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LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2021 TMOB 217**

**Date of Decision: 2021-09-29**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Norton Rose Fulbright Canada  
LLP/S.E.N.C.R.L.,S.R.L.**

**Requesting Party**

**and**

**Tony Kock Yin Chao**

**Registered Owner**

**TMA298,857 for TEA  
GARDEN:Design**

**Registration**

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA298,857 for the trademark TEA GARDEN;Design (the Mark), as shown below:



[2] All references are to the Act as amended June 17, 2019, unless otherwise noted.

[3] The Mark is registered for use in association with the following (the Goods and Services):

Goods: Prepared Chinese foods; frozen and prepared foods and fresh produce.

Services: Operation of a Chinese restaurant.

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

#### THE PROCEEDINGS

[5] At the request of Norton Rose Fulbright Canada LLP/S.E.N.C.R.L.,S.R.L. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on March 20, 2019, to Tony Kock Yin Chao, the registered owner of the Mark (the Owner).

[6] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods and services 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 20, 2016 to March 20, 2019 (the Relevant Period).

[7] The relevant definitions of use are set out in section 4 of the Act as follows:

4(1) A trademark 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[8] It is well established that bare statements that a trademark is in 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 these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and

evidentiary overkill is not required [*Union Electric Supply Co Ltd v Canada (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 trademark in association with each of the goods and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[9] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[10] In response to the Registrar's notice, the Owner furnished an affidavit of Tony Kock Yin Chao, sworn on April 15, 2019 to which were attached Exhibits "A" and "B".

[11] Both parties submitted written representations. No oral hearing was held.

#### THE EVIDENCE

[12] The Owner is a businessman resident in the Province of Quebec. His affidavit is brief, consisting of the following substantive paragraphs and two exhibits:

"2. TEA GARDEN; DESIGN, was in use in Canada at any time during the relevant period as a trademark in association with the goods: 'Prepared Chinese foods; frozen and prepared foods and fresh produce'; and the services: 'Operation of a Chinese restaurant'.

3. The goods bearing the trademark are available in the refined grocery stores. Attached hereto and marked Exhibit "A" contained labels which demonstrate the manner in which the trademark is used.

4. Attached hereto and marked Exhibit "B: are the actual product samples."

Exhibit A: Two labels for "steamed noodles" (each with a keep refrigerated note and list of ingredients), two bar codes and two stickers bearing the Mark.

Exhibit B: Two bags of "crispy noodles" each with a label containing a list of ingredients, a bar code and a sticker bearing the Mark.

## ANALYSIS AND REASONS FOR DECISION

[13] As a preliminary matter, I note that in his written representations, the Owner refers to facts not in evidence. These submissions will be disregarded [*Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)].

### Use of the Mark in association with goods

[14] First, the Requesting Party notes that the evidence is not clear as to how the goods described in the Owner's affidavit relate to the goods in the registration.

[15] The examples of products provided by the affiant are two types of steamed noodles [Exhibit "A"] and two types of crispy noodles [Exhibit "B"]. The use of the word "steamed" to describe the noodles in Exhibit "A" indicates some element of preparation or cooking and could be considered "Prepared Chinese foods". As for the crispy noodles provided as Exhibit "B", the evidence is unclear as to which Goods these relate to. While they could be considered "Prepared Chinese foods" as well, I cannot accept them as "*frozen* and prepared foods" or "*fresh* produce". Therefore, the evidence provided by the Owner correspond to only one of the registered goods, namely "Prepared Chinese foods".

[16] Second, the Requesting Party notes that there is no proof of sales during the Relevant Period included in the Owner's affidavit.

[17] On this point, I note that although invoices are not mandatory in order to satisfactorily reply to a section 45 notice [*Lewis Thomson & Son Ltd v Rogers, Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)], some evidence of transfer in the normal course of trade in Canada is necessary [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. Such evidence can be in the form of documentation like invoices, sales reports, but can also be through clear sworn 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].

[18] In this case, there is no such evidence. The affiant only makes a bare assertion of use and provides no factual particulars supporting this assertion. Moreover, while the affiant states that the Owner's goods "are available in the refined grocery stores" [para 3], it is well established

that “offering for sale” is not the same as “selling” [see *Michaels & Associates v WL Smith & Associates Ltd* (2006), 51 CPR (4th) 303 (TMOB)]. As such, without further evidence regarding where, when and whether the Goods were actually sold in those stores, this statement does not assist the Owner in establishing use of the Mark.

[19] Based on the foregoing, there is insufficient evidence upon which I could reasonably infer that any of the Goods listed in the registration were sold or transferred in the normal course of trade in Canada by the Owner during the Relevant Period in association with the Mark. Furthermore, there is no evidence before me of any special circumstances to excuse non-use of the Mark.

#### Use of the Mark in association with services

[20] The Requesting Party argues, and I agree, that the Owner has provided a bare statement that the Mark was in use in association with the Services and that the Owner has not provided evidence to show the way in which the Mark was used in association with the Services or evidence with respect to the performance or advertising of the Services themselves.

[21] The only evidence provided with respect to the Services is the statement in paragraph 2 of the Owner’s affidavit that the Mark was in use in Canada during the Relevant Period in association with the operation of a Chinese restaurant.

[22] As noted above, a bare statement that a trademark is in use is not sufficient to demonstrate use in the context of section 45 proceedings. The Owner has not provided sufficient facts to enable me to reasonably infer that the Mark was used or displayed in Canada during the Relevant Period in association with the advertising or performance of the Services.

[23] Based on the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in Canada, or any special circumstances to excuse non-use of the Mark, during the Relevant Period in association with the Services listed in the registration.

Issues not relevant in section 45 proceedings

[24] The Owner made submissions concerning the issue of whether the present proceeding is abusive. However, the parameters of the present proceeding are narrow, and the motivation of a requesting party is not a consideration in reaching a decision under section 45 of the Act.

Section 45(1) provides that the Registrar may refuse to issue a section 45 notice if he or she “sees good reason to the contrary”; but once the notice is issued, allegations that a party’s actions may be abusive or vexatious are irrelevant.

DISPOSITION

[25] In view of the above, I am not satisfied that the Owner has shown use of the Mark in association with any of the Goods and Services listed in the registration within the meaning of sections 4 and 45 of the Act.

[26] 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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Martin Beliveau  
Chairperson  
Trademarks Opposition Board  
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD  
CANADIAN INTELLECTUAL PROPERTY OFFICE  
APPEARANCES AND AGENTS OF RECORD**

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

No Agent Appointed

For the Registered Owner

Norton Rose Fulbright Canada  
LLP/S.E.N.C.R.L.,S.R.L

For the Requesting Party