



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

Citation: 2010 TMOB 52
Date of Decision: 2010-04-21

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Consorzio Del Prosciutto Di Parma against
registration No. TMA179,637 for the trade-mark
PARMA in the name of Maple Leaf Foods Inc.**

[1] On September 28, 2007, at the request of Consorzio Del Prosciutto Di Parma (the Requesting Party), the Registrar of Trade-marks issued the notice prescribed by s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the Act) to Maple Leaf Foods Inc. (the Registrant), the registered owner of registration No. TMA179,637 for the trade-mark PARMA (the Mark). The Mark is registered in association with the following wares: meats namely salami, capicollo, pepper butts, pepperoni, dry sausage, mortatella, ham (the Wares). [Although the Canadian Intellectual Property Office's records state that the statement of wares was amended on May 8, 1992 to correct the spelling of mortatella to mortadella, I note that the register still misspells that ware.]

[2] Section 45 requires the registered owner of a trade-mark to show whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice, in this case between September 28, 2004 and September 28, 2007 (the Time Period). If the mark has not been used during that time period then the registered owner is required to indicate the date on which it was last used and the reason why it has not been used since that date. The onus on a registered owner under s. 45 is not a heavy one [*Austin Nichols & Co. v. Cinnabon, Inc.* (1998), 82 C.P.R. (3d) 513 (F.C.A.)].

[3] What qualifies as use of a trade-mark is defined in s. 4 of the Act, which is reproduced below:

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.

(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.

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[4] In response to the s. 45 notice, the Registrant filed an affidavit of Adam Grogan.

[5] Only the Registrant filed written representations but an oral hearing was held at which both parties were represented.

[6] Mr. Grogan is the Vice President of Marketing of Maple Leaf Consumer Foods Inc. (MLCF), which is an affiliate of the Registrant. Mr. Grogan attests that MLCF manufactured and sold PARMA branded meat products in Canada during the Time Period pursuant to a written trade-mark license agreement from the Registrant. He further attests that the Registrant exercises direct control or indirect control of the character or quality of the PARMA wares distributed and sold in Canada by MLCF and that this is explicitly set out in the written license agreement. The case law makes it clear that these attestations are sufficient in s. 45 proceedings to invoke s. 50 of the Act, whereby use of the Mark by MLCF is deemed always to have had the same effect as use by the Registrant.

[7] Mr. Grogan has shown how MLCF used the Mark during the Time Period. He has stated that the Mark is applied to labels and packaging in which the Wares were distributed and sold and provided samples of labels and plastic wrapping bags used during the Time Period. In particular, he has provided as Exhibit A labels/plastic wrapping bags for salami, capicollo, pepperoni, mortadella, and prosciutto ham. Regarding capicollo, he has provided six different

labels/bags and he has provided the following alternate descriptions for each (the alternate descriptions also appear on the labels/bags):

- Sliced mild capicollo (cooked sausage)
- Hot capicollo (cooked boneless pork shoulder butt)
- Lean mild capicollo (cooked sausage)
- Sliced hot capicollo (cooked sausage)
- Extra hot sliced capicollo (cooked boneless pork shoulder butt)
- Lean mild capicollo (cooked sausage).

[8] Mr. Grogan has provided sales figures for each PARMA product sold in each of the years within the Time Period, as well as representative invoices from within the Time Period. In addition, he has explained that the PARMA Wares are, in the normal course of trade, sold to retailers who in turn sell them to consumers through their retail stores in Canada.

[9] Having considered the evidence as a whole, I have no doubt that the Registrant used the Mark in association with various meats in Canada during the Time Period in accordance with s. 4 of the Act. The Requesting Party agrees that the registration should be maintained for “meats namely salami, capicollo, pepperoni, mortatella, ham.” However the parties do not agree as to the fate of the remaining wares, i.e. meats namely pepper butts and dry sausage.

[10] I note that Mr. Grogan does not refer to any of the wares sold as being “pepper butts” or “dry sausage”. I can only assume that if any of the wares sold qualified as such then the Registrant’s affiant would have referred to them in such manner. Moreover, at the oral hearing, the Registrant made it clear that its position is not that there is evidence that pepper butts and dry sausage have been sold, but rather that there is no need to evidence that these wares have been sold in order to maintain them in the registration.

[11] The Registrant’s position, as I understand it, is that where a registration covers a category of wares, that category can be maintained in its entirety even if the registered mark was not used in association with some of the wares that are listed in that category. It emphasizes the “deadwood” function of s. 45 proceedings and points to two s. 45 cases in particular in support of its argument: *Westinghouse Air Brake Co. v. Moffat & Co.* (2001), 14 C.P.R. (4th) 257

(F.C.T.D.) (*Westinghouse*) and *Re Thunder Tiger Model Co.*, [2004] T.M.O.B. No. 2 (*Thunder Tiger*).

[12] On the other hand, the Requesting Party submits that even though s. 45 serves the purpose of clearing deadwood this does not mean that the requirements of s. 45 do not need to be met. The Requesting Party relies primarily on *John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.) (*Rainier*). That case stands for the proposition that use must be shown in association with *each* of the wares specified in the registration and that each ware listed is to be interpreted as having a meaning that is distinct from the others.

[13] The Requesting Party emphasizes that *Rainier*, a Federal Court of Appeal decision, should be binding on both the Trial Division and the Registrar of Trade-marks and notes that it was not referred to in either *Westinghouse* or *Thunder Tiger*.

[14] In response, the Registrant points out that the facts in *Rainier* differ from those at hand in that in *Rainier*, the trade-mark registration did not name a single category of wares which was then further defined by the use of a list. In *Rainier*, the registration covered “beer, ale, porter, stout, malt beverages, malt syrup and malt extracts” and the issue was whether use of the registered mark in association with beer ought to maintain all of the other wares on the basis that they all belong to a single family of brewery products.

[15] The Registrant has also directed my attention to the fact that the current version of the Canadian Intellectual Property Office’s *Wares and Services Manual* lists “meat” as an acceptable description. However, in my view, this does not mean that the Registrant’s evidence need not address each of the specific types of meat listed in its registration. For reasons unknown to us, the original owner of the registration chose to not register the Mark for all types of meats. In so far as the present proceeding is concerned, the current owner of the registration must be bound by that decision.

[16] I will add that the Requesting Party also referred to a recent s. 45 decision of Board Member Sprung: *St. Andrews Links Ltd. v. Glen Argyle Inc.*, 2009 CarswellNat 5041 (*St. Andrews*). That case dealt with a list of wares that read, “men’s and women’s golf wear and leisure wear, namely bermuda shorts, slacks, polo shirts, sweatshirts, sweaters, jackets and

headwear, namely hats.” This list is more analogous to the one at hand than is the one dealt with in *Rainier*. The registrant in *St. Andrews* only evidenced use in association with bermuda shorts, slacks and hats; the Registrar ordered that the remainder of the wares be struck from the registration, with the comment that “...the number of wares listed in the registration is not so large that it would have been onerous for the registrant to provide clear statements or supporting documents with respect to each ware.” Such a comment applies equally in the present case.

[17] *St. Andrews* is also similar to the case at hand in that the general category of “golf wear” that was at issue there is, like “meat”, an acceptable description of wares according to the current *Wares and Services Manual*.

[18] I note that the *Oxford Canadian Dictionary* defines “capicollo” as “spicy Italian cured pork shoulder butt, usu. served in thin slices.” However, the use of PARMA in association with capicollo cannot be relied upon to maintain a ware other than capicollo in the registration given that it is presumed that each ware in a statement of wares is distinct from the others.

[19] For the reasons set out above, I find that only those registered wares for which use has been specifically shown should remain in the registration. I would add that although Mr. Grogan makes a general statement about there being use of the Mark with the registered wares, his more specific information concerning all of the sales with respect to the registered wares during the Time Period makes it clear that there were no sales with respect to pepper butts or dry sausage. In addition, no special circumstances have been put forward to excuse the lack of use with respect to pepper butts and dry sausage.

[20] Before closing, I will note that both parties made submissions concerning the issue of whether or not the present proceeding is abusive. The Registrant has submitted that it is, in part because the Requesting Party has already challenged the present registration, first under s. 45 (in 1990) and then under s. 57 (in 1997). However, the parameters of the present proceeding are narrow and the motivation of a requesting party is not a consideration in reaching a decision under s. 45. Section 45(1) provides that the Registrar may refuse to issue a s. 45 notice if he “sees good reason to the contrary”; but once the notice is issued, allegations that a party’s actions may be vexatious are irrelevant.

Disposition

[21] Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the wares “pepper butt” and “dry sausage”, in compliance with the provisions of s. 45 of the Act.

Jill W. Bradbury
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office