



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

Citation: 2012 TMOB 20
Date of Decision: 2012-02-17

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Baker & McKenzie LLP against registration
No. TMA145,567 for the trade-mark FLAVOR SAVER in
the name of Dart Industries Inc.**

[1] At the request of Baker & McKenzie LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on January 25, 2010 to Dart Industries Inc. (the Registrant), the registered owner of registration No. TMA145,567 for the trade-mark FLAVOR SAVER (the Mark).

[2] The Mark is registered for use in association with the following wares: Plastic household articles, namely, plastic containers and covers therefor (the Wares).

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares specified in the registration at any time within the three year period immediately preceding the date of the notice, and if not, the date when it was last in use and the reason for the absence of such use since that date. In this case, the relevant period for showing use is between January 25, 2007 and January 25, 2010.

[4] In the present case, the relevant definition of “use” with respect to wares is set out in s. 4(1) of the Act:

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.

[5] Furthermore, pursuant to s. 45(3) of the Act, in the absence of use as defined above, a trade-mark is liable to be expunged unless the absence of use has been due to special circumstances excusing such absence.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1979), 45 CPR (2d) 194, aff'd (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Lang Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares specified in the registration during the relevant period.

[7] In response to the Registrar's notice, the Registrant filed the affidavit of Kimberly K. Weate, Intellectual Property Counsel and Vice President of the Registrant, sworn on July 23, 2010 in Orlando, Florida. Both parties submitted written representations; an oral hearing was not held.

[8] In her affidavit, Ms. Weate attests that the Registrant, through its related companies, manufactures and sells a variety of consumer household products worldwide in association with various trade-marks including the Mark. In particular, she states that the Registrant, through its licensee Tupperware Products S.A., used the Mark in association with the advertisement and sale of the Wares during the relevant period in Canada.

[9] In support of the Registrant's assertion of use, Ms. Weate states that the Registrant sells its products, including the Wares, "primarily through catalogue sales in its home party sales program". She attests that the price of the Wares during the relevant period was \$13.99 per unit, with total sales in Canada of approximately 500 units in 2007 and approximately 700 units for the 2008 through 2009 period.

[10] Ms. Weate also attaches as Exhibits A and B to her affidavit two “representative sample promotional flyer[s] featuring the FLAVOR SAVER product and trade-mark”. The only statements she makes regarding distribution of the flyers is that the Exhibit A flyer “was distributed to the Registrant’s customers and prospective customers in Canada in January and February of 2007” and that the Exhibit B flyer was similarly distributed “in Canada from December 2008 until approximately January 2009”. I note that both flyers display the same picture for a product identified as a “Flavor Saver® Container” with a product description, but that the Mark does not appear on the product in the picture. I further note that while the Exhibit A flyer references home parties, the Exhibit B flyer does not, and there is no indication that either flyer would be used for ordering purposes.

[11] In its written representations, the Requesting Party makes various submissions regarding the lack of detail in Ms. Weate’s affidavit, which it summarizes as stating that there is no evidence of how the Mark was associated with the Wares at the time of transfer or sale. In this respect, the Requesting Party notes that the Registrant does not provide any invoices, nor does the Registrant clearly state how or where the flyers were distributed or even whether the Mark was displayed on the Wares.

[12] In their own written representations, in reference to Exhibit A, the Registrant states that “Ms. Weate attests to the fact this flyer was distributed to the Registrant’s customers and prospective customers attending at its home party sales programs held in January and February of 2007” and that “...customers at the Registrant’s home parties were able to purchase the Registered Wares by reference to the FLAVOR SAVER Trade-mark”. The Registrant makes a similar statement in their written representations regarding the Exhibit B flyer and compares its own case favourably to jurisprudence where notice of association between the trade-mark and unmarked wares was established by way of catalogues or product literature [*Gowling, Strathy & Henderson v. Degremont-Infilico Ltee* (2000), 5 CPR (4th) 550 (TMOB); *Lapointe Rosenstien v. Elegance Rolf Offerfelt GmbH* (2005), 47 CPR (4th) 196 (TMOB); *Swabey, Ogilvy Renault v. Miss Mary Maxim Ltd.* (2003), 28 CPR (4th) 543 (TMOB); *Plastibec Inc. v. Newell Window Furnishings Inc.* 2011 TMOB 106, CarswellNat 2653; *Hudson’s Bay Co. v. Sklar-Peppler Furniture Corp.* (2007), 60 CPR (4th) 174 (TMOB)]. In summary, the Registrant cites *Philip Morris Products S.A. v. Marlboro Canada Ltd.* (2010), 90 CPR (4th) 1 (FC), where the Court

affirmed the need to adapt the definition of “use” in order to take into account commercial realities.

[13] While I agree with the principles found in the jurisprudence cited by the Registrant, I would note the following from *Philip Morris Products, ibid*, at paragraph 236:

...it has been held that leaflets, product literature, and pricing stickers bearing the trade-mark, as well as catalogues, can provide the required notice of association between the trade-mark and the wares to the purchaser *when they are used in ordering and purchasing* [emphasis added]

[14] Unfortunately, contrary to the assertions made in the Registrant’s written representations, Ms. Weate does not state in her affidavit that the flyers were distributed *at the Registrant’s home parties*, nor does she state that customers used the flyers as catalogues when ordering and purchasing the Wares. Although, as noted above, one of the flyers references the Registrant’s home parties, it is not clear from her affidavit that the flyers were distributed at the time of transfer of the property in or possession of the Wares [see *Grapha-Holding AG v. Illinois Tool Works Inc.* (2008), 68 CPR (4th) 180 (FC)].

[15] I would have benefitted had the affiant provided further details regarding the conduct of the Registrant’s home parties and the manner in which transactions took place at such parties. Absent such detail, I am unable to make the inferences necessary to conclude that there was the requisite association, as was found in the cited jurisprudence above. Although evidentiary overkill is not required, the allegations in an affidavit should be precise and not susceptible to more than one interpretation and I do not find that Ms. Weate has provided sufficient information in her affidavit establishing a *prima facie* case of use [see *Plough, supra*; *Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD); and *88766 Canada Inc. v. Tag Heuer SA* (2008), 70 CPR (4th) 276 (TMOB)].

[16] Furthermore, as use cannot be established in relation to wares through the mere advertising or distribution of promotional materials concerning the registered wares [*Gowling & Henderson v. John Morton Ltd.* (1992) 47 CPR (3d) 268 (TMOB)], I do not consider the fact that the flyers were “distributed to the Registrant’s customers and prospective customers” during the relevant period to be sufficient to establish use of the Mark in association with the Wares.

[17] Consequently, I am not satisfied that there was use of the Mark with respect to the Wares within the meaning of s. 45 and s. 4 of the Act during the relevant period, there being no special circumstances to justify such non-use.

[18] Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be expunged in compliance with the provisions of s. 45 of the Act.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office