

SECTION 45 PROCEEDINGS
TRADE-MARK: CHARLESTON CHEW & DESIGN
REGISTRATION NO.: TMA 220,535

On June 12, 2003 at the request of 88766 Canada Inc., the Registrar forwarded a Section 45 notice to Tootsie Roll Industries, Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark CHARLESTON CHEW & Design (shown below) is registered for use in association with the following wares: “candy”.



Section 45 of the *Trade-marks Act* requires the registered owner of a trade-mark to show that the trade-mark has been 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 preceding the date of the notice and, if not, to provide the date on which it was last so in use and the reason for the absence of such use since that date. The pertinent period in this case is between June 12, 2000 and June 12, 2003.

In response to the notice, the affidavit of Barry Bowen together with exhibits has been furnished. Each party filed a written argument and was represented at the oral hearing.

In his affidavit, Mr. Bowen states that during the relevant period, the registered owner continuously used in Canada the trade-mark CHARLESTON CHEW & Design in association with candy in the normal course of trade as described in his affidavit. He states that a candy bearing the trade-mark is manufactured by the registered owner in the United States where it is also packaged and shipped in finished form for sale at retail to Tootsie Roll of Canada Limited, its wholly owned subsidiary.

He adds that in order to assist Canadian purchasers, the Canadian selling agent, Tootsie Roll of Canada Limited, makes available brochures which display color samples of all the registered owner's candy products for which it acts as the Canadian selling agent and as Exhibit "A" he submits a sample of such a brochure. He then explains that the registered owner's candy is contained in wrappers, a sample of which he attaches as Exhibit "B". As Exhibit "C", he provides copies of representative invoices confirming the sale of candy bearing the trade-mark, through the Canadian distributor. He then provides Canadian sales figures for the registered wares associated with the trade-mark.

The requesting party argues that the affidavit should be construed without the exhibits or should be disregarded in its totality as there is a discrepancy between the date of swearing-in of the affidavit and the date appearing on the exhibits. In any event, it argues that the trade-mark allegedly used is not the trade-mark as registered and the product referred to in the exhibits associated with the trade-mark is not a "candy", as this term is generally construed.

The registrant submits that although the affidavit purports to be dated January 12, 2004, it was actually sworn before the Notary Public on January 22, 2004. It submits that it is clear from letter of January 12, 2004 from Ogilvy Renault (its representative for service) to the Canadian Intellectual Property Office which is of record that Mr. Bowen simply could not have executed the affidavit on that date since as stated in the letter of January 12, 2004, enclosing an unsigned copy of the affidavit, the affidavit had not yet been finalized and a one-month extension until February 12, 2004 was being requested in order to file the finalized affidavit and exhibits. Consequently, it submits that the obvious error on the face of the affidavit, namely the January 12, 2004 date set out in the jurat, is a mere technicality that does not affect the admissibility of the affidavit and its exhibits.

Concerning the evidence of use furnished it submits that the products that is being sold in association with the trade-mark is a candy and is referred to as a candy in the Bowen affidavit. Further, concerning the trade-mark shown to be in use it submits that it represents a valid derivative of the mark as registered. It argues that the differences between the two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods originating from the registered owner (*RTM v. Compagnie Internationale pour l'Informatique CII Honeywell Bull*, 4 C.P.R.(3d) 523 at 525 and *Swabey Ogilvy Renault v. Golden Brand Clothing (Canada) Ltd.*, 19 C.P.R.(4th) 516).

With respect to the swearing-in of the affidavit and exhibits, having regard to the explanation provided by the registrant and to Messrs Ogilvy Renault's correspondence of

January 12, 2004 which is of record, I am prepared to accept that the date which appears in the jurat is in error as it is clear that it was the date on the draft affidavit. Further, I am prepared to accept that the date that appears on the exhibits is the date the affidavit was actually sworn before the Notary Public. Accordingly I conclude that the discrepancy in this case is a mere technicality. Therefore, I will have regard to both the affidavit and exhibits in order to determine if use of the trade-mark has been shown in association with the registered wares.

First, concerning the trade-mark shown to be in use, I agree with the requesting party that the exhibits furnished feature a trade-mark that differs from the registered trade-mark. The trade-mark appears on a single line, the words “CHARLESTON” and “CHEW” are of equal importance and the exclamation mark has been omitted. However, I cannot agree with the requesting party that these deviations are substantial. As pointed out by the registrant the essential features of the registered trade-mark are the words CHARLESTON CHEW and such features have been preserved. Concerning the omission of the exclamation mark and the fact that both words CHARLESTON and CHEW appear on a single line, these, in my view, are minor variations not apt to deceive or injure the public in any way (*Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535). As I am of the view that the trade-mark has not lost its identity and remains recognizable (see *Promafil Canada Ltd. v. Munsingwear Inc.* 44 C.P.R.(3d) 59 [F.C.A.] and *Honey Dew Ltd. v. Rudd et al* (1929) Ex. C.R. 83), I conclude that the use shown constitutes use of the registered trade-mark.

As to whether the product that is being sold in association with the trade-mark is a “candy”, I am satisfied that it is. Mr. Bowen clearly identifies it as a candy. Further, although the Collins Dictionary of the English Language, 1986 edition has several definitions for the term “candy” one such definition is “confectionery in general” which would include the product the registrant sells. In addition to the above, I note that in Exhibit C to the affidavit, the registrant’s product is described as a “chewy flavoured nougat with a delicious chocolatey coating”. In the Wordsmyth English-Dictionary-Thesaurus online the term nougat is defined as: 1. a chewy or brittle candy that contains nuts and sometimes chunks of fruit. The Heinle’s Newbury House Dictionary of America English defines nougat as follows: a sweet candy made of honey or sugar and nuts. Consequently, these definitions clearly confirm that the registrant’s product is a “candy”.

Further, I am satisfied having regard to the evidence as a whole and particularly the fact that the product is manufactured and packaged by the registered owner, that the use shown is by the registered owner. Therefore as sales of the wares in Canada were made during the relevant period, I conclude that the trade-mark registration ought to be maintained.

Registration No. TMA 220,535 will be maintained in compliance with the provisions of
Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 4TH DAY OF MAY 2006.

D. Savard
Senior Hearing Officer
Section 45 Division