

SECTION 45 PROCEEDINGS  
TRADE-MARK: BLACK DIAMOND  
REGISTRATION NO.: UCA 02073

On August 3, 2001, at the request of Messrs. Sim & McBurney, the Registrar forwarded a Section 45 notice to Parmalat Food Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark BLACK DIAMOND is registered for use in association with the following wares:

- (1) Cheese.
- (2) A food product in the nature of a dip, spread, or fondue and a product similar to sour cream to be used as a sauce or condiment on vegetables and other foods or as a base for a dip, spread, fondue, and salad dressing or mayonnaise.
- (3) Gravy mix, cheese sauce mix, spaghetti sauce mix, flavouring spices, and flavoured ground dried meat.

Section 45 of the Trade-marks 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. The relevant period in this case is any time between August 3, 1998 and August 3, 2001.

In response to the notice, the affidavit of Steve Trofimchuk together with exhibits has been furnished. The registrant alone filed a written argument. Both parties were represented at the oral hearing.

In his affidavit, Mr. Trofimchuk states that the registrant has continuously and consistently sold its BLACK DIAMOND cheese products throughout Canada for many years and has sold such products during the relevant period. As Exhibit B, he provides samples of packaging for the BLACK DIAMOND cheese slices, BLACK DIAMOND cheese loaves, BLACK DIAMOND cheddar cheese, BLACK DIAMOND cheese spread and BLACK DIAMOND shredded cheese products. As Exhibit B1, he provides a photocopy of the BLACK DIAMOND cheese spread packaging indicating the suggested uses for the product. As Exhibit C he provides a list entitled "Case Code" which indicates the code number for each of the products found in the cheese categories. As Exhibit D and E he submits copies of invoices.

At paragraph 8 of his affidavit, he explains that his company's cheese spread product may be used as a spread and as a dip and is also sold for use as a sauce or condiment on vegetables and other foods such as crackers and tortilla chips. At paragraph 9, it is stated the cheese spread product may be used as a base for a dip, spread, fondue, salad dressing or mayonnaise.

At paragraphs 10, Mr. Trofimchuk states that the registrant's cheese products may also be used as a mixture in any kind of sauce or soup and they may be used to form a gravy,

a cheese sauce or a spaghetti sauce. In paragraph 11, he adds that the registrant's cheese products may also be used as a flavouring for meat and vegetable products.

As the registrant has conceded in its written argument that the evidence does not show use of the trade-mark in association with "flavoured ground dried meat", those wares will be deleted from the trade-mark registration.

Concerning the other wares, the requesting party submits that the only use shown of the trade-mark is in association with "cheese" and "a food product in the nature of a spread". It argues that all other wares ought to be deleted from the trade-mark registration.

Concerning the wares "cheese" (wares marked (1) on the trade-mark registration page), I am satisfied that the evidence clearly shows use of the trade-mark in association with several types of cheeses and, therefore, I conclude that the wares "cheese" ought to be maintained on the trade-mark registration.

Concerning the wares "a food product in the nature of a dip, spread, or fondue and a product similar to sour cream to be used as a sauce or condiment on vegetables and other foods or as a base for a dip, spread, fondue, and salad dressing or mayonnaise" (hereinafter wares marked (2)), the registrant submits that the evidence shows use of the trade-mark in association with such wares. It argues that the wares marked (2) should be read as a single definition of a single product having a number of characteristics, and that the use shown in association with a "cheese spread" is sufficient to maintain the entire

description. On the other hand, the requesting party argues that because of the manner the wares marked (2) are described, the only way or common sense approach to read that description is as a reference to two separate products, the first product being “a food product in the nature of a dip, spread, or fondue” and the second product being “a product similar to sour cream to be used as a sauce or condiment on vegetables and other foods or as a base for a dip, spread, fondue, and salad dressing or mayonnaise”. Further, the requesting party submits that because use has only been shown in association with a “cheese spread” only the description “a food product in the nature of a spread” ought to be maintained.

I agree that there is room for interpretation concerning the wares marked (2) and I accept that arguably the description can be read as a single definition of a single product having a number of characteristics and that the second part can be read as a continued description of the characteristics of the product. I also agree with the registrant that the product “cheese spread” shown in evidence supports the entire description. As the product is in the nature of (which I take to mean having the characteristics of) a dip, spread or fondue (as properly argued by the registrant because of the term “or” the product has to meet only one of those characteristics) and as it is similar to sour cream to be used as a sauce or condiment on vegetables and other foods or as a base for a dip, spread, fondue, and salad dressing or mayonnaise, I conclude that use has been shown in association with the wares marked (2) and that such wares ought to be maintained.

Concerning the wares “gravy mix, cheese sauce mix, spaghetti sauce mix, and flavouring spices” (hereinafter the wares marked (3)), I agree with the requesting party that each of these wares are separate and distinct wares and that none of the products sold by the registrant consists of gravy mix, cheese sauce mix, spaghetti sauce mix, and flavouring spices.

The evidence shows that the registrant sells several types of “cheeses” as well as a “cheese spread” and although some of the registrant’s cheeses may be used as an ingredient to form a gravy, a cheese sauce or spaghetti sauce, I fail to see and the registrant has not convinced me, that any of the products it sells (including the Nachos & Tacos blend of 6 natural shredded cheeses) can be characterized as a gravy mix or a cheese sauce mix or a spaghetti sauce mix, that is, a substance containing a number of dried ingredients from which a gravy or a cheese sauce or a spaghetti sauce is prepared and requiring only the addition of liquid. In support thereof, I rely on the following dictionary definitions of the word “mix”:

Webster’s Third International Dictionary of the English language:

noun:

2: a product of mixing: mixture: as a: a commercially prepared mixture of dry ingredients for a food usu. requiring the addition of only water or sometimes eggs and cooking or baking (roll -) (soup -) (cake made from a packaged -) (an instant pudding – that needs only milk and mixing).

Encarta World English Dictionary North American Edition:

noun :

3. substance used to prepare something: a substance, especially a number of dried ingredients in powder form, from which something is prepared (cake mix).

Cambridge International Dictionary of English:

noun:

2 [c or u] something which is sold in the form of a powder and to which a liquid, such as water, can be added later: cake/cement mix.

Cambridge Dictionary of American English:

noun:

... a mix is also a food substance that you can buy and to which a liquid, such as water or milk, can be added later when preparing to cook something: a cake mix.

In my view, as none of the registrant's cheeses can be considered a mixture of dry ingredients for a gravy, cheese sauce or a spaghetti sauce requiring the addition only of water or a liquid, I conclude that the registrant has failed to show use of its trade-mark in association with the wares "gravy mix, cheese sauce mix, spaghetti sauce mix" and that such wares ought to be deleted from the trade-mark registration.

Similarly, I find that none of the wares sold by the registrant can be characterized as "flavouring spices". I totally agree with the requesting party that the wares "flavouring spices" would be "any of various pungent, aromatic plant substances, such as cinnamon or nutmeg, used to flavour foods or beverages" and clearly the registrant's products are not spices and would not be perceived as spices. Consequently, as the evidence fails to

show use in association with flavouring spices, I conclude that the wares “flavouring spices” also ought to be deleted from the trade-mark registration.

In view of the above, only the wares marked (1) and (2) will remain on the registration.

Registration No. UCA 02073 will be amended accordingly in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 18<sup>TH</sup> DAY OF DECEMBER 2003.

D Savard  
Senior Hearing Officer  
Section 45 Division