



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

Citation: 2015 TMOB 102
Date of Decision: 2015-06-05

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Stikeman Elliott LLP against registration
No. TMA766,366 for the trade-mark MOZZA-
BLOCKETTO in the name of Parmx Cheese Co. Ltd.**

[1] At the request of Stikeman Elliott LLP, the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on June 10, 2013, to Parmx Cheese Co. Ltd. (the Owner), the registered owner of registration No. TMA766,366 for the trade-mark MOZZA-BLOCKETTO (the Mark).

[2] The Mark is registered for use in association with the goods “processed and unprocessed cheese, milk products, non standardised cheese and dairy products”.

[3] The Mark is also registered for use in association with the services “custom cheese making, processing cheese, processing cheese for others, private labelling and packaging of cheese, repackaging and labelling of cheese, consulting services in the area of cheese processing and manufacturing”.

[4] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the goods and services specified in the registration 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 such use since that date. In this case, the relevant period for showing use is between June 10, 2010 and June 10, 2013.

[5] The relevant definitions of “use” with respect to goods and services are set out in section 4 of the Act as follows:

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.

4(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc*, (1980) 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the goods and services specified in the registration during the relevant period.

[7] In response to the Registrar’s notice, the Owner filed the affidavit of Luisa Aiello, manager of the Owner, sworn on January 14, 2014. Neither party furnished written representations; an oral hearing was not held.

The Owner’s Evidence

[8] In her affidavit, Ms. Aiello asserts that, during the relevant period, the Owner used the Mark in association with all of the registered goods as well as the registered services “custom cheese making, processing cheese, processing cheese for others”. She states that the remaining services, “private labelling and packaging of cheese, repackaging and labelling of cheese, consulting services in the area of cheese processing and manufacturing” can be deleted from the registration. As the Owner furnished no evidence of use of the Mark in association with such services, the registration will be amended accordingly.

[9] Ms. Aiello explains that the Owner is in the dairy product business and is subject to the requirements of the Canadian Food Inspection Agency pursuant to the *Canada Agricultural Products Act* and the *Dairy Products Regulations*. Attached as Exhibits 2 and 3 are documents relating to the Owner's registration with the Agency and the Owner's status as a "Dairy Processing Establishment" pursuant to the aforementioned *Dairy Products Regulations*.

[10] Ms. Aiello states that the Owner produces different types of cheeses under the Mark. She attests that "processed cheese", such as a pizza topping, undergoes a certain process and formula whereby other types of cheeses and dairy ingredients are mixed together. She also attests that the Owner produces "unprocessed cheese", whereby the cheese is produced in raw form. She explains that, depending on the processing method and ingredients, the cheese is categorized as a "dairy product" or as a "non standardised [cheese] product". She further states that all of these products are "milk products".

[11] With respect to sales in Canada during the relevant period, Ms. Aiello provides a breakdown by year for the sale of cheese under the Mark, amounting to approximately \$700,000 over the course of the relevant period.

[12] In support, attached to her affidavit are the following exhibits:

- Exhibit 4 consists of a label that Ms. Aiello attests is representative of the labels that were used by the Owner during the relevant period. The label identifies the product as a "dairy product" that is "full fat" with ingredients that include mozzarella, cheese and milk. The Mark is displayed prominently on the label.
- Exhibit 5 is a photograph of blocks of cheese bearing the Exhibit 4 label. Ms. Aiello attests that the photos show how the Mark appeared on the Owner's cheese products in Canada during the relevant period.
- Exhibit 6 is a photograph of a roll of labels and packaging that Ms. Aiello attests is representative of the labels and packaging used by the Owner during the relevant period for its MOZZA-BLOCKETTO cheese products. The labels are similar to the Exhibit 4 label, but are for a "part skim" dairy cheese product.

- Exhibit 7 consists of several price lists and dozens of invoices that Ms. Aiello attests are representative of those sent to customers during the relevant period. She explains that price lists are customized for each of the Owner's customers and identifies cheese sold under the Mark. She further attests that the MOZZA-BLOCKETTO cheeses listed on the invoices with various code and lot numbers represent a variety of cheeses with different amounts of moisture, weight and fat content. I note that the invoices are addressed to various Canadian customers and are all dated within the relevant period.

[13] With respect to the services, "custom cheese making, processing cheese, processing cheese for others", Ms. Aiello attests that the Owner's cheeses are custom made for all its customers and are available "in all forms, i.e. grated, crumbled, chunked and wedged." Attached as Exhibit 8 to the affidavit are pages from the Owner's website that Ms. Aiello attests were available during the relevant period and which advertise the Owner's cheese making and processing services. As evidence of performance of such services, Ms. Aiello refers to the aforementioned amounts for the sale of cheese during the relevant period.

Analysis

[14] In view of Ms. Aiello's statements regarding the various types of cheese made and sold by the Owner along with the accompanying evidence of sales in Canada during the relevant period, I am satisfied that there is ample evidence of use of the Mark in association with "processed and unprocessed cheese" and "non standardised cheese products".

[15] Similarly, with respect to the services, I am satisfied that the aforementioned evidence is sufficient to show use of the Mark in association with "custom cheese making" and "processing cheese for others". In this respect, it has been held that the use of a trade-mark on a finished product can serve to support use in association with services ancillary to such goods [see *Lidl Stiftung & Co KG v Thornbury Grandview Farms Ltd* (2005), 48 CPR (4th) 147 at para 17 (TMOB)]. Indeed, the Federal Court of Appeal has held that nothing in section 4(2) restricts services to those that are independently offered to the public or that are not ancillary or connected with goods [*Gesco Industries Inc v Sim & McBurney* (2000), 9 CPR (4th) 480 at 484]. Accordingly, I am satisfied that the evidence of sales of various custom-made MOZZA-

BLOCKETTO cheeses constitutes evidence of use of the Mark in association with the services “custom cheese making” and “processing cheese for others”.

[16] However, in the absence of representations, it is not clear that the registered service “processing cheese” constitutes a service distinct from “processing cheese for others”. There is nothing in the evidence to indicate that “processing cheese” somehow differs from the service “processing cheese for others”, for which there is evidence before me; the registration will be amended accordingly.

[17] Finally, with respect to the registered goods “milk products” and “dairy products”, it is clear from the evidence that the Owner does not produce or sell dairy or milk products that are not types of cheese. Although Ms. Aiello attests that some of the Owner’s cheese products can be considered “dairy products” and all of its products are “milk products”, the evidence furnished is with respect to various types of cheese only. However, the registration specifically includes different types of cheese. While I am satisfied that some of the invoices cover “processed cheese” other than what Ms. Aiello defines as “non standardised cheese products”, I consider the evidence insufficient to encompass the broader terms “milk products” and “dairy products”. In other words, none of the evidence is for “milk products” and “dairy products” other than “processed and unprocessed cheese”.

[18] Given that the Owner made a distinction in its statement of goods, the Owner is required to provide evidence of use of the Mark for each of these goods [in this respect, see *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA), *Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD) and *Fogler, Rubinoff LLP v Canada Safeway Ltd*, 2013 TMOB 227 at para 10]. Similar to these cases, for the Owner to maintain its registration for the broader categories of goods “milk products” and “dairy products”, it had to show use in association with such goods otherwise than by reference to “processed cheese”, “unprocessed cheese” or “non standardised cheese products”.

[19] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark only in association with the services “custom cheese making ... processing cheese for others” and in association with the goods “processed and unprocessed cheese, ... non standardised cheese ... products” within the meaning of sections 4 and 45 of the Act.

Disposition

[20] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete “milk products ... and dairy” from the statement of goods and “processing cheese ... private labelling and packaging of cheese, repackaging and labelling of cheese, consulting services in the area of cheese processing and manufacturing” from the statement of services.

[21] The amended statement of goods will be: “processed and unprocessed cheese, non standardised cheese products”.

[22] The amended statement of services will be: “custom cheese making, processing cheese for others”.

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