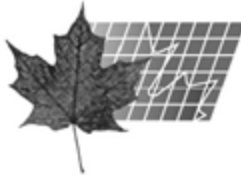


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2018 TMOB 157

Date of Decision: 2018-12-13

IN THE MATTER OF SECTION 45 PROCEEDINGS

David Michaels

Requesting Party

and

**Agros Trading Confectionery Spolka
Akcyjna**

Registered Owner

TMA728,997 for SESAME SNAPS

Registrations

TMA728,998 for SESAME SNAPS &

Design

TMA332,105 for SESAME SNAPS &

Design

[1] This is a decision involving summary expungement proceedings with respect to registration Nos. TMA728,997, TMA728,998, and TMA332,105 for the marks SESAME SNAPS (the Word Mark), SESAME SNAPS & Design (the Colour Mark), and SESAME SNAPS & Design (the Design Mark), collectively, the Marks, owned by Agros Trading Confectionery Spolka Akcyjna. The design marks are shown below with registration No. TMA728,998 claiming red lettering surrounded by a blue border.



[2] The Marks are currently registered in association with “confectionery products, namely, sesame bars” (the Goods).

[3] For the reasons that follow, I conclude that the registrations ought to be maintained.

THE PROCEEDINGS

[4] On September 16, 2016, the Registrar of Trade-marks sent notices under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Agros Trading Confectionery Spolka Akcyjna (the Owner), in respect of the Word Mark. The Registrar of Trade-marks also sent notices under section 45 of the Act in respect of the Colour Mark and the Design Mark on February 8, 2017. The notices were sent at the request of David Michaels (the Requesting Party).

[5] The notices required the Owner to furnish evidence showing that it had used the Word Mark, at any time between September 16, 2013 and September 16, 2016, and that it had used the Colour Mark and the Design Mark at any time between February 8, 2014 and February 8, 2017 (collectively, the Relevant Periods), in Canada in association with the Goods. If the Marks had not been so used, the Owner was required to furnish evidence providing the date(s) when the Marks were last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use in the present case 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”.

As such, the evidentiary threshold that the registered owner must meet is quite low [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the trade-mark was used in association with the goods specified in the registration.

[8] In response to the Registrar’s notices, the Owner furnished identical affidavits of Tomasz Grabowski, Vice President of the Owner, sworn April 10, 2017, together with Exhibits A to E. Both parties filed written representations. As with the evidence, the representations with respect to each proceeding are identical.

[9] The Requesting Party requested an oral hearing in a letter dated February 16, 2018; however, as the administrative deadline for requesting an oral hearing expired on January 24, 2018, and the Requesting Party provided no explanation for the delay, the request was denied on February 20, 2018.

[10] As a preliminary matter, I note that in its written representations, the Requesting Party makes reference to facts not in evidence. These submissions will be disregarded [*Ridout & Maybee LLP v Encore Marketing International, Inc* (2009), 72 CPR (4th) 204 (TMOB)]. In addition, I note that the Requesting Party makes representations regarding the validity of the trade-mark, which are beyond the scope of section 45 proceedings, and therefore will also be disregarded [*Ridout & Maybee LLP v Omega SA* 2005 FCA 306, 43 CPR (4th) 18].

The Evidence

[11] In his affidavit, Mr. Grabowski states that the Marks appeared on the packaging for the Goods sold in Canada during the Relevant Periods, which were manufactured in accordance with the Owner’s specifications by its wholly owned manufacturer, Unitop-Optima S.A. (Unitop). He states that, at all times, the Owner maintains control over the character and quality of the Goods manufactured by Unitop on its behalf.

[12] In support, Mr. Grabowski attaches as Exhibit A to his affidavit, photographs which are representative of how the Marks appeared on the product packaging for the Goods sold in Canada during the Relevant Periods. The Marks are clearly visible on the packaging for the Goods.

[13] According to Mr. Grabowski, the Owner sells the Goods to food product importers in Canada, who then sell to retail stores such as Sobeys, Safeway, and Costco Wholesale. He attests that total Canadian sales of Goods during the Relevant Periods were in excess of \$6.5 million. As further evidence of sales of the Goods, he provides, as Exhibit B to his affidavit, invoices showing representative sales made by the Owner to Canadian-based entities during the Relevant Periods.

[14] Mr. Grabowski explains that in the ordinary course of business, a Canadian buyer will place an order with the Owner, who will then ship the Goods to Canada. He provides a representative bill of lading as Exhibit C to his affidavit, which appears to correspond to the sale shown in the first invoice in Exhibit B.

[15] In addition, Mr. Grabowski attests that Goods bearing the Mark are sold by many vendors in Canada and provides, as Exhibit D to his affidavit, photographs of the Goods on display for sale in retail stores in Canada. While Mr. Grabowski acknowledges that these photographs were taken after the Relevant Periods, he attests that they are representative of how the Goods would have been displayed in retail stores in Canada during the Relevant Periods. Again, I note that the Marks clearly appear on the packaging for the Goods, as well on product display boxes containing the Goods.

[16] Lastly, Mr. Grabowski attests that the Goods are advertised by many of the retail stores in Canada where they are sold. In support, he attaches, as Exhibit E to his affidavit, an excerpt from a 2016 Costco Wholesale catalogue advertising the sale of the Goods.

ANALYSIS AND REASONS FOR DECISION

[17] The Requesting Party raises two main issues regarding Mr. Grabowski's affidavit: first, that use of the Marks does not appear to be that of the Owner nor does it enure to the Owner's

benefit; and second, the evidence shows that the product sold is sesame snaps, rather than the registered goods, sesame bars.

[18] With respect to the first issue, the Requesting Party submits that the Owner has failed to establish that it maintains control over the character and quality of the Goods manufactured by Unitop. In this regard, the Requesting Party submits that the Owner has merely made a bald statement that it maintains control over the character and quality of the Goods, and has not shown in its evidence how it does so remotely from Warsaw, Poland, where the Owner is based.

[19] Further to this, the Requesting Party submits that the Owner was required to clearly identify itself as the trade-mark owner on the packaging of the Goods and to produce a manufacturing agreement which specifies how the Owner controls the character and quality of manufacturing of the Goods. The Requesting Party submits that, in the present case, the packaging of the Goods identifies the Owner as the exporter of the Goods, such that, in the public's mind, the use of the Marks is by the manufacturer, Unitop, and not the Owner.

[20] However, the Owner submits, and I agree, that Mr. Grabowski's clear, unambiguous sworn statements attesting to the Owner's control over the character and quality of the Goods are sufficient for the purposes of establishing the requisite control pursuant to section 50 of the Act for the purposes of section 45 proceedings [*Empresa Cubana Del Tobacco Trading v Shapiro Cohen*, 2011 FC 102, 91 CPR (4th) 248 at para 84].

[21] The fact that the Owner is not identified on the packaging for the Goods as the trade-mark owner is irrelevant; there is no such requirement in the Act. Mr. Grabowski has clearly attested that Unitop manufactures the Goods *on behalf* of the Owner and that orders for the Goods are placed with the Owner, who is the seller and exporter of the Goods. Consequently, the Owner is the first link in the chain of transactions that lead to sales in Canada; it is the entity who orders the production, sells, and exports the Goods to Canadian importers [see *Manhattan Industries Inc v Princeton Manufacturing Ltd*, (1971), 4 CPR (2d) 6 (FCTD); *Brouillette, Kosie v Segafredo Zanetti SpA* (2005), 44 CPR (4th) 468 (TMOB)]. Accordingly, in view of the affiant's statements pertaining to the normal course of trade which is supported by both the invoices (Exhibit B) and bills of lading (Exhibit C), I am satisfied that the Goods originate from the Owner and that any evidence of sales of the Goods in Canada during the Relevant Periods enures

to the benefit of the Owner. For the purposes of a section 45 proceeding, it does not matter who the public would believe to be the owner of the Mark [*Swabey Ogilvy Renault v Golden Brand Clothing (Canada) Ltd*, (2000) 10 CPR (4th) 274 (TMOB)].

[22] With respect to the Requesting Party's submissions that the evidence shows that the products sold are not "sesame bars", I am not prepared to make such a finding. The Requesting Party's submissions in this regard include reference to facts not in evidence, as well as submissions regarding the validity of the trade-mark, which I have already indicated will be disregarded.

[23] There is nothing in the evidence to suggest, on its face, that the products sold by the Owner are not sesame bars. Mr. Grabowski identifies the products sold as the Goods, and nothing in the evidence contradicts this correlation. Furthermore, with respect to goods, the Federal Court has held that a proceeding under section 45 of the Act "is intended to be a simple, expeditious procedure to get rid of 'deadwood' from the registry and is not to be an exercise in meticulous verbal analysis" [*Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096; and *Levi Strauss & Co v Canada (Registrar of Trade-Marks)*, 2006 FC 654, 51 CPR (4th) 434]. While I note that the Registrar is permitted to reference dictionary definitions in analyzing the nature of the goods included in a specification, such an exercise in the present case would involve precisely the type of "meticulous verbal analysis" noted above.

[24] In view of the foregoing, I am satisfied that the Owner has shown use of the Marks in association with "confectionery products, namely, sesame bars" within the meaning of sections 4 and 45 of the Act.

DISPOSITION

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

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

AGENTS OF RECORD

Smart & Biggar

FOR THE REGISTERED OWNER

No Agent Appointed

FOR THE REQUESTING PARTY