

SECTION 45 PROCEEDINGS
TRADE-MARK: SOLITAIRES
REGISTRATION NO.: 335.681

On July 22, 1996, at the request of Chocolaterie Guylian N.V., the Registrar forwarded a Section 45 notice to Homestead, Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark SOLITAIRES is registered for the following wares:

"Chocolate covered nuts and candy".

In response to the Registrar's notice, the affidavit of Laurens Gerlings, Brands Manager of Hershey Canada Inc. was furnished. Each party filed a written submission and was represented at an oral hearing.

In his affidavit, Mr. Gerlings states that Homestead, Inc., is a related company of Hershey Canada Inc. and that Hershey Canada Inc. is licensed by the registrant to use the trade-mark and that under the license the registrant has control over the character or quality of the wares. He specifies that the trade-mark was in use with the wares as of July 22, 1996. He submits as Exhibits A and A-I, a representative specimen packaging (Exhibit A) and photographs of representative specimens of packaging and a photocopy of the bottom of the package (Exhibit A-1) which he states show use of the trade-mark during the relevant three-year period.

As Exhibit B, he has attached copies of invoices which he states show sales during the relevant period; as Exhibit C, he submits pages from the 1993, 1994, 1995 and 1996 catalogues which he states show the trade-mark SOLITAIRES with respect to items numbers 01309, 01310 or 01320, and/or 00404. Mr. Gerlings also has alleged that in the trade, chocolate covered nuts are candy.

The requesting party argues that the evidence is insufficient to conclude to use of the trade-mark in association with any of the wares during the relevant period in the manner required by Section 4(1) of the Trade-marks Act; in the alternative, it submits that if any use of the trade-mark has

been shown, it is only in association with the wares "chocolate covered nuts"

In my view, the evidence clearly shows use of the trade-mark SOLITAIRES in association with "chocolate covered nuts". It is clear from the specimen packaging and the pages from the catalogues that the wares sold under the trade-mark SOLITAIRES are chocolate covered almonds, therefore "chocolate covered nuts". I am also satisfied that sales of SOLITAIRES chocolate covered almonds were made during the relevant period. In the body of the invoices dated 3/03/95; 26/11/93; 31/10/93; 3/04/94 the trade-mark SOLITAIRES appears and Mr. Gerlings has clearly indicated that the invoices showed sales of the wares under the trade-mark.

I am also satisfied that the invoices dated 14/12/94 and 24/01/96 show sales of chocolate covered almonds in association with the trade-mark. The reference to "HERSHEY FAVOURITES", item 01309 in such invoices, would appear to be a reference to an assortment of chocolates sold under the trade-mark HERSHEY but including SOLITAIRES chocolate covered almonds. In this regard, the pages of catalogues submitted as Exhibit C clearly refer to item 01309 and clearly show the container for the wares bearing the trade-mark HERSHEY, a photograph of which has been submitted as Exhibit A-I. Exhibit A-I also contains a photograph of the back of the chocolate box. At the back of the box, it is explained that the product contains an assortment of chocolates which are identified under their respective trade-marks. The trade-mark SOLITAIRES appears to be one of the trade-marks used to distinguish the chocolate covered almonds contained in the box. I note that it is identified by the ® symbol and in my view, it would be perceived as a trade-mark used in association with the chocolate covered almonds. Consequently, I am satisfied that such use meets the requirements of the Trade-marks Act and that it is use of the trade-mark SOLITAIRES *per se*.

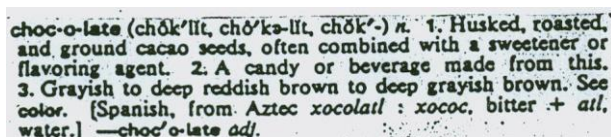
The requesting party argues that such use does not meet the requirements of Section 4 of the Act. It submits that the commercial transactions that were made involving "item 01309" were in respect of a product sold under the trade-mark HERSHEY, as can be seen on the cover of the sample box (Exhibit A-I), not in respect of a product sold under the trade-mark SOLITAIRES and in support of its argument, it relies on the case *Massana v. Zenith Electronics Corp.*, 26

C.P.R.(3d) 570. In my view, the present case is more analogous to the situation in *Service*

Intelpro v. Procter & Gamb/e Inc., 47 C.P.R.(3d) 118. What the evidence shows is that the present registrant sells a product containing an assortment of chocolates and the product is sold under the trade-mark HERSHEY; however, it is also clear that the registrant uses different trade-marks to distinguish the different chocolate products contained in the box and that it uses the trade-mark SOLITAIRES to distinguish the "chocolate covered almonds" contained therein. I agree with the registrant that there is nothing in the Act that prohibits a registrant from using more than one trade-mark at the same time. In my view, as long as the purchasing public will associate the trade-mark SOLITAIRES with the registrant's chocolate covered almonds, I do not see the reason such use would not comply with Section 4(1) of the Trade-marks Act. I am of the opinion that, when a customer purchases the registrant's chocolate box, the customer is aware that it is purchasing an assortment of chocolates, one of which are SOLITAIRES chocolate covered almonds, since such is clearly indicated on the back of the container.

I therefore conclude that the evidence shows use of the trade-mark SOLITAIRES in association with chocolate covered nuts in compliance with the requirements of the Act.

At the hearing, counsel for the registrant pointed out that as Exhibit A-I clearly refers to the product sold as "chocolates", and as "chocolates" are candies, use of the trade-mark has also been shown with the registered wares "candy": In support of her argument, she has provided the following dictionary definition for the word "chocolate":.



choc-o-late (chōk'lit, chō'ka-lit, chōk'-) *n.* 1. Husked, roasted, and ground cacao seeds, often combined with a sweetener or flavoring agent. 2. A candy or beverage made from this. 3. Grayish to deep reddish brown to deep grayish brown. See color. [Spanish, from Aztec *xocolatl*: *xococ*, bitter + *atl*, water.] —choc'o-late *adj.*

I agree that the evidence shows that the registrant sells several types of chocolates; however, the only products distinguished by the trade-mark SOLITAIRES are the "chocolate covered almonds" which would fall under the registered wares "chocolate covered nuts".

Consequently, the evidence only shows use of the trade-mark SOLITAIRES with "chocolate covered nuts".

Concerning Mr. Gerlings' allegation that in the trade, "chocolate covered nuts" are also considered "candy", I agree with the requesting party that such an allegation by Mr. Gerlings is insufficient to maintain the registration for "candy".

As pointed out by the requesting party, the wares "chocolate covered nuts" are listed separately from "candy" in the registration; consequently, in order to maintain the registration for both "candy" and "chocolate covered nuts", the registrant had to show use with "candy" other than "chocolate covered nuts". I find authority for this position in the decision *Sharp Kabushiki Kaisha v. 88766 Canada Inc.*, 72 C.P.R.(3d) 195 .

At the hearing, counsel for the registrant stated that if the Hearing Officer's decision was to maintain the registration for only one of the wares, it suggested that the wares "candy" could be redefined as "candy, namely chocolate covered nuts". However, as I have already mentioned, the wares "chocolate covered nuts" are listed in the registration as separate wares from "candy". In my view, if the registrant has listed them separately in its registration, then it must have done so because it considered the use of its trade-mark with "candy" to be different from such use with "chocolate covered nuts" (see *Sharp, supra*). Consequently, the term "candy" cannot now be amended to read "candy, namely chocolate covered nuts".

As the evidence does not show use of the trade-mark in association with any wares other than "chocolate covered nuts", then It follows that the registration ought to be maintained only for such wares (see *John Labatt Ltd. v. Rainier Brewing Co. et al.*, 80C.P.R.(2d) 228).

Registration No. 335,681 will be amended accordingly, in compliance with the provisions of
Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 31st *DAY OF OCTOBER* 1997.

D. Savard
Senior Hearing Officer
Section 45 Division