

SECTION 45 PROCEEDINGS
TRADE-MARKS: ROSE & Design; ZEST & Design
REGISTRATION NOS: TMA 318,652; TMA 401,491

At the request of Thai Indochine Trading Inc., represented by the firm Deeth Williams Wall, the Registrar forwarded Section 45 notices to Multifoods Inc., with respect to the above-noted trade-mark registrations. The notice with respect to the trade-mark ROSE BRAND & Design issued on September 21, 1995 while the notice with respect to the trade-mark ZEST & Design issued on September 27, 1995.

The trade-mark ROSE & Design (shown below) is registered for the following wares: pickles, pickled beets, mustard pickles; hot dog, hamburger, corn and tomato relishes.

The trade-mark ZEST & Design (reproduced below) is registered for the wares: (l) pickles, pickled vegetables, and relishes.

In response to the Registrar's notices, the registrant furnished in each case the affidavit of John McPherson, Group Product Manager for the registrant. Both parties filed written submissions and were represented at an oral hearing.

Concerning the trade-mark ROSE & Design, Mr. McPherson has conceded that it has not been in use in association with pickled beets and tomato relish. Accordingly, these wares will be deleted from Registration No. 318,652.

Concerning the evidence of use with respect to both trade-marks, Mr. McPherson has provided copies of invoices which he has stated represent sales in the ordinary course of the registrant's business. Mr. McPherson has submitted that "each of the "ROSE" products that is identified on the

invoices [or each of the ZEST products identified on the invoices] had a label that used the trade-mark that is the subject matter of Exhibit A”, (each Exhibit A consisting of a copy of the respective registration pages).

As Exhibit C, he has submitted labels showing the manner the registrant is using and has used each trade-mark as stated in the affidavits.

The requesting party’s main arguments are: (1) that the labels do not show use of the trade-marks as registered; (2) that there is no clear evidence that the labels (Exhibit C) represent the labels used with the wares when the wares were transferred; (3) that it is unclear whether the use is in the normal course of trade, and (4) that the use may not be by the registered owner.

Concerning the labels submitted for the trade-mark ROSE & Design, the requesting party argued at length concerning the particular design format of the trade-mark appearing thereon, and the appearance of additional matter, and submitted that the trade-mark appearing on the specimen labels did not constitute use of the trade-mark ROSE & Design as registered.

I respectfully disagree with the requesting party that the trade-mark as it appears on the specimen labels does not constitute use of the registered trade-mark.

The differences in the format are very minor and not important. As stated by the registrant, the size of the label varies depending on the size of the container on which it is affixed, but the mark in appearance is substantially the same. Concerning the additional matter, which consists of descriptive matter or generic matter such as the name of the wares, the ingredients, and the bar code, I am of the view that, notwithstanding such additional matter, the public would still perceive the trade-mark as registered “per se” to be in use. As I have stated above, the additional information consists of descriptive or generic matter and would be perceived as such. Furthermore, the visual impact of the mark as used is substantially the same as the mark as registered. In considering the issue, I have been guided by the opposition decision in Nightingale Interloc Ltd. v Prodesign Ltd., 2 C.P.R. (3d) 535 at page 538, the decision in Compagnie Internationale pour l’Informatique CII

Honeywell Bull v. Registrar of Trade-marks, 4 C.P.R. (3d) 523, and the decision in Promafil Canada Ltee v. Munsingwear Inc., 44 C.P.R. (3d) 59.

This case can be distinguished from Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd., 61 C.P.R.(3d) 93, as I am of the view that the additional matter in the present case would be seen as purely descriptive and would not be seen as matter forming part of the trade-mark.

Concerning the labels submitted with respect to the trade-mark ZEST & Design, Registration No. 401,491, I am of the view that the trade-mark appearing thereon is the trade-mark as registered.

The requesting party then stated that it is unclear from Mr. McPherson's affidavits whether the labels (attached as exhibits) were associated with any of the products sold during the relevant period. In my view, when reading each affidavit as a whole, and particularly considering Mr. McPherson's statement that each of the "ROSE" products or each of the "ZEST" products that is identified on the invoices had a label that used the trade-mark (ROSE & Design) or the trade-mark (ZEST & Design) that is the subject matter of the registrations together with his statement that the labels (Exhibit C) show the manner in which Multifoods Inc. is using and has used the trade-marks "as aforesaid", I am satisfied that it can be concluded that the labels submitted show the manner each trade-mark was associated with the wares at the time of transfer.

I am also satisfied that the sales shown appear to be sales in the registrant's normal course of trade. At paragraph 4, Mr. McPherson has stated that all transactions represent sales made in the ordinary course of his company's business and I see no basis upon which to conclude otherwise. I am satisfied that the transactions appear to be genuine transactions made in the registrant's normal course of trade.

Concerning the amount of sales, in Philip Morris Inc. v. Imperial Tobacco Ltd., 17 C.P.R.(3d) 237, at page 241, MacGuigan, J. of the Federal Court of Appeal agreed with McNair J. who, in the first Philip Morris Inc. case (13 C.P.R.(3d) 289), held that evidence of a single sale in the normal course of trade, whether wholesale or retail, may suffice. Furthermore, as stated in Coscelebre Inc. v.

Registrar of Trade-marks, 35 C.P.R.(3d) 74, Section 45 does not impose on a registrant the obligation to prove continuous use in Canada. The showing of “use in Canada” required by Section 45 can be satisfied by a usage which falls short of “marketing in a serious commercial manner” provided the use is by way of a normal commercial transaction. The jurisprudence does not require the Registrar or the Court to find a certain level of commercial activity in order to prove use.

As the sales appear to be evidence of genuine transactions in the normal course of trade, I am satisfied that the registrant has complied with all of the requirements of Section 4(1) of the Act.

The requesting party has also argued that the use is not by the registered owner or does not accrue to the registered owner. It submits that it is not clearly indicated in the affidavit whether the registrant is the party applying the labels to the products. It adds that the presence of the following trade-mark:

which appears at the top left hand corner of the invoices (which it adds is not a trade-mark of the registrant) causes confusion as to the entity who is using the trade-mark. It also draws attention to the fact that the notary who administered the oath, in each case, is limited to the attestation of instruments and the taking of affidavits, for Robin Hood Multifoods Inc. and its subsidiaries, associates and affiliates.

Although I do agree with the requesting party that it has not been clearly stated in the affidavits that the registrant is the entity affixing the labels to the wares, in my view, when each affidavit is read as a whole, it can reasonably be concluded that the registrant is the person using the trade-marks in Canada and that the labels are the registrant’s labels. Concerning the appearance of another trade-mark at the top of the invoices, in my view, the trade-mark in question does not identify any particular company. I note that the invoices indicate that “payment” is to be made to Multifoods, Inc. (the registrant) and this, in my view, would probably be taken as an indication that the registrant is the party using the trade-marks. Furthermore, I am of the view that the public would associate the present trade-marks and probably the trade-mark appearing at the top of the invoices with

Multifoods, Inc., the company named on the invoices.

In addition, the labels submitted with respect to the trade-mark ZEST & Design bear the registrant's name. In my view, this would clearly indicate that the registrant is the entity using such trade-mark.

As for the fact that the notary who administered the oath is limited to the attestation of instruments and the taking of affidavits for Robin Hood Multifoods Inc. and its subsidiaries, etc., such matter has no bearing on the issue of use. It is only an indication that the registrant must either be a subsidiary, affiliate or associate of that company.

In my view, the evidence is sufficient to permit me to conclude that use of the trade-marks ROSE & Design has been shown in association with "pickles, mustard pickles; hot dog, hamburger, and corn relishes" and that Registration No. 318,652 ought to be amended to refer only to these wares. I am also satisfied that use of the trade-mark ZEST & Design has been shown in association with the wares "pickles, pickled vegetables, and relishes", and, therefore, I conclude that trade-mark Registration No. 401,491 ought to be maintained as is on the register.

In view of the above, Registration No. 318,652 will be amended to refer only to the wares "pickles, mustard pickles; hot dog, hamburger, and corn relishes", and Registration No. 401,491 will be maintained as is on the register in accordance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 31st DAY OF December, 1996.

D. Savard
Senior Hearing Officer
Section 45 Division