

SECTION 45 PROCEEDINGS  
TRADE-MARK: POCAHONTAS  
REGISTRATION NO.: UCA 22,592

On July 18, 2001 at the request of Messrs. Desjardins Ducharme Stein Monast, the Registrar forwarded a Section 45 notice to Baird-Neece Packing Corporation (a California Corporation), the registered owner of the above-referenced trade-mark registration.

The trade-mark POCAHONTAS is registered for use in association with the following wares: “fresh citrus fruit”.

Section 45 of the Trade-marks Act requires the registered owner of a trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on 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 use since that date. The relevant period in this case is any time between July 18, 1998 to July 18, 2001.

In response to the notice the registrant filed the affidavit of Dick Neece together with exhibits. Both parties have filed a written argument. An oral hearing was requested by the registrant, but this request was later withdrawn. An oral hearing did not take place.

In his affidavit Mr. Neece states that he is President of Baird-Neece Packing Corporation, which has used and continues to use the registered trade-mark in Canada in association with fresh citrus fruit.

He explains that the normal course of trade and primary nature of the registrant's business is that of grower and packer of citrus fruit. The registrant is a grower member of Sunkist Growers Inc. which is an agricultural cooperative comprised of growers and affiliated packing houses. He states that the sales department of Sunkist Growers Inc. assists in the distribution of the products including the invoicing of such products to the buyers on behalf of its member growers.

He then indicates that the trade-mark POCAHONTAS is used in Canada in association with fresh citrus fruits by way of application of the trade-mark to packaging for the wares. As Exhibit A he attaches a sample carton box end demonstrating the manner in which the trade-mark appears in

association with the fresh citrus fruit as sold in the Canadian marketplace.

Mr. Neece includes in his affidavit a representative list of Canadian purchasers of the POCAHONTAS brand of fresh citrus fruit. As Exhibit B, he attaches four (4) representative invoices. He adds that the registrant's POCAHONTAS brand fresh citrus fruits are promoted and advertised in Canada through direct calls by sales representatives on prospective Canadian purchasers.

The requesting party argues that what the evidence shows is that the registrant is a grower and packer of citrus fruits and that it grows oranges for an entity known as Sunkist Growers who sell them in Canada under the trade-mark SUNKIST. Therefore, it submits that if there is use of a mark in association with the wares it is by Sunkist Growers and it is use of the trade-mark SUNKIST and not of the trade-mark POCAHONTAS.

It argues that this is substantiated by the fact that the invoices do not refer to the registrant and the

fact that on the packaging the “representation of an orange” bears the trade-mark SUNKIST.

Also, the requesting party argues that the term POCAHONTAS appearing on the packaging is used with additional matter and therefore POCAHONTAS “per se” is not being used.

In addition, it states that the packaging filed does not meet the requirements of article 51 of the *French Language Charter*; that such packaging could not have possibly been used for sale of the wares to the consumer in the province of Quebec and that the registrant has not been able to prove that its products were legally sold elsewhere in Canada in packaging bearing the trade-mark POCAHONTAS taking into consideration article 6(2) of the *Consumer Packaging and Labelling Regulations*. It submits that the inscriptions relating to the dimensions and the quantity of the products found on the left upper corner of Exhibit A that should have appeared in English and in French, are only written in English, contrary to article 6(2) mentioned above.

Having considered the evidence, I conclude that it shows use of the trade-mark POCAHONTAS in

association with the wares by the registrant.

Concerning sales of the wares, although the invoices filed as Exhibit B to the Neece affidavit show “Sunkist Growers” as the vendor, Mr. Neece has clearly explained that the registrant is a grower member of Sunkist Growers and that the sales department of Sunkist Growers *assists* in the distribution of the products of the grower members including the invoicing to the buyers on the *members behalf*. Therefore I accept that the invoicing was done by Sunkist Growers on behalf of the registrant and that “Sunkist Growers” merely acted as an agent or distributor. Consequently, I accept that the use is by the registrant (see *Osler, Hoskin & Harcourt v. United States Tobacco Co.* (77 C.P.R. (3d) 475 F.C.T.D.) and *Manhattan Industries v. Princeton Manufacturing Ltd* (4 C.P.R. (2d) 6 F.C.T.D)).

Concerning the required association between the trade-mark and the wares, as Mr. Neece has sworn that the trade-mark appears on the packaging for the wares when sold in the Canadian marketplace

(i.e. to grocery stores, wholesalers and supermarkets) and as Exhibit A shows the manner the trade-mark appears on the packaging, I conclude that the evidence is sufficient to permit me to conclude that at the time of transfer the required notice of association between the registered trade-mark and the wares was given to the registrant's customer in a manner complying with ss. 4(1) of the Act. In my view the evidence shows that the mark POCAHONTAS is being used by the registrant as a trade-mark to distinguish the oranges it has packed and cultivated.

I also am satisfied that the use of "POCAHONTAS" as it appears on the packaging is use of the trade-mark POCAHONTAS "per se". Although the trade-mark appears with additional matter I find that the trade-mark POCAHONTAS stands out from such additional matter and would be perceived as the trade-mark being used. Further the fact that the ® symbol appears immediately following the word POCAHONTAS would serve to provide the message to the registrant's purchasers that the word POCAHONTAS "per se" is being used as a trade-mark.(see *Nightingale Interloc Ltd. v. Prodesign Ltd.*, 2 C.P.R. (3d) 535)

As for the fact that there is no evidence of the manner the trade-mark appeared in association with the wares when the wares reached the end-user or consumer, this is not relevant. As I stated in

*Novopharm Ltd. v. Monsanto Canada Inc.* (80 C.P.R. (3d) 287) at page 290:

I also agree with the requesting party that only a portion of the 80 mg "SEARLE tablets" are sold in sleeves stamped with the trade-mark, and that such are only shipped to wholesalers and larger pharmacies and that there is no evidence of an association between the mark and the wares when the wares are sold to the end users. However, as properly argued by the registrant, when the wares in cardboard sleeves stamped with the trade-mark are sold to wholesalers and larger pharmacies, which are the registrant's customers, such use is in compliance with the Trade-marks Act. As stated in *Lin Trading Co. v. CBM Kabushiki Kaisha* (1988), 21 C.P.R. (3d) 417 (F.C.A.) at page 421:

I simply cannot agree with the appellant's position that sales "in the ordinary course of trade" can exist only if shown to have occurred along the entire chain referred to by Mr. Justice Heald, ending with an ultimate consumer. As I have already said, the *Manhattan Industries* case does not appear to lay down any such requirement.

Here, the evidence shows that the wares are sold to wholesalers, grocery stores and supermarkets in packaging bearing the trade-mark and this is sufficient for purposes of Section 45 and ss. 4(1) of the

Act.

Further the fact that the citrus fruits themselves may or may not bear the trade-mark SUNKIST is irrelevant.

Concerning the requesting party's argument that the packaging furnished does not appear to comply with the *French language Charter* concerning products sold in the province in Quebec or to comply with Section 6(2) of the *Consumer Packaging and Labelling Regulations* regarding products sold elsewhere in Canada, and its argument that the registrant's products could not have possibly been legally sold in the type of packaging that has been filed as evidence, I am of the view that compliance with other laws is not a matter which ought to be addressed in this type of proceeding as compliance with statutes other than the Trade-marks Act is not a relevant consideration in a Section 45 proceeding (see *Marks & Clerk v. Sparkles Photo Limited* (2005 FC 1012, T-1594-04), *Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr*, 21 C.P.R. (3d) 483) and *Molson Canada v. Kaiserdom-Privatbrauerei Bamberg Wörner KG* [not yet reported] decision rendered March 8<sup>th</sup>, 2005, Trade-Marks Opposition Board - Section 45 Division).



Here Mr. Neece has sworn that the wares were sold in Canada in such packaging to the registrant's customers (i.e. wholesales, grocery stores, supermarkets). Accordingly, I accept this to be the case.

To conclude otherwise would be to conclude that Mr. Neece was trying to mislead and I find there is no evidence to that effect.

As I have concluded that use of the trade-mark by the registrant in association with the wares has been shown, I conclude that the trade-mark registration ought to be maintained.

Registration No. 22,592 will be maintained in compliance with the provisions of Section 45(5) of the Trade-mark Act.

DATED AT GATINEAU, QUEBEC, THIS 24TH DAY OF NOVEMBER 2005.

D. Savard  
Senior Hearing Officer  
Section 45 Division