



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

Citation: 2016 TMOB 75
Date of Decision: 2016-05-16

IN THE MATTER OF A SECTION 45 PROCEEDING

Fetherstonhaugh & Co.

Requesting Party

and

TFI Foods Ltd. / Les Aliments TFI Ltee.

Registered Owner

**TMA673,966 for YUTAKA & Chinese
Characters Design**

Registration

[1] At the request of Fetherstonhaugh & Co. (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on March 12, 2014 to TFI Foods Ltd. / Les Aliments TFI Ltee. (the Owner), the registered owner of registration No. TMA673,966 for the trade-mark YUTAKA & Chinese Characters Design (the Mark). The Mark is shown below:



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

Rice, noodles, cereals and grains; cooking oils and cooking wine; sauces and condiments, namely, soy sauces, marinated sauces, salad dressings, fish sauce, vinegar, premixed cooking sauces, hoisin sauce, black pepper sauce; dairy products, namely, ice cream, yogurt, cheese and frozen desserts; biscuits and sugar confections; powdered mixes, namely tempura mix batter, five-spice powder, curry powder for cooking and marinating, and seaweed nori.

[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 goods 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 March 12, 2011 to March 12, 2014.

[4] The relevant definition of “use” in association with goods 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.

[5] In response to the Registrar’s notice, the Owner filed the affidavit of David Lam, President of the Owner, sworn on October 14, 2014 in Toronto. Both parties filed written representations and were represented at a hearing.

The Owner’s Evidence

[6] In his affidavit, Mr. Lam attests that the Owner is a distributor of dry food products and seafood, employing approximately 200 people in four offices across Canada. He explains that the Owner’s food products are mainly distributed to supermarkets, local grocery stores, Oriental specialty stores, restaurants and food markets across Canada. Mr. Lam attests that the Mark is associated with a line of specialty Japanese food products sold in Canada. In particular, Mr. Lam asserts that the Mark is displayed on the packaging of “a variety of food products, including rice, noodles, grains, sauces and condiments, biscuits and snack foods.”

[7] Mr. Lam asserts that the Owner first used the Mark in 2005 “in association with the full list of wares set out in the registration” and that the Owner continues to use the Mark in Canada “in association with all of these wares”. He attests that sales of YUTAKA products in Canada have been “very considerable” and provides sales figures as follows: 2011 - \$3.6 million; 2012 - \$2.6 million; 2013 - \$1.8 million; January to March 2014 - \$0.4 million.

[8] In support, attached to Mr. Lam's affidavit are the following exhibits:

- Exhibit B is a webpage printout from the Owner's website, *www.taifoong.com*, that Mr. Lam identifies as the "Japanese Products" page. Although the Mark appears on the page, it is underneath the heading "introducing Ama-ebi (cold water shrimp)" and next to a description of a shrimp product.
- Exhibit C consists of dozens of pages depicting various YUTAKA products that Mr. Lam attest are representative of the packaging that has "been in use for the last 9 years and are currently in use." The exhibit shows packaging for the registered goods rice, noodles, soy sauce, vinegar, tempura mix batter and seaweed nori as well as various goods not listed in the registration, such as ginger, sesame seeds and bamboo chopsticks. The Mark appears on the depicted packaging.
- Exhibit D consists of dozens of invoices that Mr. Lam attests are representative sample invoices for sales of YUTAKA products from 2011 to 2014. Although some of the invoices pre-date the relevant period, all of the invoices are from the Owner to customers located in Canada. The invoices show the sale of a variety of goods, only some of which are identified under the "BRAND" column as YUTAKA products. Some goods are identified by different brands, such as CAPTAIN or BLACK TIE, whereas the "BRAND" space is left blank for other goods.

[9] While some of the YUTAKA goods appearing on the invoices are easily identifiable (such as YUTAKA "rice-calrose" and YUTAKA "Sauce-Soy"), some of the goods use abbreviations or terminology that leave it unclear as to the nature of the good (such as YUTAKA "SO-BT"). Mr. Lam leaves the invoices to speak for themselves and makes no attempt to correlate the invoiced items with the registered goods. However, I am able to identify the following registered goods as appearing on the invoices next to the YUTAKA brand identification: rice, seaweed nori, noodles and soy sauce.

Analysis

[10] Although Mr. Lam asserts that the Owner “continues to use” the Mark in Canada in association with all of the registered goods, it is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD) at 480], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v 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 goods specified in the registration during the relevant period [*John Labatt Ltd v Rainer Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[11] In this case, notwithstanding the diverse range of goods listed in the registration, the Owner furnished examples of packaging for only some of the registered goods. For example, Exhibit C includes no depictions of “dairy products” or “biscuits and sugar confections”. As examples of other products *not* listed in the registration were furnished, it is not clear why examples of dairy products and biscuits, for example, were omitted.

[12] Similarly, although Mr. Lam appears to assert use of the Mark with respect to all of the registered goods, it is not clear that transfers of each occurred during the relevant period. In this respect, Mr. Lam only provides aggregate sales figures for YUTAKA-brand products during the relevant period and, despite attaching nearly 200 pages of invoices to his affidavit, only four YUTAKA-brand goods are identifiable as corresponding with the registered goods: rice, seaweed nori, noodles and soy sauce. Again, given the volume of invoices, it is not clear why only these four registered goods are reflected in the invoices.

[13] While a registered owner is not obligated to provide invoices for each registered good, sufficient evidence must nonetheless be provided to allow the Registrar to conclude that transfers in the normal course of trade actually occurred in Canada with respect to *each* of the registered goods [see *Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)]. By way of example, in the absence of invoices, such evidence can include statements regarding volumes of sales, dollar value of sales, or equivalent factual particulars [see, for example, *1471706 Ontario Inc v Momo Design srl*, 2014 TMOB 79, CarswellNat 2439; and

Gowling Lafleur Henderson LLP v Wertex Hosiery Incorporated, 2014 TMOB 193, CarswellNat 4624].

[14] While I accept that the exhibited photographs are representative of the manner in which the Mark was displayed on the goods, the issue here is that Mr. Lam does not clearly demonstrate sales and transfers of *each* of the registered goods for which he asserts use of the Mark during the relevant period.

[15] Given the gaps in Mr. Lam's affidavit and his generalized statement of sales with respect to the "YUTAKA line of products", I am left with the exhibited invoices as the only clear evidence of transfers of particular goods in Canada during the relevant period.

[16] At the oral hearing, the Owner directed attention to invoices showing sales of "Yaki-Tamago" and "Panko Bread Crumbs".

[17] With respect to Yaki-Tamago, the Owner submitted that it is a type of candy, thus corresponding with the registered goods "sugar confections". Notwithstanding that this identification of the product does not appear in the affidavit, I agree with the Requesting Party that the invoice does not clearly identify Yaki-Tamago as a YUTAKA-branded good. In this respect, the product identifier column next to Yaki-Tamago is blank; although YUTAKA appears on the line above it, it is next to the description for another product. I am not prepared to infer that YUTAKA should be associated with both of these goods, as this does not appear to be consistent with the manner of identification throughout the exhibited invoices. Indeed, various trade-marks appear in the brand column and YUTAKA often appears multiple times in a row with respect to different products.

[18] Similarly, the Owner submitted that Panko Bread Crumbs corresponds with the registered good "tempura mix batter". However, I note that the "Tempura Batter Mix" products depicted in Exhibit C do not appear to correspond with listings of "Panko Bread Crumbs" appearing on the exhibited invoices. Indeed, as with the listings for Yaki-Tamago, YUTAKA does not appear in the brand column next to item listings for "Panko Bread Crumbs".

[19] Lastly, while examples of packaging for the registered goods "vinegar" and "tempura mix batter" appear in the Exhibit C photographs, in viewing the evidence as a whole, I am not

satisfied that Mr. Lam's affidavit shows transfers of such goods in the normal of course of trade in Canada during the relevant period.

[20] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark only in association with the following registered goods within the meaning of sections 4(1) and 45 of the Act: rice, noodles, soy sauces and seaweed nori.

[21] As such, I am not satisfied that the Owner has demonstrated use of the Mark in association with the remaining registered goods within the meaning of sections 4 and 45 of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark, the registration will be amended accordingly.

Disposition

[22] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete the following goods:

... cereals and grains; cooking oils and cooking wine; ... marinated sauces, salad dressings, fish sauce, vinegar, premixed cooking sauces, hoisin sauce, black pepper sauce; dairy products, namely, ice cream, yogurt, cheese and frozen desserts; biscuits and sugar confections; powdered mixes, namely tempura mix batter, five-spice powder, curry powder for cooking and marinating, ...

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

Rice, noodles; sauces and condiments, namely, soy sauces; and seaweed nori.

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

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE: 2016-02-03

APPEARANCES

Sarah Goodwin For the Registered Owner

Daniel Anthony For the Requesting Party

AGENTS OF RECORD

Fasken Martineau Dumoulin LLP For the Registered Owner

Fetherstonhaugh & Co. For the Requesting Party