



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2015 TMOB 45
Date of Decision: 2015-03-18

**IN THE MATTER OF AN OPPOSITION
by 642897 B.C. Ltd. and Punjab Milk
Foods Inc. to application No. 1,490,259
for the trade-mark MALAI PANEER &
Design in the name of 1030983 Ontario
Ltd.**

FILE RECORD

[1] On July 27, 2010, 1030983 Ontario Ltd. filed an application to register the trade-mark MALAI PANEER & Design, shown below:



The application is based on use in Canada since at least as early as March 1, 2009, in association with the goods

cheese, namely paneer.

I will refer to the applied-for mark simply as MALAI PANEER as, for all relevant purposes in this proceeding, the word mark is equivalent to the word and design mark.

[2] The application disclaims the right to the exclusive use of the word PANEER apart from the mark as a whole. Further, the application informs the Registrar of Trade-marks that the word MALAI means “cream” in the Punjabi language: see section 29(a) of the *Trade-marks Regulations*, SOR/96-195. The Examination Section of the Canadian Intellectual Property Office

(CIPO, under whose aegis this Board also operates) initially raised an objection concerning the registrability of the applied-for mark, however, the applicant overcame the objection: see paragraphs 12 to 16, below.

[3] The subject application was advertised for opposition purposes in the *Trade-marks Journal* issue dated August 22, 2012 and was opposed by 642897 B.C. Ltd. and Punjab Milk Foods Inc. on October 30, 2012. The Registrar forwarded a copy of the statement of opposition to the applicant on November 1, 2012, as required by section 38(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13. The applicant responded by filing and serving a counter statement generally denying the allegations in the statement of opposition.

[4] The opponents' evidence consists of the affidavits of Gurpreet Arneja and Dulce Campos. The applicant's evidence consists of the affidavits of Harjinder Pabla and Amarjeet Chane. Both parties filed written arguments.

[5] Shortly before the Board forwarded copies of the written arguments to the contesting parties (see Section 46(3) of the *Regulations*), the opponents requested leave to amend their statement of opposition to add a new ground namely, that the applied-for mark is "the name in Punjabi of the wares in connection with which it is allegedly used." The new ground was based on 12(1)(c), shown below:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

(c) the name in any language of any of the goods or services in connection with which it is used or proposed to be used;

(emphasis added)

[6] The Board denied leave in a ruling dated April 9, 2014, shown below. Consequently, the question of whether the applied-for mark MALAI PANEER offends section 12(1)(c) is not in issue in this proceeding.

The opponent[sic] has[sic] not sufficiently explained why the section 12(1)(c) ground could not have been pleaded earlier. In this regard, the opponent[sic] had ample opportunity to review the statement of opposition and seek leave to amend it throughout the opposition proceeding including during the preparation of its rule 41 evidence.

The prejudice that would be suffered by the applicant would be significant if leave were granted given the late stage of the proceedings. In this regard, I agree with the applicant that the proposed changes do not reflect a mere correction of a typographical error but rather comprise an attempt to add a new ground of opposition that was not originally contemplated. As a result, the applicant would potentially need to file an amended counter statement, and also seek leave to file additional evidence and written arguments. The applicant's rule 42 evidence and written argument contemplated only the grounds of opposition as originally pleaded, particularly grounds based on the descriptiveness of the mark under section 12(1)(b) and the non-distinctiveness of the mark on the basis that it is allegedly descriptive or generic under section 2. The applicant did not presume that the opponent[sic] was[sic] relying on section 12(1)(c) as a ground of opposition.

[7] Both parties attended at an oral hearing held on November 20, 2014.

[8] Both parties filed a list of cases that they intended to rely on shortly before the oral hearing. Attached to the opponents' list was a Schedule A, which consisted of information relating to marks on the trade-marks register. It would have been appropriate for such information to have been submitted as evidence. I advised the parties that I would not have regard to Schedule A. Also, at the oral hearing, counsel for the applicant objected that paragraphs 34 and 35 of the opponents' written argument were in the nature of evidence. I agreed. I have not had regard to those paragraphs.

STATEMENT OF OPPOSITION

[9] The statement of opposition is rather lengthy (it is attached as Schedule 1 to these reasons for decision) and I have therefore summarized the salient allegations below.

1. *non-compliance with section 30(a)*

The opponents allege that the application does not describe the applicant's wares "in ordinary commercial terms" in that paneer "should be specified in greater detail."

2. *non-compliance with section 30(b)*

The opponents allege that (i) neither the applicant nor any licensee of the applicant has used the applied-for mark MALI PANEER since the date of first use claimed in the application and that (ii) the combination of the words MALI and PANEER are not capable of functioning as a trade-mark because it is a descriptive term for "cream cheese" used by various third parties and by the opponents "to describe the same goods."

3. *non-compliance with section 30(i)*

The opponents allege that the applicant could not have been satisfied that it was entitled to use the applied-for mark because the applicant knew or ought to have known that the mark is descriptive, generic and common in the cheese industry.

4. *non-compliance with section 12(1)(b)*

The opponents allege that the applied-for mark is not registrable because the dominant features of the mark are the words MALAI PANEER which are clearly descriptive or deceptively misdescriptive of the applicant's goods.

5. *non-compliance with section 2*

The opponents allege that the applied for mark is not distinctive because the term MALAI PANEER (i) is a generic and descriptive term not capable of functioning as a trade-mark to distinguish the applicant's goods, and (ii) the opponents and others in the industry use the same term MALAI PANEER in association with cheese.

[10] Before addressing the grounds of opposition, I will review the parties' evidence, the evidential burden on the opponents, and the legal onus on the applicant.

OPPONENTS' EVIDENCE

Dulce Campos

[11] Ms. Campos identifies herself as a trade-marks searcher, conducting such searches using a variety of data bases. The results of her searches are attached as Exhibits 1 to 5 of her affidavit.

Exhibits 1 and 2

[12] Exhibit 1 is copy of an objection to the subject mark, issued on November 29, 2010, by the Trade-marks Examination Section of CIPO during the processing of the trade-mark application. The Examiner objected as follows:

. . . the mark . . . is considered to be, when sounded, clearly descriptive or deceptively misdescriptive of the wares in association with which it is used since MALAI PANEER clearly describes that the applicant's paneer includes a malai cream sauce.

Pursuant to paragraph[sic] 12(1)(b) of the Trade-marks Act, this mark does not appear registrable.

[13] For convenience, section 12(1)(b) is shown below:

12. (1) Subject to section 13, a trade-mark is registrable if it is not

(a) a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding thirty years;

(b) whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin;

(c) the name in any language of any of the goods or services in connection with which it is used or proposed to be used;
(emphasis added)

[14] From the file record, I note that the applicant responded to the Examiner's objection on February 16, 2012, taking the position that "malai" does not mean "cream sauce" but that "some may use the word 'malai' to describe certain *cooked dishes* which employ a sauce."

[15] The applicant further submitted that:

Even if the Mark is clearly descriptive or deceptively misdescriptive . . . such prohibition would be limited to words in English or French. Given that the words

“malai paneer” are in neither English or French, there should be no objection to the Mark, even if it is clearly descriptive or deceptively misdescriptive.

I acknowledge that where foreign words have been assimilated or are commonly used in either the French or English languages, the words may be held to have a clearly descriptive meaning or connotation. However . . . the word “malai” is neither assimilated or commonly used in either the French or English languages nor has this word become so familiar to English or French speaking people that the Mark cannot become a valid registrable mark.

[16] Exhibit 2 is a copy of the Examiner’s correspondence dated April 11, 2012 requiring a translation of the word MALAI into French or English, pursuant to section 29(a) of the *Trade-marks Regulations*. The applicant responded on May 8, 2012 by advising that MALAI is the Punjabi word for “cream,” specifically, “the skin formed on the surface of heated milk.” Presumably the Examination Section accepted the applicant’s submissions and withdrew its objection (although there is no note of record) as the subject application proceeded to advertisement.

Exhibits 3 to 5

[17] Exhibits 3 to 5 are the results of Internet searches concerning “malai paneer.” The searches show that it is a cheese commonly used in Indian cuisine, often referred to simply as “paneer.” The cheese is made by curdling heated milk with lemon juice or other food acids. Various recipes are available for making paneer.

[18] My understanding from the above evidence is that “malai paneer” refers to a cheese made by a fairly simple process, that is, by heating and curdling milk, and that it is easily made in a domestic kitchen (the nature of “malai paneer” is further explained in the applicant’s evidence: see para. 27, below).

[19] Referring back to para. 16, above, if the Examiner had reason to believe that a translation of the phrase MALAI PANEER, as a whole, would be something approximating “cheese made from clotted cream,” the Examiner might have been alerted to object to the mark pursuant to section 12(1)(c), i.e., that the mark is the name of the goods “in any language,” see para. 13,

above. As noted earlier, non-compliance with section 12(1)(c) is not in issue in this opposition proceeding.

Gurpreet Arneja

[20] Mr. Arneja identifies himself as a senior executive of each opponent company. The opponents are located in Surrey, British Columbia; they are two of the few manufacturers of Indian dairy products in North America, employing 160 full-time staff.

[21] Mr. Arneja states that “malai” is an Indian term for “clotted cream” and that “paneer” is an Indian term for “fresh cheese.” The term “malai paneer” is commonly used by Indian dairy manufacturers to describe their “cream cheese” product. Exhibits 7 to 15 of his affidavit include printouts of packaging taken from the websites of various Indian dairy manufacturers. I note that the terms “paneer” and “malai paneer” appear on product packaging to describe their cheese products. However, the opponents have not established that any of those packaged products are available to consumers in Canada.

[22] Exhibit 17 to Mr. Arneja’s affidavit is comprised of copies of pages from various websites concerning restaurant menus featuring malai paneer dishes. From my review of Exhibit 17, it does not appear that any of the menus are for restaurants located in Canada.

APPLICANT’S EVIDENCE

Harjinder Pabla

[23] Mr. Pabla identifies himself as the Vice President of the applicant company. The applicant was incorporated in 1993 and operated an Indian sweet shop and restaurant. It later expanded to include three restaurant locations, a catering business and a line of BRAR’S branded Indian sweets, snacks and dairy products.

[24] In 1999, the applicant incorporated a new company called Ontario Impex of Canada Inc. (“OIC”) to manufacture and distribute BRAR’S products, including MALAI PANEER cheese. OIC has an “implied” license (see para. 4 of Mr. Pabla’s affidavit) from the applicant to use the mark MALAI PANEER in compliance with section 50 of the *Trade-marks Act*. The applicant

and/or its licensee OIC have been using the applied-for mark since at least as early as March 1, 2009, in association with cheese. Exhibit 5 illustrates the use of the applied-for mark on product packaging which has remained unchanged since 2009.

[25] Initially the applicant's MALAI PANEER product was sold through specialty retail stores and restaurants; by 2011, the product was being sold in major Canadian supermarkets including Loblaws and Fresh Co. Approximate gross annual sales for MALAI PANEER cheese, for the years 2010, 2011, and 2012 were \$1.2 million, \$2 million, and \$3.5 million, respectively.

[26] Since 2009 the applicant has regularly advertised its MALAI PANEER cheese through corporate websites, social media websites, print media, radio, television and through sponsoring films and entertainment events. The applicant and/or OIC expended \$28,500 for advertising in 2009, such expenditures rising steadily to \$213,900 in 2012.

[27] Mr. Pabla explains, among other things, the nature of the applicant's MALAI PANEER cheese product at para. 17 – 23 of his affidavit, shown below:

17. "Malai" is a word in the Punjabi language that refers to the layer of fat and coagulated proteins that forms on the surface of heated milk (known in English as "clotted cream"), and to the act of skimming the cream off the surface of the milk. Malai can also be used to suggest that something is of premium or top quality due to the connotation that "cream rises to the top". . .

18. "Paneer" is a particular type of fresh cheese common in South Asian cuisine. Paneer is the ordinary commercial name for this type of cheese throughout Canada, in both English and French speaking markets. . .

19. The trade-mark MALAI PANEER was chosen by the Applicant because the term MALAI is suggestive of the soft texture of the Applicant's natural paneer as well as its premium quality.

20. The term "malai paneer" is sometimes used in reference to a cooked dish made with cubes of paneer in a rich sauce made by combining cream, tomatoes, onion, garlic, spices, etc. This dish would be served hot, often with roti, naan or rice.

21. To the best of my knowledge, the Applicant was the first to use the term MALAI PANEER in association with packaged paneer or blocks of paneer in

Canada. I am aware of no particular type of cheese that would be generically referred to as "malai paneer" in Canada.

22. MALAI PANEER is not a generic term for "cream cheese". To my knowledge, cream cheese is a high fat, spreadable dairy product with a milk fat content of no less than 30% and a moisture content of no more than 55%. Cream cheese melts quickly when heated. . .

23. The Applicant's paneer has a milk fat content of 20% and a moisture content of 60%. It is not spreadable like cream cheese. The Applicant's paneer can be cut into cubes and retain its shape without melting when heated. Cubes of paneer are commonly skewered with vegetables and grilled on a barbeque.

[28] In my view the weight of the evidence supports Mr. Pabla's testimony that the applicant's product is not a cream cheese.

[29] The opponents in their written argument and at the oral hearing brought to my attention apparent inconsistencies and lacunae in Mr. Pabla's evidence. The opponents therefore submit that little if any weight should be given to his affidavit testimony. I agree with the opponents' submissions regarding apparent inconsistencies and the absence of pertinent information, however, I do not agree that Mr. Pabla's evidence should be given reduced weight. For example, in his affidavit dated September 2013, Mr. Pabla identifies himself as Vice President of the applicant company "since 2006." The opponents note that Exhibit 1 to Mr. Pabla's affidavit, which is a copy of the Articles of Incorporation for the applicant issued on May 20, 1993, lists Dial Pabla, not Harjinder Pabla, as the only officer and director of the company. Certainly the applicant might have evidenced a current certificate of incorporation, however, such an omission is not sufficient, in my view, to call into question the affiant's credibility. Cross-examination was available to the opponents to canvass the affiant's ability to give evidence on behalf of the applicant. In the absence of cross-examination, I have no reason to doubt the reliability of Mr. Pabla's evidence.

Amarjeet Chane

[30] Ms. Chane identifies herself as a legal assistant with the firm representing the applicant. Her affidavit serves to introduce into evidence a search of a website listing " . . . over 550

specialty cheeses from 57 countries . . .” The first cheese listed under the letter M is Maasdam; the last is Myzithra. Malai Paneer is not listed. However, I note that there is no indication whether India is included in the group of 57 countries.

EVIDENTIAL ONUS AND LEGAL BURDEN

[31] In accordance with the usual rules of evidence, there is an evidential burden on the opponents to prove the facts inherent in the allegations pleaded in the statement of opposition: see *John Labatt Limited v. The Molson Companies Limited*, 30 CPR (3d) 293 at 298 (FCTD). The presence of an evidential burden on the opponents with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist. There is also a legal onus on the applicant to show that the application does not contravene the provisions of the *Trade-marks Act* as alleged by the opponents in the statement of opposition (for those allegations for which the opponents have met its evidential burden). The presence of a legal onus on the applicant means that if a determinate conclusion, based on the usual civil balance of probabilities standard, cannot be reached once all the evidence is in, then the issue must be decided against the applicant.

CONSIDERATION OF THE GROUNDS OF OPPOSITION

Section 30(a)

[32] The material date with respect to section 30 is the date of filing the application, in this case July 27, 2010. The opponents, in para. 9 of their written argument, submit that “The Wares and Services Manual as kept by CIPO contains no listing for the term ‘paneer’” and therefore the applicant has not specified its goods with sufficient particularity. I disagree with the opponents’ conclusion. Whether or not a certain good is listed in the Manual is not determinative of compliance with section 30(a). The evidence of record indicates that the applicant has described its product in ordinary commercial terms and with sufficient specificity. The first ground of opposition is therefore rejected.

Section 30(b)

[33] With respect to the first branch of the ground of opposition based on section 30(b) (see para. 9-1, above), the opponents, in their written argument, rely on “inconsistencies and inaccuracies” in Mr. Pabla’s affidavit to argue that the applicant has not established a license agreement between the applicant and Ontario Impex of Canada Inc. The opponents therefore conclude that the applicant has not established that use of the applied-for mark by Impex inures to the benefit of the applicant. I disagree with the opponents’ conclusion. In my view, while the applicant’s evidence regarding licensing might have been more informative, in the absence of cross-examination I am unable to find any reason why Mr. Pabla’s affidavit testimony of a licensing agreement with Impex should be discounted. The first branch of this ground of opposition is therefore rejected.

[34] The opponents in their written argument do make any submissions with respect to the second branch, which is premised on the words MALI and PANEER not being capable of functioning as a trade-mark because it is a descriptive term for “cream cheese” used by various third parties and by the opponents “to describe the same goods.” As discussed earlier, the evidence of record does not support the opponents’ contention that MALI PANEER is a descriptive term for cream cheese or that the term is used in Canada by third parties or by the opponents. The second branch of this ground is therefore also rejected.

Section 30(i)

[35] The opponents allege that the applicant could not have been satisfied that it was entitled to use the applied-for mark because the applicant knew or ought to have known that the mark is descriptive, generic and common in the cheese industry. However, there is a long line of opposition cases holding that a section 30(i) ground of opposition must allege exceptional circumstances such as bad faith or non-compliance with a Federal statute. The fact that an applicant is aware or has knowledge that an applied-for mark may possibly be descriptive or generic cannot form the basis of this ground of opposition. I find that the pleadings do not support a ground of opposition based on section 30(i) and therefore this ground is rejected.

Section 12(1)(b)

[36] The opponents allege that the applied-for mark is not registrable because the dominant features of the mark are the words MALAI PANEER which are clearly descriptive or deceptively misdescriptive of the applicant's wares. The applicant made its submission on this issue to the Examination Section, at para. 15, above, and takes the same position in this proceeding, at para. 118 of its written argument, shown below:

. . . Section 12(1)(b) only prohibits the registration of clearly descriptive or deceptively misdescriptive marks English or French. The Opponent has not only failed to establish that the Trade-mark is in the English or French languages, but has in fact taken the contradictory position, submitting evidence that MALAI is an Indian term. As such, the Applicant respectfully submits that this ground of opposition is unfounded and should be dismissed.

[37] I agree with the applicant's submissions and therefore this ground of opposition is rejected.

Section 2

[38] The opponents allege that the applied-for mark is not distinctive because the term MALAI PANEER (i) is a generic and descriptive term and (ii) the opponents and others in the industry use the term MALAI PANEER in association with cheese. In my view, the opponents have not met their evidential onus to establish that either premise is factually correct in this jurisdiction. Accordingly, this ground is rejected.

DISPOSITION

[39] As each of the grounds of opposition has been rejected, the opposition is rejected. This decision has been made pursuant to a delegation of authority by the Registrar of Trade-marks under section 63(3) of the *Trade-marks Act*.

[40] I would add that, even if section 12(1)(c) had been included as a ground of opposition, it is not clear that the opponents would have succeeded on this ground. In this regard, the opponents have taken the position that MALAI PANEER means "cream cheese" in the Punjabi language. However, as mentioned earlier, I have found that the weight of the evidence supports

the applicant's contention that its product is not, in the ordinary commercial sense, a cream cheese.

Myer Herzig, Member,
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule 1

STATEMENT OF OPPOSITION

TO: REGISTRAR OF TRADE-MARKS
Gatineau, Quebec, Canada

IN THE MATTER OF an Opposition by 642897 B.C. Ltd. and its related company Punjab Milk Foods Inc. to Application No. 1,490,259 filed on behalf of 1030983 Ontario Ltd. for the trade-mark MALI PANEER & Design

1. 642897 B.C. Ltd. and its related company Punjab Milk Foods Inc. (hereinafter referred to as the "Opponent"), the full post office address of whose principal office and place of business is:

6308 – 146th Street
Surrey, BRITISH COLUMBIA
CANADA, V3S 3A4

gives notice of opposition to the proposed registration of the trade-mark MALI PANEER (the "Trade-mark") filed on behalf of (the "Applicant") and advertised under application number 1,490,259 (the "Application") in the issue of the Canadian Trade-marks Journal dated August 22, 2012 (Vol. 59, No. 3017)

1,490,259. 2010/07/27. 1030983 Ontario Ltd., 19 Victoria Crescent, Brampton, ONTARIO L6T 1E2 Representative for Service/Représentant pour Signification: PERFINDEVER SINGH PATROLA. (PATROLA LAW), HSBC BUILDING, 888 WEST GEORGIA ST., SUITE 1500, VANCOUVER, BRITISH COLUMBIA, V6C3E8



The translation provided by the applicant of the PUNJABI word(s) MALAI is CREAM.

The right to the exclusive use of the word PANEER is disclaimed apart from the trade-mark.

WARES: Cheese, namely paneer. **Used** in CANADA since at least as early as March 01, 2009 on wares.

Selon le requérant, la traduction anglaise du mot panjabi MALAI est CREAM.

Le droit à l'usage exclusif du mot PANEER en dehors de la marque de commerce n'est pas accordé.

MARCHANDISES: Fromage, notamment panir. **Employée** au CANADA depuis au moins aussi tôt que le 01 mars 2009 en liaison avec les marchandises.

2. All sections and sub-sections herein refer to the *Trade-marks Act* of Canada, R.S., c. T-10, s.1 as amended.

3. **This Statement of Opposition is based on the following grounds of opposition:**

- (a) **Sections 38(2)(a) and 30(a):** Pursuant to Section 38(2)(a) of the Act, the Application does not conform to the requirements of Section 30(a) of the Act because, at all material dates including the date of filing of the Application, the Application does not contain a statement in ordinary commercial terms of the specific wares in association with which the Trade-mark allegedly used. In particular, the description of wares "cheese namely paneer" This description is not found in nor does it comply with The Wares and Services Manual as maintained by the Canadian Intellectual Property Office. In particular, "paneer" should be specified in greater detail.
- (b) **Sections 38(2)(a) and 30(b):** The trade-mark applied for is not registrable in view of Sections 38(2)(a) and 30(b) of the Trade Marks Act. The Applicant has not used the mark, as a trade-mark by itself or through a licensee, or by itself and through a licensee since the alleged claimed March 1, 2009 date of first use. Further, that both the dominant elements namely the word MALI and the word PANNER are generic, clear descriptions of the quality or characteristic of the goods outlined in application no. 1,490,259. The word MALAI translates as is "cream" and the word PANEER translates as "cheese" which is evident by the disclaimer to the word PANEER in the application. In effect the mark is the descriptive term "cream cheese" and is used by others in similar channels of trade to describe the same goods. The term MALI PANEER as well as combinations thereof and phonetically similar elements are used in Canada by numerous third parties including but not limited to the Opponent in identical and similar channels of trade as generic descriptive terms for identical or similar goods to that recited in application no. 1,490,259. The Applicant's date of first use claimed in its application cannot be relied upon in view of 1.) the Applicant has not used the applied for mark since at least March 1, 2009 and 2.) Neither the individual elements MALI nor PANEER or combination thereof are independently registrable and therefore not capable of functioning as a trade-mark to identify the Applicant's goods from those of other third parties in identical or similar channels of trade including but not limited to the Opponent.

- (c) **Sections 38(2)(a) and 30(i):** The trade-mark applied for is not registrable in view of Sections 38(2)(a) and 30(i) of the Trade Marks Act because, at the date of filing of the Application, the Applicant could not properly have been satisfied that it was entitled to use the mark in particular the dominant elements MALI PANEER or combination thereof with any exclusivity because the Applicant knew, or ought to have known, that the elements MALI PANEER whether individual elements, combinations thereof or phonetically similar elements are merely descriptive, generic and have been used by others and that the term MALI PANEER is common in its industry, in Canada when applied to goods similar to that recited in the Applicant's application no. 1,490,259 and because the elements MALI PANEER have been used by the Opponent and others in the industry in association with similar goods to that of the Applicant.
- (d) **Section 38(2)(b) and Section 12(1)(b):** The trade-mark applied for is not registrable in view of Sections 38(2)(b) and 12(1)(b) of the Trade Marks Act because the dominant features namely the words MALI PANEER, combination thereof or phonetically similar elements when used in association with the goods outlined in the Applicant's application no. 1,490,259 whether depicted, written or sounded, are clearly descriptive or deceptively misdescriptive of the Applicant's goods. The elements MALI PANEER, are clearly the dominant features of the mark depicted in application no. 1,490,259 and, given that these elements are clearly descriptive of the character or quality of the Applicant's goods, the mark in its entirety, when sounded, is unregistrable pursuant to paragraph 12(1)(b) of the Act. The elements MALI PANEER as well as a combination thereof only function as descriptive elements, used to describe a quality or characteristic of the Applicant's goods. The granting of a registration which provides for exclusivity of elements and combinations of elements that are used by others in the industry would merely serve to unreasonably limit this industry.
- (e) **Sections 38(2)(d) and 2:** The applied for trade-mark is not distinctive, having regard to the provisions of Section 38(2)(d) and 2 of the Trade Marks Act, because the words MALI PANEER as well as phonetically similar elements and/or combinations thereof are generic and descriptive which are not capable of functioning as a whole or dominant part of a mark to distinguish the Applicant's

goods from the goods of others. In particular, but not by way of limitation, the Opponent and others in the industry use of the same descriptive term MALI PANEER as well as phonetically similar elements, alone or in combinations thereof for identical and/or similar goods to that identified in the Applicant's application no.1,490,259, nor is the Applicant's mark adapted to so distinguish such goods.

4. The Opponent appoints ACCUPRO TRADEMARK SERVICES LLP, whose full post office address in Canada is:

702 - 401 WEST GEORGIA STREET
VANCOUVER, BRITISH COLUMBIA
CANADA V6B 5A1

as the firm upon which service of any document in respect of this opposition may be made with the same effect as if it had been served upon the Opponent.

EXECUTED at Vancouver, British Columbia, Canada, this 22nd day of October, 2012.

642897 B.C. Ltd. and its related company Punjab Milk Foods Inc.

By its Agent:

Accupro Trademark Services LLP
Accupro Trademark Services LLP
Trade-mark Agent No. 10705