



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

Citation: 2015 TMOB 193
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

TMA706,660 for OISHI Design

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA706,660 for the trade-mark OISHI Design shown below (the Mark), owned by Liwayway Marketing Corporation.

The word 'Oishi' is written in a bold, rounded, bubbly font. Each letter has a thick white outline, giving it a 3D or shadowed appearance. The letters are black with a white border.

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

Fruit juices, soft drinks, energy drinks, mineral and aerated water, beer, and preparations for making beverages, namely, syrups, powders, crystals, granules, liquid concentrates, leaves and tablets.

[3] For the reasons that follow, I conclude that the registration ought to be maintained solely with respect to the registered good “preparations for making beverages, namely, powders.”

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. TMA605,878, TMA692,890, 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 "fruit juices and preparations for making beverages, namely powders." He states that such distribution and sales of the aforementioned products has been "specifically" by way of the Registrant's "OISHI SUNDAYS" products.

[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 SUNDAYS products for the years 2009 through 2012, and attaches to his affidavit representative samples of commercial invoices, as well as associated packing lists and shipping documents. Mr. Chan attests that the "applicable goods" are highlighted in these documents. I note that various flavours of "OISHI SUNDAYS" products have been highlighted.

[12] With respect to display of the Mark, Mr. Chan provides a representative specimen of the packaging for the "OISHI SUNDAYS" products, which he attests were actually sold and distributed in Canada. The Mark clearly appears on the packaging. I note the packaging describes the product as an "instant powdered drink mix" and includes directions for preparing beverages from the mix.

[13] Lastly, with respect to the remaining registered goods, 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 further states that these goods are promoted to international clients including Canadians at international trade fairs, and identifies two such trade shows which 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. TMA706,660 will be distributed and sold in Canada."

Submissions of the Parties and Analysis

[14] In his affidavit, Mr. Chan makes no claim of use with respect to any of the registered goods, except for the goods "fruit juices and preparations for making beverages, namely powders."

[15] At the oral hearing, the Requesting Party conceded that use of the Mark had been shown in association with "preparations for making beverages, namely, [...], powders". However, the Requesting Party maintained that the Registrant had failed to show use of the Mark in association with "fruit juices".

[16] Upon review of the evidence and given the Requesting Party's above-noted concession, I accept that use of the Mark has been shown in association with "preparations for making beverages, namely, [...], powders". At issue then, is whether the evidence is also sufficient to show use of the Mark in association with "fruit juices", and if not, whether special circumstances have been shown to excuse the absence of use with "fruit juices" as well as with respect to the remaining registered goods.

[17] The Registrant submits the evidence is sufficient to support the goods "fruits juices and preparations for making beverages, namely, powders", and that it is not required to show all manners of use and sales, or explain the lack thereof. In this regard, the Registrant submits that Mr. Chan has made clear sworn statements in his affidavit regarding such use and that

representative use with respect to these goods has been shown via its “OISHI SUNDAYS” product.

[18] The Requesting Party, on the other hand, submits that the only evidence provided of use of the Mark relates to powdered drink mixes, which corresponds to the registered good “preparations for making beverages, namely, powders.” Indeed, the Requesting Party submits, the specimen packaging describes the product as an instant powdered drink mix, and there is no indication that fruit juices form even an ingredient of this product. The Requesting Party submits that it appears from the Registrant’s submissions that the Registrant is intending to rely on the same evidence of use of the Mark as serving to support both “fruits juices” and “preparations for making beverages, namely, powders.” However, the Requesting Party submits, these goods are listed as separate, independently specified goods in the registration. As such, the Requesting Party submits, the Registrant cannot rely on use in association with “preparations for making beverages, namely, powders” to simultaneously support use in association “fruit juices” [citing *MAPA GmbH Gummi-und Plastikwerke v to 2956-2691 Québec Inc*, 2012 TMOB 192 at para 11; and *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[19] I agree with the Requesting Party that it appears that the Registrant is intending to rely on the same evidence in support of two distinct goods. The “OISHI SUNDAYS” product is clearly a powdered drink mix, not a fruit juice. Furthermore, section 45 clearly indicates that use is to be shown “with respect to each of the goods or services specified in the registration” [see also *John Labatt, supra*]. I see nothing in the evidence that permits me to conclude or enables me to draw the inference that use of the Mark in association with “preparations for making beverages, namely, powders” extends to “fruit juices”. Furthermore, I do not find in the present case that it would have placed an unreasonable burden on the Registrant to have shown use with respect to both of these goods.

[20] Thus, having regard to the foregoing, I accept that the Registrant has shown use of the Mark solely in association with “preparations for making beverages, namely, [...], powders”, within the meaning of sections 4 and 45 of the Act. However, use of the Mark has not been shown with respect to any of the remaining registered goods. Consequently, I must now

determine whether special circumstances have been demonstrated that would excuse the absence of such use.

Special Circumstances

[21] 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)].

[22] 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].

[23] In the present case, Mr. Chan has not provided any reasons or evidence to indicate why the Mark was not used in association the remaining goods, nor would I add 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.

[24] 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 to date. 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 five 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 or commence 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*].

[25] 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 the remaining goods was due to special circumstances that would justify such non-use.

Disposition

[26] Having regard to the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained solely with respect to the registered goods "preparations for making beverages, namely, powders".

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