

**SECTION 45 PROCEEDINGS**  
**TRADE-MARK: ACTIVA**  
**REGISTRATION NO.: TMA519963**

- [1] On December 6, 2006 at the request of Innophos, Inc. (the “requesting party”), the Registrar forwarded a notice under s. 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13 (the “Act”) to Ajinomoto Kabushiki Kaisha DBA Ajinomoto (the “registrant”), the owner of the trade-mark ACTIVA (the “Mark”), certificate of registration TMA519963, registered in association with: enzymes and enzyme preparations used in the processing and preparation of food products (the “Wares”).
- [2] The notice requires the registrant to show whether the Mark has been used in Canada in association with each of the Wares 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 use since that date. The relevant period in this case is any time between December 6, 2003 and December 6, 2006 (the “relevant period”).
- [3] In response to the notice, the registrant filed the affidavit of Tadanori Umezawa, sworn on April 17, 2007. Both parties filed written arguments and neither party requested an oral hearing.
- [4] I refer to the following quote of Mr. Justice Russell in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2004), 31 C.P.R. (4<sup>th</sup>) 270 (F.C.T.D.) that summarizes the purpose of s. 45 proceedings:
- The purpose of s. 45 proceedings is to clean up the dead wood on the register. The mere assertion by the owner that the trade-mark is in use is not sufficient and the owner must show how, when and where the trade-mark is being used. At the same time, it is necessary to maintain a sense of proportion and avoid evidentiary overkill. The type of evidence required will vary from case to case, depending upon a range of factors such as the trade-mark owner's business and merchandising practices.
- [5] Mr. Umezawa describes himself as the General Manager, Food Ingredients Department, Food Products Company, a division of the registrant.

[6] He alleges that the product bearing the Mark is transglutaminase sold to food manufacturers for the processing and preparation of food products. He states that the product bearing the Mark is both an enzyme and an enzyme preparation. To support his contention he filed extracts of dictionaries defining the term transglutaminase as an enzyme.

[7] He states that during the relevant period the registrant sold over 23,000 kilograms of Wares to Canadian food manufacturers. All the Wares are sold in 1 kg containers. The value of these sales was in excess of \$1.5 million U.S. He filed the registrant's computerized sales records for the sale of the Wares bearing the Mark in Canada during the relevant period.

[8] He describes how the sale of the Wares is concluded with Canadian food manufacturers. The registrant's North American distributor, Ajinomoto Food Ingredients LLC ("Ajinomoto U.S.") of Chicago, U.S.A. receives from a Canadian food manufacturer an order for the Wares bearing the Mark. Ajinomoto U.S. then places an order to the registrant for the required quantity of the Wares bearing the Mark. The registrant then manufactures, or has manufactured for it, the Wares and ships the requested quantity to Ajinomoto U.S. The latter then sells and ships the Wares directly to that Canadian food manufacturer.

[9] He filed a photocopy of a sample packaging bearing the Mark that is used by the registrant for the sale of the Wares to Canadian food manufacturers. He associates the packaging filed with one of the Wares listed on the computerized sales records attached to his affidavit.

[10] Finally he produced sample invoices issued during the relevant period, issued during the relevant period, evidencing the sale of Wares bearing the Mark from Ajinomoto U.S. to Canadian food manufacturers. He states that those invoices are typical invoices, which would have accompanied each shipment of Wares bearing the Mark.

[11] I have to determine if I am satisfied that the evidence described above enables me to conclude that the Mark has been used in association with each of the Wares in Canada during

the relevant period. The requesting party is of the view, for the reasons detailed hereinafter, that the evidence is not conclusive and that the Registrar should expunge the Mark.

[12] The Requesting party argues that there is no evidence of use in Canada of the Mark in association with the Wares. If there has been any use of the Mark in Canada, it would be in association with other wares, namely transglutaminase. In its written argument, the requesting party refers to the last page of annex B to Mr. Umezawa's affidavit to support its contention. That exhibit is simply a two page document identified as "computerized sales records" and as such, I fail to understand how this document supports the requesting party's contention. Perhaps the requesting party meant instead to refer to Exhibit A, which consists of extracts of various dictionary's definitions of the word "transglutaminase". One dictionary defines such word as " A group of enzymes that....". The requesting party takes the position that "transglutaminase" is not an enzyme preparation. However, from the evidence filed, I am satisfied that "transglutaminase" is an enzyme and an enzyme preparation.

[13] I also conclude that it is aimed for the preparation of food products as it is sold to Canadian food manufacturers. Mr. Umezawa does state that Canadian food manufacturers used transglutaminase sold to them for the processing and the preparation of food products. Moreover, the invoices produced were issued to Canadian food manufacturers such as Maple Leaf Consumer Foods.

[14] The requesting party is arguing that the description of the transactions in paragraph 5 of Mr. Umezawa's affidavit does not enable it to understand the implication of the registrant within the meaning of the decision of *Manhattan Industries Inc. v. Princeton Manufacturing Ltd.* (1971), 4 C.P.R. (2d) 6. (I wish to mention that the requesting party, in its written argument, simply refers to *Manhattan* without any full citation which makes it difficult to guess not only the right citation but also the extract relied upon. I am referring to the cited case law mentioned in the registrant's written argument in response to the argument raised by the requesting party.)

[15] In *Manhathan* supra., Mr. Justice Heald stated:

Having decided that there was not a transfer of possession of the wares until they were received from the Post Office in Canada, and that, accordingly the facts in this case have established use in Canada, it is unnecessary to pursue the matter further. However, I express the opinion that respondent seeks to interpret s. 4 of the *Trade Marks Act* in a manner that is too narrow and too restricted. He restricts "use" as being related only to the time of transfer of property or possession. To give such a construction to the section would be to render ineffective and meaningless the words "in the normal course of trade".

I think that those words must surely mean that s. 4 contemplates the normal course of trade as beginning with the manufacturer, ending with the consumer and with a wholesaler and retailer or one of them as intermediary.(my underlines)

[16] I do not see any deficiency in the content of paragraph 5 of Mr. Umezawa's affidavit. He does explain that the Wares are manufactured by the registrant and shipped to its distributor located in the United States to be delivered by it to Canadian food manufacturers. This is clearly use of the Mark in Canada in the normal course of trade by the registrant within the meaning of s. 4 of the Act.

[17] Finally, the requesting party is "surprised" that only one side of the "label" used has been filed. The affiant states that Exhibit C represents a sample packaging and not a label. The Mark can be clearly seen on the packaging. As for the reference on the packaging "Product of France", as correctly stated by the registrant there is nothing preventing the owner of a trade-mark from having the wares manufactured in a foreign country. The country of origin of the wares has nothing to do with the concept of use of a trade-mark in Canada as defined in s. 4 of the Act.

[18] Having regard to the foregoing, I am satisfied that the evidence filed shows use of the Mark in Canada by the registrant during the relevant period in association with the Wares.

[19] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, registration No. TMA519963 will be maintained on the register in compliance with the provisions of s. 45(5) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 29th DAY OF MAY 2009.

Jean Carrière  
Member, Trade-marks Opposition Board