



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

Citation: 2013 TMOB 227
Date of Decision: 2013-12-30

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Fogler, Rubinoff LLP against registration
No. TMA688,027 for the trade-mark FOOD, BY
NATURE. in the name of Canada Safeway Limited**

[1] At the request of Fogler, Rubinoff 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 November 28, 2011 to Canada Safeway Limited (the Owner), the registered owner of registration No. TMA688,027 for the trade-mark FOOD, BY NATURE. (the Mark).

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

Organic foods and beverages, namely, bread, frozen fruits, frozen vegetables, milk, soy milk, yogurt, bottled tea, butter, chocolate chips, popcorn, snacks, ketchup, macaroni and cheese, maple syrup, peanut butter, salad dressing, crackers, dry pasta, pretzels, juice, tortilla chips, balsamic vinegar, canned beans, coffee, dry cereal, eggs, honey, jams, preserves, mustard, olive oil, pasta sauce, salsa, broth, applesauce, canned tomatoes, cookies, frozen entrees, frozen pizza, frozen ravioli, mayonnaise, truffles, soup, cheese, cream cheese, dairy, Mexican frozen entrees, ice cream, chocolate, oatmeal, tea bags, frozen chicken, chicken broth.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares 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 between November 28, 2008 and November 28, 2011.

[4] The relevant definition of “use” in association with wares is set out in section 4(1) of the Act:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

[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 wares specified in the registration during the relevant period.

[6] In response to the Registrar’s notice, the Owner furnished the affidavit of Dave Pullar, Director of Consumer Brands of the Owner, sworn on June 11, 2012. Both parties filed written representations, however only the Owner was represented at an oral hearing.

[7] In his affidavit, Mr. Pullar attests that the Owner operates a chain of 215 supermarkets located across Canada and also owns several manufacturing and food processing facilities located in western Canada. He explains that, during the relevant period, the Owner used the Mark in association with its line of O ORGANIC branded products available for sale in its supermarkets. He attests to sales in Canada of O ORGANIC branded products ranging from \$35 million to \$41 million annually for each year of the relevant period.

[8] At paragraph 9 of his affidavit, Mr. Pullar identifies these products as follows:

Bread, frozen fruits, frozen vegetables, ketchup, maple syrup, peanut butter, salad dressing, dry pasta, juice, balsamic vinegar, canned beans, eggs, jams, mustard, olive oil, pasta sauce, frozen entrees, tea bags, frozen chicken, carrots, herbs, meat, salads, honey, canned fruit, coffee, soup, fresh fruit and vegetables, canned fruit and vegetables, sugar, nuts, spices, cereal, milk, prawns, rice, salsa, soy milk, flour and yogurt.

[9] As noted by the Requesting Party in its written representations, use of the Mark during the relevant period is asserted only in association with some, but not all, of the wares as registered. At the oral hearing, the Owner conceded no use in association with the following registered wares: bottled tea, butter, chocolate chips, popcorn, snacks, macaroni and cheese, crackers, pretzels, tortilla chips, broth, applesauce, canned tomatoes, frozen pizza, frozen ravioli, mayonnaise, truffles, cheese, cream cheese, Mexican frozen entrees, ice cream, chocolate, oatmeal, and chicken broth.

[10] With respect to the registered ware “dairy”, although Mr. Pullar attests to use of the Mark in association with “milk” and “yogurt”, these wares are specifically covered by the registration and attested to by Mr. Pullar. Likewise, even if I were to consider eggs to be a dairy product, “eggs” also appears specifically in the statement of wares and in Mr. Pullar’s assertion of use. Noting that the Owner concedes non-use with respect to certain other dairy products such as “cheese”, I consider Mr. Pullar’s assertion of use to be insufficient to encompass the broader term “dairy” from the registration.

[11] Similarly, although the Owner submits that the term “jams” corresponds to the plain meaning of “preserves”, I note that the wares “jams” are separately covered by the registration and attested to by Mr. Pullar. As such, I consider Mr. Pullar’s assertion of use to be insufficient to encompass the broader term “preserves” in the statement of wares.

[12] However, with respect to the product “cereal”, given the generally understood meaning of this term, I accept that it corresponds with the registered ware “dry cereal” for the purposes of this decision.

Display of the Mark

[13] With respect to the manner in which the Mark was displayed in association with the Owner’s line of O ORGANICS products, Mr. Puller attests that the Mark was displayed on “bib tags” placed next to the products in the Owner’s supermarkets. He explains that the tags are specific to each product and hang from the shelf directly below the corresponding product to provide the customer with the product price and other information. Attached as Exhibit B to the affidavit is an information page, which Mr. Puller attests is representative of the tags used in the

Owner's supermarkets in association with its O ORGANICS products during the relevant period. I note that the bib tag displays the name of the product, price and other information in the top portion of the tag and that "FOOD BY NATURE" is displayed in the bottom portion of the tag.

[14] In its written representations, the Requesting Party notes that the only product identified in the Exhibit B tag is "tomato ketchup", and it submits that there is no evidence with respect to every one of the products set out in paragraph 9 of Mr. Pullar's affidavit. However, it is clear that the Exhibit B tag is representative evidence; it is not necessary to show use in association with every ware when, as in this case, there is an otherwise clear assertion of use and an example of the manner by which the trade-mark was displayed is provided [see *Saks & Co v Canada (Registrar of Trademarks)* (1989), 24 CPR (3d) 49 (FCTD)].

[15] As well, the Requesting Party notes that the mark as it appears on the bib tags differs from the Mark as registered, in that the comma after FOOD and the period after NATURE are both omitted. However, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA), I consider the omission of the punctuation in the trade-mark as used to be a minor deviation from the Mark. In my view, the dominant feature is the words; as such, the identity of the Mark is preserved and the deviation would not, in my opinion, mislead an unaware purchaser.

[16] In addition to the exhibited bib tag, Mr. Pullar provides sample flyers, coupons and signage at Exhibits C, D and E, respectively, which he attests were distributed or displayed during the relevant period. All of the exhibits display the Mark or minor variants thereof in association with different O ORGANIC food products. While not evidence of use of the Mark in association with the wares within the meaning of section 4(1) of the Act, I accept the Owner's characterization of such evidence as "corroborative" of Mr. Pullar's assertion and evidence of use as described above.

[17] In my view, the display of the Mark on tags on shelves directly below the corresponding products would bring the Mark to the attention of consumers at the time of transfer of the wares and, as such, would satisfy the requisite notice of association within the meaning of section 4(1) of the Act [see *Loblaws Ltd v Richmond Breweries Ltd* (1982), 73 CPR (2d) 258 (TMOB);

Riches McKenzie & Herbert LLP v Parissa Laboratories Inc (2006), 59 CPR (4th) 219 (TMOB)].

[18] Accordingly, and in view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the following registered wares within the meaning of sections 45 and 4(1) of the Act:

Organic foods and beverages, namely, bread, frozen fruits, frozen vegetables, milk, soy milk, yogurt, ... ketchup, ... maple syrup, peanut butter, salad dressing, ... dry pasta, ... juice, ... balsamic vinegar, canned beans, coffee, dry cereal, eggs, honey, jams, ... mustard, olive oil, pasta sauce, salsa, ... frozen entrees, ... soup, ... tea bags, frozen chicken....

Disposition

[19] As the Owner submitted no evidence of special circumstances excusing non-use of the Mark in association with the remaining wares, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following wares from the registration:

... bottled tea, butter, chocolate chips, popcorn, snacks, ... macaroni and cheese, ... crackers, ... pretzels, ... tortilla chips, ... preserves, ... broth, applesauce, canned tomatoes, cookies, ... frozen pizza, frozen ravioli, mayonnaise, truffles, ... cheese, cream cheese, dairy, Mexican frozen entrees, ice cream, chocolate, oatmeal, ... chicken broth.

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