

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

**Citation: 2015 TMOB 235**  
**Date of Decision: 2015-12-30**

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

<b>Blake, Cassels &amp; Graydon LLP</b>	<b>Requesting Party</b>
<b>and</b>	
<b>Euro-Can Manufacturing Inc.</b>	<b>Registered Owner</b>
<b>TMA539,956 for DOGADE</b>	<b>Registration</b>

[1] At the request of Blake, Cassels & Graydon LLP (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on February 7, 2014 to Euro-Can Manufacturing Inc. (the Owner), the registered owner of registration No. TMA539,956 for the trade-mark DOGADE (the Mark)

[2] The Mark is registered for use in association with the goods “food and drinks for dogs”.

[3] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the goods specified in the registration, at any time between February 7, 2011 and February 7, 2014. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[4] The definitions of use with respect to goods are set out in sections 4(1) and 4(3) 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.

...

4(3) A trade-mark that is marked in Canada on goods or on the packages in which they are contained is, when the goods are exported from Canada, deemed to be used in Canada in association with those goods.

[5] It is well established that mere assertions of 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 quite 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 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 trade-mark in association with each of the goods specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Mr. Mauro Trinchini, President of the Owner, sworn on April 30, 2014. Both parties filed written representations; however, only the Owner was represented at an oral hearing.

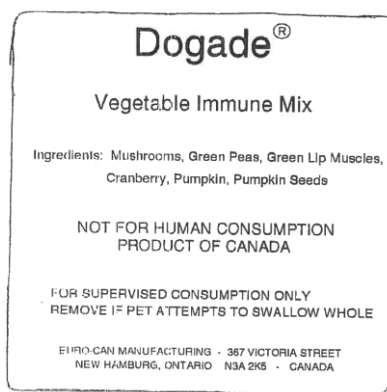
#### Owner's Evidence

[7] In his affidavit, Mr. Trinchini attests that the Owner is in the business of producing pet products with an emphasis on natural, nutritious and high quality pet treats. He explains that the Owner has several brands, including DOGADE, and that its products are available throughout Canada and the U.S. in pet specialty stores, large retail outlets and other retailers. In particular, he notes that the Owner has a sales and marketing office located in Texas.

[8] Mr. Trinchini attests that, in 2000, the Owner began advertising and selling food and drinks for dogs in association with the Mark. More specifically, he asserts that, during the relevant period, the Owner used the Mark in association with "an immune mix for dogs".

[9] Mr. Trinchini provides evidence of two sales by export to the U.S.A. Attached at Exhibit A to his affidavit are copies of two invoices that Mr. Trinchini attests show sales of cases of the immune mix for dogs associated with the Mark during the relevant period. The invoices are dated 2/10/2012 and 1/1/2013. Both invoices are for “Dogade Immune Mix 12/case” and are addressed to Creative Marketing Resources, having an address in Tyler, Texas.

[10] Attached as Exhibit B to the affidavit is a “copy of a label included on the product sold under the DOGADE trade-mark and delivered in relation to the invoices”. This label is shown below:



[11] I note that while the Mark appears along with a list of ingredients, other indicia typical of packaged goods, such as the weight of the product, are not included on this “label”. The label appears to have a hand-drawn border around it; absent that border, the label appears to be a simple printout of text.

[12] I further note that while Mr. Trinchini refers to the goods as a “mix”, it is not clear how the mix is packaged. In this respect, the invoices indicate that the goods were shipped in cases containing 12 units per case. However, the nature of the units is unclear, *e.g.*, bags, cans or other packaging.

### Analysis

[13] In its written representations, noting the ingredients of the goods and the instructions on the exhibited “label”, the Requesting Party submits that the mix is not a “food” or “drink”, but rather a dietary supplement or pharmaceutical product. In the alternative, it submits that there is

no evidence that the mix is a beverage – both the ingredients and the warning instructions on the label suggest that the mix is at best a food, not a drink.

[14] However, I note that “food” is a broad term and may include products that are not suitable for consumption without caution. The Owner submits that “an ordinary consumer would consider ‘food’ to include, at least, solid material of any kind that can be ingested.” In this case, I agree with the Owner that an ordinary consumer’s view of what would constitute “food” would include mushrooms, green peas and the other ingredients indicated on the exhibited label.

[15] On the other hand, I agree with the Requesting Party that the label gives no clear indication that the goods should be considered “drinks for dogs”. In its representations, the Owner refers to the product as a “powder” and the label’s warning, “remove if pet attempts to swallow whole”, suggests some form of dilution is necessary for consumption. However, Mr. Trinchini simply states that the Mark is associated with “a Vegetable Immune Mix designed to be consumed by dogs”. Accordingly, I find the evidence ambiguous as to whether the good can be considered a “drink for dogs”.

[16] Otherwise, the Requesting Party focused on the fact that the evidenced transfers do not appear to have been made “in the normal course of trade”, pursuant to section 4(1) of the Act. For example, it notes that the Owner maintains a sales and marketing office in Texas, and that the exhibited invoices are to “Creative Marketing Resources”, a company in Texas. As such, the Requesting Party suggests that the two shipments in evidence may have been in the nature of promotional goods to a related company.

[17] However, as noted by the Owner, a transfer “in the normal course of trade” is not a requirement under section 4(3) of the Act. As stated by the Federal Court:

... the plain meaning of s. 4(3), whether read by itself or in the context of the whole of s. 4 or of the Act as a whole, does not lead to an absurdity or an inconsistency with the rest of the enactment. It provides for a deemed use in Canada of a trade mark affixed in this country to wares or the packages in which they are contained when those wares are exported from Canada. That is a use different from that provided for in s. 4(1), and it is a use which does not specifically refer to the conditions for use in Canada set out in s. 4(1) that the trade mark be affixed when property in or possession of the wares is transferred in the normal course of trade. [*Molson Canada v Moosehead Breweries Ltd* (1990), 32 CPR (3d) 363 (FCTD) at 371]

[18] The Court went on to find that the evidenced sales were *bona fide* sales, notwithstanding that the companies were related.

[19] Similarly, in *Parlee McLaws LLP v Molson Canada*, 2007 CarswellNat 2251 (TMOB), the Registrar found that even a one-time export commercial transaction was sufficient to meet the requirements of sections 4(3) and 45 of the Act. At paragraph 12, the Registrar stated the following:

From the *Molson v Moosehead (supra)* decision, it would appear that although a commercial transaction must be established, there is no requirement that the sale be in the normal course of trade in s-s. 4(3). The requesting party alleges that the Brazil company is a subsidiary of Molson Canada and that therefore this cannot be considered a commercial transaction. An attempt was made to introduce evidence to support this allegation; however, as the registrant is the only party allowed to file evidence in s.45 proceedings, this material was disregarded. In any event, the registrant has provided a certificate of origin, commercial invoices and packing lists ... all of which tend toward a conclusion of a commercial transaction.

[20] Indeed, in *Brouillette Kosie v Molson Breweries, a partnership*, 2002 CarswellNat 4408 (TMOB), the Registrar stated the following at paragraphs 11 and 12:

I agree with the registrant that in order to demonstrate use under s-s. 4(3) of the Act, the registrant need only show that:

- (a) the trade-mark was marked in Canada,
- (b) on the wares or on their packaging,
- (c) when the wares were exported from Canada.

Although from the case *Molson Cos v. Moosehead Breweries Ltd., supra*, it seems that the wares must be sent out of Canada to another country in a commercial transaction (as opposed to a gift), there is no requirement in s-s. 4(3) that the transaction be “in the normal course of trade”. In the present case the beer appears to have been sent to another country by way of a commercial transaction as it can be seen from the invoices that the registrant charged its customer for each case of beer it exported.

[21] Applied to this case, and taking Mr. Trinchini’s statements at face value, on two occasions during the relevant period, the “immune mix” goods were sold and shipped to an entity in Texas. Per the limited jurisprudence regarding 4(3) of the Act, this is sufficient to constitute a commercial transaction by export pursuant to that section.

[22] The real issue in this case is whether the evidence sufficiently establishes that the Mark appeared on the packages in which the goods were contained. Unlike section 4(1) of the Act, there is no provision for a trade-mark to be associated “in any other manner” with exported goods pursuant to section 4(3) of the Act; the trade-mark must appear directly on the goods or the packaging of the goods in which they are contained.

[23] In this case, there is no evidence that the Mark appeared directly on the “immune mix” goods. Accordingly, it was incumbent on the registered owner to furnish evidence showing the subject trade-mark on the packaging of the goods themselves. As stated by the Federal Court, “showing is safer than telling” [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270 at paragraph 75].

[24] Here, although Mr. Trinchini attests that Exhibit B “is a copy of a label included on the product sold under the DOGADE trade-mark”, in the absence of evidence showing the label on the product, I consider his statement a mere assertion.

[25] In this respect, I first note that whereas section 4(1) refers to “the packages in which they are *distributed*”, section 4(3) refers more narrowly to “the packages in which they are *contained*”. As noted above, the product descriptions on the invoice indicate “Dogade Immune Mix 12/case” – but Mr. Trinchini does not explain the nature of the contents of each case. He only states that the invoices show sales of “cases of the immune mix for dogs”. It should have been a simple matter for the Owner to furnish a photograph, for example, showing the “immune mix” unit packages.

[26] In the absence of clear evidence showing the Mark displayed on the packaging of the goods, I am not prepared to conclude that the Mark appeared on “the packages in which [the goods] are contained” in a manner that satisfies section 4(3) of the Act. In this respect, it is not clear whether the Mark would have appeared on the unit packaging of the goods directly, or whether it was included with shipments in the nature of a temporary label, such as a shipping label accompanying the cases.

[27] Indeed, Mr. Trinchini goes on to state that the Exhibit B label was “delivered in relation to the invoices” – absent clear evidence, such as a photograph of the goods in question, it is not clear what this means.

[28] In view of the foregoing, I am not satisfied that the Owner has demonstrated use of the Mark in association with the registered goods pursuant to sections 4 and 45 of the Act. Furthermore, there is no evidence of special circumstances excusing non-use of the Mark before me.

Disposition

[29] 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.

---

Andrew Bene  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office

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

---

Hearing Date: 2015-09-27

Appearances

Neil Henderson

For the Registered Owner

No one appearing

For the Requesting Party

Agents of Record

Gowling Lafleur Henderson LLP

For the Registered Owner

Blake, Cassels & Graydon LLP

For the Requesting Party