

PROCEDURE PURSUANT TO SECTION 45
TRADE-MARK: PURITAN
REGISTRATION NO: UCA 15,071

On December 30, 1997, at the request of Brouillette Kosie, the Registrar of Trade-marks gave notice, as provided under s. 45 of the *Trade-marks Act*, to U L Canada Inc., the entity then registered as owner of the aforesaid trade-mark registration. On June 5, 1998, International Home Foods (Canada) Inc. was entered in the record as the new owner of the mark.

The PURITAN trade-mark is registered for the following wares:

- (1) Raw meats, sausages, smoked and cooked meats.
- (2) Canned meats.
- (3) Fresh, canned, frozen or otherwise processed poultry, and poultry products, namely, jellied chicken, boneless chicken, chicken spread; fresh, canned, frozen or otherwise processed fish, and fish products, namely, fish pastes, fish sticks.
- (4) Dried grain products, namely spaghetti and macaroni.
- (5) Canned soup, tomato ketchup, tomato juice, packaged dinners, comprising alimentary pastes, sauces, meats, poultry, fish, frozen or otherwise preserved.

In response to the notice by the Registrar, the registered owner International Home Foods (Canada) Inc. furnished an affidavit from George Cowie, as well as five supporting documents. The requesting party and the registrant filed written arguments, and a hearing requested by the registrant was granted. The hearing was held on March 23, 2000.

Upon receipt of the notice provided under s. 45, the owner of the mark must prove to the Registrar that the trade-mark was in use in Canada at some time during the three-year period immediately preceding the date of the notice, in this case, between December 30, 1994 and December 30, 1997. Since International Home Foods (Canada) Inc. became owner of the mark as a result of a transfer dated March 9, 1998, i.e., after the relevant period, it decided to submit evidence of use by the previous owner of the mark, U L Canada Inc., which had owned it during the relevant period.

In his affidavit, George Cowie declared that he had been an employee of U L Canada Inc. for 19 years and was currently Vice-President of the company's Customer Development Division. He began by asserting that U L Canada Inc. had owned the PURITAN trade-mark from January 1, 1993 to March 9, 1998, when it was transferred to the current holder, International Home Foods (Canada) Inc. He went on to state that, during the relevant period for the purposes of s. 45, i.e., from December 30, 1994 to December 30 1997, the PURITAN mark had been continually used by the company's Thomas J. Lipton Division in association with a number of food products. Paragraph 3 of his affidavit contains a list of the various food products sold in Canada in association with the PURITAN mark: 'beef stew; Irish stew; turkey and chicken stew; frontier stew; meat ball stew; meatballs and gravy; meatballs, potatoes and gravy; flaked ham; flaked chicken; flaked turkey; beef, turkey and ham spread; corned beef spread; devilled ham spread; beef with pickle and ham spread; beans and wieners; spaghetti and meatballs; Chili con carne; Texas style chili; lasagna; corned beef hash; beef and ham spread; beef, ham and turkey spread; beef and devilled ham spread; beef, ham

and pickle spread; beef chunks and gravy'.

Mr. Cowie next introduced as Exhibit B in support of his affidavit a number of labels bearing the PURITAN mark, and asserted that, during the relevant period, the PURITAN mark was used in association with the wares by marking the aforesaid labels on the wares and packaging for the wares. Exhibit C appended to the affidavit shows the use of the PURITAN mark in Canada in association with advertising campaigns.

Mr. Cowie then stated that U L Canada Inc. sold food products under the PURITAN mark to a number of Canadian supermarkets, which in turn sold those products to consumers. He filed as Exhibit D in support of his affidavit copies of price lists for those products in the various regions of Canada, and declared that his company had produced similar lists during the relevant period. In paragraph 6 of his affidavit, Mr. Cowie stated that annual sales achieved by his company for products bearing the PURITAN mark were over \$48 million in 1995, 1996 and 1997. Finally, he filed as Exhibit E appended to his affidavit sample invoices showing that his company sold products bearing the PURITAN mark during the relevant period.

An the hearing, counsel for the registrant stated that she had no objection to the statement of wares being amended as follows:

- (2) Canned meats.
- (3) Canned or otherwise processed poultry, and poultry products, namely boneless chicken, chicken spread.
- (5) Packaged dinners, comprising alimentary pastes, sauces, meats, poultry, preserved.

In light of the foregoing, I find that all the wares in the registration, with the exception of those listed *supra*, should be expunged from the registration.

I will accordingly examine the evidence to determine whether it shows that the mark was used in association with the remaining wares.

An the hearing, the requesting party offered a number of arguments in favour of expunging the registration of the PURITAN mark. First, it contended that the evidence did not show that the mark was used in association with the wares in the registration. On this point, the requesting party was of the opinion that none of the wares listed in Mr. Cowie's affidavit were covered by the registration and that, therefore, the entire registration should be expunged.

Next, it argued that the use shown is by a third party, i.e., the Thomas J. Lipton Company. According to the requesting party, the labels in Exhibit B of the affidavit show that PURITAN is a registered trade-mark of Thomas J. Lipton, and the requesting party argues that there is no evidence that Thomas J. Lipton is simply a division of U L Canada Inc., as stated by Mr. Cowie in his affidavit. Furthermore, the requesting party adds that, since the registration shows that Thomas J. Lipton Limited was owner of the mark from 1981 to 1993, the labels could be old labels and would

therefore not show use during the relevant period.

At the hearing, the registrant offered a number of arguments for maintaining the registration in association with the amended wares. First, it noted that the purpose of s. 45 is to expunge marks that are apparently not being used. Second, it submitted that the products as stated in paragraph 3 of Mr. Cowie's affidavit were covered by the registration, since the wares covered by the registration may include a number of products. According to the registrant, it is clear in the present case that the wares listed in paragraph 3 of Mr. Cowie's affidavit fall within the definition of the products covered by the registration.

The registrant asserts that it has provided sufficient evidence to maintain the registration in association with the wares as amended. It argues that, since the evidence shows that sales during the relevant period amounted to roughly \$150 million, it could certainly not be said that the mark was not being used and should be expunged. The registrant is also of the opinion that s. 45 of the Act requires no specific form of evidence, but rather evidence that the registrant has used the mark in association with the wares in the registration at some time during the three-year period immediately preceding the date of the notice.

As for the name that appears on the labels, the registrant states that it is clear from the evidence that Thomas J. Lipton is a division of U L Canada Inc., not a separate entity (*Re Cluett, Peabody Canada Inc.*, [1999] T.M.O.B. No. 140 (Q.L.)) and that the use demonstrated is use by the owner.

First, on the issue of the name 'Thomas J. Lipton' appearing on the labels, I must side with the registrant and conclude that this is obviously a division of U L Canada Inc. First, paragraph 3 of Mr. Cowie's affidavit specifies that Thomas J. Lipton (now Lipton) is a division of U L Canada Inc. As well, the heading on the invoices in Exhibit E appended to Mr. Cowie's affidavit clearly indicates under 'Lipton' that it is 'A Division of U L Canada Inc.' I note that no designation such as 'Inc.' or 'Ltd.' appears with the name 'Thomas J. Lipton' on the labels to indicate that it is a separate legal entity or that it is a reference to the owner of the mark prior to 1993. Consequently, nothing in the evidence suggests to me that it is a separate entity. I therefore conclude that any use shown by the evidence is use by U L Canada Inc., the owner of the mark from January 1993 to March 9, 1998.

Second, I am of the opinion that the evidence as a whole is sufficient to show the use of the PURITAN mark in association with the wares listed in paragraph 3 of Mr. Cowie's affidavit. First, it is obvious from the labels in Exhibit B that the mark is used as a trade-mark and associated with the wares when it is transferred in the normal course of trade. Also, considering the evidence as a whole, I conclude that the labels demonstrate how the mark was associated with the wares during the relevant period. In addition, although the invoices do not show sales of each of the products listed in paragraph 3 of the affidavit, I accept Mr. Cowie's statement in paragraph 3 of his affidavit that each

of the products listed was sold during the relevant period, and in light of the strong sales figures contained in the affidavit and in view of the products appearing on the price lists in Exhibit D, I am of the opinion that it can be concluded that the PURITAN mark was used during the relevant period, in the normal course of trade, in association with all the wares in paragraph 3, and in accordance with the requirements under s. 4(1) of the *Trade-marks Act*.

I must now determine whether the products listed in Mr. Cowie's affidavit are products covered by the registration. The requesting party submits that the wares, as defined in the registration, do not appear anywhere in Mr. Cowie's affidavit and, therefore, that the use shown is in association with wares other than those in the registration. I am in total disagreement with the requesting party..

Although it would have been preferable for Mr. Cowie to establish an association between the wares listed in his affidavit and those covered by the registration, clearly, wares such as 'canned meats', and 'packaged dinners comprising alimentary pastes, sauces, meats, poultry, preserved' have a broad meaning and cover a number of products.

In my opinion, the wares referred to as 'canned meats' would include the following products appearing in the affidavit: 'meatballs and gravy, flaked ham, beef, turkey and ham spread, corned beef spread, devilled ham spread, beef with pickles and ham spread, beef and ham spread, beef, ham and turkey spread, beef and devilled ham spread; beef, ham and pickle spread; beef chunks and gravy'. It is clear from the evidence that the owner's products are sold in cans and the products that I have listed are canned meats. Therefore I find that the wares referred to as 'canned meats' should be maintained on the registration.

As for the wares referred to as 'packaged dinners comprising alimentary pastes, sauces, meats, poultry, preserved', I find that the use shown in association with 'beef stew, irish stew, turkey and chicken stew, meat ball stew, meatballs, potatoes and gravy, beans and wieners, spaghetti and meatballs, chili con carne, Texas style chili, and lasagna' is in association with those wares. The aforesaid products are, in my opinion, packaged dinners containing one or more of the ingredients listed. The requesting party raised the issue of whether the packaged dinners should contain each of the ingredients identified, i.e., 'alimentary pastes, sauces, meat, and poultry'. I conclude that they should not and base my conclusion on the initial statement, which read as follows: 'packaged meals comprising alimentary pastes, sauces, meats, poultry, fish, frozen or otherwise preserved'. In my opinion, a packaged meal would be unlikely to contain meat, chicken and fish. I find, therefore, that the wares referred to as 'packaged meals comprising alimentary pastes, sauces, meats, poultry preserved' should be maintained on the registration.

As for the wares referred to as 'canned or otherwise processed poultry, and poultry products, namely boneless chicken, chicken spread', I find that no use has been shown in association with the wares

referred to as ‘chicken spread’. Accordingly, ‘chicken spread’ will be expunged from the registration. As for the wares referred to as ‘boneless chicken’ I agree that the product ‘flaked chicken’ would be covered by the definition of ‘boneless chicken’. Furthermore, as the evidence only demonstrates use in association with ‘canned flaked chicken’, I find that the statement of wares should be amended to read as follows: ‘canned poultry and poultry products namely boneless chicken’.

Since at least one of the wares listed in paragraph 3 of Mr Cowie’s affidavit could be associated with the wares described as ‘canned meats; canned poultry and poultry products namely boneless chicken; packaged dinners, comprising alimentary pastes, sauces, meats, poultry, preserved’, I find that these wares should be maintained on the registration.

Registration No. UCA 15071 shall accordingly be amended pursuant to s. 45(5) of the Act.

DATED IN HULL, QUEBEC, THIS DAY OF JULY 2000.

D. Savard
Hearing Officer
Section 45