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Votre reference Your file
G-2328
Notre reference Our file
474,319

Dear Sir/Madam:

RE: SECTION 45 PROCEEDINGS
Registration No. TMA272,498
Trade-mark: REGINA

At the request of Messrs. Gowling , Strathy & Henderson , the Registrar issued a S.45 Notice dated April 27, 1988, to 121,369 Canada Inc., the registered owner of the above referenced trade-mark registration.

The mark Regina was registered on October 8, 1982 for use in association with the following wares:

"(1) Breads of all sorts, cake, pastry, biscuits, bread crumbs and pizza. (2) Canned, frozen, processed and packaged spaghetti and macaroni products, namely,
spaghetti dinner, pizza dinner, ready- to-serve macaroni and ravioli, anti pasta, pizza and ravioli; sausages; canned , f r oz e n , processed and bottled fish products,
namely, tuna, anchovies. sardines, and salmon; edible oils; condiments, namely, spices, herbs, vinegars, sauces, marinades , mustard , and mayonnaise; canned, frozen, and processed fruit; canned fruit and vegetable juices; cheese; coffee, tea and cocoa; salads; fresh , frozen , canned and packaged cakes, pies, pastries, puddings and de s e r t s ; canned , frozen, and processed vegetables."

Ownership of this mark was transferred on several occasions, the last assignment being the only one material to these proceedings. This last assignment, recorded on the register on October 21, 1988, indicates a change in title with an effective date of March 19, 1986 and recognizes Les Aliments Da Vinci Ltee as the new owner of the mark as of that d a t e.

I have reviewed the assignment documents filed under Section S.48 of the Act and I am satisfied that the t r a ns f e r in title from Les Aliments Regina Foods Inc., to Les Al iments *Da* Vinci Ltee., was properly recorded nunc pro tunc on October 21, 1988 with effective date of transfer as of March 19, 1986.

In response to the Registrar's Notice, the registrant furnished the affidavit of its controller, Mr. Richard Farran, along w ith exhibits A and B thereto. Fu r the r to the filing of this evidence, the requesting party filed a written submission to wh ich the registrant responded in like manner.

On reviewing the evidence fi1ed and the arguments of both parties, I find the Farran affidavit quite informative and to the point. I also find the written arguments of both parties to be comprehensive and pertinent. Given that the governing jurisprudence in S. 45 matters is in a constant state of evolution, since the famous Ae r o so l F'i l l e rs ' Inc., decision 1 in 1980, the only problem to be resolved in t h is instance is wher e the 1 aw stands at this point in time.

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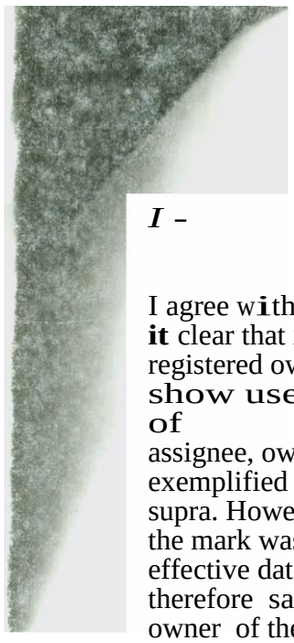
1 - Aerosol Fillers Inc'.,v. Plaugh-(Canada) Ltd.(1480) 45 C.P.R.. (2nd) 194; .affirmed 53 C.P.R. (2d) 62.

Canada



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I agree with counsel for the requesting party that the Marcus decision 2 made it clear that in s. 45 proceedings, the evidence of use must be furnished by the registered owner *of* the mark by a duly registered user, that the evidence must show use of the mark by either of these parties and that the principle of assignee, owner in fact or legal owner, accepted in previous decisions, as exemplified by the STAR-K1ST decision 3, was put to rest by the Marcus decision, supra. However, in the instant case and as indicated supra, an assignment of the mark was recorded nune pro tunc on October 21, 1988 with confirms an effective date of March 19, 1986 again as discussed in the Marcus case. I am therefore satisfied that the evidence in this case was properly furnished by the owner of the mark: and that any use shown by the evidence is use by this new owner.

On the question of whether the trade-mark is in us with all and each of its registered wares, the Farran affidavit is quite clear ; it is not. The wares in association with which the mark was in use as of the notice date are clearly listed on page 2 of the said affidavit.

The reasons adduced to excuse the absence of use with the remaining wares, in My opinion, are not very convincing. While I would probably agree that a recent assignment coupled with a constraining situation would excuse non-use for a justifiable period of time. I do not believe that a not so recent assignment coupled with a pious intention of resuming use oat a vague date in the future would be compelling enough to deserve an exception to the general rule; see Harris Knithing Mills4.

In the instant case, the new owner was already dealing in most of the registered wares, under different trade-marks, as of the notice date and the evidence does not establish an acceptable reason why the REGINA mark was not put to comprehensive use from inception, nor any serious plan to do so as soon as feasible.

In my respectful opinion, the statement of paragraph 5 of the Farran affidavit which reads as to follows:

> "A cause de l'acquisition récente de cette marque de commerce, il a été impossible d'employer la marque en liaison avec toutes les marchandises visées par l'enregistrement numéro 272,498. Cependant, ma compagnie se propose d'employer cette marque de commerce en liaison avec toutes ces marchandises dans les meilleurs délais possibles."

Cannot be considered as special circumstances which could excuse the apparent period of non-use of over two (2) years; that is, from the effective date of the transfer March 19, 1986 in the notice date of April 27, 1988 or even to the date of the Farran affidavit of July 4, 1988.

Therefore, by reason of the evidence filed in these proceedings, I have Concluded that the subject trade-mark is in use in association with some of its Registered wares, but not with all of them and, that the reasons adduce

2. – Marcus v. Quaker Oats Company of Canada Ltd. (1989) 20 C.P.R. (3d) 46

3. – Star-Kist Foods Inc. v. RTM (1985) 3 C.P.R. (3d) 208, reversed 20 C.P.R. (3d) 46

4. – Registrar of Trade-marks v. Harris Knitting Mills (1985)

3 C.P.R. (3d) 488.