

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

Citation: 2018 TMOB 92

Date of Decision: 2018-08-28

IN THE MATTER OF A SECTION 45 PROCEEDING

Parlee McLaws LLP

Requesting Party

and

Barry Callebaut AG

Registered Owner

**TMA698,488 for
WORLD CHOCOLATE MASTERS &
DESIGN**

Registration

[1] At the request of Parlee McLaws LLP (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 April 14, 2016, to Barry Callebaut AG (the Owner), the registered owner of registration No. TMA698,488 for the trade-mark WORLD CHOCOLATE MASTERS & DESIGN shown below (the Mark):



[2] The Mark consists of the words WORLD CHOCOLATE MASTERS above a stylized cocoa bean, all within an underlined ring.

[3] The Mark is registered in association with the following goods:

Chocolate; confectionery products, namely, chocolates and assorted chocolates; chocolate mass; cocoa mass; chocolate pieces; baking chocolate; chocolate bars and chocolate tablets; chocolate coated candy; chocolate squares; chocolate lozenges; chocolate molded into various shapes; chocolate bonbons; filled chocolate bars; shaped, iced and hollow chocolates; chocolate-based glazes; imitation chocolate; imitation chocolate confectionery; diet chocolate; raw chocolate; raw chocolate in the form of small lentils or tablets (in one piece or divided in small parts); raw chocolate in the form of lens-shaped drops or small tablets for use in industry or households; chocolate coatings and diet chocolate coatings; compound coating for use in the manufacture of candies, air-filled chocolate, chocolate syrup, chocolate desserts; small wrapped milk chocolate eggs; chocolate cakes; chocolate candy drops; chocolate-based candy for retail sale and use in food manufacturing; dark chocolate; plain chocolate, chocolate candy and sweets, in particular filled with fruits; chocolate coated fruits; chocolate-covered sweetmeats, namely, chocolate covered raisins, nuts, almonds; chocolate beverages; chocolate flavoured beverages; cocoa powder for making beverages; chocolate bread spreads; chocolate spreads; thin chocolate slabs for laying on bread; chocolate-nut-nougat cream for bread; liquid and solid chocolate intended for sale to the chocolate industry and not for direct human consumption; chocolate based beverages, namely milk shakes; chocolate sauces; chocolate drops; chocolate pralines; pralines; alcoholic pralines filled with liqueur; pralines filled with nuts, hazelnut cream and walnut cream; diet pralines; chocolate truffles; truffles; chocolate sticks; fudge; chocolate ices; wafers and pastries with chocolate coating; chocolate wafer; wafer biscuits; plain flour wafers; wafered pralines; wafer sandwiches; farinaceous and bakery products, namely rusks, cakes, breads, sweet breads, cookies, biscuits, pies; waffles; crackers; chocolate covered waffles, in particular, waffle biscuits and waffle pralines; toast; gingerbread; syrup waffles-namely, two waffles held together by syrup; confectionery articles covered with chocolate namely, cake, crackers, toast, gingerbread; chocolate-coated biscuits; chocolate wafers; blancmange powder; baking powder; albumen to be used as a raw material for the bakery; creams for the bakery; edible oils; flour; honey; honey molasses; syrup; yeast; yeast baking powder; apricot flavored fruit-based gel for pastries; flan; marzipan.

[4] The Mark is also registered in association with the following services:

Organizing competitions for chocolate professionals to create chocolate artworks, pralines, pastry and desserts.

[5] 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 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 the trade-mark was last used and the reason for the absence of such use since that date. In this case, the relevant period for showing use is April 14, 2013 to April 14, 2016.

[6] The relevant definitions of “use” are set out in sections 4(1) and 4(2) 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.

4(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.

[7] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register. As such, the evidentiary threshold that the registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. A registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184, 90 CPR (4th) 428 at paragraph 2].

[8] With respect to services, the display of a trade-mark on advertising is sufficient to meet the requirements of section 4(2) of the Act when the trade-mark owner is offering and prepared to perform the advertised services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[9] In response to the Registrar’s notice, the Owner furnished the affidavit of Jean-Jacques Berjot, solemnly declared on November 14, 2016. Both parties filed written representations; a hearing was not requested.

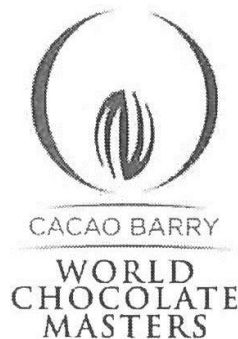
THE OWNER’S EVIDENCE

[10] In his affidavit, Mr. Berjot identifies himself as the Commercial Director for Canada of the Callebaut Group’s Gourmet & Decorations Division. He describes the Callebaut Group as “the world’s leading manufacturer of high-quality chocolate and cocoa products, with a global

network of production sites ... selling to chefs, food service companies, food manufacturers and beverage vendors around the world”.

[11] Mr. Berjot states that the Owner is one of the companies in the Callebaut Group. He explains that the Owner was created in 1996 through the merger of Callebaut of Belgium and Cacao Barry of France, producers of chocolate and cocoa products for more than 150 years.

[12] Mr. Berjot further states that the Owner is the parent company of an international group of companies that includes its wholly owned subsidiary Barry Callebaut Canada Inc. (BCC). Mr. Berjot attests that BCC is licensed by the Owner to use the Mark in Canada, including the following “minor variant” of the Mark (the Expanded Logo):



[13] In the Expanded Logo, the underlined words CACAO BARRY have been added below the graphic element, while the words WORLD CHOCOLATE MASTERS have been enlarged and moved to the bottom of the design.

[14] Mr. Berjot attests that, under the licence, the Owner has control over the character and quality of the services provided by BCC. He specifies that the Owner “monitors” the services and oversees BCC’s online “digital and website” content. He adds that the Owner will ensure that any services found to be unsatisfactory are improved to meet its standards.

[15] With respect to the registered services in particular, Mr. Berjot explains that the Owner organizes a “World Chocolate Masters” competition that has taken place every two years since 2005, with competitors including professional chocolatiers and pastry chefs. He explains that local subsidiaries organize national “pre-selection” competitions, whose winners move on to the final. He notes that the last three finals were streamed live from France in Canada on the *worldchocolatemasters.com* website.

[16] Mr. Berjot attests that BCC organized the two most recent Canadian pre-selection competitions, which took place on January 20, 2013, in Toronto, and on April 17, 2015, in Montreal. He confirms that, in the 2015 competition, competitors were required to make a chocolate artwork, a moulded praline, a pastry, and a dessert. He further attests that the Owner has a global team of employees that “closely tracks the entire competition process” to ensure that the character and quality of the Canadian competitions satisfies the rules and standards required by the Owner. He specifies that this team determines the rules and parameters of the competitions and participates in local team meetings leading up to the event.

[17] Regarding use of the Mark, Mr. Berjot first states that it is used in advertising and “press materials” for the Canadian pre-selection competitions. In this respect, he attaches to his affidavit the following exhibits:

- Exhibit 1A consists of English and French versions of an invitation to the 2015 Canadian pre-selection competition. Mr. Berjot attests that this invitation was e-mailed to hundreds of customers in Canada on April 10, 2015.
- Exhibits 1B and 1C consist of English and French versions of two press-releases for the 2015 Canadian pre-selection competition. The press releases describe the nature of the competition and the chocolate works to be created in a manner consistent with the registered services. The press releases also mention the final to be held in Paris in the fall. Mr. Berjot attests that these press releases were sent to over 80 journalists and bloggers in Canada on April 10, 2015, and April 20, 2015, respectively.
- Exhibit 2 is an invitation to the 2013 Canadian pre-selection competition.
- Exhibits 3A, 3B and 3C are identified by Mr. Berjot as printouts from the *worldchocolatemasters.com* website showing the results of the Canadian pre-selection competitions from 2015, 2013 and 2011, respectively. I note that the web page for 2013 describes the pre-selection in a manner consistent with the registered services, and also mentions the final to be held in Paris in the fall. The copyright notice at the bottom of the web pages for 2015 and 2013 reads “©2005-2016 Barry Callebaut”, which suggests that these documents remained available online at least until 2016.

- Exhibits 7A and 7B are described by Mr. Berjot as examples of “photo albums” posted by representatives of Barry Callebaut Canada to the Cacao Barry and World Chocolate Masters Facebook profiles, in connection with the 2013 and 2015 Canadian pre-selection competitions, respectively. The various photographs depict what appear to be competition scenes and chocolate creations. I note that the pages from 2013 indicate that they were “Updated about 4 years ago”, which is consistent with their continued availability until at least November 2016. The page from 2015 is dated April 17, 2015.

[18] To the extent that some of these materials reference Cacao Barry in connection with the competitions, the English press release at Exhibit 1C confirms that Cocoa Barry® is a global brand of the Barry Callebaut group. I also note that the contact information provided in the invitations and press releases is for individuals at Barry Callebaut.

[19] The Expanded Logo is displayed at the top of all of the invitations, press releases, and webpages from 2015, as well as in the backdrop of certain photographs posted on the World Chocolate Masters website and Facebook profile in 2015. The Expanded Logo is also displayed at the top of the 2013 pre-selection results webpage.

[20] In addition, a photograph in the 2015 press releases shows a variation of the Mark (the Stacked Logo), which resembles the Expanded Logo, but omits the underlined words CACAO BARRY, as shown below:



[21] The photograph in question features a competitor who participated in all three Canadian pre-selection competitions; the Stacked Logo is visible in the background.

[22] The Stacked Logo is also displayed at the top of the invitation from 2013 and in the backdrop of photographs posted online that year, as well as being displayed at the top of the webpage from 2011.

[23] Mr. Berjot states that the Canadian pre-selection competitions attract spectators that include not only competitors' friends and family but also journalists and bloggers. He attaches, as Exhibits 4A and 4B to his affidavit, printouts of two articles about the 2015 Canadian pre-selection competition, posted on the website of Quebec-based magazine *Hôtels Restaurants & Institutions* on April 22, 2015, and October 28, 2015, respectively. The October article also mentions the ability to view the final online and to cast a vote for one's favourite chocolate creation there. The Expanded Logo is displayed above the first article; the Stacked Logo is displayed in a photograph accompanying the first article (the same photograph as in the 2015 press releases) and on its own beside the second article.

[24] Mr. Berjot next provides examples of communications that took place between BCC and prospective competitors leading up the 2015 Canadian pre-selection, and of printed materials employed during the competition itself. In this respect, he attaches the following exhibits to his affidavit:

- Exhibit 5A is identified by Mr. Berjot as a series of e-mails between BCC employees, regarding Canadian pre-selection competitors for 2015. The e-mails contain application form data which, according to Mr. Berjot, was submitted online through *wordchocolatemasters.com* in the fall of 2014.
- Exhibit 5B is a November 2014 letter notifying successful applicants that they have been selected to compete in the 2015 Canadian pre-selection competition.
- Exhibit 5C contains three product requisition forms for ingredients to be used in the 2015 Canadian pre-selection competition, along with two covering e-mails. The forms offer various chocolate and other products under the trade-marks CALLEBAUT and CACAO BARRY. Mr. Berjot states that the forms were provided to competitors by BCC and that competitors submitted the completed forms in or around late December 2014.

- Exhibit 5D is a document titled “WCM NATIONAL PRESELECTIONS EQUIPMENT LIST”, which sets out the equipment that will be made available during the competition. I note that this equipment includes automatic tempering machines “filled with Cacao Barry Chocolates”. Mr. Berjot states that this list was sent to Canadian competitors in March 2015.
- Exhibit 6 is described by Mr. Berjot as an example of a redacted “jury score card” from the 2015 Canadian pre-selection competition.

[25] The Expanded Logo is displayed at the top of each of these materials, with the exception of the e-mails.

[26] Mr. Berjot concludes his affidavit by asserting several public benefits provided by the competitions, for example, promotion of the profession of chocolatier and provision of entertainment to the public.

ANALYSIS

[27] In its written representations, the Owner concedes that the evidence does not establish use of the Mark in association with the registered goods. Indeed, there is neither any evidence of the Mark being displayed on or otherwise associated with such goods nor any evidence of such goods being sold or otherwise transferred in Canada during the relevant period. Although the provision of chocolate and chocolate products is referenced in the exhibited product requisition form and equipment list, the listed products are identified by *different* trade-marks, such as CALLEBAUT and CACAO BARRY. Accordingly, since there is also no evidence before me of special circumstances excusing such non-use of the Mark, the registered goods will be deleted from the registration.

[28] With respect to use of the Mark in association with the registered services, the Requesting Party submits that the trade-marks in evidence are “substantially and materially different in both look and feel” from the Mark as registered. In the Requesting Party’s submission, the arrangement of the elements in the Expanded and Stacked Logos departs significantly from the “indivisible” presentation of the Mark as registered: the graphic element

becomes more prominent, while the word element becomes “a mere postscript”. The Requesting Party further submits that, in the Expanded Logo, the eye is naturally drawn, after the prominent graphic, to the newly added words CACAO BARRY.

[29] In addition, the Requesting Party notes that certain exhibits displaying the Stacked Logo predate the relevant period.

[30] The Owner, for its part, submits that the both the Expanded Logo and the Stacked Logo retain all of the dominant features of the Mark as registered, namely, the words “WORLD CHOCOLATE MASTERS” and the graphic element. The Owner further submits that the addition of CACAO BARRY in “much smaller font” between the “much larger and more prominent” elements is a minor and insignificant variation that would not mislead an unaware purchaser as to the source of the services. The Owner submits that the Mark remains recognizable.

[31] The Owner relies primarily on the advertising and press materials at Exhibit 1, the communication materials at Exhibits 5 and 6, and the photographs at Exhibit 7A to show use of the Mark in the performance and advertising of the registered services during the relevant period.

[32] In considering whether display of the Stacked Logo or Expanded Logo constitutes display of the Mark as registered, the question to be asked is whether the trade-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 internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[33] In the case of a trade-mark to which words or design features have been added, use of the combination generally qualifies as use of the registered mark if the public, as a matter of first impression, would perceive the mark *per se* as being used. The issue is a question of fact, dependent upon such factors as whether the mark stands out from the additional material as a separate trade-mark [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)].

[34] In the case of the Expanded Logo, the Mark is integrated with the added elements to a considerable extent. In particular, the added name CACAO BARRY is positioned in the very centre of the combination mark, and is highlighted by lines above and below it, as if on a banner. Moreover, this CACAO BARRY “banner” breaks up the combination of elements from the registered Mark, separating the graphic element from the descriptive words WORLD CHOCOLATE MASTERS. It also alters an aspect of the graphic element: the line forming a base for the ring is now also the top of the CACAO BARRY “banner”.

[35] However, it is not necessary to decide whether the Expanded Logo constitutes use of the Mark as registered for the purposes of this proceeding. Although I find that the Requesting Party’s submissions regarding the Expanded Logo are not without merit, I agree with the Owner that the Stacked Logo constitutes only a minor deviation from the Mark as registered.

[36] In my view, the dominant feature of the Mark as registered—being a combination of the graphic element and the words WORLD CHOCOLATE MASTERS—is maintained in the Stacked Logo, notwithstanding the different configuration. In this respect, although the word element is no longer centrally located, it is immediately adjacent to the graphic and slightly larger than before, thus retaining its connection to the graphic and relative prominence. Accordingly, the identity of the Mark is preserved; the Mark remains recognizable.

[37] Furthermore, considering the evidence in its totality, I accept that this minor variation of the Mark was displayed in advertising the registered services during the relevant period.

[38] For example, the 2015 press releases (Exhibits 1B and 1C) display not only the Expanded Logo at the top of each page, but also the Stacked Logo in a promotional photograph. Mr. Berjot attests that these press releases were sent to over 80 journalists and bloggers in Canada on April 10, 2015, and April 20, 2015, respectively. His statement is corroborated by the article at Exhibit 4A, which relays information from the first press release and reproduces the photograph in question. At a minimum, I am satisfied that these two press releases constitute advertising for the 2015 Canadian pre-selection competition and for the organization of future iterations of this competition, respectively.

[39] I would also note that the Exhibit 3B and 7B web pages show the Stacked Logo displayed in the background of promotional photographs from the 2013 pre-selection, which appear to have remained available online throughout the relevant period. Given Mr. Berjot's statement that the competition's spectators included the Canadian competitors' friends and family, as well as journalists and bloggers, and in view of the timing of the finals streamed in Canada and related publicity, I also find it reasonable to infer that at least some Canadians would have accessed these web pages during the relevant period.

[40] Accordingly, after reviewing the evidence as a whole, I am satisfied that at least some advertising displaying an acceptable variation of the Mark was distributed in Canada during the relevant period.

[41] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[42] Accordingly, 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 the registered goods.

[43] The registration will be maintained with respect to the registered services only.

Oksana Osadchuk
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No Hearing Held

AGENTS OF RECORD

Featherstonhaugh & Co.

FOR THE REGISTERED OWNER

Parlee McLaws LLP

FOR THE REQUESTING PARTY