



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

**Citation: 2015 TMOB 195**  
**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**

**TMA692,890 for OISHI Design**

**Registration**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA692,890 for the trade-mark OISHI Design shown below (the Mark), owned by Liwayway Marketing Corporation.

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

Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee, flour, and preparations made from cereals, namely, bread and pastry; confectionery, namely, nuts, chocolate, gum, sugar; ices, namely, frozen confections on a stick, ice cream; honey, treacle, yeast, baking-powder, salt, mustard, vinegar; sauces, namely, fruit, cheese, chocolate, gravy, hot, soy, pizza, spaghetti, tartar, tomato; condiments, namely, chutney, honey, jam, ketchup, lemon juice, mayonnaise, mustard, relish, salad dressing, salt and pepper, spice and ice.

[3] For the reasons that follow, I conclude that the registration ought to be expunged.

### 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, 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 “preparations made from cereals, namely, bread and pastry and confectionery.” He states that such distribution and sales has been “specifically” by way of the Registrant’s “OISHI RIBBED CRACKLINGS”, “OISHI SPONGE CRUNCH”, “OISHI CHOCO PLUNGE”, and “OISHI TENTA SQUID CHIPS” 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 associated packing lists and shipping documents. Mr. Chan attests that the “applicable goods” are highlighted in these documents. Consistent with his attestation, I note that the highlighted goods correspond to the four OISHI Goods specifically identified above. I note that the invoices shows sales of a variety of additional OISHI products (other than the OISHI Goods) which are not highlighted on the 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 correspond with three of the OISHI Goods as follows: OISHI RIBBED

CRACKLINGS, OISHI SPONGE CRUNCH, and OISHI CHOCO PLUNGE. However, there is no specimen packaging provided for the OISHI TENTA SQUID CHIPS product.

[13] With respect to the remaining registered goods, Mr. Chan explains that the Registrant has “all the intention” to use the Mark with 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. 692,890 will be distributed and sold in Canada.”

#### Submissions of the Parties and Analysis

[14] At the outset, I note that Mr. Chan consistently refers in his affidavit to use of the Mark in association with goods described as “preparations made from cereals, namely, bread and pastry and confectionery”. However, the statement of goods in the registration further specifies “confectionery” as follows: “confectionery, namely, nuts, chocolate, gum, sugar”. In addition, I note that Mr. Chan makes no claim of use with respect to any of the remaining registered goods. Consequently, the determination to be made in the present case is whether use of the Mark has been shown with the registered goods “preparations made from cereals, namely, bread and pastry” and “confectionery, namely, nuts, chocolate, gum, sugar”; and if not, whether special circumstances have been shown to excuse the absence of use with such goods, as well as the remaining registered goods.

[15] The Requesting Party submits that the Registrant has failed to show use of the Mark in association with any of the registered goods. Instead, the Requesting Party submits, use is only shown in association with what appears to be “grain-based snack foods” and “breakfast cereals”, neither of which are goods that are listed in the registration.

[16] More specifically, the Requesting Party submits that in looking at the list of ingredients on the packaging for the various OISHI Goods in evidence, it is not clear how these products

qualify as bread or pastry or any of the confectionery products specified in the registration. In this regard, the Requesting Party submits that the OISHI RIBBED CRACKLINGS product appears to be a wheat-based cracker, the OISHI SPONGE CRUNCH product appears to be a chocolate-flavoured snack food product, and the OISHI CHOCO PLUNGE product appears to be a breakfast cereal product. Further to this, the Requesting Party submits, Mr. Chan does not explain what the OISHI TENTA SQUID CHIPS product is, and there is nothing in the affidavit or the exhibits which shed any light on the issue. Moreover, the Requesting Party submits, Mr. Chan does not clarify in his affidavit which products described and shown in the evidence correspond with which particular registered good. Accordingly, the Requesting Party submits, in the absence of information about the true nature of the OISHI products, and in view of the specificity of the goods in the registration, the evidence is ambiguous and incapable of showing use with any of the registered goods.

[17] The Requesting Party submits that while certain of the products (*i.e.* – the OISHI RIBBED CRACKLINGS) may be broadly construed as products which fall within the general categories of “preparations made from cereals” or “confectionery”, this does not qualify as use of the Mark with respect to the specific goods listed in the registration. The Requesting Party submits that since the definite term “namely” follows the general categories of goods with lists of specific types of goods in those general categories, the Registrant is required to show use of the Mark in association with each of the specified goods - not just any good (such as a wheat based cracker) that falls within the general category [see, for example, *167407 Canada Inc (Re)*, 2010 TMOB 167].

[18] Additionally, the Requesting Party submits, where a registered owner has distinguished between two or more types of goods in the registration, the registered owner is required to provide evidence of use with respect to each such good unless doing so would amount to evidentiary overkill. In this regard, the Requesting Party submits, a registered owner cannot rely on a single example of use to support use with two or more goods that have been listed separately in the registration [per *John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[19] The Registrant, on the other hand, submits that the evidence is sufficient to support use of the Mark in association with “preparations made from cereals, namely, bread and pastry and confectionery”. Again, however, similar to Mr. Chan’s characterization of the statement of goods in the evidence, I note that the Registrant refers to “confectionery” generally, without further reference to the specific types of confectionery goods listed in the registration. This appears to be deliberate, as the Registrant submits that it is not required to show all manners of use and sales, or explain the lack thereof. The Registrant submits that Mr. Chan clearly indicates that the specimens in evidence are representative examples of the limited set of goods for which the affiant is setting forth in the affidavit and has provided clear sworn statements regarding sales of such goods; thus, the Registrant submits it is not required to show whether the products are bread, pastry, or confectionery.

[20] In addition, with respect to representative use, the Registrant submits that “although Mr. Chan highlighted certain products for the Registrar’s attention” in his affidavit, the invoices also refer to other “products of interest”, such as “BREAD PAN”, “WAFU” (which it submits are wafers), and “CHOCOLATE PILLOWS”. The Registrant characterizes these products as being “bread and pastry and chocolate” in its written representations. As such, the Registrant submits that the affiant has submitted sufficient examples in this case of sales and labels showing representative specimens bearing the Mark related to the goods “of interest”. Consequently, the Registrant submits, the Mark should not be expunged “from the Register for those specific goods from those more general in nature; ie: cigarillos being tobacco products and canned tomatoes being canned fruit and vegetables” [citing *Empressa Cubana del Tabaco v Shapiro Cohen* 2011 FC 102, affirmed FCA 340, and *Countryside Cannery Co v Canada (Registrar of Trade-marks)* (1981), 55 CPR (2d) 25 (FCTD)].

[21] However, I do not find the *Empressa Cubana* or the *Countryside Cannery* cases to be of assistance to the Registrant. The present case is distinguishable in that no evidence has been furnished to assist in understanding how the “products of interest” are encompassed by the goods specified in the registration. While the names of the above-noted “products of interest” might imply that they are related to bread and pastry and perhaps chocolate confection, there is no information in the evidence to provide a clear understanding of the nature of these products. Noteworthy, I would add, is that Mr. Chan does not correlate these “products of interest” to the

registered goods in his affidavit. Indeed, Mr. Chan is clear in his affidavit that the goods that correspond to his general reference to “preparations made from cereals, namely, bread and pastry and confectionery” are *specifically* the four identified OISHI Goods. Consequently, the inference is that any other goods that may be referenced in the evidence do not constitute “preparations made from cereals, namely, bread and pastry” or “confectionery”.

[22] Thus, I am left to decide whether the evidence of use of the Mark in association with the OISHI Goods sufficiently demonstrates use with respect to the registered goods, “preparations made from cereals, namely, bread and pastry” and “confectionery, namely, nuts, chocolate, gum, sugar”.

[23] In looking at the OISHI Goods identified by Mr. Chan, and with reference to the packaging specimens provided, I agree with the Requesting Party that none of these products appear to correspond to the registered goods “preparations made from cereals, namely, bread and pastry” or “confectionery, namely, nuts, chocolate, gum, sugar.” Additionally I agree with the Requesting Party that while some of the OISHI Goods may fall within the general categories of “preparations made from cereals” or “confectionery”, this does not qualify as use of the Mark with respect to the specific goods listed in the registration [per *John Labatt, supra* and *167407 Canada, supra*].

[24] In view of the foregoing, I am not satisfied that the Registrant has demonstrated use of the Mark in association with the goods “preparations made from cereals, namely, bread and pastry” or “confectionery, namely, nuts, chocolate, gum, sugar” within the meaning of sections 4 and 45 of the Act. I must now determine whether special circumstances have been demonstrated that would excuse the absence of use in association with these goods, as well as with the remaining registered goods.

#### *Special Circumstances*

[25] 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].

[26] Per *Harris Knitting Mills, supra*, 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. Merely demonstrating an intention to resume use is insufficient on its own [per *Scott Paper, supra*], and 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)].

[27] 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 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.

[28] 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 almost six years [see *Oyen Wiggs Green & Mutala v Rath*, 2010 TMOB 34, 82 CPR (4th) 77 at para 10, regarding the date of registration as being considered the relevant date, when a date of last use has not been provided]. Furthermore, even if I were to consider 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*].



[29] 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 registered goods was due to special circumstances that would justify such non-use.

Disposition

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

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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

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For the Registrant

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For the Requesting Party