



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

Citation: 2011 TMOB 197
Date of Decision: 2011-11-03

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Miller Thompson LLP against registration
No. TMA514,666 for the trade-mark MONT BLANC in
the name of Splendid Chocolates Ltd.**

[1] At the request of Miller Thompson LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on March 24, 2009, to Splendid Chocolates Ltd., the registered owner (the Registrant) of registration No. TMA514,666 for the trade-mark MONT BLANC (the Mark).

[2] The Mark is registered in association with “*chocolate confectionery*” (the Wares).

[3] 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 wares and/or services listed on 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 use since that date. In this case, the relevant period for showing use is any time between March 24, 2006 and March 24, 2009.

[4] The relevant definition of “use” in the present case is set out in s. 4(1) of the Act as follows:

4. (1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares 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 s. 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register. Assertions of use as a matter of law are insufficient to demonstrate use [see *Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194 (F.C.T.D.)]. A recipient of a s. 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to s. 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)].

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of Doug Liberman, together with Exhibits A and B. Both parties filed written submissions; however, an oral hearing was not conducted.

[7] In his affidavit, Mr. Liberman identifies himself as the Executive Vice President of the Registrant, having held this position since March 6, 2006. He explains that the Registrant has been a manufacturer of chocolate confectionery in Canada since 1976 and is involved in retail sales, private labels, and contract manufacturing.

[8] With respect to the Mark, Mr. Liberman states that the Registrant manufactures, packages, and distributes chocolate confectionery bearing the Mark in Canada, having used the Mark in association with the Wares in Canada since at least 1999. In support, he attaches as Exhibit A, a photograph of a representative sample of chocolate confectionery which has been sold in Canada during the Relevant Period. I note that the packaging includes the words MONT and BLANC interposed by a relatively substantial design consisting of the letter "M" (in the same size and style of font) placed inside a wreath.

[9] To support evidence of sales of the Wares in Canada during the relevant period, Mr. Liberman provides both an invoice dated within the Relevant Period (Exhibit B), as well as sales figures. The invoice shows the sale of 110 boxes of 60 units of chocolate bars and includes the following product description: *Mont Blanc Choc Bar 100g x 60*. Mr. Liberman clearly attests that this invoice accompanied the Wares when delivered to the customer, and is representative of the invoices that were sent to customers accompanying the delivery of the Wares at their time of sale during the relevant period.

[10] One of the arguments brought forth by the Requesting Party is that the trade-mark shown on the packaging in Exhibit A does not constitute use of the trade-mark as registered. It submits that the trade-mark shown on this packaging has been modified into a composite mark, so as to have become unrecognizable, having lost its identity. The Registrant, on the other hand, argues that the public would perceive the Mark as being used as a trade mark wherein the “M” and wreath design would be perceived as a separate trade-mark.

[11] While it is arguable if the packaging displays a mark that would constitute use of the trade-mark as registered, I need not make a determination on the matter. This is so, as I consider that there is evidence of use of the Mark on the invoice in Exhibit B. As previously indicated, the body of the invoice contains the product description “*Mont Blanc Choc Bar 100g x 60*”. In my view, the Mark would be discernable from the remaining matter, given that the remaining matter would be readily perceived as simply descriptive of the product [see *Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)]. Furthermore, as the affiant has provided a clear statement attesting to the fact that the invoice accompanied the wares at their time of transfer [see *Mantha & Associes/Associates v. Central Transport, Inc.* (1995), 64 C.P.R. (3d) 354 (F.C.A.), regarding statements of fact], the requisite notice of association would have been provided to the consumer [see *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471 (F.C.T.D.)]. Consequently, I accept that use of the Mark has been shown pursuant to s. 4 of the Act.

[12] Lastly, the Requesting Party also argues that as the Registrant has described its normal course of trade as including private label sales, the sale shown in the invoice of Exhibit B is

ambiguous as to whether it is a sale of the Registrant's own branded chocolate or whether it is a sale of goods manufactured by the Registrant for offer under another's brand. A private label sale, it submits, does not constitute trade-mark use by the Registrant; a private label brand is not owned by the manufacturer, but rather, it is owned by the entity that contracted the manufacturer to produce its goods under its own label. The Requesting Party argues that as the affidavit is susceptible to such an interpretation, it is the interpretation adverse to the interest of the Registrant that must be adopted [see *Aerosol Fillers, supra*].

[13] However, contrary to the Requesting Party's position, I do not see anything in the evidence to suggest that this must be a private label sale. In any event, s. 45 proceedings are limited in scope; the determination to be made is whether or not the Registrant is using the registered trade-mark within the meaning of sections 4 and 45 of the Act. Issues such as ownership, distinctiveness, etc., are not to be dealt with in s. 45 proceedings [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 at 293 (F.C.T.D.)]. In the present case, the Registrant has provided evidence of use of the Mark in association with the Wares in the manner prescribed by sections 4 and 45 of the Act; that is all that is required.

[14] In view of the above, I conclude that use has been shown of the Mark for the wares described as "*chocolate confectionery*". Consequently, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be maintained, in compliance with the provisions of s. 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

