



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

Citation: 2014 TMOB 274
Date of Decision: 2014-12-10

**IN THE MATTER OF SECTION 45 PROCEEDINGS
requested by Julia Wine Inc. against registration
Nos. TMA675,272 and 675,493 for the trade-marks
COMPLIMENTS and COMPLIMENTS DESIGN
respectively, in the name of Sobeys Capital Incorporated**

[1] At the request of Julia Wine Inc., the Registrar forwarded notices under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on December 7, 2012 to Sobeys Capital Incorporated (the Registrant), the registered owner of registration Nos. TMA675,272 and 675,493 for the trade-marks COMPLIMENTS and COMPLIMENTS DESIGN (shown below) respectively (sometimes collectively referred to as the Marks):



[2] The Marks are currently registered for use in association with the wares and services listed in the attached Schedules A (with respect to the word mark COMPLIMENTS) and B (with respect to the COMPLIMENTS DESIGN mark).

[3] The section 45 notices required the Registrant to show whether the Marks had been used in Canada in association with each of the wares and services listed in the registrations at any time between December 7, 2009 and December 7, 2012 (the relevant period). If the Marks had not been so used, the Registrant was required to provide the date when they were last in use and the reason for the absence of such use since that date.

[4] The relevant definition of “use” in the present cases is set out in subsections 4(1) and (2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

(2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] It is well established that the purpose and scope of section 45 of the Act is to provide a simple, summary and expeditious procedure for removing “deadwood” from the register and, as such, the evidentiary threshold that the registered owner must meet is quite low [*Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)].

[6] In response to the Registrar’s notices, the Registrant furnished in each file, an affidavit of its Vice President, General Counsel, and Secretary, Karin McCaskill, sworn July 3, 2013, together with Exhibits A through F. Unless indicated otherwise, I will use the singular form to refer to these two affidavits as they are essentially identical except for their respective Exhibit B.

[7] Only the Registrant filed written submissions in each case and was represented at a single hearing.

[8] For the reasons that follow, I am satisfied that the evidence filed by the Registrant shows use of the Marks in Canada by the Registrant in association with all of the wares and services listed in Schedules A and B respectively during the relevant period. I agree with the Registrant that the Marks in no way constitute “deadwood” in need of removal from the register.

[9] As set out by Ms. McCaskill, the Registrant, its subsidiaries, and franchisees make up the second largest food retailer in Canada. During the relevant period, the Registrant, its subsidiaries, and franchisees owned or franchised more than 1,300 stores throughout Canada under retail banners that include SOBEYS, IGA *extra*, THRIFTY FOODS, IGA, FOODLAND

and FRESHCO, as well as LAWTON'S DRUG stores, in addition to over 260 retail fuel locations. [para 5 of the McCaskill affidavit]

[10] In the course of its business, the Registrant has developed its own extensive line of private label grocery and other consumer products and services identified under the Marks. The line of COMPLIMENTS and COMPLIMENTS DESIGN brand products covers thousands of items in the food and non-food categories and the registered wares and services listed in Schedules A and B are all products identified under these private label brands. [para 6 of the McCaskill affidavit]

[11] More particularly, Ms. McCaskill states that throughout the relevant period, the Marks were displayed on the products and packaging of the registered wares. To this end, she attaches under Exhibit A, representative images exemplifying how the Marks were displayed in association with the registered wares during the relevant period. Upon review of this exhibit, I note that the Marks appear directly on the packaging. The images show hundreds of samples of the packaging of the registered wares, each of which display the Marks. Ms. McCaskill explains that these images do not present an exhaustive catalogue of all the registered wares sold in association with the Marks during the relevant period in Canada, but rather are a representative example of how the Marks appeared on the registered wares during that period. [paras 7 and 8 of the McCaskill affidavit]

[12] The registered wares were sold in the normal course of trade during the relevant period at supermarkets and retail grocery stores, including those owned and operated by the Registrant in Ontario under the SOBEYS banner and elsewhere. [paras 9-11 of the McCaskill affidavit]

[13] Sales of the registered wares displaying the Marks from the Registrant's owned and operated SOBEYS stores in Ontario between May 8, 2011 and December 3, 2012 were in excess of \$16,800,000 (with respect to the registered wares listed in Schedule A) and \$15,800,000 (with respect to the registered wares listed in Schedule B). This is only a representative sample of sales taken from a portion of the relevant period from SOBEYS stores in Ontario. The total sales of registered wares displaying the Marks across all supermarket, grocery and other stores in Canada during the relevant period would be in excess of a billion dollars. [paras 12 and 13 of the McCaskill affidavit; Exhibit B – spreadsheet printout setting

out consolidated sales information for the registered wares in each case, from the Registrant's owned and operated SOBEYS stores in Ontario]

[14] Commenting on Exhibit B, Ms. McCaskill explains that each of the spreadsheets is a summary taken from the Registrant's electronic records. The spreadsheet in each case lists each of the registered wares as they are described in the trade-mark registration at issue, the corresponding retail product name used by the Registrant, the product UPC code, and where applicable, the size of the product. The spreadsheet in each case also sets out the consolidated sales figures for each category of the registered wares. The products in the spreadsheets have been grouped into food and non-food categories and consolidated sales figures have been provided for each category reflecting sales from the Registrant's owned and operated SOBEYS stores in Ontario during the relevant period. The products listed in each of the spreadsheets can be cross-referenced with the images at Exhibit A by using the UPC code from Exhibit B which corresponds to the "file name" included under each of the images at Exhibit A. Exhibit B also contains a column setting out the page number in Exhibit A on which the representative product image appears to facilitate cross-referencing. The sales figures have been consolidated to make the presentation of the evidence more digestible given the large number of individual product descriptions contained in each of the registrations. However, Ms. McCaskill expressly asserts that each and every product listed in each Exhibit B displays the COMPLIMENT or COMPLIMENTS DESIGN trade-marks, as the case may be, and has been the subject of sales in Canada during the relevant period in the ordinary course of business.

[15] Turning to the services, Ms. McCaskill states that the Marks were also prominently displayed in the performance and advertising of the registered services during the relevant period in Canada on weekly flyers, in-store displays and website advertising. To this end, she attaches under Exhibit C representative sample images showing how the Marks were displayed on signage inside the Registrant's retail grocery stores during the relevant period. She further attaches under Exhibit D sample weekly flyers from the relevant period advertising and promoting the registered services in association with the Marks. She also attaches under Exhibit E copies of printouts from the websites *www.compliments.ca* printed on August 21, 2012 showing the display of the Marks on this site. Ms. McCaskill states that the website had in excess of 300,000 hits from Canadian IP addresses each year during the relevant

period. The website provided visitors with information on the nearest supermarket or grocery store where COMPLIMENTS and COMPLIMENTS DESIGN branded products were available. The website also provided visitors with information on these products including product images, nutritional information and a listing of ingredients. [paras 14-16 of the McCaskill affidavit]

[16] Ms. McCaskill states that the Registrant also offered for retail sale a number of cooking tools and utensils at supermarkets and grocery stores in Canada in association with the Marks during the relevant period. To this end, she attaches under Exhibit F sample images of a small selection of such cooking tools and utensils. Ms. McCaskill states that as noted above, the retail sales of COMPLIMENTS and COMPLIMENTS DESIGN brand products, including cooking tools and utensils during the relevant period in Canada were in excess of a billion dollars. [para 16 of the McCaskill affidavit]

[17] As noted in *Saks & Co v Canada (Registrar of Trademarks)* 1989, 24 CPR (3d) 49 (FCTD), actually showing use of all of the wares or services listed in a registration is not necessarily required when the affidavit clearly states that the trade-mark is used on all of the wares and services and adequate examples of use from each category of wares or services is shown. The application of *Saks, supra*, in the present cases is particularly appropriate, given the lengthy list of wares, Ms. McCaskill's clear sworn statements regarding use, and the ample representative examples of use with respect to each category of wares and services. Indeed, there is no need or justification for evidentiary overkill.

Decision

[18] Having regard to the foregoing, pursuant to the authority delegated to me under

section 63(3) of the Act, the registrations will be maintained in accordance with the provisions of section 45(5) of the Act.

Annie Robitaille
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Schedule A

List of wares and services covered by registration No. 675,272 for the COMPLIMENTS word mark

Wares :

(1) Acetaminophen as an oral analgesic; acetaminophen combined with codeine in tablet or capsule form as an oral analgesic; acetylsalicylic acid; adhesive bandages; adhesive for bandages for skin wounds; adult diapers; after-sun lotions; alcohol for topical use; alcohol swabs; all purpose cotton swabs; all purpose disinfectants; allergy medications; allergy relief medication; almond spreads; aluminum foil; ammonia for cleaning purposes; analgesics; antacids; antibacterial handwash; antibiotic creams; antibiotic handwash; antibiotic ointments; antihistamines; anti-inflammatories; anti-microbial handwash; antiperspirants; antiseptics; anti-static dryer sheets; artificial sweeteners; baby formula; baby lotion; baby oil; baby powder; baby shampoo; baby wipes; baked beans; baking chocolate; baking powder; baking soda; bandages; barber scissors; bath and shower gels; bath salts; bathing additives, namely foam, gel, oil, powder and crystals; bathroom tissue; beauty creams; beer; beverages, namely water, mineral water, spring water, soy-based drinks, sodas, pops, fruit juices, vegetable juices, non-alcoholic fruit sodas, carbonated and non-carbonated soft drinks, vegetable juices, non-alcoholic fruit beverages, juice concentrates, fruit drinks namely non-carbonated fruit-flavoured drinks, non-alcoholic vegetable beverages, and concentrates for making such beverages; bird food; biscuits; bleach; body cream; body shampoos; bread; breath freshener; bronzers and sun tanning creams and lotions; bubble bath; buns; burn relief medication; cake mix; cakes; calcium supplements; candies; canned, fresh and frozen pasta dishes; cat litter; cereal; cereal based snack bars; cereal based snack food; cheese; chemical preparations for the treatment of premenstrual and menstrual pain; chemical preparations to relieve muscle and back pain; chocolate bars; chocolates; cleansers and cleaners namely all-purpose household cleaners, disinfectants, dish detergents, glass cleaners, oven cleaners and powder cleansers; cocoa; coffee; coffee filter baskets; coffee filter papers; coffee whiteners; combinations of fruit and nuts in bar form; compression bandages; condiments; cookies; cooking oil; cosmetic pads; cotton balls; cotton balls for cosmetic purposes; cotton for cosmetic purposes; cotton swabs for cosmetic purposes; cough drops; cough expectorants; cough lozenges; cough syrups; cough treatment pharmaceutical preparations; crab meat; crackers; cream cheese; croutons; curry dip; cuticle nippers; cuticle pushers; cuticle scissors; cuticle trimmers; dandruff shampoo; de-alcoholised beer; decongestants, namely nasal sprays and capsules; dental floss; dental hygiene products, namely mouthwash; dental rinse; denture cleaning preparations; dentures; deodorant; antiperspirants; dessert topping mix; desserts, namely sorbet, shortbread, puddings, cakes, pastries and crisps; diapers; diarrhea medication; dietary aids, namely a lactase enzyme used to assist in the digestion of lactose; dietary supplements, namely vitamins, minerals; dishcloths; dishwasher detergent; disinfectant soaps; disinfecting handwash; dispensers for pills or capsules sold empty ; disposable diapers; disposable latex gloves; disposable wipes without chemicals or compounds for household use and personal hygiene; distilled water; drain cleaners; dried herbs and herb extracts; dried soup mixes; dropper bottles for administering medication, sold empty; droppers for administering medication, sold empty; ear drum protectors; ear plugs for swimming purposes; ear plugs not for medical purposes; egg rolls; eggs; elastic bandages; emery boards; epsom salts; evaporated milk; expectorants; eye drops; eye patches; eyeglass chains and cords; eyeglass comfort pads; eyeglass repair kits; eyelash curlers; eyelid creams and pencils; fabric softener; face

and body creams and lotions; facial cleansers; facial creams; facial tissues; feminine pads and panty liners; feminine protection products, namely sanitary napkins and panty shields; files and buffers for use in foot and nail care; fire logs; flat bread; flour; folic acid; foot care products, namely corn cutters and, corn cutter blades; frankfurters; fresh pizza; fresh, bottled, tinned and dried fruits; fresh, bottled, tinned and frozen vegetables; fresh, frozen and canned meat, beef and pork and prepared meat, beef and pork products namely ham, bacon, bologna, salami, pepperoni, corned beef, pastrami, sausage and wieners; fresh, frozen and canned poultry and prepared poultry products; fresh, frozen and canned fish; frosting mix; frozen ice cream confections; frozen ice cream novelties; frozen pizza; fruit based snack food; fruit cake; fruit-based snack bars; glycerine; granola bars; granola-based snack bars; gravy; hair conditioners; hair gel; hair shampoo-conditioners; hand cream; hand lotions; health food or health food supplements, namely calcium, garlic and parsley, ginseng, magnesium; herbal remedies and supplements for the relief of the symptoms associated with menopause, PMS, weakened immune systems, colds, sore throats, influenza and nasal congestion; honey; hosiery; hot chocolate mix; hot water bottles; household gloves for general use; hydrogen peroxide for medical use; ibuprofen as an oral analgesic; ice cream; ice cream cones and cups; incontinence products namely garments and pads; iodine; iron supplements; jams; jellies; jelly powder; ketchup; lard; laundry detergent; laxatives; lemonade; light bulbs; lip balms; liquid soaps for hands, face, and body; lunch bags; macaroni; macaroni and cheese; malt beverages; manicure sticks and emery boards; margarine; marmalades; marshmallows; matches; mayonnaise; meat pies; medicated chest rub; medicated cream for the treatment of stiff and sore muscles, arthritis and similar ailments; medicated lozenges; medicated mouthwash; medicated shampoo; milk and milk products namely cream, cottage cheese, sour cream, yogurt, eggnog and butter; mineral oil; mineral water; motion sickness treatment pharmaceutical preparations; mousse for use on the hair or skin; mouth rinses; mouthwash; muffins; multi-grain chips; muscle relaxants; mustache scissors; mustard; nail brushes; nail buffing preparations; nail care preparations namely nail polish remover; nail clippers; nail files; nail nippers; nail scissors; nasal spray preparations; non-medicated bath salts; non-medicated dental rinse; non-medicated lozenges; non-medicated mouth rinse; non-medicated mouthwash and rinse; non-medicated sunburn lotions; noodles; nuts; olives; oral analgesics; pancake mix; panty shields; pantyhose; paper and plastic tableware; paper bags; paper napkins; paper serviettes; paper towels; pasta; pasta sauce; peanut butter; peat moss; pepper; pet foods; petroleum jelly for cosmetic and medical purposes; pharmaceutical preparations for nausea treatments; pharmaceutical preparations for sinus treatment and medication; pharmaceutical preparations for treating colds and allergies; pharmaceutical preparations to assist with sleep in liquid, tablet or capsule form; pharmaceutical preparations to relieve digestive and intestinal disorders; pharmaceutical preparations to relieve heartburn; pickles; pie filling; pies; pillboxes; pizza mix; plastic garbage and kitchen bags; plastic pillboxes; plastic wrap; popcorn; potato chips; potting soil; pregnancy test kits for home use; preparations made with plant extracts, namely liquids in ampoules and in bottles, capsules and tablets for the treatment of colds, flu and headaches; prepared meals; pudding; puff pastry appetizers; pumice sponges and stones; quiche; razor blades; razors; relish; rice; rice cakes; rice-based snack bars; rolls; rubber gloves; rubber household gloves; rubbing alcohol; salad dressing; salads; salsa; sanitary napkins; sanitary pads; sauces, namely barbecue, spaghetti, pasta, hollandaise, seafood, steak, béarnaise, horseradish, cranberry, marinade, tartar, seafood dipping and dessert sauces; sausages; scissors; sculpting gel; shampoo, conditioner and gel; shaving brushes; shaving cream; shaving foam; shaving gel; shaving lotion; shortening; shower gel; skin cream; skin lotion; skin moisturizers; skin soap; skin treatment and moisturizing lotions, liquids,

gels, spray, creams and soap; snack food dips; soap; soft drink mixes and crystals; soil; soups; soya/flax bars; spaghetti; spaghetti sauce; spices; sponges; spring rolls; stain remover; styling gels; styling lotions; sugar; sun block preparations; sun protection creams and lotions; sun screen preparations; sun tan gel; sun tan lotions; sunflower oil; swabs; syrup namely chocolate syrup, flavouring syrup, maple syrup, pancake syrup, table syrup and topping syrup; taco sauces; taco shells; tampons; tarts; tea; tea bags; tea towels; thermometers for medical purposes; throat lozenges; toilet soaps; toilet deodorizers; toilet tissue; tomato paste; tomato sauce; toothbrushes; topical analgesics; topical gel; tweezers; vegetable cooking spray; vitamin and mineral supplements; vitamins; waffles; waxed paper; wheat-based snack bars; whipped topping; witch hazel; women's hosiery; zinc and castor oil ointment; zinc cream.

Services :

(1) Operating supermarkets and grocery stores; retail sale of cooking tools and utensils.

Schedule B

List of wares and services covered by registration No. 675,493 for the COMPLIMENTS DESIGN trade-mark

Wares :

(1) Almond spreads; aluminum foil; ammonia for cleaning purposes; anti-static dryer sheets; artificial sweeteners; baby conditioner; baby formula; baby lotion; baby oil; baby powder; baby shampoo; baby wipes; baked beans; baking chocolate; baking powder; baking soda; bathroom tissue; beer; beverages, namely water, mineral water, spring water, soy-based drinks, sodas, pops, fruit juices, vegetable juices, non-alcoholic fruit sodas, carbonated and non-carbonated soft drinks, vegetable juices, non-alcoholic fruit beverages, juice concentrates, fruit drinks namely non-carbonated fruit-flavoured drinks, non-alcoholic vegetable beverages, and concentrates for making such beverages; bird food; biscuits; bleach; boric acid; bottle liners; bread; breath freshener; buns; cake mix; cakes; candies; canned, fresh and frozen pasta dishes; cat litter; cereal; cereal based snack bars; cereal based snack food; cheese; chocolate bars; chocolates; cleansers and cleaners namely all-purpose household cleaners, disinfectants, dish detergents, glass cleaners, oven cleaners; cocoa; coffee; coffee creamer; coffee filter baskets; coffee filter papers; coffee whiteners; cold cream; combinations of fruit and nuts in bar form; condiments; cookies; cooking oil; crab meat; crackers; cream cheese; croutons; curry dip; de-alcoholised beer; decongestants, namely nasal sprays and capsules; dental floss; dessert topping mix; desserts, namely sorbet, shortbread, puddings, cakes, pastries; dishcloths; dishwasher detergent; disposable baby diapers; disposable latex gloves; disposable wipes without chemicals or compounds for household use and personal hygiene; distilled water; drain cleaners; dried herbs and herb extracts; dried soup mixes; egg rolls; eggs; elastic bandages; emery boards; epsom salts; evaporated milk; eyeglass chains and cords; eyeglass comfort pads; eyeglass repair kits; fabric softener; fire logs; flat bread; flour; flowers; frankfurters; fresh pizza; fresh, bottled, tinned and dried fruits; fresh, bottled, tinned and frozen vegetables; fresh, frozen and canned meat, beef and pork and prepared meat, beef and pork products namely ham, bacon, bologna, salami, pepperoni, corned beef, pastrami, sausage and wieners; fresh, frozen and canned poultry and prepared poultry products; fresh, frozen and canned fish; frosting mix; frozen ice cream confections; frozen ice cream novelties; frozen pizza; fruit based snack food; fruit cake; fruit-based snack bars; granola bars; granola-based snack bars; gravy; honey; hosiery; hot chocolate mix; hot water bottles; household gloves for general use; ice cream; ice cream cones and cups; jams; jellies; jelly powder; ketchup; lard; laundry detergent; lemonade; light bulbs; lighter fluid; lunch bags; macaroni; macaroni and cheese; malt beverages; margarine; marmalades; marshmallows; matches; mayonnaise; meat pies; milk and milk products namely cream, cottage cheese, sour cream, yogurt, eggnog and butter; mineral water; motor oils; muffins; multi-grain chips; mustard; nail brushes; nail buffing preparations; noodles; nuts; olives; pancake mix; paper and plastic tableware; paper bags; paper napkins; paper serviettes; paper towels; pasta; pasta sauce; peanut butter; peat moss; pepper; pet foods; petroleum jelly for cosmetic and medical purposes; pickles; pie filling; pies; pillboxes; pizza mix; plastic garbage and kitchen bags; plastic pillboxes; plastic wrap; popcorn; potato chips; potting soil; puddings; puff pastry appetizers; quiche; relish; rice; rice cakes; rice-based snack bars; rolls; rubber gloves; rubber household gloves; salad dressing; salads; salsa; sanitary napkins; sauces, namely barbecue, spaghetti, pasta, hollandaise, seafood, steak, béarnaise, horseradish, cranberry, marinade, tartar, seafood dipping and dessert sauces; sausages; scissors; shortening; snack food dips; soap; soft drink mixes and

crystals; soil; soups; soya/flax bars; spaghetti; spaghetti sauce; spices; sponges; spring rolls; stain remover; styling gels; styling lotions; sugar; sunflower oil; syrup namely chocolate syrup, flavouring syrup, maple syrup, pancake syrup, table syrup and topping syrup; taco sauces; taco shells; tarts; tea; tea bags; tea towels; toilet soaps; toilet deodorizers; toilet tissue; tomato paste; tomato sauce; tweezers; vegetable cooking spray; vegetable oil; waffles; waxed paper; wheat-based snack bars; whipped topping; witch hazel.

Services :

(1) Operating supermarkets and grocery stores; retail sale of cooking tools and utensils.