



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

Citation: 2015 TMOB 194
Date of Decision: 2015-10-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Gowling Lafleur Henderson LLP

Requesting Party

and

Liwayway Marketing Corporation

Registered Owner

TMA605,878 for OISHI & Design

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA605,878 for the trade-mark OISHI & Design shown below (the Mark), owned by Liwayway Marketing Corporation.

The word 'Oishi' is written in a bold, rounded, black font with a white outline. The letters are slightly irregular and have a playful, bubbly appearance.

[2] The Mark is registered in association with the following goods:

Snack food products, namely, prawn crackers, potato flakes, potato crunches, cheese sticks, sweet corn puffs, potato fries, potato crisps, baked potatoes, pizza squares, sour cream and onion rings, melon crackers, banana crisps, caramel popcorn, onion rings, butternut crunch, corn pottage, fish crackers, peasnacks, cocktail curls.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete the following goods: “[...], *potato flakes, potato crunches, [...], sweet corn puffs, potato fries, [...], pizza squares, sour cream and onion rings, melon crackers, banana crisps, caramel popcorn, [...], butternut crunch, corn pottage, and fish crackers.*”

The Proceeding

[4] On April 12, 2013, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Liwayway Marketing Corporation (the Registrant). The notice was sent at the request of Gowling Lafleur Henderson LLP (the Requesting Party).

[5] The notice required the Registrant to furnish evidence showing that it had used the Mark in Canada, at any time between April 12, 2010 and April 12, 2013, in association with each of the goods specified in the registration. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use is set out in section 4(1) of the Act as follows:

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

[7] It has been well established that the purpose and scope of section 45 of the Act is to provide a simple, summary, and expeditious procedure for clearing the register of “deadwood”. The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. Nevertheless, sufficient evidence must still be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered goods [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Furthermore, mere statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[8] In response to the Registrar's notice, the Registrant furnished the affidavit of Oszen A. Chan, the President of the Registrant. Both parties filed written representations. Both parties were also represented at an oral hearing held jointly with hearings for summary expungement proceedings with respect to three other registrations owned by the Registrant. Separate decisions will be issued for these other proceedings, which pertain to registration Nos. TMA692,890, TMA706,660, and TMA724,715.

The Evidence

[9] In his affidavit, Mr. Chan attests that the Registrant is a corporation based in the Philippines that is engaged in the business of "manufacturing and distributing in the field of food and beverages."

[10] With respect to use of the Mark in Canada, Mr. Chan attests that since at least as early as 2008, the Registrant began distributing and selling in association with the Mark, "snack food products, namely, prawn crackers, baked potato, potato crisps, potato flakes, cheese sticks, corn puffs, onion rings, peasnacks, and cocktail curls." He states that such distribution and sales of the aforementioned products has been "specifically" by way of the Registrant's "OISHI Prawn Crackers", "OISHI CRISPY PATATA Baked Potato", "OISHI Gourmet Picks", "OISHI Kirei Yummy Flakes", "OISHI Cheese Clubs Sticks", "OISHI Onion Rings", "OISHI PODS PEASNACKS" and "MARTY'S CRACKLIN" products" (hereafter referred to as the OISHI Goods).

[11] With respect to the Registrant's normal course of trade, Mr. Chan attests that Scarborough, Ontario-based Apo Products Ltd. and Richmond, BC-based Uno Foods, Inc. purchase products marked with the Mark from the Registrant for resale throughout Canada. In support of such sales, he provides aggregate sales figures for the above-noted OISHI Goods for the years 2009 through 2012, and attaches to his affidavit representative samples of commercial invoices, as well as with associated packing lists and shipping documents. I note that various OISHI Goods are highlighted on the representative invoices.

[12] With respect to display of the Mark, Mr. Chan provides representative specimens of packaging for the OISHI Goods, which he attests were actually sold and distributed in Canada.

The Mark clearly appears on all of the packaging. The products identified on the specimens of packaging are as follows: “OISHI Prawn Crackers”, “OISHI Crispy Patata Baked Potato Flavor”, “OISHI Gourmet Picks Potato Chips”, “OISHI Kirei Yummy Flakes”, “OISHI Cheese Clubs”, “OISHI Onion Rings”, “OISHI Pods Peasnack”, and “OISHI Marty’s Cracklin”.

[13] Lastly, with respect to the remaining registered goods, namely, “potato crunches, potato fries, pizza squares, sour cream and onion rings, melon crackers, banana crisps, caramel popcorn, butternut crunch, corn pottage, and fish crackers”, Mr. Chan explains that the Registrant has all the intention to use the Mark for these goods in Canada. He states that these products are actively advertised on the Registrant’s website, which includes further links to various social media accounts. He also states that these goods are promoted to international clients including Canadians at international trade fairs, and identifies two such trade shows that were recently held in the Philippines. He then concludes his affidavit by stating that “Canada is one country where our company has decided to actively market all its OISHI & Design products and it is just a matter of time that all the wares listed in the Registration No. 605,878 will be distributed and sold in Canada.”

Submissions of the Parties and Analysis

[14] At the outset, I note that the Requesting Party conceded at the oral hearing that use of the Mark has been shown with respect to the following goods: “prawn crackers”, “potato crisps”, “cheese sticks”, “onion rings”, and “peasnacks”. The Registrant, on the other hand, submits that use of the Mark has been shown with respect to all of the goods to which Mr. Chan identifies as having been distributed and sold in Canada during the relevant period, namely, “prawn crackers, baked potato, potato crisps, potato flakes, cheese sticks, corn puffs, onion rings, peasnacks, and cocktail curls.”

[15] Upon review of the evidence and given the parties’ respective concessions and submissions, I accept that use of the Mark, at a minimum, has been shown in association with “prawn crackers”, “potato crisps”, “cheese sticks”, “onion rings”, and “peasnacks”. At issue then, is whether the evidence is also sufficient to show use with “baked potatoes”, “potato flakes”, “corn puffs”, and “cocktail curls”, and whether special circumstances have been shown to excuse the absence of use with respect to the remaining registered goods.

Baked Potatoes

[16] The Requesting Party submits that with respect to the good “baked potatoes”, the only evidence of use of the Mark is with a baked potato flavoured snack food product (*i.e.* “OISHI CRISPY PATATA Baked Potato Flavor” product). Thus, the Requesting Party submits, that at most, the Registrant has only shown use with a potato-derived product, and not “baked potatoes”. Further to this, the Requesting Party submits that the fact that potato is one ingredient of this baked potato flavoured product is of no consequence [citing *Kellogg Co v Granovita UK Ltd*, 2011 TMOB 242 at paras 34-35].

[17] The Registrant on the other hand, submits that Mr. Chan has provided clear statements of use with respect to the goods, including “baked potatoes”. Further to this, the Registrant submits that Mr. Chan’s sworn statements are not inconsistent and that an inquiry as to whether the Crispy Patata product is technically a baked potato is beyond the scope of section 45. Indeed, the Registrant submits that its potato-based snack products, such as chips for example, are inherently baked or fried potatoes.

[18] In the circumstances, I find it appropriate in the circumstances to consider the context of the good “baked potatoes” in the statement of goods as a whole when determining whether the evidence is sufficient to establish use with such goods. In this regard, I note that in the statement of goods, the good “baked potatoes” is identified specifically as a “snack food product”, and is clearly included in a list that consists of other processed snack food products. As such, I am of the view that in its context, the good listed as “snack foods, namely, baked potatoes”, would not be strictly interpreted as a baked potato in the whole food sense that refers to a starch side dish or accompaniment to a meal. Rather, the good as listed would reasonably be interpreted as encompassing a product such as the “OISHI Crispy Patata Baked Potato Flavor” product. Thus, the decision in *Kellogg, supra*, relied upon by the Requesting Party is distinguishable, in that the good in question is not so narrowly construed.

[19] Indeed, I note that the context of a good in a statement of goods may serve to specify an otherwise unacceptable or ambiguous statement of goods for the purposes of section 30(a) of the Act [per the *Canadian Trade-marks Examination Manual*, II.5.4.2, Context of the Goods and Services; see also the decision *Industries Lassonde Inc v Olivia’s Oasis Inc*, 2010 TMOB 107,

CarswellNat 3508]. Although such an analysis is for the purposes of compliance with section 30(a) of the Act, I see no reason why a stricter approach to interpreting statements of goods should be applied in section 45 proceedings. I note further it has been held that a statement of goods should be granted a generous interpretation as opposed to a restrictive one [see *ConAgra Foods, Inc v Fetherstonhaugh & Co* (2002), 23 CPR (4th) 49 (FCTD); and *Molson Canada v Kaiserdom-Privatbrauerei Bamberg Wörner KG* (2005), 43 CPR (4th) 313 (TMOB)].

Consequently, I accept that the evidence of use in association with the “OISHI Crispy Patata Baked Potato Flavor” product is sufficient in this case to show use with respect to “snack foods, namely, baked potatoes”. I find this approach to be most consistent with the purpose and intent of section 45 of the Act.

Potato Flakes

[20] The Requesting Party submits that there is ambiguity concerning the goods with which the Mark has been purportedly used because Mr. Chan does not clearly explain which products correspond with which specific registered good. The Requesting Party admits that correspondence between the examples of use and the registered goods can be inferred in some cases; however, none of the examples of use in the evidence appear to be in relation to “potato flakes”. Further to this, the Requesting Party submits that while the Registrant has shown use of the Mark with its “OISHI Kirei Yummy Flakes” product, this product does not contain potato as one of its ingredients (as per the ingredient list on the product packaging). Thus, the Requesting Party submits, the Registrant’s evidence fails to explain which of its examples of use relate to this product and it is not possible to infer from the evidence that use has been shown in association with “potato flakes”.

[21] The Registrant, on the other hand, submits that the evidence is sufficient to support use with respect to this good, as representative use has been adequately shown. Further, the Registrant submits that it is not required to show all manners of use and sales, or explain the lack thereof. The Registrant additionally submits that snack food products can be inherently cyclical with regards to description (flakes/scoops/sticks/strips/crunches) and ingredients (gluten-free etc.). What is more, the Registrant submits, is that its products can be prepared and sold in a manner of ways and distributed and sold in varying premises or grocery stores; its registration

does not preclude it from doing so [relying on *Cartier Men's Shops Ltd v Cartier Inc* (1981), 58 CPR (2d) 68 (FCTD) at 73; *Eminence SA v Registrar of Trade-marks* (1977), 39 CPR (2d) 40 (FCTD) at 43].

[22] I do not find the cases cited by the Registrant to be of assistance in this case; those cases do not stand for the proposition that statements of goods or services are not restricted to those which are specified in the statements of goods or services, but rather that statements of goods or services do not necessarily impose restrictions on channels of trade.

[23] In any event, I agree with the Requesting Party that the evidence does not show use of the Mark in association with “potato flakes”. Mr. Chan has not provided *clear* sworn statements to link any of the goods in the evidence with “potato flakes”, but has only made a somewhat ambiguous connection to this good through “OISHI Kirei Yummy Flakes”, which I do not consider to constitute “potato flakes”. Although use of the Mark has been shown with respect to other goods which fall under the general category of snack food products, such use is not sufficient to demonstrate use in association with “potato flakes” [see *88766 Canada Inc v 167407 Canada Inc*, 2010 TMOB 167].

Corn Puffs and Cocktail Curls

[24] The Requesting Party submits that as with “potato flakes”, it is not clear from the examples in the evidence, which goods relate to the goods “corn puffs” and “cocktail curls”, and Mr. Chan has not explained which examples in the evidence relate to these goods. Additionally, the Requesting Party submits that, to the extent the Registrant takes the position that any of its snack food products for which use has been shown demonstrates use with more than one specific type of registered good, the Registrant cannot rely on a single example of use to show use with separately listed goods [citing *2956-2691 Quebec Inc (Re)*, 2012 TMOB 192 at para 11; *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)]. Lastly, the Requesting Party submits that while the Registrant has put forward evidence of use of the Mark with the product “MARTY’S CRACKLIN”, it has failed to explain which of the listed goods this product corresponds, and use in association with any product that falls within the a general category of products is not sufficient [per *167407 Canada Inc, supra*].

[25] The Registrant submits that Mr. Chan's statements regarding representative use of the Mark in association with snack food products are clear, consistent, and unambiguous. In this regard, the Registrant submits that Mr. Chan's statements are clear that the examples given in the evidence are *representative*, and therefore are not intended to be an exhaustive list. Thus, the Registrant submits, the cases cited by the Requesting Party are not applicable. Further to this, the Registrant submits that use has been sufficiently established as Mr. Chan has provided a sworn statement of use with respect to specific goods, as well as representative examples of use of those goods [see *Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FC)].

[26] While Mr. Chan has provided a statement of use with regard to nine specific registered goods in his affidavit, he immediately ties this statement of use to a list of eight specific OISHI Goods. Moreover, Mr. Chan provides no explanation as to which OISHI Good corresponds to which registered good. Although I agree with the Requesting Party that inferences in this regard can be made in some cases or that the linkage is obvious (e.g. "OISHI prawn crackers"), overall I find Mr. Chan's attestations leave ambiguity as to which OISHI Good corresponds to which registered good.

[27] Indeed, even from the Registrant's submissions, it appears as though the Registrant is attempting to claim that use with respect to one OISHI Good is sufficient to qualify as use with respect to two registered goods simultaneously (*i.e.* OISHI Cheese Clubs Sticks constitutes use with respect to both "cheese sticks" and "corn puffs"). In this regard, I note that the Registrant submits in paragraph 10 of its written representations that "the Registrant's cheese snacks are **corn-based** Exhibit "M" and cheese sticks and/or corn puffs may be ball-shaped, curly ("cheese curls"), straight, or irregularly shaped." Further to this, it appears from the Registrant's submissions that they are of the position that the OISHI Goods, which encompass a variety of snack foods, do not need to correspond directly with the registered goods, as "snack food products can be inherently cyclical with regards to description (flakes/scoops/sticks/strips/crunches) and ingredients (gluten-free etc.)."

[28] However, section 45 of the Act clearly indicates that use is to be shown "with respect to each of the goods or services specified in the registration". As proceedings under section 45 of

the Act are summary and administrative in nature, concerns of evidentiary overkill do weigh against requiring use to be shown of every registered good and service so as to prevent removal of each from the register [see *Saks, supra*; *Ridout & Maybee LLP v Omega SA*, 2005 FCA 306, 39 CPR (4th) 261; and *Gowling Lafleur Henderson LLP v Neutrogena Corporation* (2009), 74 CPR (4th) 153 (TMOB)]. However, this concept is appropriately applied to cases where there is a long list of goods and where the statement of goods is organized such that demonstration of use for a number of goods within a category can be sufficient to show use for the entire category. In *Performance Apparel Corp, supra*, Justice Russell spoke of the balance between evidentiary overkill and the obligation to show use to the extent that the Registrar is able to form an opinion on the “use” within the context of section 45. In these circumstances, an affidavit must contain a clear and comprehensive statement of use in association with each of the goods for the relevant period as well as sufficient facts to permit the Registrar to conclude that the trade-mark is in use in association with each good.

[29] In the present case, the list of registered goods, to which use is claimed in Mr. Chan’s affidavit, is limited to nine goods. In contrast to *Saks, supra*, a showing of use in association with each good specified would not have been overly burdensome or required evidentiary overkill. In addition, as previously indicated, while Mr. Chan has provided a sworn statement of use with respect to nine specific goods, his statement is confounded by his attestation that such use has occurred “specifically” through eight OISHI Goods, wherein the link between the OISHI Goods and the registered goods is not clear. Nor, would I add, are there sufficient facts to permit me to conclude that the Mark was used in association with *each* of the goods claimed, as the representative use shown only pertains to the OISHI Goods.

[30] Nevertheless, as previously indicated, certain inferences regarding the link between the OISHI Goods and the registered goods can reasonably be made. In particular, I accept that OISHI Cheese Club Sticks reasonably encompasses the registered good “cheese sticks”. However, considering the ambiguity in the evidence concerning the link between the OISHI Goods and the registered goods, the fact that each good in a statement of goods is considered to be distinct [per *Labatt, supra*], and the name of the product itself, I am not prepared to accept that this good demonstrates use of the registered good “corn puffs” as well. With respect to the registered good, “cocktail curls”, although not a defined term, I find it reasonable to infer, in the

context of the statement of goods, that this term refers to a curled snack food product. As I note that the specimen packaging for the MARTY'S CRACKLIN' product displays a distinctively curled snack food product, I accept that the Registrant has shown use of the Mark in association with "cocktail curls".

[31] Having regard to all of the foregoing, I accept that the Registrant has shown use of the Mark in association with "Snack food products, namely, prawn crackers, cheese sticks, potato crisps, baked potatoes, onion rings, peasnacks, cocktail curls." However, use of the Mark has not been shown with respect to the remaining goods: [...], potato flakes, potato crunches, sweet corn puffs, potato fries, pizza squares, sour cream and onion rings, melon crackers, banana crisps, caramel popcorn, butternut crunch, corn pottage, fish crackers. I must now determine whether special circumstances have been demonstrated that would excuse the absence of such use.

Special Circumstances

[32] To determine whether special circumstances have been demonstrated, the Registrar must first determine, in light of the evidence, the reasons surrounding why the trade-mark was not used during the relevant period. The Registrar must then determine whether these reasons for non-use constitute special circumstances [per *Registrar of Trade Marks v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488 (FCA)], such that an exception to the general rule, that the absence of use will be penalized by expungement, ought to be made [*Smart & Biggar v Scott Paper Ltd* (2008), 65 CPR (4th) 303 (FCA) at para 22]. Special circumstances mean "circumstances that are unusual, uncommon or exceptional" [see *John Labatt Ltd v Cotton Club Bottling Co* (1976), 25 CPR (2d) 115 (FCTD)].

[33] A determination of whether there are special circumstances that excuse non-use involves consideration of three criteria: (1) the length of time during which the trade-mark has not been in use; (2) whether the reasons for non-use were beyond the control of the registered owner; and (3) whether there exists a serious intention to shortly resume use [per *Harris Knitting Mills, supra*]. Merely demonstrating an intention to resume use is insufficient on its own [per *Scott Paper, supra*]. The intent to resume use must be substantiated by the evidence [see *Arrowhead Spring*

Water Ltd v Arrowhead Water Corp (1993), 47 CPR (3d) 217 (FCTD); *NTD Apparel Inc v Ryan*, 2003 FCT 780, 27 CPR (4th) 73].

[34] In the present case, Mr. Chan has not provided any reasons or evidence to indicate why the Mark was not used in association with the aforementioned remaining goods, nor did he provide a date of last use. At the oral hearing, the Registrant submitted that certain goods have simply not been sold, that the Registrant has been trying to sell these goods and has demonstrated concrete steps taken to sell such goods in Canada.

[35] However, while it may be true that the Registrant has actively attempted to sell the remaining goods in Canada, no reasons have been brought forth to explain what has prevented the sale of such goods. In the absence of such evidence, I am unable to determine whether there were reasons that existed for the absence of use that would amount to special circumstances, let alone for a period of roughly nine years [see *Oyen Wiggs Green & Mutala v Rath*, 2010 TMOB 34, 82 CPR (4th) 77 at para 10, regarding the date of registration being considered the relevant date, when a date of last use has not been provided]. Furthermore, to the extent that the Registrant's product marketing activities (*i.e.* online and at international trade shows) could be considered as demonstrating an intention to resume use of the Mark in Canada shortly, as previously indicated, these activities in and of themselves would be insufficient to maintain the registration in respect of these goods [per *Scott Paper*, *supra*].

[36] Consequently, in view of the above, I conclude that the Registrant has failed to establish that the absence of use of the Mark in association with these remaining goods was due to special circumstances that would justify such non-use.

Disposition

[37] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, registration No. TMA605,878 will be amended to delete the goods “[...], potato flakes, potato crunches, [...], sweet corn puffs, potato fries, [...], pizza squares, sour cream and onion rings, melon crackers, banana crisps, caramel popcorn, [...], butternut crunch, corn pottage, and fish crackers.”

[38] The amended statement of goods will read as follows:

Snack food products, namely, prawn crackers, cheese sticks, potato crisps, baked potatoes, onion rings, peasnacks, cocktail curls.

Kathryn Barnett
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

Hearing Date: 2015-06-04

Appearances

Bayo Odutola

For the Registrant

James Green

For the Requesting Party

Agents of Record

G. Ronald Bell & Associates

For the Registrant

Gowling Lafleur Henderson LLP

For the Requesting Party