



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2023 TMOB 056

**Date of Decision:** 2023-03-29

## **IN THE MATTER OF AN OPPOSITION**

**Opponent:** Kerry Luxembourg S.a.r.l.

**Applicant:** Kuok Registrations Limited

**Application:** 1,725,738 for KERRY

### **OVERVIEW**

[1] Kuok Registrations Limited (the Applicant) has filed application No. 1,725,738 (the Application) to register the trademark KERRY (the Mark). The Application is based on use of the Mark in Canada since at least as early as January 2015 in association with the services set out in Schedule A to this decision (the Services).

[2] Kerry Luxembourg S.a.r.l. has opposed the Application alleging that the Applicant had not used the Mark in Canada since the date claimed in the Application in accordance with section 30(b) of the *Trademarks Act* (as it read prior to June 17, 2019). The Opponent's evidence is sufficient to call that claimed date into question and consequently the Opponent has met its initial evidential burden. The Applicant did not file sufficient evidence to support the claimed date of use and therefore the section 30(b) ground of opposition succeeds and the Application is refused.

## **THE RECORD**

[3] The Application was filed on April 28, 2015 and was advertised for opposition purposes in the *Trademarks Journal* on May 3, 2017. On July 3, 2018, the Opponent filed a statement of opposition pursuant to section 38 of the *Trademarks Act*, RSC 1985, c T-13 (the Act). I note that the Act was amended on June 17, 2019, and pursuant to section 70 of the Act, the grounds of opposition in this proceeding will be assessed based on the Act as it read prior to June 17, 2019.

[4] The Opponent's statement of opposition alleges that the Application does not comply with sections 30(a) and 30(b) of the Act. The Applicant filed a counter statement denying the grounds of opposition. Both parties filed evidence and written representations and attended a hearing.

[5] While the section 30(a) ground of opposition was not formally withdrawn by the Opponent, I note that no submissions were made regarding that ground. It was instead the section 30(b) ground that was the focus of both parties' submissions in writing and at the hearing.

## **EVIDENCE**

### ***Opponent's Evidence***

[6] The Opponent filed the affidavit of Harvey Lim sworn January 7, 2019 (the Lim Affidavit), the affidavit of Sylvaine Tanguay sworn January 7, 2019 (the Tanguay Affidavit), the affidavit of Roslyn Theodore-McIntosh sworn January 7, 2019 (the Theodore-McIntosh Affidavit), and the affidavit of Anthony Kunkel sworn January 7, 2019 (the Kunkel Affidavit). Each of these affiants was cross-examined and the transcripts are of record.

### **Lim Affidavit**

[7] Mr. Lim, at the time his affidavit was sworn, was a law student with the Opponent's agent. His affidavit includes the results of online searches he conducted regarding the Applicant, as well as an entity operating under the name Kerry Logistics. His affidavit also includes printouts from archived versions of websites.

### Tanguay Affidavit

[8] Ms. Tanguay is a law clerk with the Opponent's agent. Her affidavit includes the results of various corporate searches for the terms "Kuok" and "Kerry Logistics".

### Theodore-McIntosh Affidavit

[9] Ms. Theodore-McIntosh is the Director of Library Services at the Opponent's agent. Her affidavit includes the results of searches of Canadian publications (e.g. newspapers, journals, magazines) via the Westlaw and Infomart databases for articles which include the phrase "KERRY LOGISTICS".

### Kunkel Affidavit

[10] Mr. Kunkel is the Co-founder and General Manager of the private investigation agency Mitchell Partners Investigation Services. He is a licensed private investigator. His affidavit includes a description of an investigation he conducted regarding a business named "Kerry Logistics" located in Mississauga, Ontario.

### ***Applicant's Evidence***

[11] The Applicant filed the affidavit of Sandy Singh sworn November 13, 2019 (the Singh Affidavit). At the time her affidavit was sworn, Ms. Singh was an articling student with the Applicant's agent. She was not cross-examined on her affidavit.

[12] Ms. Singh states that she is informed by the Applicant, and verily believes, that:

- a. the Applicant is an intellectual property rights holding company;
- b. the Applicant licences and controls the rights to use intellectual property, including the KERRY trademark, to the Kerry group of companies, which includes, amongst other companies, Kerry Logistics Network Limited ("KLN"); and
- c. KLN has operated in Canada since at least as early as January 2015 through its Canadian subsidiaries, Total Logistics Partner (TLP) Ocean Consolidators Inc. and Total Logistics Partner (TLP) Air Express Inc., which were amalgamated on January 1, 2016 and formed Kerry Logistics (Canada) Inc.

[13] The Singh Affidavit also includes the results of various corporate and online searches regarding the above-referenced entities, as well as the results of Internet archive and WHOIS searches.

### **ONUS**

[14] The Applicant bears the legal onus of establishing, on a balance of probabilities, that the Application complies with the requirements of the Act. However, there is an initial evidential burden on the Opponent to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist [*John Labatt Limited v The Molson Companies Limited* (1990), 30 CPR (3d) 293 (FCTD) at 298].

### **ANALYSIS OF THE GROUNDS OF OPPOSITION**

#### ***Section 30(a)***

[15] In its statement of opposition, the Opponent alleges that the statement of Services in the Application is vague and ambiguous and is not in ordinary commercial terms in accordance with section 30(a) of the Act. The Opponent filed no evidence on this point and made no submissions relating to this ground either in its written representations or at the hearing. Therefore, I reject the section 30(a) ground as the Opponent has not met its initial evidential burden.

#### ***Section 30(b)***

[16] With a ground of opposition based on section 30(b) of the Act, it is well established that if the date of use claimed in the application is earlier than the applicant's actual date of first use of the trademark in Canada, the section 30(b) ground of opposition is successful [see *Scenic Holidays (Vancouver) Ltd v Royal Scenic Holidays Ltd*, 2010 TMOB 63].

[17] Since facts relating to an applicant's date of first use of a trademark are more readily available to the applicant, an opponent's initial burden under section 30(b) is light [see *Tune Masters v Mr P's Mastertune Ignition Services Ltd* (1986), 10 CPR (3d) 84 (TMOB) at 89; see also *Zillow, Inc v HomeZilla Inc*, 2014 TMOB 131 at paras 10-11].

[18] In the present case, the Application is in association with the lengthy list of Services set out in Schedule A to this decision. The list includes a wide variety of services ranging from transportation and logistics related services such as computerized cargo management, delivery of goods by air, vehicle rental, and gift wrapping of goods for others, to business management and marketing services.

[19] The Application claims use of the Mark in Canada in association with the Services since at least as early as January 2015, which for the purpose of the section 30(b) analysis will be treated as January 31, 2015 [see *Certified Management Accountants of Ontario v Chartered Institute of Management Accountants*, 2019 TMOB 107 at para 181]. The Opponent contends that the Applicant has not used the Mark in Canada in association with the Services since that date, and has filed a variety of evidence to support that position, as discussed below.

#### Factual background

[20] To begin, the Lim Affidavit includes printouts from the Applicant's website at *kuokgroup.com*. The WHOIS information included in Exhibit "M" to the Lim Affidavit identifies the Applicant as the "Admin Organization" for that domain. This website identifies three lines of business which include the word "KERRY", namely, KERRY PROPERTIES, KERRY WINES, and KERRY LOGISTICS. The former two lines of business appear to have no relevance to the Application at hand, but the latter business under the name Kerry Logistics (sometimes identified as Kerry Logistics Network Limited) has its own website at *kerrylogistics.com* which describes service offerings which appear to align with some of the Services identified in the Application. For example, the printout from the Kerry Logistics website included as Exhibit "H" to the Lim Affidavit states as follows:

Kerry Logistics Network Limited (the "Company") and its group of companies ("Kerry Logistics Network" or the "Group") is a diversified group based in Asia. Our core businesses encompass integrated logistics, international freight forwarding, express supply chain solutions, seaport management and operations as well as insurance brokerage.

[21] The Kerry Logistics website identifies Canadian locations in Montreal and Mississauga in connection with the name Kerry Logistics (Canada) Inc. [see Exhibit “J” to the Lim Affidavit].

[22] In the Kunkel Affidavit, the private investigator Mr. Kunkel describes how he contacted the Kerry Logistics business located in Mississauga and made certain inquiries of a named employee of that business. In particular, Mr. Kunkel states that he was told by the employee that Kerry Logistics in 2015 acquired a Canadian business at that location named Total Logistics Partner. This portion of the Kunkel Affidavit is hearsay; however, I consider it to be admissible as it is both necessary and reliable [see *R. v Starr*, 2000 SCC 40 at paras 33-34]. First, it is necessary because these are facts within the knowledge of the Applicant and the Applicant chose not to file evidence from anyone with first-hand knowledge of its activities in Canada or elsewhere. Second, I consider this portion of the Kunkel Affidavit to be reliable because it is consistent with evidence filed by the Applicant, namely, Exhibit “E” to the Singh Affidavit which includes multiple press articles announcing that Kerry Logistics expanded into Canada via the acquisition of majority stakes in entities identified as Total Logistics Partner Ocean Consolidators Inc. and Total Logistics Partner Air Express Inc. in January 2015. This portion of the Kunkel Affidavit is also consistent with aspects of the Tanguay Affidavit filed by the Opponent and discussed below.

[23] Corporate searches discussed in the Tanguay Affidavit disclosed no Canadian corporations, either Federal or Provincial, with names containing the word “Kuok”, nor any foreign corporations registered to do business in Canada with names that include “Kuok”. Ms. Tanguay’s corporate searches identified a Federal corporation named Kerry Logistics (Canada) Inc. which was created on January 1, 2016 via the amalgamation of two other Federal corporations named Total Logistics Partner (TLP) Air Express Inc. and Total Logistics Partner (TLP) Ocean Consolidators Inc. The Tanguay Affidavit also identifies a business name registration in Ontario for “KERRY LOGISTICS” that was registered on August 3, 2018. In addition, the Lim Affidavit indicates that the first appearance of the word “KERRY” in archived versions of the Total Logistics Partner website (at *tlp.ca*) was from May 21, 2016 [see Exhibit “L” to the Lim Affidavit].

[24] To briefly summarize, in my view, the following picture emerges from the Opponent's evidence: At or around January 2015, an entity related to the Applicant acquired an existing business in Canada which appears to have been offering at least some of the Services listed in the Application. Use of the trademark KERRY in Canada appears to have commenced at some point after that acquisition. The evidence indicates that any such use of the trademark KERRY was by an entity (or entities) located in Canada (e.g. one or more of Total Logistics Partner (TLP) Air Express Inc., Total Logistics Partner (TLP) Ocean Consolidators Inc., and Kerry Logistics (Canada) Inc.) rather than by the Applicant directly.

#### Application of the law to the facts

[25] There are two aspects of the Opponent's evidence that, at least when taken in combination, render it sufficient for the Opponent to meet its initial evidential burden for the section 30(b) ground of opposition. First, while the corporate acquisition of the Total Logistics Partner business by Kerry Logistics appears to have taken place at some point in January 2015, it strikes me as unlikely based on the evidence of record that by the end of that month the trademark KERRY was actually being used in Canada in association with the lengthy list of Services in the Application. For example, the first appearance of the word "KERRY" in archived versions of the Total Logistics Partner website was from May 21, 2016. In any event, to the extent that there was any use of the Mark in Canada by January 31, 2015 in association with any of the Services listed in the Application, I am left in the dark by the evidence of record regarding with which Services the Mark was used.

[26] Second, to the extent that any use of the Mark was taking place in Canada in association with any of the Services (including any use that may have taken place prior to January 31, 2015), the evidence indicates that such use was by an entity or entities located in Canada, rather than the Applicant directly, and I have no admissible evidence from the Applicant to demonstrate that such use accrued to the Applicant via section 50(1) of the Act.

[27] On this latter point with respect to section 50(1) of the Act, I note that the Applicant filed the Singh Affidavit which in paragraph 2 purports to speak to the licensing relationship between the Applicant, Kerry Logistics Network Limited and its subsidiaries in Canada. However, this evidence was provided via an articling student with the Applicant's agent firm, based on information and belief, and I agree with the Opponent that it is hearsay which is inadmissible for the truth of its contents. The evidence does not meet the requirement of necessity because it was not necessary for evidence on this point to come from an articling student at the Applicant's agent firm. To the contrary, if the Applicant wished to put forward facts relating to such a key issue, it should have put forward an affiant with direct knowledge of those facts, who could potentially be tested via cross-examination. In addition, I have no basis to assess the reliability of the evidence provided, as the Singh Affidavit does not even identify the individual or individuals from whom the affiant received the information.

[28] Indeed, while my decision regarding section 30(b) would have been the same in the absence of the Singh Affidavit, the attempt to enter key facts regarding the licensing relationship and the Applicant's activities in Canada via hearsay in this manner, only serves to reinforce my view that the Opponent has successfully called the claimed date of use into question.

[29] I note that the Applicant has raised objections to the admissibility and/or weight which should be afforded to the Opponent's evidence. For example, the Applicant contends that evidence should not have come from employees of the Opponent's agent such as Mr. Lim. However, I do not consider printouts from the Applicant's publicly available website to be controversial pieces of evidence in this case, nor is it the type of opinion evidence that is apt to be found inadmissible as in *Cross-Canada Auto Body Supply (Windsor) Ltd v Hyundai Auto Canada*, 2006 FCA 133. As noted in *Petronas Lubricants Italy SpA v Sasol Olefins & Surfactants GmbH*, 2017 TMOB 25 at para 20, website printouts obtained by affiants who are employed by agents for parties have regularly been accepted in the context of section 30(b) grounds of oppositions, and I see no reason to depart from that practice here. To the extent that the Applicant felt that the Lim Affidavit was too selective in what it included, the Applicant had the opportunity



to clarify the facts with evidence from someone with first-hand knowledge of the Applicant's activities, and it chose not to do so.

[30] Finally, the Applicant argues that because the Services in the Application are not ones which would have necessarily been offered online, the absence of the Mark on relevant websites is not sufficient to demonstrate that the Mark was not in use. However, I do not consider that position to be persuasive in the present case, where the evidence of record suggests that any use of the Mark in Canada, regardless of whether the service would have been provided online or not, was by an entity (or entities) other than the Applicant directly, and the Applicant has not established how any such use accrued to it under section 50(1) of the Act.

[31] Taking all of the above into account, I am satisfied that the Opponent has met its initial evidential burden for the section 30(b) ground of opposition in respect of all of the Services. The legal burden then shifts to the Applicant. The evidence of record does not demonstrate on a balance of probabilities that the Applicant has used the Mark in Canada in association with the Services since January 31, 2015. In particular, the Applicant has not filed evidence from anyone with first-hand knowledge of the Applicant's activities in respect of the Mark. As an aside, I note that the Singh Affidavit includes as Exhibit "G" some printouts of archived versions of the Kerry Logistics website that reference Canada; however, all but one of these post-date January 31, 2015. The one exception is the printout of an archived page from the Kerry Logistics website dated February 12, 2014 that references Canada [page 1 of Exhibit "G" to the Singh Affidavit], but there is no indication on this page of what, if any, services are being offered, nor is there any evidence to suggest that this is trademark use which would accrue to the Applicant via section 50(1) of the Act. Ultimately, the Applicant has not met its legal burden, the section 30(b) ground of opposition is successful, and the Application is therefore refused in its entirety.

**DISPOSITION**

[32] Pursuant to the authority delegated to me under section 63(3) of the Act, I refuse the Application pursuant to section 38(12) of the Act.

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Timothy Stevenson  
Member  
Trademarks Opposition Board  
Canadian Intellectual Property Office

## **SCHEDULE A**

(1) Agencies for contract relating to transportation, namely, air charter services and aircraft chartering; Messages or merchandise courier services, namely, courier services for messages and merchandise; computerised distribution planning relating to transportation, namely, computerized cargo management, provision of data relating to methods of products transportation; delivery of goods, namely, delivery of goods by air, sea carriers, mail order, train, truck; delivery of goods by mail order; freight forwarding; freight brokerage; air transport, namely, air transportation of goods; boat transport, namely, barge transport and cargo ship transport; railway transport, namely, freight transportation by train; road transport, namely, freight transportation by truck; providing transportation and storage warehousing information via global computer networks, namely, providing administrative and logistical information in the field of transportation and storage warehousing via global computer networks and providing information on transportation supply chains, transportation systems and issues in transportation via global computer networks; packaging and storage of goods, namely, packaging of articles for transportation and warehouse storage services; transport reservation, namely, reservation and booking of transportation of goods by air, rail, truck, and sea carriers; rental of storage containers; storage information, namely, storage information about products provided via website; transportation information, namely, providing information in the fields of transportation supply chains, transportation systems and issues in transportation; vehicle rental; warehousing; wrapping of goods, namely, gift wrapping of goods for others for delivery to customers; in-store transport, namely, dispatch and loading of goods and for inventory management and logistics; placing goods on shelves in-store, namely, inventory stocking services; advisory, information and consultancy services in the fields of all of the foregoing; location of freight-cars by computer, namely, tracking and tracing of packages in transit and tracking and tracing of freight cars in transit; warehouse management services

(2) Retail merchandising and marketing services, namely, advice in the field of business management and marketing; market price monitoring for others, namely, market price monitoring for third party logistics, freight services, warehouse operations and supply chain solutions; compilation of information into computer databases, namely, management and compilation of computerised databases; accounting; drawing of statements of accounts; business management assistance; professional business consultancy, namely, business administration consultancy, business management consultancy services, and business management consultancy in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; business information, namely, providing business information in the field of transport and delivery, logistics, freight services warehouse operations and supply chain

solutions; business management and organization consultancy; cost price analysis; computerised compilation of order lists; distribution of samples; efficiency experts, namely, efficiency expert services in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; import-export agencies; marketing research; public relations; commercial or industrial management assistance, namely, management assistance for commercial or industrial businesses in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; inventory management, namely, inventory management in the field of transport and delivery, logistics, freight services warehouse operations and supply chain solutions; order processing, namely, administrative processing of purchase orders and order fulfillment services; the bringing together of the goods of others and compiling the goods in a general merchandise catalogue enabling customers to conveniently view and purchase these goods by mail order, by means of telecommunications, namely via the Internet, and through a discount store, the foregoing service being for the benefit of others; warehouse management services; sales promotion for others, namely, sales promotions for others by means of website information and public relations campaigns and sales promotions for others by promoting the sale of goods and services through promotional contests and the distribution of related printed and digital material; business management relating to logistics services; advisory, information and consultancy services in the fields of all of the foregoing

# Appearances and Agents of Record

**HEARING DATE:** 2022-12-01

## **APPEARANCES**

**For the Opponent:** James Green

**For the Applicant:** Michael O'Neill

## **AGENTS OF RECORD**

**For the Opponent:** Gowling WLG (Canada) LLP

**For the Applicant:** Marks & Clerk