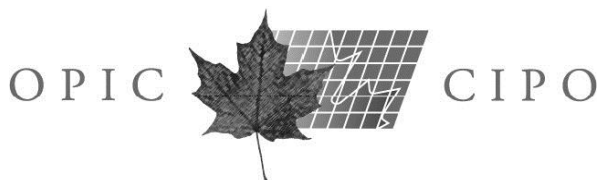


## TRADUCTION/TRANSLATION



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

**Citation: 2010 TMOB 143**  
**Date of Decision: 2010-08-30**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Smart & Biggar against registration  
No. TMA299,636 for the trade-mark RIVIERA & design  
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 & design trade-mark:



(the Mark)

the subject of registration certificate number TMA299,636, 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 (design) with a slight variation 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 at least be amended accordingly.

[7] Finally, I must determine whether the use of the RIVIERA & Design mark, illustrated below, constitutes use of the Mark:



(RIVIERA & Design)

[8] Mr. Chalifoux attached to his affidavit samples of packaging for Products bearing the RIVIERA & Design 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.

[9] He specified that the Registrant had always manufactured its own Products bearing the RIVIERA & Design 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 RIVIERA & Design mark for the years 2006, 2007 and 2008, which exceeded \$17 million annually.

[10] He filed advertising material used in [TRANSLATION] “recent years” bearing the RIVIERA & Design 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.

[11] 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 RIVIERA & Design mark.

[12] 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 RIVIERA & Design mark (through filed packaging bearing the RIVIERA & Design mark). However, does use of the RIVIERA & Design mark constitute use of the Mark?

[13] It goes without saying that each case turns on its own facts when it is a matter of determining whether the changes to a mixed mark have caused the registered mark to lose its distinctiveness. One of the leading cases on this issue is *Promafil Canada Ltée. v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59, in which Mr. Justice MacGuigan of the Federal Court of Appeal set out the following principles:

Obviously, with every variation the owner of the trademark is playing with fire. In the words of Maclean J., "the practice of departing from the precise form of a trade-mark as registered . . . is very dangerous to the registrant." But cautious variations can be made without adverse consequences, if the same dominant features are maintained and the differences are so unimportant as not to mislead an unaware purchaser.

. . .

The law must take account of economic and technical realities. The law of trademarks does not require the maintaining of absolute identity of marks in order to avoid abandonment, nor does it look to miniscule differences to catch out a registered trademark owner acting in good faith and in response to fashion and other trends. It demands only such identity as maintains recognizability and avoids confusion on the part of unaware purchasers. (Emphasis added.)

[14] Based on this passage, I conclude that the RIVIERA & Design mark must maintain the dominant features of the Mark and that the differences must be so unimportant as not to mislead an unaware purchaser.

[15] Both of the marks at issue contain the word portion RIVIERA. The mere fact that the RIVIERA & Design mark includes the word RIVIERA does not necessarily mean that its use constitutes use of the Mark. The RIVIERA & Design mark must give the same overall impression as the Mark. If the Registrant has gone to the trouble of registering the Mark, it was to secure protection for more than just the word portion.

[16] Apart from the word portion RIVIERA, the dominant features of the Mark to be considered are as follows:

the font used;

the relatively uniform thickness of the letters comprising the word RIVIERA, except for the first and last letters, which seem somewhat thicker than the others; and

the raised letters of the word RIVIERA appearing on a grey background that follows the letters' contours.

[17] Aside from the word RIVIERA, none of these characteristics appears in the RIVIERA & Design mark. That mark has its own distinctive features, such as the following:

a red background in the shape of an ellipse;

a stylized letter R with an extension that forms part of the letter A;

a sailboat in the upper portion of the ellipse; and

the phrase "Depuis • Since 1959".

[18] These elements, taken together and in combination with the word portion RIVIERA, give the RIVIERA & Design mark a separate identity. The Mark is no longer recognizable within the RIVIERA & Design mark. There are important differences between the two trade-marks: the absence of the Mark's graphic features from the RIVIERA & Design mark and the presence of the additional distinctive elements described above with respect to the latter mark.

[19] For these reasons, I am unable to conclude that the RIVIERA & Design mark constitutes a minor variation of the Mark. The changes made to the Mark are too extensive to allow me to conclude in the Registrant's favour. Applying the *Promafil* test described above, the RIVIERA & Design mark does not contain most of the dominant features of the Mark, and the changes made to the Mark are in no way unimportant. Therefore, I cannot find that the use of the RIVIERA & Design mark constitutes use of the Mark.

[20] Accordingly, I conclude that use of the Mark in Canada in association with the Wares by the Registrant during the Relevant Period has not been established.

[21] Pursuant to the authority delegated to me under s. 63(3) of the Act, registration No. TMA299,636 will be expunged in compliance with the provisions of s. 45 of the Act.

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

Certified true translation  
Francie Gow, BCL, LLB