



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2025 TMOB 36

Date of Decision: 2025-02-27

IN THE MATTER OF AN OPPOSITION

Opponent: Consorzio Per La Tutela Del Formaggio Asiago

Applicant: Consortium for Common Food Names Holdings Inc.

Application: 2071324 for ASIAGO STYLE CCFN & Design

INTRODUCTION

[1] Consorzio Per La Tutela Del Formaggio Asiago (the Opponent) opposes registration of the trademark ASIAGO STYLE CCFN & Design (the Mark), which is the subject of application No. 2071324 by Consortium for Common Food Names Holdings Inc. (the Applicant). The Mark is shown below.



[2] The Mark is applied for in association with the goods “Cheese”.

[3] The opposition is primarily based on an allegation that the Mark is not registrable due to “Asiago” being a protected geographical indication that identifies a type of cheese.

THE RECORD

[4] The application for the Mark was filed on December 16, 2020. The application was advertised for opposition purposes on August 17, 2022.

[5] On February 17, 2023, the Opponent opposed the application by filing a statement of opposition under section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). The grounds of opposition are based on non-registrability pursuant to sections 38(2)(b) and 12(1)(h.1) of the Act; that the Applicant was not using and did not propose to use the Mark, pursuant to section 38(2)(e) of the Act; and bad faith pursuant to section 38(2)(a.1) of the Act.

[6] The Applicant filed a counter statement that it intended to respond to the opposition.

[7] In support of its opposition, the Opponent filed a certified copy of the subject application and the affidavit of John Adam Aucoin, sworn August 3, 2023 in Toronto (the Aucoin Affidavit).

[8] In support of its application, the Applicant filed the affidavit of Dulce Campos, sworn December 4, 2023 in Vancouver (the Campos Affidavit), and the affidavit of Bronwen Jamison, sworn December 4, 2023 in Vancouver (the Jamison Affidavit).

[9] None of the affiants were cross-examined.

[10] Both parties submitted written representations and were represented at a hearing.

OVERVIEW OF THE OPPONENT'S EVIDENCE

Aucoin Affidavit

[11] Mr. Aucoin is an associate employed by the Opponent's agent of record [para 1]. The Aucoin affidavit provides the following:

- Particulars of geographical indication No. 1858648 for Asiago [para 4, Exhibit A].
- Particulars of sections 114, 115, 116 and Schedule 6 of the *Canada-European Union Comprehensive Economic and Trade Agreement Implementation Act*, SC 2017, c 6 [para 5, Exhibit B].
- Printouts of pages from what appears to be the Applicant's website (but which the Applicant disputes in its representations), *commonfoodnames.com* [para 6, Exhibits C1 to C4].
- Printouts of webpages from what appear to be various third-party websites relating to asiago cheese sold in the United States [paras 7 and 8, Exhibits D1, D2 and E1 to E4].
- Printouts from the United States Patent and Trademark Office website pertaining to U.S. trademark application no. 90106567 for a variation of the Mark (i.e., without the "-STYLE" element) [para 9, Exhibits F1 to F5].

[12] I note that Mr. Aucoin makes no substantive statements regarding the meaning or relevance of these printouts.

OVERVIEW OF THE APPLICANT'S EVIDENCE

Jamison Affidavit

[13] Ms. Jamison is a law librarian, employed by the Applicant's agent of record [para 1]. The Jamison Affidavit essentially consists of the following:

- Printouts from the United States Patent and Trademark Office's document retrieval website, *tsdr.uspto.gov*, regarding now-abandoned application number 77/073030 in respect of the word "Asiago", filed in the name of the Opponent [para 4, Exhibit 1].

- Printout of the entry for “Asiago cheese” from the website *wikipedia.org* [para 5, Exhibit 2].
- Printout from the website for the *Comprehensive Economic and Trade Agreement* (CETA) between Canada and the European Union regarding “Chapter Twenty – ‘Intellectual Property’ Sub-Section C Geographical Indications Article 20.21 under ‘Exceptions’”, found at *policy.trade.ec.europa.eu* [para 6, Exhibit 3].

[14] I note that Ms. Jamison makes no substantive statements regarding the meaning or relevance of these printouts.

Campos Affidavit

[15] Ms. Campos is a trademark researcher employed by the Applicant’s agent of record [para 1]. The Campos Affidavit essentially consists of printouts of the following from the Canadian trademarks register:

- Certified copy of registration No. TMA1150600 for the trademark FETA STYLE CCFN & Design, registered in the name of the Applicant [para 4, Exhibit 1].
- Certified copies of various third-party registrations for design marks, registered in association with various alcoholic beverage goods [paras 5 to 12, Exhibits 2 to 9].
- Particulars of Geographical Indication 849997 for Scotch Whisky and Geographical Indication 1203996 for Irish Cream Liqueur [paras 13 and 14, Exhibits 10 and 11].

[16] I note that Ms. Campos makes no substantive statements regarding the significance of these registrations or geographical indications.

EVIDENTIAL BURDEN AND LEGAL ONUS

[17] In accordance with the usual rules of evidence, there is an evidential burden on the Opponent to prove the facts inherent in its allegations pleaded in the statement of opposition [*John Labatt Ltd v Molson Companies Ltd* (1990), 30 CPR (3d) 293 (FCTD)].

The presence of an evidential burden on the Opponent with respect to a particular issue means that in order for the issue to be considered at all, there must be sufficient evidence from which it could reasonably be concluded that the facts alleged to support that issue exist.

[18] For those allegations for which the Opponent has met its evidential burden, the legal onus is on the Applicant to show that the application does not contravene the provisions of the Act as alleged in the statement of opposition. The presence of a legal onus on the Applicant means that, if a determinate conclusion cannot be reached once all the evidence has been considered, then the issue must be decided against it.

NOT REGISTRABLE – SECTION 12(1)(H.1) GROUND

[19] In the preamble to the specific grounds of opposition set out in the statement of opposition, the Opponent pleads the following:

- The Opponent is the institution authorized by the government of Italy to coordinate, manage and protect the “ASIAGO Protected Designation of Origin (the ASIAGO DOP)”.
- The ASIAGO DOP identifies “a cheese produced in a delimited territory in the northeast of Italy in compliance with rules set forth in the relevant Product Specification”.
- In Canada, “Asiago” has been protected as a geographical indication (No. 1858648) since September 21, 2017 in association with the goods “cheese” and the territory description of “Italy”.
- The protection of Asiago as a geographical indication has been granted pursuant to the *Canada-European Union Comprehensive Economic and Trade Agreement Implementation Act*.
- The Opponent is an association of authorized users of the ASIAGO DOP, namely those involved in the production activities of milk production, cheese making, cheese aging and/or packaging in association with the ASIAGO DOP.

- The Opponent is responsible, on behalf of its members and all the products of the ASIAGO DOP cheese, for protecting against improper adoption of the ASIAGO DOP in Canada.

[20] Accordingly, the Opponent pleads that the Mark is not registrable under section 12(1)(h.1) of the Act, which gives effect to Article 20.19(6) *Canada-European Union Comprehensive Economic and Trade Agreement*, because it is in whole or in part a protected geographical indication identifying a food product and because registration is sought in association with a food product not originating in the territory indicated by the geographical indication. In this respect, the Opponent further pleads that the Mark is in whole or in part the protected geographical indication Asiago (No. 1858648) identifying cheese originating in Italy, and the Applicant is seeking to register the Mark in association with a cheese not originating in Italy.

[21] Section 12(1)(h.1) of the Act provides as follows:

12. (1) ... a trademark is registrable if it is not ...

(h.1) in whole or in part a protected geographical indication, and the trademark is to be registered in association with an agricultural product or food – belonging in the same category, as set out in the schedule, as the agricultural product or food identified by the protected geographical indication – not originating in a territory indicated by the geographical indication ...

[22] Section 11.2(3) of the Act sets out exceptions, as follows:

11.2 ... (3) Section 11.15 and paragraph 12(1)(h.1) do not prevent the adoption, use or registration as a trademark in association with an agricultural product or food of a category set out in the schedule of a protected geographical indication, or any translation of it in any language, by a person if they have, in good faith, before the day on which a statement by the Minister is published under subsection 11.12(2) or (2.1) in respect of the indication or translation,

(a) filed an application in accordance with section 30 for, or secured the registration of, the trademark in association with an agricultural product or food belonging to the same category; or

(b) acquired rights through use to the trademark in respect of an agricultural product or food belonging to the same category.

[23] However, as discussed below, these exceptions regarding registrability are not applicable and were not at issue in this case.

[24] In their written representations and at the hearing, the parties also made reference to sections 11.15 (regarding the prohibited *adoption* of a geographical indication) and 11.17(3) and (4) of the Act (which sets out certain exceptions regarding *use* of particular indications, including Asiago), as follows:

Prohibited adoption of indication for agricultural products or food

11.15 (1) No person shall adopt in connection with a business, as a trademark or otherwise,

(a) a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that does not originate in the territory indicated by the protected geographical indication; or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

Prohibited use

(2) No person shall use in connection with a business, as a trademark or otherwise,

(a) a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that does not originate in the territory indicated by the protected geographical indication or adopted contrary to subsection (1); or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

Prohibited use

(3) No person shall use in connection with a business, as a trademark or otherwise,

(a) a protected geographical indication identifying an agricultural product or food of a category set out in the schedule in respect of an agricultural product or food belonging to the same category that originates in the territory indicated by the protected geographical indication if that agricultural product or food was not produced or manufactured in accordance with the law applicable to that territory; or

(b) a translation on the list kept under subsection 11.12(1) of the protected geographical indication in respect of that agricultural product or food.

Use — certain cheeses

11.17 ... (3) Section 11.15 does not apply to the use, in connection with a business, of any of the indications “Asiago”, “Feta”, “Φέτα” (Feta), “Fontina”, “Gorgonzola” or “Munster”, or any translation of them in any language, by a person if they or their predecessor in title used the indication or the translation in relation to any business or commercial activity in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, before October 18, 2013.

Use with qualifying term

(4) Section 11.15 does not apply to the use, in connection with a business, of any of the indications “Asiago”, “Feta”, “Φέτα” (Feta), “Fontina”, “Gorgonzola” or “Munster”, or any translation of them in any language, in respect of an agricultural product or food of the category of cheeses, as set out in the schedule, if

(a) a qualifying term such as “kind”, “type”, “style” or “imitation” is used in connection with the indication or the translation; and

(b) the geographical origin of the cheese is clearly displayed on the cheese or on the packaging in which it is distributed, or is in any other manner associated with the cheese so that notice of the cheese’s origin is given to the person to whom the cheese is transferred.

[25] As pleaded by the Opponent, I note that, on September 21, 2017, the geographical indication “Asiago” was entered on the list in association with the goods “Cheeses” with a territory description of “Italy”, and the responsible authority identified as “As per the Canada-European Union Comprehensive Economic and Trade Agreement Implementation Act / Selon la Loi de mise en oeuvre de l’Accord économique et commercial global entre le Canada et l’Union européenne”.

[26] The parties agree that the material date for this ground appears to be the date of this decision [see also, by analogy, *Instituto Dos Vinhos Do Douro e Do Porto, I.P. v SALENTEIN ARGENTINA B.V.*, 2024 TMOB 225 at para 63]; however, I note that the analysis below does not fundamentally differ if an earlier material date is considered.

[27] In its written representations at paragraph 42, the Opponent cites section 4.7.16 of the *Trademarks Examination Manual* for its summary of the applicable statutory regime, as follows:

If the [applied-for] trademark is in whole or in part a protected geographical indication and the application covers wines or spirits not originating in a territory indicated by the geographical indication, or the application covers an agricultural product or food

belonging to the same category as the agricultural product or food identified by the geographical indication and not originating in a territory indicated by the geographical indication, the application is contrary to paragraph 12(1)(g), (h) or (h.1) of the Act, as applicable.

To overcome an objection raised pursuant to paragraph 12(1)(g), (h) or (h.1), the applicant must provide a written statement that the goods originate in a territory indicated by the geographical indication.

[28] Referencing the evidenced certified copy of the subject application's file history, the Opponent notes that, during the examination process, the Registrar did not raise an objection pursuant to section 12(1)(h.1) of the Act, and that the file history of the application does not include any statement from the Applicant that the "Cheese" goods covered by the application originate in Italy [Opponent's written representations at para 18].

[29] At the hearing, the Opponent speculated that, during examination of the subject application, the Registrar simply erred by not raising an objection and/or not requesting the written statement from the Applicant that the applied-for goods originate in Italy. For its part, the Applicant argued that the Registrar did not so err, submitting that the applied-for Mark does not actually give rise to an objection pursuant to section 12(1)(h.1) of the Act, as the Mark is not, in fact, "in whole or in part" the geographical indication Asiago.

[30] In this respect, in its written representations [paras 32 to 34], the Applicant submits the following:

- The Mark is a composite unitary design which includes, as a small portion, the unitary trademark/expression ASIAGO-STYLE.
- The unitary expression ASIAGO-STYLE is less than 20% of the entire applied-for "composite visual design mark".
- ASIAGO-STYLE is in compliance with the exception set out in section 11.17(4) of the Act, which permits use of the indication Asiago when used in connection with a qualifying term such as "style".

- Although this exception relates to “use”, the Act “is silent with respect to registration which is not to imply that it is not proper subject matter”.
- The registrability of the Mark “is in keeping with recently accepted marks previously registered in similar unitary composite designs”, including terms such as “feta-style”, “blended scotch whiskey”, and “Irish style cream liqueur”.
- The state of the Canadian trademarks register “leads to the inference that not only consumers but [also the Registrar] have become accustomed to seeing and recognizing that the accepted and registered composite design marks in the same or related agricultural or wine/spirits channels of trade can exist on the register”.

[31] In support, the Campos Affidavit evidences certified copies of nine trademark registrations, including registration No. TMA1150600 for the trademark FETA STYLE CCFN & Design, registered in the name of the Applicant. I note that this registered design mark, shown below, is similar to the applied-for Mark:



[32] However, as discussed at the hearing, the circumstances regarding the registration of these nine trademarks has not been evidenced. As described above, there are exceptions to the non-registrability of trademarks that are, in whole or in part, a geographical indication. Such exceptions may have applied in these cases. However, regardless of the circumstances, even if these trademarks were registered in error, it is trite law that if the Registrar has erred in the past, there is no reason to perpetuate that error [*Worldwide Diamond Trademarks Limited v Canadian Jewellers Association*, 2010 FC 309 at para 52; aff'd at 2010 FCA 326].

[33] In view of the foregoing, I find that the state of the register evidence is of no assistance to the Applicant in this proceeding.

[34] Otherwise, I agree with the Opponent that the Applicant's arguments regarding how the Act should be interpreted and applied in the present case should be rejected. Whether or not the expression "ASIAGO-STYLE" is characterized as unitary – and whether or not the STYLE element is read as modifying the ASIAGO element – it remains that the Mark is, in part, the protected geographical indication "Asiago". Indeed, the language in section 11.17(4)(a) of the Act contemplates that a qualifying term such as "style" can be used *in connection with* an indication, not that presence of the indication is somehow negated by the qualifying term.

[35] As noted above, in this case, the exceptions to non-registrability do not apply. Furthermore, the exceptions regarding "use" or "adoption" are not relevant to the determination of registrability in this case.

[36] It follows that the Applicant has not met its legal onus to show, on a balance of probabilities, that the Mark is registrable in view of section 12(1)(h.1) of the Act.

[37] Accordingly, the non-registrability ground of opposition is successful.

NOT USING AND DID NOT PROPOSE TO USE – SECTION 38(2)(E) GROUND

[38] The Opponent pleads that, at the filing date of the application in Canada, the Applicant was not using and did not propose to use the Mark in association with the goods identified in the application. In this respect, the Opponent further pleads that the Applicant was not using and did not propose to use the Mark for the following reasons:

- The Applicant did not engage and did not propose to engage in the manufacturing of the applied-for goods;
- The Applicant did not own or operate and did not propose to own or operate a facility in Canada in which it could produce the applied-for goods or from which it could distribute such goods;
- The Applicant did not have and did not propose to have an agreement with a distributor in Canada to distribute the applied-for goods;

- The Applicant did not have and did not propose to have the facilities or knowhow in Canada or anywhere else required to manufacture the applied-for goods;
- The Applicant did not and did not propose to associate the Mark with the applied-for goods in a manner that would constitute “use” under section 4 of the Act;
- The Applicant did not and did not propose to associate the Mark with the applied-for goods in such a way that the Mark would function as a trademark within the meaning of the term in section 2 of the Act; and/or
- The Applicant did not and did not propose to adopt the Mark as a certification mark and, specifically, the Applicant did not propose to register the Mark in order to license to others the right to use the Mark for the purpose of distinguishing or so as to distinguish goods that are of a defined standard from those that are not of that defined standard.

[39] The material date for this ground of opposition is the filing date of the application.

[40] In my view, this kind of “kitchen sink” pleading pursuant to section 38(2)(e) of the Act is both inappropriate and insufficient. Despite the numerous allegations, the Opponent has not plead how the Applicant did not or could not have proposed to use the Mark. In this respect, section 30(1) of the Act states as follows:

30(1) A person may file with the Registrar an application for the registration of a trademark in respect of goods or services if they are using or propose to use, and are entitled to use, the trademark in Canada in association with those goods or services.

[41] The effect of section 30(1) of the Act is that an applicant necessarily proposes to use the applied-for trademark if they are not using that trademark as of the filing date of the application. Whether or not an applicant “proposed to” engage in the particular pleaded activities is not within the scope of section 38(2)(e) of the Act. With the amendments that came into force in June 2019, section 30 of the Act (re: “Contents of application”) was notably amended to remove the requirement to include in an application – in the case of a proposed trademark – a statement that the applicant

“intends to use” the trademark. This removed the language of “intends to use” from the Act in favour of the abovementioned language and structure regarding “propose to use”. In my view, these were not superficial or merely semantic changes, in particular given the new bad faith ground that can be properly utilized to address issues of, *inter alia*, trademark “squatting” or “trafficking” [see, for example, *Honor Device Co., Ltd. v Shenzhen Honor Electronic Co., Ltd*, 2024 TMOB 49 at para 50; *Mahindra & Mahindra Limited v Pawandeep Dhunna*, 2024 TMOB 69 at para 49; and *Moca Loca Coffee Co Inc v Monster Energy Company*, 2024 TMOB 129 at para 92].

[42] In other words, the absence of an active business operation in Canada does not disqualify an applicant from proposing to use its trademark by applying for registration of that trademark pursuant to section 30 of the Act. Section 38(2)(e) of the Act is not intended to look behind an applicant’s business plans, timeframe or means of using its proposed trademark; as of the material date, an applicant need not have a business plan or resources to propose to use a trademark. In this regard, the definition of “use” as set out in section 4 of the Act is broad and, as noted by the Applicant, section 50 of the Act contemplates licensed use of a trademark. I further agree with the Applicant that the mere fact that it has “not yet set up any licensees in Canada” for use of the Mark is irrelevant [Applicant’s written representations at para 39]. To the extent non-use is or may become an issue, expungement proceedings under section 45 may apply at the appropriate time.

[43] As such, speculative pleadings such as this regarding an applicant’s alleged lack of a plan or resources to actually use the Mark are necessarily insufficient to support a ground pursuant to section 38(2)(e) of the Act.

[44] In any event, the Opponent’s evidence falls well short of evidencing any of its pleadings under this ground.

[45] As the Opponent properly focused on the section 12(1)(h.1) ground of opposition at the hearing, it was largely unnecessary for the parties to thoroughly address the probative value of the Opponent’s evidence in their representations. However, I first note that Mr. Aucoin makes no substantive statements in support of the Opponent’s

allegations under this ground. Indeed, to the extent the exhibits to the Aucoin Affidavit largely comprise hearsay, the criteria of necessity and reliability are not satisfied in this case. At most, Mr. Aucoin has evidenced that the exhibited webpages existed – but the Opponent has not evidenced the truth of their contents.

[46] Even if I were to accept the website printouts for what they are as reliable, it is at best not clear why the Opponent furnished its evidence through Mr. Aucoin rather than a principal of the Opponent, who would be knowledgeable regarding the Opponent's allegations as pleaded and could be appropriately subject to a meaningful cross-examination. In this respect, generally, an affidavit of an employee of an agent's firm is admissible only to the extent that the evidence relates to non-controversial and non-central matters [*Cross Canada Auto Body Supply (Windsor) Limited et al v Hyundai Auto Canada*, 2005 FC 1254, aff'd 2006 FCA 133].

[47] In view of the foregoing, at a minimum, I find that the Opponent has not met its initial evidential burden under this ground.

[48] Accordingly, the ground based on section 38(2)(e) of the Act is rejected.

BAD FAITH – SECTION 38(2)(A.1) GROUND

[49] Pursuant to section 38(2)(a.1) of the Act, the Opponent pleads that the Applicant filed the application for the Mark in bad faith, because it was filed for the purpose of detracting from the rights of the Opponent to the protected designation of origin ASIAGO and for the purpose of undermining the intention of Parliament in passing the *Canada-Europe Union Comprehensive Economic and Trade Agreement Implementation Act*. In this respect, the Opponent further pleads that the Applicant filed the application for the purposes of furthering its agenda to protect the term ASIAGO as an allegedly generic food name rather than out of a bona fides intention to use the Mark as a trademark, noting that the Applicant describes itself as an "International Initiative to Preserve the Right to Use Generic Food Names".

[50] In my view, the pleading is insufficient, as it does not identify the prior relationship between the parties and the relevant obligation or duty owed by the

Applicant to the Opponent; absent such a prior relationship or duty owed, it is at best not clear how the pleading can amount to one of “bad faith”. Absent further context (for example, a prior determination regarding the relevant rights of the parties by a court of competent jurisdiction; a pattern of abuse of process; trademark trafficking, etc.), a competing “agenda” does not make for an application filed in bad faith.

[51] In any event, again, Mr. Aucoin makes no substantive statements in support of this ground of opposition. Furthermore, whatever inference is meant to be made from the printouts from the *commonfoodnames.com* website is moot, as the exhibited webpages constitute inadmissible hearsay evidence in this case. Evidence in support of a bad faith ground is properly furnished through a person with knowledge of the opponent’s allegations as pleaded and who can be appropriately subject to a meaningful cross-examination.

[52] In view of the foregoing, at a minimum, I find that the Opponent has not met its initial evidential burden under this ground.

[53] Accordingly, the bad faith ground of opposition is rejected.

DISPOSITION

[54] In view of all of the foregoing, pursuant to section 38(12) of the Act and the authority delegated to me under section 63(3) of the Act, I refuse the application.

Andrew Bene
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2025-01-30

APPEARANCES

For the Opponent: Jonathan Burkinshaw

For the Applicant: Trisha A. Doré and Jonathan Woolley

AGENTS OF RECORD

For the Opponent: Smart & Biggar LP

For the Applicant: Richards Buell Sutton LLP