findings on confusion since the overlap in the nature of

goods was one of many factors weighing against the Applicant Certico, most significantly the high degree of resemblance between the respective marks. Lastly, this Ramsay Affidavit evidence is unreliable as there is no information that can confirm whether Ms. Ramsay spoke with the appropriate and knowledgeable representatives of Mastrandrea. For example, the affidavit does not reference the representatives' job titles or duration of employment with Mastrandrea that would substantiate the confirmations "did not, nor had they ever sold" and "at that or any of its locations".

[29] Second, the Applicant submits that the Ramsay Affidavit is material because Exhibit KA-1 demonstrates that it engaged the services of a graphic artist in 2011 to design its trademark in good faith, and has not received any allegations of infringement or confusion since. This evidence is not significant or of any probative value since the date the mark was designed does not change the Applicant Certico's date of first use of its trademark FORNO MAGNIFICO & DESIGN. The date of first use is the relevant fact, which the TMOB correctly analysed and decided favoured the Respondent Mastrandrea in the factor "Length of Time in Use" at paragraph 78 of the Decision. In any event, the TMOB has already acknowledged the lack of evidence of actual confusion as a factor in the Applicant Certico's favour at paras 59 and 86 of the Decision. Therefore, this new evidence would not have made any difference in shifting this factor and/or the balance of the various confusion factors in Certico's favour.

[30] Third, the Applicant submits that the Ramsay Affidavit is material because the sales receipts in Exhibit KA-2 demonstrate that it has sold pizza crusts in good faith since 2013, and has not received any allegations of infringement or confusion. This evidence is not material

because it is repetitive. To be “material” and to affect the standard of review applied by the Court on the appeal, the additional evidence must not be repetitive and should enhance the overall cogency of the evidence on the record (*Cortefiel, S.A. v. Doris Inc.*, 2013 FC 1107 at para 33, aff’d 2014 FCA 255; see also *Servicemaster Company v. 385229 Ontario Ltd. (Masterclean Service Company)*, 2015 FCA 114 at paras 23-24). The TMOB already specifically acknowledges in its Decision that the Applicant “*has evidenced use of its Mark since 2013 in association with pizza crusts*” (at para 78), while continuing on to say “*whereas the Opponent has evidenced use of the Opponent’s Trademark since 2011 in association with pizza and pizza dough*”. As such, the Applicant’s additional evidence of sales receipts going back to October 15, 2013, while they predate the December 31, 2013 date of first use referenced in the Application, do not predate the Respondent Mastrandrea’s evidenced use since 2011 of its FORNO CULTURA SQUARE & DESIGN trademark in association with pizza and pizza dough. Further, the TMOB has already acknowledged the lack of evidence of actual confusion as a factor in the Applicant Certico’s favour (at paras 59 and 86) so this would not help to tip the balance of the other factors in the Applicant’s favour.

[31] As mentioned during the hearing, where the Applicant might have tendered material evidence helpful to its case would have been to fill in gaps in the evidence before the TMOB Officer. For example, state of the register and/or marketplace evidence showing widespread use and/or registration of arch designs and/or flame designs, with or without the term FORNO. No such evidence demonstrating the commonality of these design elements were tendered on appeal, which were key to the TMOB’s findings under the “Degree of Resemblance” and “Additional

Surrounding Circumstances” factors (see paras 43 and 57 of the Decision for the s.12(1)(d) of the Act finding and paras 71 and 84 of the Decision for the s. 16 of the Act finding).

[32] Overall, the Ramsay Affidavit would not have materially affected the TMOB’s findings. Therefore, the new evidence does not alter the standard of review from the default appellate standards. Since the Applicant is challenging the TMOB’s findings regarding confusion between the respective trademarks of Certico, Mastrandrea, and CTM, the applicable standard of review is palpable and overriding error.

[33] The palpable and overriding error standard of review is highly deferential. As noted in *Venngo Inc v Concierge Connection Inc*, 2017 FCA 96 [*Venngo*] at paragraph 42 (citing *Canada v South Yukon Forest Corporation*, 2012 FCA 165 at para 46):

[42] [...] “Palpable” means an error that is obvious. “Overriding” means an error that goes to the very core of the outcome of the case. When arguing palpable and overriding error, it is not enough to pull at leaves and branches and leave the tree standing. The entire tree must fall.

B. *Did the TMOB err in its findings that the Applicant’s FORNO MAGNIFICO & DESIGN mark is unregistrable based on confusion with the registered FORNO & DESIGN mark (TMA991845) and that the Applicant is not entitled to registration based on confusion with the FORNO CULTURA SQUARE & DESIGN mark previously used in Canada?*

[34] The Court finds the Applicant’s arguments on appeal to be largely repetitive of the arguments made before the TMOB. In many respects, as is apparent from the discussion that follows, the Applicant is asking this Court to intervene and conduct a *de novo* confusion

assessment and to substitute my assessment of the evidence for that of the TMOB. However, that is something that this Court cannot do on appeal.

[35] The Federal Court can only intervene in factual issues or issues of mixed fact and law from which a legal issue cannot be extricated if the TMOB made a palpable and overriding error and in legal issues if the TMOB applied an incorrect legal principle. I am unable to qualify any alleged errors submitted by the Applicant to be palpable and overriding errors committed by the TMOB in its analysis of the test for confusion under s. 6(5) of the Act. I will nonetheless go through those identifiable alleged errors raised by the Applicant one by one with respect to the two grounds of opposition under appeal respectively.

C. *Did the TMOB commit any palpable and overriding errors in its finding that the Applicant's FORNO MAGNIFICO & DESIGN mark is unregistrable based on confusion with the registered FORNO & DESIGN mark (TMA991845)?*

[36] The Court has not been convinced that the TMOB made a palpable and overriding error in assessing the degree of resemblance (in this case, the most important factor) between the marks. There was no new material evidence on this issue, and the TMOB's findings were therefore entitled to a high degree of deference. The Applicant submits that "*the Decision at para. 43 contains a manifest and dominant error where the Member attributes significant consideration to the shared word FORNO and its sound notwithstanding that the said word is common and was disclaimed by Respondent CTM*". With all due respect, this is a mischaracterization of the TMOB's finding at para 43 of the Decision; the TMOB clearly states "*the subject trademarks have a high degree of resemblance in appearance and in ideas*

suggested, given not only the shared word FORNO but also and especially due to the similar arch with flame designs.” [Our emphasis] This finding is reasonable in the circumstances.

[37] Likewise, the Court has not been convinced that the TMOB made a palpable and overriding error in assessing the nature of the parties’ goods, business and channels of trade in respect of the issue of confusion. There was no new material evidence on this issue, and the TMOB’s findings were therefore entitled to a high degree of deference. The Applicant submits that *“the Decision contains a palpable and overriding error at paragraphs 54 and 62 thereof where the Member concludes that there is “...the potential for overlap in the nature of the parties’ goods, businesses, and channels of trade to some extent” and “the potential overlap in the nature of the relevant goods, businesses and trades, and notwithstanding the absence of evidence of actual confusion”, which is not supported by the evidence whatsoever”*. The Applicant’s applied-for goods are “pizza ovens” and the Respondent CTM’s registered goods are “Household appliances, namely: built-in ovens, stovetops”. Both parties’ goods are ovens (as their names indicate) and qualify as household appliances. While the Applicant is a manufacturer and distributor of portable electric pizza ovens and the Respondent CTM is an importer and distributor of larger household appliances, the TMOB did not make a palpable and overriding error at paragraph 54 when it held *“given the shared elements, a consumer with imperfect recollection of the CTM Trademark may understand the pizza ovens sold in association with the Mark to be the “magnifico” variety of the Opponent’s line of cooking appliances.”*

[38] The Applicant also indicated that the “*Decision ignores the indisputable fact that there has been co-existence of the Respondents’ respective FORNO CULTURA and FORNO trademarks and the Applicant’s FORNO Magnifico trademark since at least 2013 without any notice whatsoever from either Respondent of any infringement or confusion (...)*” Quite to the contrary, the TMOB considered this at paragraph 59 of its Decision when it considered the factor “Additional Surrounding Circumstance – No evidence of actual confusion” and found this factor tended to favour the Applicant albeit not to a significant extent.

[39] Lastly, the Applicant submits that “*The Decision did not take into consideration that Respondent CTM Household initially opposed the Applicant’s trademark, but it did not pursue said opposition which Respondent Mastrandrea Bakeries then picked up the mantle to invoke its opposition (...) when in fact, it had no practical purpose to do so as it was, and is not, engaged in the sale of any appliances whatsoever.*” Again, this is incorrect as the TMOB specifically considered this at paragraph 34 of its Decision when it correctly held: “*While the Opponent is not the owner of this registration, an opponent may rely on third-party registrations for the purposes of a ground of opposition based on section 12(1)(d) of the Act [USV Pharmaceuticals of Canada Ltd v Sherman and Ulster Ltd (1974), 15 CPR (2d) 79 (TMOB)].*”

D. *Did the TMOB commit any palpable and overriding errors in its finding that the Applicant is not entitled to registration of its FORNO MAGNIFICO & DESIGN mark based on confusion with the FORNO CULTURA SQUARE & DESIGN mark previously used in Canada?*

[40] The Applicant disagrees with the TMOB’s non-entitlement finding that the balance of probabilities regarding the likelihood of confusion to be evenly balanced between the

Applicant's FORNO MAGNIFICO & DESIGN mark and Mastrandrea's FORNO CULTURA SQUARE & DESIGN mark. The TMOB reached "*this conclusion due to the resemblance between the trademarks and the overlap in the nature of the goods, and notwithstanding the absence of evidence of actual confusion.*"

[41] The Applicant argues there is no likelihood of confusion between the two respective marks. On the degree of resemblance and distinctiveness between the two marks, the Applicant submits the following:

- A. the brick hearth graphic is commonly used commercially for numerous goods and services broadly related to cooking and baking,
- B. only its hearth design contains a flame whereas the other mark contains a distinctly obvious ears of wheat design,
- C. the overall designs are different enough to be easily distinguished,
- D. the word FORNO is commonly used "for various types of ovens and food products" and therefore not very distinctive,
- E. the word FORNO is the dominant word in Mastrandrea's trademark and MAGNIFICO is the dominant word in its trademark, and

F. both marks have substantially different visual styles.

[42] The Applicant did not file any evidence before the TMOB or on appeal before this Court to show that the brick hearth graphic is commonly used commercially for numerous goods and services broadly related to cooking and baking as it submits is the case. Rather, the filed state of register evidence only covered the term FORNO and did not cover either hearth or fire designs. This was the key to the TMOB's Decision at paras 71, 76 and 84 where the TMOB found *"Applicant has not evidenced common usage of striking arch design and/or its combination with the word FORNO itself."* As previously mentioned, had the Applicant found and submitted such evidence, it might have constituted material new evidence and may have, depending on the extent of the evidence, tipped the balance of the factors in the confusion analysis in the Applicant's favour. This was not done.

[43] Certico also argues that its nature of wares and business is totally different from that of Mastrandrea: Certico is a Montreal based manufacturer and distributor of portable electric pizza ovens and preformed pizza crusts, while Mastrandrea is an Italian artisanal bakery and catering service with five locations in the Greater Toronto Area. Further, neither pizza nor pizza products are specifically listed in the registration for Mastrandrea's trademark. While Mastrandrea claims to sell pizza dough balls and pizza slices, "those products only constituted a meagre 2% of its total annual sales between October 2011 to December 31, 2018."

[44] The Court cannot find any palpable and overriding error in the TMOB's analysis and findings regarding the nature of the goods or business/nature of trade criteria (paras 80 to 85).

[45] The Applicant argues *“the said Decision at paragraph 81 also manifestly erred when it concluded that both parties’ goods are in the nature of pizza products, thereby erroneously equating Respondent Mastrandrea’s products of pizza dough to the Applicant’s food product of preformed pizza crusts.”*

[46] This Court fails to see any palpable and overriding error in the TMOB’s analysis and paragraph 81 reproduced hereinafter, which makes sense in the circumstances of the parties’ respective pizza-related products, namely pizza dough and pre-formed pizza crusts:

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

V. **Conclusion**

[48] As the Applicant has not shown that the TMOB made a palpable and overriding error in its findings of fact or mixed fact and law, the appeal must be dismissed. The facts in this case, particularly the fact that the appeal was unopposed, support the Court exercising its discretion not to award costs.

[49] The appeal is dismissed, the whole without costs.

JUDGMENT in T-2081-22

THIS COURT'S JUDGMENT is that:

1. The appeal is dismissed.
2. No costs are awarded.

"Ekaterina Tsimberis"

Judge

FEDERAL COURT
SOLICITORS OF RECORD

DOCKET: T-2081-22

STYLE OF CAUSE: LES INDUSTRIES CERTICO INC. v.
MASTRANDREA COMMERCIAL BAKERIES
LIMITED AND CTM HOUSEHOLD APPLIANCES
INC.

PLACE OF HEARING: MONTREAL, QUEBEC

DATE OF HEARING: APRIL 13, 2023

JUDGMENT AND REASONS: TSIMBERIS J.

DATED: SEPTEMBER 1, 2023

APPEARANCES:

Howard L. Tatner

FOR THE APPLICANT

SOLICITORS OF RECORD:

Howard L. Tatner
Westmount, Quebec

FOR THE APPLICANT
LES INDUSTRIES CERTICO
INC.