



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 181

Date of Decision: 2022-09-20

IN THE MATTER OF A SECTION 45 PROCEEDING

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

Requesting Party

And

Wismettac Asian Foods, Inc.

Registered Owner

TMA718,339 for KAEDE

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. TMA718,339 for the trademark KAEDE (the Mark).

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

(1) Nori, (2) Furikake, (3) Canned, frozen and dried fruits and vegetables, (4) Seasoned soy bean curd, (5) Pickled plums, (6) Noodles, (7) Rice, (8) Wasabi flavoured powder, (9) Rice, wheat, yam, fish and bean cakes, (10) Tempura batter mix, (11) Soy bean flour, (12) Tea and tea leaves, (13) Crackers, (14) Fish powder, (15) Chopsticks, (16) Ginger,

(17) Dried kelp, (18) Potato starch, (19) Beans, (20) Soup base, (21) Carbonated beverages, namely soda pop, (22) Agar, (23) Natto, (24) Dried seeds, (25) Cooking oil, (26) Fish and fish products, namely fish, frozen crab, shellfish, fishcakes, and frozen tempura, (27) Dried anchovies, (28) Fish eggs, (29) Bean paste, (30) Bread crumbs, (31) Octopus, (32) Eel, (33) Dried vegetables, (34) Shrimp, (35) Barley, (36) Canned seafood, (37) Cooking wine, (38) Instant curry, (39) Mayonnaise, (40) Seasoned seaweed, (41) Mirin, (42) Dumplings, (43) Unagi sauce, (44) Dried shaved bonito, (45) Jelly, (46) Candy, (47) Sake.

[3] For the reasons that follow, I conclude that the registration ought to be amended.

THE PROCEEDING

[4] On November 30, 2021, at the request of Norton Rose Fulbright Canada S.E.N.C.R.L., s.r.l. / LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Wismettac Asian Foods, Inc. (the Owner). The notice required the Owner to show whether the Mark was used in Canada in association with 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 the Mark 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 between November 30, 2018 and November 30, 2021 (the Relevant Period).

[5] The relevant definition of use in the present case is set out in section 4(1) 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.

[6] In response to the Registrar's notice, the Owner submitted the affidavit of Mr. Toshiyuki Nishikawa, Senior Vice President for the Owner, sworn on January 27, 2022.

[7] Both parties submitted written representations and no hearing was held.

THE OWNER'S EVIDENCE

[8] Mr. Nishikawa explains that the Owner is in the business of selling Asian food products [para 3]. The Owner is a wholesale food distributor selling to restaurants, groceries, and other retailers in Canada with offices in Alberta, British Columbia, Ontario and Quebec [paras 4 and 5].

[9] Mr. Nishikawa states that during the Relevant Period, the Owner used the Mark in Canada “in association with rice, nori and seasoned seaweed” [para 6]. He adds that the Owner sold these products in Canada during the Relevant Period [para 9] and the Mark appeared on product packaging and advertising material in Canada during the Relevant Period [para 7].

[10] In support, Mr. Nishikawa attaches the following exhibits to his affidavit:

- Exhibit 1: photograph of a bag of roasted seaweed bearing the Mark. Mr. Nishikawa states that the photograph shows a sample container of “seaweed/nori” produced by the Owner and sold in Canada in association with the Mark during the Relevant Period [para 8].
- Exhibit 2: photograph of a bag of rice bearing the Mark. Mr. Nishikawa states that the photograph shows a sample bag of rice produced by the Owner and sold in Canada in association with the Mark during the Relevant Period [para 8].
- Exhibit 3: Copies of three invoices from the Relevant Period from the Owner to Canadian customers displaying the Mark in association with the following products: “RICE CALROSE KAEDE” and “NORI KAEDE.”

ANALYSIS AND REASONS FOR DECISION

[11] In their respective written arguments, both parties agree that the evidence provided relates to only three of the goods listed in the registration, namely: nori, rice and seasoned seaweed. Furthermore, in paragraph 6 of his affidavit, Mr. Nishikawa specifically says that the Mark was used “in association with rice, nori and seasoned seaweed” without mentioning any other goods.

[12] That being said, given the invoices from the Owner to Canadian customers from the Relevant Period are for two goods only, specifically for “*RICE CALROSE KAEDE*” and “*NORI KAEDE*” (Exhibit 3), I am only satisfied that the Owner has shown use of the Mark in Canada within the meaning of sections 4 and 45 of the Act for nori and rice.

[13] While evidentiary overkill is not required in a section 45 proceeding, it is nonetheless well-established that use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration. Having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)]. In this case, while the Owner has provided evidence supporting use of the Mark in association with nori/seaweed, listed as “*NORI KAEDE*” on invoices (Exhibit 3), the Owner has not provided separate evidence demonstrating the sale of *seasoned seaweeds* to Canadian customers during the relevant period. In the absence of such evidence, or of special circumstances excusing such non-use, the Mark will be amended accordingly.

[14] Finally, there is no suggestion in the affidavit or written representations that the Owner used the Mark in association with the remaining goods. In the absence of evidence showing use of the Mark in association with these goods within the meaning of sections 4 and 45 of the Act, or special circumstances to justify the absence of use, these goods will be deleted from the registration.

DISPOSITION

[15] Pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following goods in compliance with the provisions of section 45 of the Act:

(2) Furikake, (3) Canned, frozen and dried fruits and vegetables, (4) Seasoned soy bean curd, (5) Pickled plums, (6) Noodles, (8) Wasabi flavoured powder, (9) Rice, wheat, yam, fish and bean cakes, (10) Tempura batter mix, (11) Soy bean flour, (12) Tea and tea leaves, (13) Crackers, (14) Fish powder, (15) Chopsticks, (16) Ginger, (17) Dried kelp, (18) Potato starch, (19) Beans, (20) Soup base, (21) Carbonated beverages, namely soda pop, (22) Agar, (23) Natto, (24) Dried seeds, (25) Cooking oil, (26) Fish and fish products, namely fish, frozen crab, shellfish, fishcakes, and frozen tempura, (27) Dried anchovies, (28) Fish eggs, (29) Bean paste, (30) Bread crumbs, (31) Octopus, (32) Eel, (33) Dried vegetables, (34) Shrimp, (35) Barley, (36) Canned seafood, (37) Cooking wine, (38) Instant curry, (39) Mayonnaise, (40) Seasoned seaweed, (41) Mirin, (42) Dumplings, (43) Unagi sauce, (44) Dried shaved bonito, (45) Jelly, (46) Candy, (47) Sake.

[16] The statement of goods will now read as follows:

(1) Nori, (7) Rice

Martin Béliveau
Chairperson
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No Hearing Held

AGENTS OF RECORD

DLA Piper (Canada) LLP

For the Registered Owner

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

For the Requesting Party