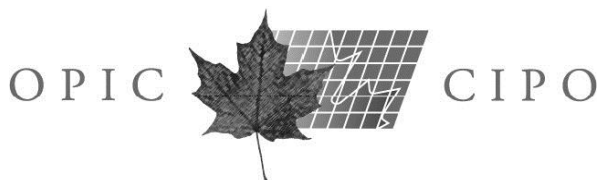


TRADUCTION/TRANSLATION



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

Citation: 2010 TMOB 142
Date of Decision: 2010-08-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Smart & Biggar against registration
No. TMA299,635 for the trade-mark RIVIERA in the
name of Laiterie Chalifoux Inc.**

[1] At the request of Smart & Biggar (the Requesting Party), the Registrar forwarded a notice under section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) on September 15, 2008, to Laiterie Chalifoux Inc. (the Registrant), requiring it to show the use of the RIVIERA trade-mark (the Mark), the subject of registration certificate number TMA299,635, in association with the following wares: [TRANSLATION] “cheddar cheese curds, mild block cheddar cheese, medium block cheddar cheese, butter, fruit juice and non-carbonated fruit beverages, old block cheddar cheese” (the Wares).

[2] Section 45 of the Act requires the Registrant to show that it used its trade-mark in Canada in association with each of the wares and/or services specified in the registration at any time within the three-year period immediately preceding the date of the notice or, if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between September 15, 2005, and September 15, 2008 (the Relevant Period).

[3] Case law tells us that there is no need to show use of the Mark by evidentiary overkill and that the purpose of section 45 proceedings is to remove the "deadwood" from the register [see *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62].

[4] In response to the notice, the Registrant furnished an affidavit by Jean-Pierre Chalifoux together with Exhibits P-1 through P-4. Only the Registrant filed written submissions and neither party requested a hearing.

[5] Mr. Chalifoux has been president of the Registrant since November 29, 2001. For the purposes of this decision, it is useful to reproduce paragraph 5 of his affidavit:

[TRANSLATION]

The trade-mark RIVIERA has been used in Canada for several years, including the past three years, on packaging for cheddar cheese curds, mild block cheddar cheese, medium block cheddar cheese, old block cheddar cheese (hereafter the “Products”).

[Note: I shall use the term “Products” in my decision as defined by Mr. Chalifoux in order to distinguish it from the term “Wares”, defined above.]

[6] This bare allegation, in and of itself, is insufficient to establish use of the Mark within the meaning of subsection 4(1) of the Act. I must determine whether there is evidence in the record to support such a statement. It also bears noting that Mr. Chalifoux’s affidavit makes no mention whatsoever of use of the Mark in Canada during the Relevant Period in association with butter, fruit juice or non-carbonated juice beverages. Mr. Chalifoux provided no explanation for the non-use of the Mark in association with these wares during the Relevant Period. The registration of the Mark should therefore be amended accordingly.

[7] Mr. Chalifoux attached to his affidavit samples of packaging for Products bearing the RIVIERA mark (Exhibit P-1). He stated that the packaging was identical to that currently being used in Canada and that which has been used in Canada for the past three years.

[8] He specified that the Registrant had always manufactured its own Products bearing the Mark in Canada. He explained that the Products were sold by distributors in store chains such as IGA, Metro and Provigo. He provided sales figures for the Products bearing the Mark for the years 2006, 2007 and 2008, which exceeded \$17 million annually.

[9] He filed advertising material used in [TRANSLATION] “recent years” bearing the Mark. However, it is not clearly stated that this material was used in Canada during the Relevant Period. Mr. Chalifoux also filed excerpts from the Registrant’s website dated

November 17, 2008, but he did not mention whether these excerpts appeared on the website during the Relevant Period.

[10] Finally, Mr. Chalifoux filed copies of invoices issued to store chains such as IGA, Maxi, Wal-Mart and Épiciers Unis Metro-Richelieu by the Registrant during the Relevant Period (Exhibit P-3) for the sale in Canada of Products bearing the Mark.

[11] From this evidence I conclude that the Registrant has shown the use in Canada of the RIVIERA & Design mark within the meaning of subsection 4(1) of the Act during the Relevant Period in association with the Products only. I have reached this conclusion because the Registrant has demonstrated the sale in Canada during the Relevant Period of Products (through filed invoices) bearing the Mark (through filed packaging bearing the Mark).

[12] Pursuant to the authority delegated to me under s. 63(3) of the Act, registration No. TMA299,635 will be amended to delete the following wares:

[TRANSLATION]

butter, fruit juice and non-carbonated fruit beverages

in accordance with the provision of section 45 of the Act.

Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Certified true translation
Francie Gow, BCL, LLB