



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

Citation: 2011 TMOB 177
Date of Decision: 2011-10-04

**IN THE MATTER OF AN OPPOSITION by
Saputo Produits Laitiers Canada s.e.n.c. /
Saputo Dairy Products Canada G.P. to
application No. 1,383,420 for the trade-mark
MOZZARELLA FRESCA in the name of
Grande Cheese Company Limited.**

[1] On February 14, 2008, Grande Cheese Company Limited (the Applicant) filed an application to register the trade-mark MOZZARELLA FRESCA (the Mark) based upon proposed use of the Mark in Canada in association with “cheese; cheese namely mozzarella cheese”. The application, as revised, states that the English translation of the term FRESCA is FRESH.

[2] The application was advertised for opposition purposes in the *Trade-marks Journal* of December 3, 2008.

[3] On January 28, 2009, Saputo Produits Laitiers Canada s.e.n.c. / Saputo Dairy Products Canada G.P. (the Opponent) filed a statement of opposition. The grounds of opposition can be summarized as follows:

1. The application does not conform to the requirements of s. 30 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) in that the Applicant falsely stated in its application that it was satisfied it was entitled to use the Mark in Canada in association with the wares

claimed therein in view of the allegations set forth in the statement of opposition.

Moreover, the Applicant never had the intention to use the Mark or has abandoned same;

2. The Mark is not registrable pursuant to s. 12(1)(b) of the Act in that it is either clearly descriptive or deceptively misdescriptive in the English or French language of the character or quality of the wares in association with which it is proposed to be used;
3. The Mark is not registrable pursuant to s. 12(1)(c) of the Act in that it is the name in any language of the wares in connection with which it is proposed to be used;
4. The Mark is not registrable pursuant to s. 12(1)(e) of the Act in that it is a mark of which the adoption is prohibited by s. 10 of the Act since MOZZARELLA FRESCA has, by ordinary and bona fide commercial usage become recognized in Canada as designating a kind or quality of cheese; and
5. The Mark is not distinctive of the wares of the Applicant pursuant to s. 2 of the Act in that the Mark is made of ordinary terms used in the cheese industry in Canada, that it is either clearly descriptive or deceptively misdescriptive of the wares, and is the name of the wares in any language, as alleged above.

[4] The Applicant filed and served a counter statement in which it denied the Opponent's allegations.

[5] In support of its opposition, the Opponent filed the solemn declaration of Nancy Baillie, Senior Vice President Quality Assurance and Product Development with the Opponent, sworn June 26, 2009. In support of its application, the Applicant filed the affidavit of Miranda Cole, an articling student with the law firm representing the Applicant in the instant proceeding, sworn October 29, 2009.

[6] Both parties filed written arguments. Only the Opponent was represented at an oral hearing.

Onus

[7] 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 evidentiary 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 [see *John Labatt Ltd v. Molson Companies Ltd.* (1990), 30 C.P.R. (3d) 293 (F.C.T.D.); and *Dion Neckwear Ltd. v. Christian Dior, S.A. et al.* (2002), 20 C.P.R. (4th) 155 (F.C.A.)].

Summary of the parties' evidence

The Opponent's evidence – The solemn declaration of Nancy Baillie

[8] Ms. Baillie first goes over her qualifications and experience in the dairy industry.

[9] Ms. Baillie states that in 1977, she obtained a Bachelor of Science Degree in Food Science from the University of British Columbia. Since 1979, she has always worked in the dairy industry essentially with the same company, which ultimately became the Applicant through a series of corporate reorganizations, amalgamations and acquisitions described in her solemn declaration.

[10] Ms. Baillie states that since the time she started her career in the dairy processing industry in 1979, she has always been involved in product development and quality assurance. As a consequence, she is familiar with various laws and regulations relating to foods and beverages destined for human consumption, as well as guidelines and directives relating to such laws and regulations issued from time to time by the Canadian Food Inspection Agency (CFIA) and other governmental departments and agencies.

[11] In 1979 and continuing until 1990, Ms. Baillie was employed in various functions relating to quality assurance and product development at the project management level. More particularly, she states that she was charged with ensuring that products on the market and products being developed for the market complied with applicable laws and regulations, as well as governmental and quasi-governmental directives and guidelines, relating to food safety and food labelling.

[12] In 1991, Ms. Baillie was promoted to a senior management level, with the tasks of ensuring that the staff under her supervision properly executed their duties relating to product development and quality assurance, as well as being charged with the ongoing obligation of implementing any new legal requirements (such as amendments to existing laws and regulations) and directives and guidelines (such as any amendments to the CFIA's food labelling requirements).

[13] From 2001 through 2007, Ms. Baillie was Vice President Product Development with the Opponent. In this capacity, she was in charge of all product development for the Opponent across Canada. Principally, her obligations consisted of ensuring that all existing products on the market manufactured by the Opponent, as well as new products launched on the market by the Opponent, complied with all laws and regulations, as well as with all governmental and quasi-governmental guidelines and directives, including in the area of product labelling.

[14] Ms. Baillie states that since 2007, she has been given the additional task of being charged with quality assurance of all products manufactured by the Opponent across Canada. Therefore, since 2007, she has been in charge at the Opponent of both product development, which includes ensuring that products are correctly labelled, and quality assurance.

[15] Ms. Baillie then turns to the packaging and labelling of food, and regulations concerning mozzarella cheese in particular.

[16] More particularly, Ms. Baillie states that the legislation and directives and guidelines most often referred to in Canada relating to manufacturing and labelling of foods and beverages include, without limitation, the *Food and Drugs Act* and the *Food and Drugs Regulations*, the *Canada Agricultural Products Act* and the *Dairy Products Regulations*, the *Consumer Packaging and Labelling Act* and its regulations, and the CFIA's *Guide to Food Labelling and Advertising*.

[17] Ms. Baillie states that MOZZARELLA is a type of cheese of Italian origin known around

the world. MOZZARELLA can be generally described as a mild, white-coloured fresh or unripened cheese. Traditionally, MOZZARELLA was made from the milk of water buffalos. Today, however, the majority of MOZZARELLA made around the world, including Canada, is made with the milk of cows. I note that these statements of Ms. Baillie are corroborated by the various dictionary definitions of the word MOZZARELLA attached to her solemn declaration as Exhibit NB-2.

[18] Ms. Baillie states that in Canada, under the provisions of the *Food and Drug Regulations* and the *Dairy Products Regulations*, MOZZARELLA is a varietal cheese for which standards are prescribed, with the consequence that a cheese in Canada cannot be labelled MOZZARELLA, unless such cheese meets the specific requirements of the *Food and Drugs Regulations* and the *Dairy Products Regulations*.

[19] Ms. Baillie states that under the *Dairy Products Regulations*, the principal ripening characteristic of pre-packaged varietal cheese must be identified on the label, except if the varietal cheese is cottage cheese or a varietal cheese listed in the table to s. 28 of the *Dairy Products Regulations*. Such table lists MOZZARELLA, with the consequence that the principal ripening characteristic of MOZZARELLA may be identified on the label even though there is no legal requirement to do so. In this regard, s. 70(4) of the *Dairy Products Regulations* defines four terms that could be used to identify the principal ripening characteristic of pre-packaged varietal cheese, namely: (a) “ripened”, (b) “surface ripened”, (c) “blue veined” or (d) “unripened” or “fresh”. In respect of the last category, “fresh” (or the French equivalent “frais”) is used to identify the principal ripening characteristic of pre-packaged varietal cheese where the cheese has not undergone any ripening.

[20] Ms. Baillie states that a principal characteristic of MOZZARELLA is that this varietal cheese has not undergone any ripening, which statement is again corroborated by the dictionary definitions filed under Exhibit NB-2. Therefore, pursuant to s. 70(4) of the *Dairy Products Regulations*, its principal ripening characteristic may be identified on the label either as “fresh” (or the French equivalent “frais”) or “unripened”.

[21] Ms. Baillie states that when the words MOZZARELLA and FRESH are used together in Canada on the label of a cheese product, a communication is made to consumers in general to the effect that such cheese product has been manufactured in compliance with all the requirements for MOZZARELLA set forth in the *Food and Drugs Regulations* and the *Dairy Products Regulations*, and moreover, such cheese product is “FRESH” in that the product has not undergone any ripening. As a consequence of the provisions in the *Food and Drugs Regulations* and the *Dairy Products Regulations* relating to MOZZARELLA and FRESH, any cheese product that either does not meet the characteristics for MOZZARELLA as required by the *Food and Drugs Regulations* or the *Dairy Products Regulations* or has undergone any ripening, cannot be labelled in any fashion whatsoever “FRESH MOZZARELLA”.

[22] Ms. Baillie states that in principle, any person who manufactures a cheese product in Canada that meets the requirements of MOZZARELLA under the provisions of the *Food and Drugs Regulations* and the *Dairy Products Regulations* and, moreover, has not undergone any ripening, is entitled by virtue of the *Food and Drugs Regulations* and the *Dairy Products Regulations* to label such cheese product “FRESH MOZZARELLA”.

[23] I note that these statements of Ms. Baillie are corroborated by specimens of packaging materials used by a third party cheese maker in Canada attached to her solemn declaration as Exhibit NB-1. The first of these packaging materials brands and labels the cheese product FRESH MOZZARELLA, while the second packaging material describes a MOZZARELLA product as “Fresh Soft Cheese / Fromage à pâte molle frais”. Commenting on this exhibit, Ms. Baillie adds that as previously noted, it is optional under s. 70(4) of the *Dairy Products Regulations* to indicate on its label the principal ripening characteristic of MOZZARELLA, i.e. “unripened” or “fresh”. In fact, most Canadian cheese makers, including the Opponent, do not exercise the option to indicate the principal ripening characteristic of MOZZARELLA on their labels given that MOZZARELLA is, by nature, a FRESH (or unripened) varietal cheese.

[24] Ms. Baillie further notes that outside the legal requirements of the *Food and Drugs Regulations* and the *Dairy Products Regulations*, the term FRESH or its Italian equivalent FRESCA, is ordinarily defined as having its original qualities unimpaired, such as not being

stale, sour or decayed. I note that these statements of Ms. Baillie are corroborated by dictionary definitions of the word FRESH, as well as the translation of the word FRESCA in English (“FRESH”) and French (“FRAÎCHE”) also included in Exhibit NB-2 discussed above.

[25] Concerning more particularly the Applicant’s Mark, Ms. Baillie states that the term “MOZZARELLA FRESCA” is nothing more than a descriptive indication that the cheese product labelled with such term: (a) meets all the requirements for MOZZARELLA as provided for by the *Food and Drugs Regulations* and the *Dairy Products Regulations*; and (b) has not undergone any ripening as provided by s. 70(4) of the *Dairy Products Regulations*. She further states that from her numerous years of experience in the food industry in Canada and more specifically in the dairy industry, and also from the samples of packaging materials attached as Exhibit NB-1 to her solemn declaration, it is obvious to her that the expression “MOZZARELLA FRESCA” is widely recognized and used in Canada as descriptive of a particular variety of cheese, *i.e.* MOZZARELLA, a principle characteristic of which is that such varietal cheese is FRESH as understood from both a legal perspective, *i.e.* unripened as provided for by the *Dairy Products Regulations*, and from a layperson’s point of view, *i.e.* as having its original quality unimpaired, such as not being stale, sour or decayed. I am not prepared to accord weight to these latter statements of Ms. Baillie for the following reasons.

[26] First, I am of the opinion that Ms. Baillie cannot properly be qualified as an expert in this proceeding. While I do not question Ms. Baillie’s professional experience and integrity, it seems to me that an expert qualification necessarily includes independence from the parties on the outcome of the case [see *Black Entertainment Television, Inc. v. CTV Limited* (2008), 66 C.P.R. (4th) 212 (T.M.O.B.)]. Second, the issue of descriptiveness of the Mark involves questions of fact and law to be determined by the Registrar.

[27] That said, I find the remaining portions of Ms. Baillie’s solemn declaration summarized above admissible as they essentially consist of uncontested statements of facts (as opposed to statements of opinion) corroborated by pieces of Federal legislation or regulations, dictionary definitions or sample packaging materials. I further note that the Applicant has not objected *per se* to the entirety of Ms. Baillie’s written testimony but simply submitted that “[r]educd weight

must be given to this evidence as it was not produced by an independent third party, but was produced by the Opponent in support of its own position” [my emphasis].

The Applicant’s evidence – The affidavit of Miranda Cole

[28] The purpose of Ms. Cole’s affidavit is merely to attach pages from English and French dictionaries to demonstrate that FRESCA is not a term in the English or French languages.

Analysis of the grounds of opposition

Section 12(1)(c) ground of opposition

[29] Transposing the comments of former Board Member Metcalfe in *Canadian Bankers Association v. Northwest Bancorporation* (1979), 50 C.P.R. (2d) 113 (T.M.O.B.) to the instant case, the issue to be determined is whether the words MOZZARELLA FRESCA, which constitute the whole of the Mark, are in fact the name in any language of the wares in association with which the Applicant intends to use the Mark. If it is found that MOZZARELLA FRESCA is the name of the wares, it will follow that the Mark is not registrable in view of the provisions of s. 12(1)(c) of the Act.

[30] As pointed out in *Canadian Bankers Association*, s. 12(1)(c) of the Act does not require that the trade-mark be primarily the name in any language of any of the wares in association with which the mark is used or proposed to be used. The provisions of s. 12(1)(c) apply if the mark to be registered is simply the name in any language of the wares in connection with which it is used or proposed to be used. As further pointed out by former Board Chairman Partington in *Jordan & Ste-Michelle Cellars Ltd. v. Andres Wines Ltd.* (1986), 11 C.P.R. (3d) 252 (T.M.O.B.), “there is no limitation in s. 12(1)(c) of the [Act] which would limit the name in any language to the name as would be recognized throughout a country or universally as the name of the wares in a particular language”.

[31] The material date that applies to this ground of opposition is the date of my decision [see *Park Avenue Furniture Corp. v. Wickes/Simmons Bedding Ltd.* (1991), 37 C.P.R. (3d) 413

(F.C.A.)].

[32] The Opponent relies upon the solemn declaration of Ms. Baillie and, in particular, Exhibit NB-2 discussed above, which consists of copy of definitions of the terms MOZZARELLA and FRESH, as well as the translation of the Italian word FRESCA in English and French from various dictionaries.

[33] As per these definitions, and as indirectly acknowledged by the Applicant itself in its application, the Mark is a straightforward translation of the designation FRESH MOZZARELLA (or the French equivalent MOZZARELLA FRAÎCHE).

[34] As underlined above, a principal characteristic of MOZZARELLA is that this varietal cheese has not undergone any ripening. As further underlined above, pursuant to s. 70(4) of the *Dairy Products Regulations*, its principal ripening characteristic may be identified on the label either as “fresh” (or the French equivalent “frais”) or “unripened”.

[35] The Applicant submits in its written argument that “[t]he Opponent has not filed any evidence to show that MOZZARELLA FRESCA, when considered as a whole, is the name of the wares. As the term MOZZARELLA FRESCA is not the name of the wares claimed in the application, this ground of opposition should be dismissed”. These brief submissions of the Applicant are totally contradicted by the evidence introduced through Ms. Baillie’s solemn declaration. Not only do they fail to address the above-mentioned dictionary definitions and regulations, they also fail to take into account the specimens of packaging materials used by a third party cheese maker in Canada attached as Exhibit NB-1 to Ms. Baillie’s solemn declaration.

[36] In view of the above, I conclude that the Applicant has failed to establish, on a balance of probabilities, that the Mark is not the name of the wares in any language. Accordingly, the ground of opposition based on s. 12(1)(c) of the Act succeeds.

Remaining grounds of opposition

[37] As I have already found in favour of the Opponent, I do not consider it necessary to address the remaining grounds of opposition. That said, I would have likely dismissed the second ground of opposition on the basis that the Opponent has failed to satisfy its initial evidentiary burden to show that the Mark, which includes the *Italian* word FRESCA, is either clearly descriptive or deceptively misdescriptive of the character or quality of the wares in the *English or French* language pursuant to s. 12(1)(b) of the Act. Likewise, I would have likely dismissed the fourth ground of opposition on the basis that the Opponent has failed to satisfy its initial evidentiary burden to show that the Mark *per se* as opposed to the corresponding English designation FRESH MOZZARELLA has, by ordinary and bona fide commercial usage become recognized in Canada as designating a kind or quality of cheese. I would have also likely dismissed both prongs of the first ground of opposition on the basis that the Opponent has failed to satisfy its initial evidentiary burden in respect thereof. More particularly, concerning the first prong of the s. 30 ground, I would have likely found that the Mark *per se* does not offend the Federal legislation and regulations mentioned above concerning the labelling of food and mozzarella cheese in particular. However, I would have likely accepted the last ground of opposition based upon non-distinctiveness of the Mark on the basis that the Mark, being the name of the wares in Italian, cannot function to distinguish the Applicant's wares from those of others.

Disposition

[38] In view of the foregoing and pursuant to the authority delegated to me under s. 63(3) of the Act, I refuse the application pursuant to s. 38(8) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office