



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

Citation: 2016 TMOB 96
Date of Decision: 2016-06-20

IN THE MATTER OF A SECTION 45 PROCEEDING

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l. **Requesting Party**
and
Erie Meat Products Limited **Registered Owner**
TMA371,952 for DELI-CLASSIC **Registration**

[1] At the request of Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l. (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 August 13, 2014 to Gaston Cardinal, the registered owner at that time of registration No. TMA371,952 for the trade-mark DELI-CLASSIC (the Mark).

[2] The Mark is registered for use in association with the following goods: “Food products, namely: smoked beef, and sausages; pork products, namely: ham.”

[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 goods 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 August 13, 2011 to August 13, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) 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.

[5] 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 section 45 proceedings is quite 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 specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[6] Subsequent to the issuance of the section 45 notice, the Registrar recorded a change in title of the registration to Erie Meat Products Limited (the Owner). This change in title is not at issue in this proceeding.

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Linda Malawi, Finance Manager of the Owner, sworn on November 6, 2014 in Mississauga, Ontario. Only the Owner filed written representations; an oral hearing was not requested.

The Owner's Evidence

[8] In her affidavit, Ms. Malawi attests that the Owner is a food company based in Mississauga, Ontario. She states that the Owner processes, produces and sells meat products, primarily at wholesale, to industrial customers, such as grocery stores, who in turn sell the products to consumers.

[9] Ms Malawi explains that such meat products include "a line of deli smoked beef, such as pastrami, Montreal smoked beef, corned beef and roast beef."

[10] In particular, Ms. Malawi attests that, during the relevant period, the Owner's meat products were individually wrapped in plastic packages bearing the Mark and distributed in boxes, which also bore the Mark, to customers in Canada. Based on her review of the Owner's records, Ms. Malawi states that sales of such goods reached nearly \$6,000,000 during the relevant period.

[11] In support, attached to Ms. Malawi's affidavit are the following exhibits:

- Exhibit C consists of four photographs depicting the packaged meat products "Pastrami Smoked Beef Round", "Montreal Old Style Smoked Beef Round", "Cooked Corned Beef Round" and "Seasoned Cooked Roast Beef Round". Ms. Malawi confirms that the packaging displayed in the photographs is representative of such beef products sold during the relevant period. In each case, the Mark is displayed on the packaging. However, I note that none of the products appear to be "sausages" or "ham".
- Exhibit D consists of four photographs of boxes that Ms. Malawi attests are representative of those used for shipment of the Owner's meat products during the relevant period. The boxes all display the Mark. Where the descriptions of the box contents are visible, I note that one is for "Pastrami Smoked Beef Round" and two are for "Corned Beef"; none appear to be for sausage or ham products.
- Exhibit E consists of 12 invoices showing sales of meat products from the Owner to Canadian customers during the relevant period. Ms. Malawi provides the particular product numbers for the Owner's pastrami, Montreal smoked beef, corned beef and roast beef products. Although the Mark does not appear on the invoices, Ms. Malawi confirms that such goods bore the Mark, as shown in Exhibit C.
I note that Ms. Malawi does not identify any of the other products listed on the invoices; as such, there is no indication that the invoices list any sausage or ham products.
- Exhibit F consists of sales analysis reports from the Owner with respect to the relevant period. The reports show large quantities of sales of pastrami, Montreal smoked beef, corned beef and roast beef to a variety of costumers located in Canada, such as Wal-Mart.

Ms. Malawi confirms that the reports reflect sales of goods bearing the Mark.
Again, no sales reports were furnished for sausage or ham products.

Analysis – smoked beef

[12] As described above, the Owner furnished ample evidence of transfers in the normal course of trade of various “smoked beef” products bearing the Mark to Canadian customers during the relevant period.

[13] As such, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered good “smoked beef” within the meaning of sections 4(1) and 45 of the Act.

Analysis – sausages and ham

[14] In its brief written representations, the Owner claims it “has demonstrated overwhelming evidence of significant and continuous use” of the Mark in association with the registered goods.

[15] However, although Ms. Malawi asserts use of the Mark in association with all of the registered goods, I note that the evidence in this case is limited to the four types of smoked beef products described above. None of the exhibited photographs depict ham products or any type of sausages. Notably, the exhibited sales reports are limited to the four particular smoked beef products. If the invoices show sales of sausages or ham, this is not clear from the invoices themselves or from Ms. Malawi’s statements. In any event, there is no indication that any such sausage or ham products would have displayed the Mark as registered.

[16] In contrast to the identification of the four smoked beef products by their product numbers, Ms. Malawi makes no similar effort to identify any sausage or ham products. The Owner’s brief written representations shed no light on this omission, making no reference to either “sausages” or “ham”.

[17] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “sausages” and “ham” within the meaning of sections 4 and 45 of the Act.

[18] Furthermore, the Owner furnished no evidence of special circumstances excusing such non-use of the Mark. The registration will be amended accordingly.

Disposition

[19] In view of the foregoing, 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 "... and sausages; pork products, namely: ham" from the statement of goods.

[20] The amended statement of goods will read as follows: "Food products, namely: smoked beef."

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

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Pallett Valo LLP

For the Registered Owner

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Requesting Party