



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

Citation: 2015 TMOB 27
Date of Decision: 2015-02-11

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Cassels Brock & Blackwell LLP against
registration No. TMA595,097 for the trade-mark SWEET
CREATIONS in the name of Sweet Creations Inc.**

[1] At the request of Cassels Brock & Blackwell LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 10, 2012 to Rosis's Deli-Café Inc., the registered owner at that time of registration No. TMA595,097 for the trade-mark SWEET CREATIONS (the Mark).

[2] The Mark is registered for use in association with the following goods: bakery goods, namely cookies and pies; chocolates.

[3] The notice required the registered owner to show that the Mark was in use in Canada, in association with each of the goods specified in the registration, at any time between December 10, 2009 and December 10, 2012. If the Mark had not been so used, the registered owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The relevant definition of "use" in association with goods is set out in section 4(1) of the Act:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is

marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] As discussed below, the registration currently stands in the name of Sweet Creations Inc. (the Owner).

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Leo Giannantonio, President of the Owner, affirmed on May 10, 2013 in Woodbridge, Ontario. Both parties filed written representations and were represented at an oral hearing.

Preliminary Issue

[8] In his affidavit, Mr. Giannantonio attests that the Owner was incorporated in 1989 under the name Rosis’s Deli-Café Inc., but has been conducting business under the trade name Sweet Creations since at least April 1993. Mr. Giannantonio states that the Owner filed an application to register the Mark in 2000. However, he explains that the application was erroneously filed in the name of “Rosis’s Deli-Café Inc.,” an error that was not known to the Owner at the time of filing. The registration was subsequently issued in the name of Rosis’s Deli-Café Inc.

[9] Mr. Giannantonio further attests that after the issuance of the registration, but before the Owner became aware of the error on the registration, the Owner changed its name to Sweet Creations Inc. He provides, at Exhibit A to his affidavit, a copy of the corresponding Articles of Amendment filed with the Ontario Ministry of Government Services.

[10] Mr. Giannantonio explains that it was not until March 2013, after the issuance of the section 45 notice, that the Owner became aware of the error in its name listed on the registration. Upon learning of the error, the Owner instructed its trade-mark agent to take steps to correct the error and to register the subsequent change of name with the Registrar. I note that the correction and the change of name to Sweet Creations Inc. were recorded by the Registrar on June 19, 2013.

Copies of the documents filed with the Registrar are provided at Exhibit B to Mr. Giannantonio's affidavit.

[11] Despite the foregoing, the Requesting Party submits that the Mark does not serve as a trade-mark within the meaning of section 2 of the Act. In this respect, it argues that the actual entity using the Mark during the relevant period was not the registered owner on the Register during the relevant period, being "Rosis's Deli Café Inc".

[12] However, as the Owner submits, section 41(1)(a) of the Act allows the Registrar to amend the Register to correct any error or enter any change in the name of the registered owner. In his affidavit, Mr. Giannantonio sufficiently explains the circumstances surrounding the initial erroneous identification in the registration. He further explains in detail the history of the Owner, the adoption of its trade name Sweet Creations and the Owner's eventual legal name change to Sweet Creations Inc.

[13] In any event, section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trade-mark [*United Grain Growers v Lang Michener* (2001), 12 CPR (4th) 89 (FCA)]. As noted by the Federal Court of Appeal in *Ridout & Maybee LLP v Omega SA* (2005), 43 CPR (4th) 18 (FCA), the validity of the registration is not in dispute in section 45 proceedings.

[14] In view of the foregoing, I am satisfied that the affidavit of Mr. Giannantonio is evidence furnished by the registered owner pursuant to section 45 of the Act.

Evidence of Use of the Mark

[15] In his affidavit, Mr. Giannantonio attests that the Owner sells its bakery goods, including cookies and pies, to several retailers located throughout Ontario and Quebec, who in turn sell them to consumers. He explains that the Owner's cookies and pies are sold with the Mark appearing on labels affixed to the packaging of the goods.

[16] At Exhibits C and D to his affidavit, Mr. Giannantonio attaches photographs of what he attests are representative examples of the Owner's cookies and pies in packaging as they appear when they are sold to consumers. Specifically, the Exhibit C photograph depicts bakery goods

packaged in a box with a label that identifies the goods as “Chocolate Palm Leaf Pastries”. The photograph at Exhibit D depicts a similar label on packaging containing what is identified as “Apple Cake”. The Mark appears on the packaging as shown below:



[17] As noted by the Requesting Party, the Owner’s goods are identified on its packaging as “Palm Leaf Pastries” instead of cookies, and as “cakes” instead of pies. As discussed further below, Mr. Giannantonio explains in his affidavit that the Owner has elected to use these terms in the marketing of its cookies and pies. Notwithstanding the terms used on the packaging, Mr. Giannantonio’s descriptions of the goods are consistent with what are commonly known as “cookies” and “pies”. In this respect, Mr. Giannantonio states that the Owner’s cookies consist of a puff pastry core that is firm and crisp on the outside, and is partially coated in chocolate. He also attests that the Owner makes several different types of pies having different types of filling, but all consist of a pastry shell and a filling of some sort.

[18] With respect to sales, Mr. Giannantonio attests that, during the relevant period, the Owner sold in excess of \$4.7 million worth of its bakery goods bearing the Mark, “including cookies and pies”. Specifically, Mr. Giannantonio states that the Owner sold in excess of \$1.5 million, \$1.7 million and \$1.5 million in 2010, 2011 and 2012 respectively.

[19] In support, Mr. Giannantonio attaches, at Exhibit E to his affidavit, three sample invoices that were issued by the Owner to retailers at the time the purchased cookies and pies were shipped. The Mark, as shown above, appears in the top left corner of the invoices.

[20] The invoices are all dated within the relevant period, namely August 10, 2010, October 26, 2011 and November 9, 2012. Mr. Giannantonio explains that the names and addresses of the Owner’s retailers, as well as the pricing information of the products sold, have been redacted to protect the privacy of the Owner and its customers. The products sold are identified in the “Description” column of each invoice, with the quantities sold listed under the “Shipped” column. Together, the invoices show 147 “palm leaves” products and 12 “cake” products sold.

Mr. Giannantonio confirms that the “palm leaves” products refer to the Owner’s cookies; this corresponds with the “Chocolate Palm Leaf Pastries” depicted at Exhibit C. He also states that the various “cake” products identified on the invoices refer to the Owner’s pies; again, this corresponds with the “Apple Cake” depicted at Exhibit D.

Use of Present Tense in the Affidavit

[21] At the oral hearing, the Requesting Party submitted that, since Mr. Giannantonio’s statements regarding the manner in which the Mark is affixed on the packaging and regarding the issuance of the invoices are in the present tense, such statements cannot purport to reflect the manner in which the Mark was used during the relevant period. As such, the Requesting Party submitted that there is no evidence of use of the Mark during the relevant period.

[22] Although Mr. Giannantonio could have been more precise in his affidavit, use of the present tense must be considered with the evidence as a whole [see *Smart & Biggar v Anthony Tesselaar Plants Pty Ltd*, 2010 CarswellNat 3520 (TMOB); *WRH Marketing AG v Conros Corporation*, 2010 CarswellNat 1908 (TMOB)]. Given that Mr. Giannantonio specifically identifies instances of sales within the relevant period, read in context, I find nothing in the evidence inconsistent with the interpretation that Mr. Giannantonio’s recitation of the Owner’s normal course of trade is applicable to the goods during the relevant period. As such, it is reasonable to conclude that the present tense statements are with respect to the Owner’s normal course of trade generally, including during the relevant period.

Use of the Mark as Registered

[23] In its written representations, the Requesting Party submits that the Mark is not used as registered since the evidence shows a composite mark with the words in a different font and with a rolling pin design (as shown above). The Requesting Party further submits that the additional material is not simply descriptive, and the resultant trade-mark would be perceived as a different trade-mark to an unaware purchaser.

[24] Generally, use of a registered word mark can be supported by the use of a composite mark featuring the word mark and other elements [see *Nightingale Interloc Ltd v Prodesign*

(1984), 2 CPR (3d) 535 (TMOB)]. Further, as stated in *Stikeman, Elliott v Wm Wrigley Jr Co* (2001), 14 CPR (4th) 393 (TMOB) at 395:

As clearly pointed out by the registrant, the trade-mark as registered is a word mark. No particular design or font size was registered. Consequently, in the case of a word mark, use of the trade-mark word or words in any stylized form and in any colour can be considered as use of the registered mark.

[25] I thus agree with the Owner's submission that since the Mark is registered as a word mark, display of the words SWEET CREATIONS in any stylized form and in any colour can be considered as use of the Mark as registered.

[26] With regards to the background rolling pin design, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canda Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I find that the dominant feature of the Mark as registered, namely the words SWEET CREATIONS, has been maintained and the addition of the background design element is a minor deviation.

[27] In view of the foregoing, I find that the trade-mark as displayed on the exhibited packaging and invoices constitutes display of the Mark.

Use in Association with Cookies and Pies

[28] With respect to use of the Mark in association with the registered goods, cookies and pies, the Requesting Party submits that Mr. Giannantonio's affidavit "states but does not show or prove that Palm Leaf Pastries are not really pastries but rather cookies, and that Apple Cake is really some how a 'pie'."

[29] I note, however, that Mr. Giannantonio provides explanations on the use of the terms "palm leaf pastries" and "cake" in reference to the registered goods. In particular, at paragraph 11 of his affidavit, he states that:

... cookies of the sort shown in Exhibit C are actually known by several different names in different cultures, including "Palm Leaves", "Palm Leaf Pastries", "Butterfly Cookies", "Pig Ears", "Elephant Ears" and "Bakar Jani". However, many consumers ... refer to the

product as “cookies”. Although we have elected to use the term “Palm Leaf Pastries” in our marketing of this product, we generally refer to the product as a “cookie” and ... most other producers of baked goods also refer to products such as those depicted in Exhibit C as “cookies”.

[30] Similarly, Mr. Giannantonio explains that pies of the sort shown at Exhibit D are known by various names in various cultures, such as “pies”, “cakes”, “crostata” and “tarts”. He attests that the Owner “generally refers to such products as ‘pies’, even though we have chosen to use the term ‘cake’ in the marketing of the product ... and most other producers of baked goods also refer to products such as those depicted in Exhibit D as ‘pies’.”

[31] Consequently, while the Owner’s packaging identifies the goods as “pastries” and “cake”, I find it appropriate to defer to the affiant’s expertise in the industry. Given Mr. Giannantonio’s sworn statements indicating that these terms correspond to the registered goods, I am satisfied that there is no reason to conclude differently.

[32] With respect to evidence of sales during the relevant period, the Requesting Party submits that Mr. Giannantonio’s statement regarding sales of \$4.7 million of the Owner’s bakery goods merely reflects a global amount that likely includes bakery goods beyond the registered goods, cookies and pies. As well, since the pricing information has been redacted from the invoices furnished at Exhibit E, the Requesting Party submits that such evidence of sales is ambiguous at best.

[33] While Mr. Giannantonio’s statement of millions of sales is with respect to “bakery goods” generally, and not just the registered goods more specifically, I note that he does specify at paragraph 17 of his affidavit at least three particular sales of cookies and pies that occurred during the relevant period. These sales are supported by the exhibited invoices, which Mr. Giannantonio attests are representative examples of the Owner’s sale of cookies and pies “that have occurred continuously since at least April, 1993”. Consequently, I find it reasonable to infer that at least some portion of the \$4.7 million in sales were attributable to sales of these registered goods.

[34] In view of the foregoing, I accept that the Owner has demonstrated use of the Mark in association with “bakery goods, namely cookies and pies” pursuant to sections 4 and 45 of the Act.

Use in Association with Chocolates

[35] At the oral hearing, the Owner conceded that the evidence does not show use of the Mark in association with “chocolates” and, further, that there was no evidence of special circumstances excusing the absence of use of the Mark in association with such goods. The registration will be amended accordingly.

Disposition

[36] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended in compliance with the provisions of section 45 of the Act to delete “chocolates” from the statement of goods.

[37] The amended statement of goods will read as follows: bakery goods, namely cookies and pies.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office