



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 2

Date of Decision: 2020-01-21

IN THE MATTER OF A SECTION 45 PROCEEDING

Love Productions Limited

Requesting Party

and

The Pillsbury Company, LLC

Registered Owner

**TMA348,913 for BAKE-OFF and
TMA305,664 for BAKE OFF**

Registrations

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA348,913 and TMA305,664, respectively for the marks BAKE-OFF and BAKE OFF (the Marks), owned by The Pillsbury Company, LLC.

[2] Registration No. TMA305,664 is registered in association with the goods “Printed publications, namely cookbooks”, while registration No. TMA348,913 is registered in association with the services “Cooking contests for the purpose of promoting and creation of new recipes.”

[3] For the reasons that follow, I conclude that registration No. TMA 305,664 ought to be maintained; however, registration No. TMA 348,913 will be expunged.

THE PROCEEDINGS

[4] On May 26, 2016, the Registrar of Trademarks sent notices under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to The Pillsbury Company, LLC (the Owner). The notices were sent at the request of Love Productions Limited (the Requesting Party).

[5] The notices required the Owner to furnish evidence showing that it had used the Marks in Canada, at any time between May 26, 2013 and May 26, 2016, in association with the goods and services specified in the registrations. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were last in use and the reasons for the absence of use since that date.

[6] The relevant definitions of use are set out in sections 4(1) and 4(2) of the Act as follows:

4(1) A trademark 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.

(2) A trademark 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 has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. As such, the evidentiary threshold that the registered owner must meet is quite low [see *Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the goods and services specified in the registrations [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270 and *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notices, the Owner furnished identical affidavits of Benjamin Irby, sworn December 16, 2016, together with Exhibits A to F.

[9] Both parties filed written representations; an oral hearing was not held.

THE EVIDENCE

[10] Mr. Irby is the Business Unit Director for Pillsbury baking products, employed by General Mills, Inc. He explains that the Owner became a wholly owned subsidiary of General Mills in 2001, but remains a separate legal entity. He further explains that General Mills has managed the operations of both the Owner and General Mills through the creation of business units dedicated to certain product lines of these companies.

[11] Mr. Irby explains that as Business Unit Director for the Owner, he oversees the marketing and performance of the Owner's BAKE-OFF cooking contests and the marketing and sale of BAKE-OFF cookbooks relating to the contests. He attests that over the past 5 years, annual sales of the Owner's products totaled over \$100 million in Canada.

[12] Mr. Irby states that the Owner has used the Marks in association with the registered goods and services continually since their respective registration dates. With respect to the services, Mr. Irby explains that the BAKE-OFF contest is a competition in which participants submit their own new recipes to the Owner, thus promoting the creation of new recipes. He provides as Exhibit A to his affidavit, printouts from the Owner's website detailing the first winning entry to the contest. While he states that Canadian consumers can view the website, and the Marks appear on the printouts in relation to a contest, the printouts post-date the relevant period.

[13] Mr. Irby attests that the BAKE-OFF contest was most recently held in December of 2014, and was broadcast on ABC in the USA and CityTV networks in Canada. In support, he provides viewer statistics for the broadcast in the United States and Canada, respectively, under Exhibits B and C.

[14] Mr. Irby states that the Owner advertises its BAKE-OFF contest through its website, accessible to Canadians, and provides website traffic statistics for the period of February 2014 to

February 2015 under Exhibit D. He explains that the Owner's BAKE-OFF contests are also promoted through the sale of a cookbook, also called BAKE-OFF, which includes the contest's finalist's recipes.

[15] Mr. Irby states that the Owner's BAKE-OFF contest has been associated with its BAKE-OFF cookbook throughout the publication's history. He describes the BAKE-OFF goods and services as being interrelated, as consumers enjoy the contest by reading about the contest winners and recreating the contest's winning entries with the assistance of the cookbook. He contends that the BAKE-OFF contest and the BAKE-OFF cookbooks (and the contest, as enjoyed by consumers through the cookbooks) thus promote the creation of new recipes.

[16] Mr. Irby states that the Owner provides all the content included in the cookbook magazines by re-working the finalists' entries, providing updated recipes for the re-worked entries and by taking professional photographs of the final product. In this manner, Mr. Irby states, the Owner maintains control of the character and quality of the publications sold under the Mark.

[17] Mr. Irby states that the Owner's cookbook magazines are sold in grocery stores, and provides a representative sample of a BAKE-OFF cookbook magazine, sold in Canada during the relevant period as Exhibit E. He attests that this particular magazine contained the finalists for the 2014 BAKE-OFF contest, and as indicated in text on the front cover which includes the price listed in both USD and CAD, retailers were instructed to keep the publication on display until November 28, 2014.

[18] Mr. Irby states that in the normal course of trade, Time Inc. Retail (Time) publishes the magazine for the Owner and provides the BAKE-OFF magazine to various distributors of media publications in Canada, who sell the cookbooks on consignment. That is, Time retains legal ownership of the publications until they are sold. The magazines are sold to Canadian retailers, namely grocery stores, which then sell the cookbook magazines to end consumers.

[19] Lastly, with respect to evidence of sales of the goods, Mr. Irby provides representative customs invoices as Exhibit F to his affidavit, showing the transfer of the BAKE-OFF cookbooks from Time to its customers for sale in Canada during the relevant period. The invoices show

details for the transfer of 5 shipments of cookbooks from Time to various Canadian distributors, which have been offered to show that Time transferred possession in goods marked with the Mark to its distributors on these dates. He states that the goods were then sold by the consignees, as agents for Time, to grocery stores, which then sold the cookbook magazines to their consumers. He states that the customs invoices show a total value of approximately \$60,000 of BAKE-OFF cookbooks imported for sale in Canada during the relevant period.

[20] As for the services, Mr. Irby states that as is shown on the Exhibit E cookbook covers, the publications advertise the BAKE-OFF contest by promoting and publicizing the contest results, and by sharing recipes for winning BAKE-OFF contestants with consumers. He further asserts that although the contest has not yet been held in Canada, the contest has been broadcast in Canada and the promotion and creation of new recipes have occurred in Canada during the relevant period.

ANALYSIS AND REASONS FOR DECISION

TMA305,664 - Goods

[21] With respect to registration No. TMA305,664 registered in association with “printed publications, namely cookbooks”, the Requesting Party submits that the registration ought to be expunged. In this regard, the Requesting Party submits that there is no use of the Mark in association with cookbooks, but instead with magazines, a separate good [citing *Norton Rose Canada LLP/SENCRL v Reader’s Digest Assn, Inc*, 2015 TMOB 85 [*Reader’s Digest*] which held that a distinction exists between a book and a magazine]. Further to this, the Requesting Party submits that the affiant refers to the Exhibit E publication cover page, as a “cookbook magazine”, and without a full copy of the publication, this is a bald one-page document in which it is not possible to determine whether it is a cookbook or a magazine [*Smart & Biggar v Canada (Attorney General)*, 2006 FC 1542 at para 14; *Plough*].

[22] The Owner submits on the other hand, that the *Reader’s Digest* case cited by the Requesting Party discusses the differences between “books” and “magazines”, but does not consider what constitutes a “cookbook” or if a “cookbook” cannot also be a “magazine”. The Owner submits that the Requesting Party’s position is also directly contradicted by the evidence,

which shows that the affiant uses these terms interchangeably, never refers to these goods as “books”, and rarely refers to them as “magazines” alone. Moreover, the Owner submits that the representative sample of the BAKE OFF goods included in the evidence at Exhibit E is clearly labelled “Pillsbury Classic Cookbooks 367”.

[23] I agree with the Owner, and despite that the full publication was not furnished under Exhibit E to Mr. Irby’s affidavit, there is nothing on the cover page of the publication to suggest that the content includes anything other than a compendium of recipes. This, in my view, is entirely consistent with a cookbook, and to decide otherwise would be to improperly engage in an overly meticulous analysis of the specification of goods [see *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096; *Levi Strauss & Co v Canada (Registrar of Trade-Marks)* 2006 FC 654, 51 CPR (4th) 434 (FC)].

[24] Further to the above, the Requesting Party submits that there is no evidence of use of the Mark that accrues to nor sales of the goods in the normal course of trade by the Owner, but rather by Time Inc. Retail. The Requesting Party submits that to support a claim of a valid license, a registered owner must put forward detailed evidence to show that there was a license between the parties during the relevant period, through which the owner exercised control pursuant to section 50 of the Act [citing *Tucumcari Aero, Inc v Cassels, Brock & Blackwell LLP*, 2010 FC 267 at para 9 [*Tucumcari*]].

[25] With respect to licensing and whether the use of the Mark by Time accrues to the benefit of the Owner, the Owner submits that there are three main methods by which a trademark owner can demonstrate the requisite control, pursuant to section 50(1) of the Act: first, by clearly attesting to the fact that it exerts the requisite control; second, by providing evidence demonstrating that it exerts the requisite control; or third, by providing a copy of the license agreement that provides for the requisite control [*Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102, aff’d 2011 FCA 340]. In the present case, the Owner submits, and I agree, that Mr. Irby’s clear attestation to the fact that the Owner exerts the requisite control over the character and quality of the goods is sufficient. Furthermore, given that the Owner provides all of the content included in the cookbook magazines for publishing by Time, I have no difficulty inferring the existence of a license agreement. The Owner correctly distinguishes

Tucumcari from the present case, as the Registrar lacked evidence that the registered owner in *Tucumcari* had direct or indirect control over the goods at issue. Furthermore, I would add that, the question in *Tucumcari* regarded whether adequate requisite control existed through sub-licensing arrangements.

[26] Lastly, the Owner submits that the Requesting Party's submissions concerning the use of the Marks being within Time's normal course of trade are inconsistent with the Federal Court's decision in *Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD). In that case, it was held that the words "normal course of trade" contemplate a chain of commercial events beginning with the manufacturer, ending with a consumer and with a wholesaler or retailer as intermediary. Further, if any part of that chain takes place in Canada, then the trademark owner uses the trademark within the meaning of section 4 of the Act.

[27] The Owner submits, and I agree, that as it is the provider of the content of the BAKE OFF cookbooks, it serves as the beginning of the chain of transfer in possession or property in the goods, which are ultimately sold in Canada. Furthermore, the evidence clearly demonstrates that a substantial amount of BAKE OFF cookbooks were sold in Canada by the Owner's licensee, Time. I will add that the inclusion of a hyphen in the Mark as it appears on the cover of the cookbook shown in Exhibit E constitutes a minor deviation, whereby the dominant feature of the Mark, namely the words "BAKE OFF", has been preserved.

[28] Having regard to the aforementioned, I am satisfied that the Owner has shown use of the Mark in association with the registered goods within the meaning of sections 4(1) and 45 of the Act.

TMA348,913 – Services

[29] With respect to registration No. TMA348,913 registered in association with "Cooking contests for the purpose of promoting and creation of new recipes", the Requesting Party submits that by the Owner's own admission, the Mark has not been used in association with the registered services. This submission is in reference to Mr. Irby's statement that the contest has not yet been held in Canada. The Requesting Party submits that broadcasting a contest that is unavailable in Canada does not constitute statutory use of contest services as per section 4(2) of

the Act. The Requesting Party further submits that Mr. Irby does not even assert that the contest was open to Canadian entries nor has any evidence been provided of how one could enter the contest. The Requesting Party submits that the Owner is attempting to conflate the use of the Marks in association with goods with use in association with services, and a party cannot rely on use of a mark in association with goods as evidence of use of the registered services [citing *MB Research & Development Ltd v MacMillan Bloedel Ltd* (1997), 75 CPR (3d) 283 (TMOB)].

[30] The Owner submits that the affidavit of Mr. Irby provides clear evidence of the interrelatedness of the contest and the cookbooks. The Owner further submits that the public benefits from the Owner's contest services, which were made available for the Canadian public to view within the relevant period. The Owner submits that the explicit purpose of those services identified in the registration, as "the purpose of promoting the creation of new recipes", is achieved through television viewing as well as through actual competition.

[31] While I agree that the evidence supports that the Owner's contest promotes the creation of new recipes, it does so in the United States, as contestants in the United States, where the contest is based, create new recipes to enter and vie to win the contest, as is evident from the publishing of the contest finalist's recipes. However, there is no evidence that Canadians can enter the contest (thus no evidence of the creation of new recipes by Canadians), and no evidence that the broadcast of a contest only available to entrants in the United States promotes the creation of new recipes in Canada. I would add that the evidence does not show the Mark being used during the broadcast. Moreover, it appears that the interconnectedness of the goods and services, in Canada, is that the broadcast of the contest only available to participants in the United States is advertising, and serves to promote the sale of the cookbooks in Canada. Thus, evidence of merely being able to view a service conducted outside of Canada, does not constitute use of a mark in Canada for the purposes of section 4(2) of the Act [see *Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[32] Having regard to the aforementioned, I am not satisfied that the Owner has shown use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

DISPOSITION

[33] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA305,664 will be maintained, however, registration No. TMA348,913 will be expunged in compliance with the provisions of section 45 of the Act.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

Deeth Williams Wall LLP

FOR THE REGISTERED OWNER

Gowling WLG (Canada) LLP

FOR THE REQUESTING PARTY