



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 120

Date of Decision: 2020-10-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling WLG (Canada) LLP

Requesting Party

and

ZICAFFE' S.p.A.

Registered Owner

**TMA619,911 for ZI CAFFE (&
DESIGN)**

Registration

INTRODUCTION

[1] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on May 19, 2017, to ZICAFFE' S.p.A., the registered owner of registration No. TMA619,911 for the trademark ZI CAFFE (& DESIGN) (the Mark), shown below:



[2] The Mark is registered for use in association with the goods “Coffee (coffee beans, ground coffee), blends of coffee.”

[3] The notice required the Owner to show whether the Mark had been used in Canada in association with the registered goods 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 such use since that date. In this case, the relevant period for showing use is May 19, 2014, to May 19, 2017.

[4] For the reasons that follow, I conclude that the registration ought to be maintained.

[5] The relevant definition of use in the present case is set out in section 4(1) 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.

[6] It is well established that bare statements that a trademark is in 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)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] In response to the Registrar’s notice, the Owner furnished the affidavit of Vito Michele Zichittella, sworn November 28, 2017. Only the Requesting Party submitted written representations and was represented at an oral hearing.

THE OWNER'S EVIDENCE

[8] Mr. Zichittella is the Legal Representative of the Owner. He states that in the normal course of trade, the Owner sells its coffee goods directly to distributors in Canada. As Exhibit A-1 to his affidavit, he attaches “four representative invoices, evidencing sales in Canada” of the Owner’s goods. The invoices show sales during the relevant period to a retailer in British Columbia of the following products: “Aromatica” and “Zidec”, which Mr. Zichittella correlates with ground coffee; “Antico Aroma”, “Gustosa”, and “Dolce”, which Mr. Zichittella correlates with coffee beans; and “Crema in tazza”, which Mr. Zichittella correlates with coffee beans.

[9] As Exhibit A-2, Mr. Zichittella attaches photographs of packaging for ground coffee and blend coffee. Further images of packaging for products identified as “Aromatica”, “Zidec”, “Antico Aroma”, “Gustosa”, “Dolce”, and “Crema in tazza” are shown in screenshots from the Owner’s website, attached as Exhibit A-3. Mr. Zichittella states that these are the goods listed in the invoices, and that while the latter screenshots were taken after the relevant period, the same packaging was used for these goods in Canada during the relevant period. The packaging shown in the exhibits displays logos which include elements of the Mark, including the cursive “Zi” with a coffee bean design replacing the dot of the “i”, but with the word “zicaffé” replacing the word “caffé” beneath the cursive letters, as shown below:



[10] In the case of the “Zidec” product, the word “DEC” appears below the cursive “Zi” instead of “zicaffé” or “caffé”. In some instances, these elements are surrounded by a coloured box or border. On the invoices, but not on the packaging, the words “INDUSTRIA DI TORREFAZIONE DAL 1929” appear beneath the logo.

ANALYSIS

[11] The Requesting Party raises three issues with the Owner's evidence: first, that the packaging shown in evidence does not display the Mark as registered, second, that the display of the logo on the invoices does not establish use of the Mark in association with the registered goods, and third, that the invoices do not establish that any of the registered goods were actually transferred during the relevant period. Each submission will be addressed in turn.

Display of the Mark as Registered

[12] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed 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 registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[13] The Requesting Party observes that the logo shown on the packaging contains the coined word "zicaffé" rather than the dictionary word "café", and notes that "zicaffé" is presented as a single word in the same font, size and colour such that it is likely to be viewed as a single element or expression. The Requesting Party further notes that some instances of the logo feature a box or border, and finally that some of the photographs are sufficiently blurry that it is ambiguous as to whether the coffee bean design appears in the logo shown on the packaging. The Requesting Party submits that these variations are such that the dominant elements of the Mark have not been preserved on the packaging shown in evidence. In support, it cites *Mantha & Associates v Cravatte di Pancaldi SrL* (1997), 79 CPR (3d) 382 [*Cravatte di Pancaldi*], in which the Registrar found that the addition of a second word in the same font and size to the design mark VITALIANO & Design served to create a trademark that was quite different from the mark as registered. Similarly, the Requesting Party cites *Farris, Vaughan, Wills & Murphy v Sav-On*

Drugs Ltd (1997), 79 CPR (3d) 570 [*Sav-On Drugs*], in which the Registrar found that use of the words “SAV-ON DRUG MART”, with the word “MART” in the same font and size as the other words, was not sufficient to maintain use of the word mark “SAV-ON DRUGS”.

[14] In this case, I consider the dominant element of the Mark to be the cursive “Zi”, including the bean design element, which is much larger and more stylized than the word “caffé”. While some of the images attached to Mr. Zichittella’s affidavit are blurry, the cursive Zi and bean design appear consistently on the packaging shown in evidence. Despite the substitution of the word “zicaffé” for the word “caffé”, and the fact that the elements are set against a coloured background or framed by a square, I am satisfied that the logo maintains the dominant features of the Mark such that the Mark has not lost its identity and remains recognizable.

[15] I would further note that the formulation of the logo reproduced above, substituting “zicaffé” for “caffé” and not including the additional Italian text, appears on packaging for products that Mr. Zichittella correlates with each of the registered goods. Accordingly, it is not necessary for me to consider whether the other evidenced variations of the logo substituting “DEC” for “caffé”, or including the additional Italian text, would constitute use of the Mark as registered.

[16] This case is distinguishable from *Cravatte di Pancaldi* and *Sav-On Drugs*, as those cases involved the addition of textual materials that were the same size as the dominant textual elements in those trademarks, while this case involves the addition of textual elements that are significantly smaller and secondary to the dominant element of the Mark. I note that additions or variations of secondary textual elements in a design mark, or changes to background colour and framing, have been found to be permissible deviations so long as the dominant elements of the design mark have been preserved [see, for example, *Hoa Pin Wei Biotech & Food Co, Ltd v Hai Pa Wang International Group Corp*, 2020 TMOB 79 at paras 14-15; *Aird & Berlis LLP v Sonaco SARL*, 2014 TMOB 37 at para 13; *Brouillette & Associés/Partners v Constellation Brands US Operations, Inc*, 2016 TMOB 159 at paras 19-20].

[17] As such, comparing the Mark to the logo displayed on the packaging, the dominant feature of the Mark, namely, the cursive “Zi” with the bean design, is still present in the logo

shown in evidence. This dominant feature having been preserved, I conclude that the evidenced display of the logos on the Owner's coffee packages constitutes use of the Mark.

[18] As such, it is not necessary to consider the second issue of whether the goods would have been associated with the logo displayed on the invoices at the time of transfer, given that the appearance of the Mark on the packaging of those goods is sufficient to establish notice of association within the meaning of section 4(1) of the Act.

Transfer of the Goods

[19] With respect to the question of transfer of the goods in Canada during the relevant period, the Requesting Party states that aside from Mr. Zichittella's "bare allegations of sales", there is no evidence that the sales in relation to the invoices were actually completed, noting that the invoices are not signed by their purported recipient. As such, the Requesting Party submits that it cannot be inferred that transfer of property or possession of the goods occurred during the relevant period.

[20] However, Mr. Zichittella confirms in his affidavit that the invoices attached as Exhibit A-1 are "representative invoices, evidencing sales in Canada". This is not a bare statement of use, as submitted by the Requesting Party, but a sworn statement of fact that goods were sold in Canada, supported by representative invoices reflecting such sales. Although the Requesting Party submits that the Owner has not provided confirmation that the goods were actually shipped or transferred to the customer, it would be evidentiary overkill to require a registered owner to provide evidence that possession of the goods was actually transferred where that owner has provided a sworn statement that a sale took place as well as invoices detailing such sales.

[21] As the invoices show sales of each of the registered goods in Canada during the relevant period, and the photographs show that the Mark was displayed on the packaging of such goods, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the registered goods.

DISPOSITION

[22] In view of all of 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.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE 2020-10-14

APPEARANCES

No one appearing

For the Registered Owner

Monique Couture

For the Requesting Party

AGENTS OF RECORD

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For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party