



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

Citation: 2012 TMOB 99
Date of Decision: 2012-05-24

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Barbera 1870 S.p.A. against registration
No. TMA428,531 for the trade-mark BARBERA &
Design in the name of Barbera Caffé S.p.A.**

[1] At the request of Barbera 1870 S.p.A. (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 November 20, 2009, to Barbera Caffé S.p.A., the registered owner (the Registrant) of registration No. TMA428,531 for the following trade-mark (the Mark):



[2] The Mark is registered for use in association with “coffee” (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 services 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 use since that date. In this case, the relevant period for showing use is between November 20, 2006 and November 20, 2009 (the Relevant Period).

[4] The relevant definition of “use” in the present case 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 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 settled law that evidentiary overkill is not required in order to properly reply to a section 45 notice [*Union Electric Supply Co Ltd v Registrar of Trade-marks* (1982), 63 CPR (2d) 56 (FCTD)]. The burden that has to be met by a registrant under section 45 is not a heavy one. All the registrant has to do is establish a *prima facie* case of use [*Cinnabon, Inc v Yoo-Hoo of Florida Corp* (1998), 82 CPR (3d) 513 (FCA)]. However, sufficient facts must be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with the registered wares and services during the relevant period.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Enrico Barbera, the Chief Executive Officer and Managing Director of the Registrant. While both parties filed written submissions, the Registrant was the sole party represented at an oral hearing.

[7] As a preliminary matter, I note that the Requesting Party included additional written submissions with its request for an oral hearing, dated April 5, 2011. As the Requesting Party did not file these submissions within the time period to do so, they are not considered to form part of the record. Consequently, I will only have regard to the written submissions of the Requesting Party that were filed on October 25, 2010.

[8] In his affidavit, Mr. Barbera explains that the Registrant processes its coffee products at its plant in Italy, and packages and distributes coffee in association with the Mark internationally, including in Canada. He states that during the Relevant Period, the Registrant sold such coffee products bearing the Mark in Canada.

[9] With respect to the Registrant's ordinary business practices, Mr. Barbera explains that when overseas importers and end users place an order for the Registrant's coffee products, the Registrant's export office typically prepares a *pro forma* invoice for signature by the buyer. He attaches, as Exhibit C, representative *pro forma* invoices to reflect such purchases made in 2008 and 2009.

[10] Mr. Barbera then explains that when a buyer returns a signed invoice, the Registrant's export office processes the order and, following payment, ships the products referred to in the invoice to the buyer together with a commercial invoice issued by the Registrant. Copies of representative commercial invoices that accompanied such shipments are attached as Exhibit E.

[11] With respect to the manner in which the Mark appeared on the product packaging for the Wares sold in Canada during the Relevant Period, Mr. Barbera attaches representative packaging as Exhibit D.

[12] Examples of how the Mark appears in the above-noted exhibits are as follows:

Exhibits C and E (the *pro forma* and commercial invoices):



Exhibit D (the product packaging):



[13] The Requesting Party submits that the border anchored by the banner, including the words “... dal 1870” forms a distinctive part of the mark shown on the invoices. It further submits that as the registered Mark does not incorporate these features, the mark shown on the invoices is distinctively different and does not constitute use of the registered Mark.

[14] With respect to the product packaging, the Requesting Party similarly argues that it includes a trade-mark that differs from the registered Mark. Specifically, the Requesting Party submits that the immediate perception is that there are two trade-marks present on the product packaging: the first of which is comprised of the words “Europa gusto forte... dal 1870” together with the design of the fanciful man carrying the steaming cup on his back, and the second being the words “Barbera il mago del caffè” in script font underneath it, identified by the TM symbol. The Requesting Party argues that the positioning of the ® symbol with respect to the fanciful man design, as well as the positioning of the TM symbol following the words “Barbera mago del caffè” reinforces this perception. Neither of these trade-marks, the Requesting Party submits, is the Mark as registered. Similar comments apply with respect to other product packaging identified in Exhibit D.

[15] Generally, where the mark as used deviates from the mark as registered, the question to be asked is whether the mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Cie International pour*

l'informatique CII Honeywell Bull (1985), 4 CPR (3d) 523 at 525 (FCA)]. In deciding this issue, one must look to see if the “dominant features” have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) at 59 (FCA)]. Whether the differences between the marks are “so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin” [*CII Honeywell, supra* at p. 525], is a question of fact. Furthermore, the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public as a matter of first impression, would perceive the trade-mark *per se* as being used [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[16] In the present case, I agree with the Registrant that the dominant features of the Mark include an intricate design of a gnome or an elf carrying a steaming, overflowing coffee cup on his hunched back (the fanciful man design), the word “Barbera”, and the phrase “il mago del Caffé”, with all such text in fanciful script, rising to the right. It is clear that all of these dominant features have been maintained in every instance of the Mark illustrated in the evidence. Furthermore, the inclusion of the border and banner design on the invoices does not alter the identity of the trade-mark; the Mark overwhelmingly remains recognizable and the addition of the border and banner is so unimportant as not to mislead or deceive the public in any way.

[17] With respect to the Requesting Party’s submissions regarding the positioning of the ® and ™ symbols on the product packaging, I do not find the placement of these symbols to be determinative in the present case. In my view, these symbols merely provide the message that certain portions of the Mark, namely, the fanciful man design and the words “il mago del Caffé” are also trade-marks on their own [see *Aramark Canada Ltd v 637870 Ontario Ltd* (2002), 22 CPR (4th) 409 (TMOB) for a similar finding]. Furthermore, I find the words above the fanciful man design on the packaging to be sufficiently separated from the Mark, in a different size, style, and positioning of font, to the extent that they would not be perceived as forming part of the trade-mark *per se*.

[18] Aside from the issue of deviation, the Requesting Party also argues the notation “payment: AT SIGHT” on the commercial invoices contradicts statements made by Mr. Barbera

that payment is made prior to the shipment of goods. Furthermore, the Requesting Party submits that if in fact the Registrant's customers have paid for their orders once the signed proforma invoices have been returned, this is not apparent from the commercial invoices as none of the invoices show confirmation of payment. Accordingly, the Requesting Party argues that the commercial invoices do not support the Registrant's assertions as to its normal course of trade in Canada and this is an ambiguity that ought to be construed against the Registrant.

[19] However, the Registrant argues, and I agree, that the timing of the customer's payment has no bearing on the determination of whether the Mark was used during the Relevant Period. I have no reason to doubt that payment was made and I accept that the Registrant has provided invoices that represent *bona fide* commercial transactions that took place during the Relevant Period.

[20] In view of the foregoing, I accept that the Registrant has shown use of the Mark in association with the Wares pursuant to sections 4 and 45 of the Act.

Disposition

[21] Accordingly, having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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

