



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

Citation: 2010 TMOB 217
Date of Decision: 2010-12-10

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Convenience Food Industries (Private)
Limited against registration No. TMA323,215 for the
trade-mark LAZIZA & Design in the name of Clic
International Inc.**

[1] On December 5, 2008, at the request of Convenience Food Industries (Private) Limited (the requesting party), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T -13 (the Act) to Clic International Inc. (Clic), the registered owner of the trade-mark LAZIZA & Design (the Mark) as illustrated hereinafter:



[2] The Mark is registered for use in association with canned fava beans (the Wares).

[3] Such notice requires the Registrant to show whether the Mark has been used in Canada in association with the Wares at any time within the three-year period immediately preceding the date of the notice, and if not, the date when it was last in use and the reason for the absence of use since that date. The relevant period in this case is any time from December 5, 2005 to December 5, 2008 (the relevant period).

[4] In response to the notice, the affidavit of Mr. Antoine Kassas has been furnished together with exhibits A to C. The parties filed written submissions and were represented at an oral hearing.

[5] Section 45 proceedings are simple, expeditious and serve the purpose of clearing the register of “deadwood”; as such, the threshold test is quite low [see *Smith Lyons v. Vertag Investments Ltd.* (2000), 7 C.P.R. (4th) 557].

[6] A simple allegation of use of the Mark is not sufficient to evidence its use in association with the Wares within the meaning of s. 4(1) of the Act. There is no need for evidentiary overkill. However any ambiguity in the evidence filed shall be interpreted against the owner of the Mark [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980) 53 C.P.R. (4th) 62].

[7] I therefore have to determine if I am satisfied that the evidence to be described hereinafter enables me to conclude that the Mark has been used in association with the Wares in Canada during the relevant period.

[8] Mr. Kassas has been Clic’s Executive Vice-President for about six years as of the date of execution of his affidavit. He describes the different business activities of Clic, which include the operation of a canning plant and a manufacturing plant in St-Leonard, Quebec for specialized products.

[9] He states that Clic is the registered owner of the Mark and filed as Exhibit A an extract of the Canadian Trade-marks Database. Mr. Kassas alleges that Clic has continuously used the Mark in Canada during the relevant period in association with the Wares. To substantiate such allegation he has filed as exhibit B samples of the type of labels that were affixed to the cans sold by Clic in Canada during the relevant period.

[10] He admits that the trade-mark depicted on the labels filed has certain modifications that he qualifies as “slight” and contends that the trade-mark used does not differ substantially from the Mark. For sake of clarity I reproduce hereinafter a sample label filed by Mr. Kassas:



(modified version of the Mark)

[11] I also reproduce paragraph 7 of his affidavit:

Attached to my Affidavit and marked as Exhibit “B” are representative samples of labels which were affixed to cans of Clic’s fava beans which were sold in Canada in association with the [Mark] during the period between December 5, 2005 and December 5, 2008 and which continue to be sold today. Although slight modifications to the [Mark] have been made, the [Mark] does not differ substantially from that which is the subject of Canadian Trade-mark Registration No. TMA323,215. Clic’s customers still recognize the [Mark] as being Clic and associate the [Mark] with Clic’s products.

[12] Finally, he filed samples of invoices issued during the relevant period to substantiate his allegation that Clic sold the Wares bearing the modified version of the Mark during the relevant period.

[13] There is no dispute between the parties that there is evidence of use of the modified version of the Mark in association with the Wares in Canada during the relevant period. The only outstanding issue that remains to be decided is whether the use of the modified version of the Mark constitutes use of the Mark. If the answer is negative, then I would have to expunge the registration of the Mark for failure to prove use of the Mark during the relevant period.

[14] Both parties have cited *Canada (Registrar of Trade-marks) v. Cie Internatioanle pour l’informatique CII Honeywell Bull SA*, (1985) 4 C.P.R. (3d) 523 (FCA) and have commented *Promafil Canada Ltee v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59(FCA). It is important to quote the pertinent excerpts of each of these cases.

[15] In *CII Honeywell* Mr. Justice Pratte defined in the following words the test to determine if a deviation of a trade-mark could still be considered as use of the registered trade-mark:

The problem to be resolved is not whether CII deceived the public as to the origin of its goods. It clearly did not. The real and only question is whether, by identifying its goods as it did, CII made use of its trade mark "Bull". That question must be answered in the negative unless the mark was used in such a way that the mark did not lose its identify and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used. The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[16] In *Promafil*, Mr. Justice MacGuigan, after quoting the above extract made the following comment:

20 Pratte J.A. expressed the same test in two ways: in a theoretical way, as to the maintenance of identity and recognisability in spite of the use of different forms of the mark; in a practical way, by estimating the likely confusion of an unaware purchaser. The practical test must clearly be one of probability, because, as a general rule, one could not lay down such a test in terms requiring certainty of conclusion.

[17] I also wish to refer to the following quote from Mr. Justice Maclean in *Honey Dew, Limited v. Rudd*, [1929] Ex.C.R. 83:

[...] The practice of departing from the precise form of a trade-mark as registered is objectionable, and is very dangerous to the registrant.

[18] In our case we are dealing with a registered trade-mark that comprises a word portion and a design portion. The trade-mark used by Clic has also those general characteristics. Both parties agree that the word portion in both cases is a dominant feature. The disagreement is with respect to the design portion.

[19] The requesting party argues that the font of the letters in both cases is a dominant feature as well as the design of the palm trees in a circle, in so far the Mark is concerned, while the dominant features of the design portion of the modified version of the Mark are: the

presence of Arabic characters in an oval portion, a pattern at the top of the label and a similar one across the label underneath the word portion of the trade-mark.

[20] Therefore the requesting party pleads that, not only the modified version of the Mark does not have one of the features of the Mark, being the palm trees in a circle, but it has additional features of its own. The Mark would have lost its identity through these modifications.

[21] Clic asserts that the only dominant feature of the Mark is the word portion. It is a foreign language word and what will be remembered by a consumer is this unique word, part of the Mark as a whole. As long as the trade-mark used does contain that word, there could not be any likelihood of confusion in the minds of consumers as to the source of the wares sold in association with that trade-mark.

[22] Each party filed case law to support their contentions by trying to draw an analogy between the cases cited and the present situation. The requesting party relied heavily on the case of *Bierrsdorf AG v. Becton, Dickinson & Co* (1992), 44 C.P.R. (3d) 151 wherein the mark registered consisted of the letters “B-D” incorporated in a maple-leaf design. The trade-mark used was the letters B-D in a box design. The Registrar concluded that the trade-mark used was not the one registered as one of the dominant features, the maple leaf design, was missing and the registration was expunged.

[23] Clic considers the present situation to be similar to *Alibi Roadhouse Inc. v. Grandma Lee's International Holdings Ltd.* (1997), 76 C.P.R. (3d) 327 (FCTD). It was a proceeding under s. 57 of the Act wherein the moving party was seeking the expungement of the registered trade-mark ALIBI BAR & GRILL and Design. In order to argue that such trade-mark was in use since an earlier date of use of the moving party's trade-mark, the registered owner of the trade-mark under attack relied on use of a modified version of its registered trade-mark ALIBI which did not include the words BAR and GRILL nor a diamond design covered by its registration. In that case the court noticed that the owner of the registered trade-mark disclaimed the exclusive use of the words “BAR” and “GRILL”.

[24] Although the Court concluded that the modified version of the trade-mark ALIBI BAR & GRILL and Design constituted use of the registered trade-mark, Mr. Justice Teitelbaum made the following statement after reviewing similar case law that has been cited by the parties in our case, including *Beiersdorf supra*:

The question of whether all the elements of a particular trade-mark are prominent and must be present to permit a finding of use is a question of fact to be determined on a case-by-case basis.

[25] Applying the principles enunciated above, I conclude that Clic has not shown use of the Mark during the relevant period. I agree with the requesting party that the palm trees and circle design is one of the essential features of the Mark. It is a distinctive element of the Mark. The absence of that feature changes the identity of the Mark. If Clic wanted to protect its rights in the use of the word LAZIZA, it could have simply filed an application to register as a trade-mark that word alone. As stated by the Registrar in *Stikeman, Elliott v. Wm. Wrigley Jr. Co.* (2001), 14 C.P.R. (4th) 393:

[...] 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.

[26] Had Clic registered the word mark LAZIZA, there is no doubt in my mind that use of the Mark or its modified version would have constituted use of such trade-mark. However in this case, Clic decided to obtain protection not only in the word LAZIZA but in combination with a palm trees design.

[27] The modified version of the Mark, as illustrated above, does not contain the palm trees design and has features not found in the Mark, creating a different look. The modified version of the Mark does contain variations and additions that are far from being “slight” or “minor” in nature. The Mark has lost its identity through the use of the modified version. Therefore an unaware customer would likely to infer that the Wares sold in association with the modified version of the Mark do not have the same origin. There is no reason in this case to maintain Clic’s exclusive rights in a trade-mark composed of the word LAZIZA and a palm trees design that is no longer in use.

Disposition

[28] Pursuant to the authority delegated to me under s. 63(3) of the Act, registration TMA323,215 for the Mark will be expunged from the register in compliance with the provisions of s. 45 of the Act.

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