

## TRADUCTION/TRANSLATION



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

**Citation: 2010 TMOB 151**  
**Date of Decision: 2010-09-14**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Baker & McKenzie LLP, against  
registration No. TMA525,425 for the trade-mark KAILO  
BRAND & Design in the name of Paris Store SA**

[1] On August 19, 2008, at the request of Baker & McKenzie LLP (the Applicant), the Registrar forwarded a notice pursuant to section 45 of the *Trade-Marks Act*, R.S.C. 1985, c. T-13 (the Act), to Paris Store SA (the Owner), requiring it to show the use of the trade-mark KAILO BRAND & Design (the Mark), the subject of certificate of registration number TMA525,425.

[2] That certificate of registration covers the following wares and services:

Meat, namely meat extract, jellied meat, meat juice, meat paste, meat spread, cold meat, dried meat, fish, shellfish, poultry and game meat, meat extracts, tinned, dried and cooked fruit and vegetables; jellies, jams, compotes, eggs, milk and dairy products, namely milk, yogurt, ice cream, cheese, cream, milk flavoured, butter, edible oils and greases. Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes, flours and cereal preparations, namely bread, pastry, oatmeal, noodles, confectionary, namely candies, chocolate, nougat, pralines, frozen treats, honey, molasses, yeast, leavening powder, salt, mustard, vinegar, sauces (condiments); spices, cooling ice. Products agricultural, horticultural, forest, not prepared or transformed, namely seeds, live animals, fresh fruits and vegetables, seeds, natural plants and flowers; animal feed, namely meal, feed for livestock, for pork, for pets, malt. Beers, mineral waters and carbonated waters and other beverages non-alcoholic, namely fruit beverages, namely fruit juice crystals, fruit punch and fruit juice, namely fresh fruit juice in bottles, tins or frozen, syrups and other preparations for making beverages, namely preparations in concentrate, liquid or crystal form, made with fruits or plants, for making liqueurs by

adding yeasts or alcohol. Alcoholic beverages (except beers) namely wine, vodka, rum, gin, cherry, port, vermouth (the Wares); and

Food services (alimentation), café restaurants, cafeterias, cantines, fast-food and permanent restaurants, caterers, making dishes for take-out, bars (the Services).

[3] Section 45 of the Act requires the owner of a trade-mark to show that it was in use in Canada in association with each of the wares and/or services specified in the registration at any time during the three-year period immediately preceding the date of the notice and, if not, to furnish the date when it was last so in use and the reason for the absence of such use since that date. Therefore, the relevant period in this case is from August 19, 2005, to August 19, 2008 (Relevant Period).

[4] Case law tells us that there is no need to show use of the mark by evidentiary overkill and that the purpose of section 45 proceedings is to remove the “deadwood” from the register [See *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (4th) 62].

[5] In response to the notice, the Owner filed the affidavit of Giang Leang, together with Exhibits P-1 and P-2. The parties filed brief written submissions, and neither party requested a hearing.

[6] Mr. Leang has been the managing director of the Owner since 1990. He alleged that the Owner sells and has sold the following products bearing the Mark over the last three years in Canada: flours and cereal preparations, namely noodles (the Products). This statement in itself is flawed in a number of respects. First, no reference was made to the other Wares and the Services. Furthermore, as his affidavit was dated February 5, 2009, his use of the words [TRANSLATION] “the last three years” covers the period from February 5, 2006, to February 5, 2009, extending beyond the Relevant Period.

[7] Nevertheless, the affidavit contains other allegations and refers to evidence. The evidence as a whole must therefore be considered.

[8] He filed photos of the packaging that is used and that has been used during the Relevant Period in Canada for Products bearing the Mark. The Products were sold during the Relevant Period in Canada through agents such as Central Asia Pacific Limited, Central Asia Pacific

Trading Co. Ltd. and Wing Man Trading Co. Ltd. He alleged that the Products were made in China according to the Owner's own specifications and quality standards.

[9] He filed specimens of invoices issued by some of the above-mentioned agents during the Relevant Period showing the sale in Canada of Products bearing the Mark. In his affidavit, he explained how the Products were identified in these invoices. He stated that the mark shown on the packaging in the photos, Exhibit P-1, is indeed the Mark.

[10] Lastly, he provided the approximate 2006 and 2007 sales figures in Canada for the Products bearing the Mark.

[11] I note that there are no circumstances alleged excusing the absence of use of the Mark in Canada during the Relevant Period in association with the Wares—besides the Products—and the Services. Moreover, the Applicant's written submissions are limited to this fact, and the Owner admitted that the evidence of use of the Mark on file is limited to the Products.

[12] I am satisfied that the evidence described above shows evidence of use of the Mark in Canada during the Relevant Period in association with the Products, within the meaning of subsection 4(1) of the Act. However, there is no evidence of use of the Mark for the other Wares and the Services, and the certificate of registration should be amended accordingly.

[13] Pursuant to the authority delegated to me under subsection 63(3) of the Act, registration number TMA525,425 will be amended so that the statement of Wares reads as follows:

Flours and cereal preparations, namely noodles.

As for the statement of Services, it will be expunged, the whole pursuant to section 45 of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

Certified true translation Tu-Quynh Trinh, Translator