

SECTION 45 PROCEEDINGS
TRADE-MARK: BARESI
REGISTRATION NO.: TMA492,874

On July 30, 2003, at the request of LIDL Stiftung & Co. KG, the Registrar issued the notice prescribed by section 45 to Joseph Rutigliano & Sons, Inc., the registered owner of the above-mentioned registration.

The trade-mark BARESI is registered in association with cheeses, canned or processed olives, canned vegetables, edible oils, pasta and vinegar.

Section 45 of the *Trade-Marks Act* requires the registered owner of a trade-mark to indicate 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 and, if not, the date on which it was last used and the reason why it has not been used since that date. The relevant period in this case is any time between July 30, 2000 and July 30, 2003. What qualifies as use of a trade-mark is defined in s. 4 of the Act.

In reply to the notice, the registrant furnished the affidavit of Vincent Rutigliano. Both parties submitted written arguments. An oral hearing was not requested.

Mr. Rutigliano, the registrant's President, attests that the trade-mark has been in use in Canada since July 30, 2000 and before such date. He then provides documentary evidence in support of each of the registered wares, including the following:

- Two invoices dated in 2001 issued by J. Rutigliano & Sons, Inc. to Bella International Food Brokers of Burlington, Ontario (the registrant's Canadian distributor at that time). The invoice refers to the following BARESI brand items: tomatoes, cheese, olives, pasta, vinegar and olive oil. The invoices indicate that the wares were delivered to the same address that they were

invoiced to.

- Labels for BARESI olives “which appear on bottles sold primarily in Italian specialty grocery stores throughout Canada”.
- A label for BARESI peeled tomatoes “which appears on cans sold primarily to restaurants specializing in Italian cuisine throughout Canada”.
- Labels for BARESI boiled lentils, kidney beans, and chick peas “which appear on cans sold primarily in Italian specialty grocery stores throughout Canada”.
- Labels for BARESI ceci and fava nuts, sweet roasted peppers, pine nuts, capers, garden vegetable mix and lupini beans “which appear on cans and bottles sold primarily in Italian specialty grocery stores throughout Canada”.
- Labels for BARESI olive oil “which appear on bottles sold primarily to restaurants specializing in Italian cuisine throughout Canada”.
- Packaging for BARESI pasta “sold primarily to restaurants specializing in Italian cuisine throughout Canada”.

In its written argument, the requesting party makes the following points:

1. Regarding the registered wares “canned or processed olives”, “it is not possible to ascertain whether the evidence relates to canned olives or processed olives”.
2. The invoices were issued by J. Rutigliano & Sons, Inc., not Joseph Rutigliano & Sons, Inc.
3. Each of the labels refers to Joseph Rutigliano & Sons, Inc. but with an address in South Plainfield, New Jersey, which is not the street address listed in the registration.

In response, the registrant submits:

1. Regarding “canned or processed olives”: “The Requestor has made a specious argument relying on nothing more than a semantic analysis of these wares...any olives permitted for sale in Canada require processing of some degree.”
2. Regarding the name of the registrant: “The legal name of the Registrant is Joseph Rutigliano and Sons, Inc. The Registrant was occasionally referred to as ‘J. Rutigliano and Sons, Inc.’ on

labels and invoices for the sole purpose of conserving graphic space.

3. “The Registrant has two addresses. We inadvertently omitted the statement in the Registrar’s affidavit that J. Rutigliano and Sons, Inc. and Joseph Rutigliano and Sons, Inc. are one and the same entity having two addresses. We respectfully submit that it would be inequitable for the Registrar to expunge the trade-mark from the Register on the basis of this technical oversight.”

Of course, the registrant is not entitled to rely on facts in its written argument that are not set out in its evidence and the registrant’s written argument will be disregarded to the extent that it attempts to do that.

Based on Mr. Rutigliano’s evidence, I conclude that the registrant has fully complied with the requirements of s. 45. The evidence “shows” that the mark BARESI has been so associated with each of the registered wares during the relevant three-year period that notice of the association was then given to the person to whom the property or possession was transferred, as required by s. 4(1). This has been accomplished by displaying the mark on both the products’ packaging and on the invoices relating to such products. It is evident from Mr. Rutigliano’s affidavit that the registrant is in the business of manufacturing, or having manufactured for it, various Italian food items that it sells under the trade-mark BARESI to food distributors in Canada who distribute the wares either to Italian restaurants or to consumers through specialty grocery stores. (The invoices provided refer to the invoicer as “Importers of the Finest Italian Foods”.) Thus, in the normal course of trade, the trade-mark is brought to the attention of the recipient of the wares in two ways: first, the mark would be brought to the attention of the Canadian food distributor through its appearance on both the invoices (which appear to accompany the wares) and on the wares themselves; second, the end users of the wares would see the mark on the wares themselves. Although Mr. Rutigliano has not provided labels or packaging for cheese or vinegar, I consider the invoices to be sufficient to maintain these wares (as well as the other registered wares). In this regard, I distinguish the decision in *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471 (F.C.T.D.) on the basis that in the present case there is evidence that the wares were shipped to the same physical place that the invoice was delivered to. As the “bill to” entity is the same as the “ship to” entity, the invoice would be seen by the same party who receives the wares and, for the

purposes of s. 45, this would provide sufficient notification to satisfy s. 4(1). [see *Gordon A. MacEachern Ltd. v. National Rubber Co.* (1963), 41 C.P.R. 149 and *McCarthy Tetrault v. Acer America Corp.* (2003), 30 C.P.R. (4th) 562]

Regarding “canned or processed olives”, I am of the view that evidence of use of the mark in association with either “canned olives” or “processed olives” suffices to maintain “canned or processed olives”. Although it is unusual for wares to be listed in a disjunctive manner, in the present case such a format was presumably accepted because “olives” in themselves are a sufficiently specific ordinary commercial term. In any event, given the presence of the word “or”, I see no need for the registrant to evidence the use of both canned and processed olives. Furthermore, I consider it self-evident that bottled olives would be olives that had been processed in some way.

Finally, I shall address the issues raised by the requesting party with respect to the names and addresses that appear on the invoices and wares. The invoices refer to J. Rutigliano & Sons, Inc. with the exact same New Jersey address as that listed in the trade-mark registration. On the other hand, the packaging refers to the exact name of the registrant, Joseph Rutigliano & Sons, Inc., but lists a different address within the state of New Jersey. It does not concern me that the packaging does not provide the same address as that listed in the registration; it is not a requirement under s. 45 that it does. The abbreviated form of the registrant’s name on the invoices is a bit more problematic but I have concluded that it is not fatal to the registrant’s case, for several reasons. The first reason is that the packaging does state the exact name of the registrant. The second reason is that the appearance on the invoices of the address from the registration reinforces the idea that J. Rutigliano & Sons, Inc. is simply an abbreviated version of the company who, according to the registration, is located at that address. Third, I refer to the August 31, 2005 decision in *Northwest Airlines Inc. v. Informix Software, Inc.* re registration No. 370,262 for WINGZ where Senior Hearing Officer Savard, in dealing with an analogous fact situation, stated:

The requesting party has argued that the invoices are in the name of “Investment Intelligence Systems Group of Overland Park, Kansas, USA” which name differs from the name of the licensee, namely “Investment Intelligence Systems Corporation”. Although I agree that the registrant could have provided an explanation concerning the name on the invoices, I note that Dr. Fromm has specified that IISC has offices in London, UK; Paris,

France; Overland Park, Kansas, U.S.A.; and New York, New York, U.S.A.
Accordingly, as the licensee has an office in Overland Park, Kansas, U.S.A., I am prepared to accept that the invoice is from the office in “Overland Park, Kansas, U.S.A.” and that the name “Investment Intelligence Systems Group” is probably merely a trade-name used by the “licensee”.

In the present case, given that the registered address accompanies the abbreviated form of the registrant’s name, for the purposes of s. 45 it seems appropriate to accept that J. Rutigliano & Sons, Inc. is not a separate legal entity from Joseph Rutigliano & Sons, Inc.

Registration No. TMA492,874 will therefore be maintained in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO, THIS 2nd DAY OF DECEMBER 2005.

Jill W. Bradbury
Member
Trade-marks Opposition Board