

SECTION 45 PROCEEDINGS
TRADE-MARK: AL-RIFAI ROASTERY (MAHMASAT)
REGISTRATION NO.: TMA530,273

On January 15, 2004, at the request of Smart & Biggar, the Registrar issued the notice prescribed by section 45 to Al-Rifai Roastery (Mahmasat) Inc., which was then the registered owner of the above-mentioned registration.

The trade-mark AL-RIFAI ROASTERY (MAHMASAT) is registered in association with coffee and roasted or otherwise processed nuts. The registration indicates that the Arabic word MAHMASAT means ROASTERY in English. The right to the exclusive use of the word ROASTERY has been disclaimed apart from the trade-mark.

Section 45 of the *Trade-marks Act* requires the registered owner of a trade-mark to indicate whether the mark has been used in Canada in association with each of the wares and services listed in the registration at any time during the three years preceding the date of the notice and, if not, the date on which it was last used and the reason why it has not been used since that date. The relevant period in this case is any time between January 15, 2001 and January 15, 2004. What qualifies as use of a trade-mark is defined in s. 4 of the Act.

On March 22, 2004, the Canadian Intellectual Property Office recorded Fares Jarawan as the owner of registration TMA530,273.

In reply to the notice, the registrant furnished the affidavit of Fares Jarawan, sworn April 8, 2004. Only the requesting party submitted a written argument. An oral hearing was not requested.

Mr. Jarawan identifies himself as the President of Al-Rifai Roastery (Mahmasat) Inc. (hereinafter “Al-Rifai”), and also as its “new owner”. He states,

Al-Rifai, in its normal course of trade, is an importer, distributor and seller to retailers and

wholesalers of all types of coffee and roasted or otherwise processed nuts. The items that have been manufactured in and/or imported to Canada and sold to retailers and/or wholesalers in Canada during the past three years, and indeed since August 1998 in association with the trade-mark AL-RIFAI ROASTERY (MAHMASAT) are “coffee and roasted or otherwise processed nuts”. The wares associated with Al-Rifai’s mark are shipped to various clients in boxes or bags. The trade-mark AL-RIFAI ROASTERY (MAHMASAT) is visible on packaging, namely, boxes and bags containing the wares associated with the trade-mark AL-RIFAI ROASTERY (MAHMASAT).

Mr. Jarawan provides details and examples of the advertisement of the AL-RIFAI ROASTERY (MAHMASAT) mark. He also provides the combined annual Canadian sales figures for coffee and nuts from June 1, 2001 to February 17, 2004 (approximately two hundred thousand dollars per year).

The pertinent exhibits that he provides are:

1. Exhibit B: a copy of the assignment whereby he acquired the mark.
 - It is entitled Assignment Nunc Pro Tunc and was executed by Mr. Jarawan on behalf of Al-Rifai Roastery (Mahmasat) Inc. on February 25, 2004.
 - The first paragraph reads, in part, “Whereas, Al-Rifai Roastery (Mahmasat) Inc... did, as of the 4th day of September, 1999, sell, assign and set over absolutely unto Fares Jarawan”.
 - The second paragraph reads, “And whereas, for the purpose of registration and by way of further assurance, the said Fares Jarawan has requested the said Al-Rifai Roastery (Mahmasat) Inc. to execute and deliver this Assignment.”
 - The third paragraph reads, “...Al-Rifai Roastery (Mahmasat) Inc. doth hereby sell, assign and set over to Fares Jarawan all its rights, titles and interests in and to the aforesaid trade-mark and the registration relating thereto with the intent that the titles in Canada to such trade-mark and registration shall be fully vested in the said Fares Jarawan, his successors and assigns, as and from the 4th day of September, 1999.”
2. Exhibit D: “photographs showing the trade-mark AL-RIFAI ROASTERY (MAHMASAT) on boxes containing the wares, ready to be shipped from Al-Rifai’s warehouse.”
 - I cannot make out the name of any person or company on the boxes.

- AL-RIFAI appears prominently on the boxes. Underneath those words, in a box in considerably smaller letters, appears “ROASTERY - BRÛLERIE - MAHMASAT”.
 - The words “nuts – noix”, above the words “coffee – café”, appear in the upper right hand corner of the boxes.
3. Exhibits E and F: advertisements for AL-RIFAI ROASTERY (MAHMASAT) products from the years 2002-2003.
 - The ads indicate that the products are “distributed in Canada and the US by Wake-Cup Coffee”.
 4. Exhibit H: Invoices to retailers or wholesalers dated 2002 and 2003.
 - Each invoice is issued by Wake-Cup Coffee Depot Inc.
 - Each invoice is to a Canadian company, with the same party and address being listed as “sold to” and “ship to”.
 - The trade-mark AL-RIFAI ROASTERY (MAHMASAT) appears near the top of each invoice, in a design form, along side several other marks.
 - In the bodies of the invoices there are references to a variety of AL-RIFAI nuts, such as “AL-RIFAI Peanuts Red. Oil Rst/NoSalt”
 - Although coffee is listed in the bodies of some of the invoices, no trade-mark prefaces such listings.

In its written argument, the requesting party raises the following points:

1. The assignment, although entitled *Nunc Pro Tunc*, is only effective as of its date of signature since it says, “Al-Rifai Roastery (Mahmasat) Inc. doth hereby sell, assign and set over...” Such wording, according to *88766 Canada Inc. v. Barlow, Menard & Associates* (2002), 22 C.P.R. (4th) 542 at 545 (T.M.S.H.O.), is indicative of giving something retroactively, rather than being confirmatory in nature.
2. There is no evidence as to what the packaging looked like in the relevant time period and in any event, the packaging shown does not display the registered mark.
3. There is no indication that the invoices accompanied the wares. In any event, the invoices

originate from a legal entity other than Mr. Jarawan or Al-Rifai Roastery (Mahmasat) Inc. Moreover, the invoices do not show the mark as registered, nor do they show the mark in association with the registered wares.

My comments concerning the three general points raised by the requesting party are as follows:

1. I agree that in accordance with the case law cited by the requesting party, and also *Marcus & Associates v. Quaker Oats Co. of Canada* (1988), 20 C.P.R. (3d) 46 (F.C.A.), I must treat the assignment in favour of Mr. Jarawan to have been effected on its execution date, that is after the material three year period. However, I do not consider this to be of great import because Mr. Jarawan's affidavit does not say that he used the mark; rather he refers to Al-Rifai Roastery (Mahmasat) Inc.'s normal course of trade, *etc.*
2. I agree that the boxes do not show the trade-mark exactly as registered. The words ROASTERY and MAHMASAT appear below the word AL-RIFAI in smaller print, and they themselves are separated by the word BRÛLERIE. It is possible that consumers might respond to AL-RIFAI *simpliciter* as being a trade-mark and consider the remaining words to be descriptive matter. I must consider though whether the mark is used in such a way that it has not lost its identity and remains recognizable in spite of the differences between the form in which it was registered and the form in which it is used. As stated in *Registrar of Trade Marks v. Compagnie Internationale Pour L'Informatique CII Honeywell Bull Société Anonyme et al.*, 4 C.P.R. (3d) 523 (F.C.A.) at 525, "The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin." I conclude that this is the case. The key components of the registered mark, the three words AL-RIFAI, ROASTERY and MAHMASAT, have been retained and the French equivalent of "roastery", namely BRÛLERIE, has been added. Given the intent and purpose of s. 45, I believe that the difference is not so significant as to warrant expungement. [see *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) 59, *Alibi Roadhouse Inc. v. Grandma Lee's International Holdings Ltd.*, 76 C.P.R. (3d) 326, and a *Nightingale Interloc Ltd. v. Prodesign*

Ltd., 2 C.P.R. (3d) 535]

Regarding the requesting party's questioning of what the packaging looked like in the relevant time period, I refer to the unreported November 24, 2005 decision in the s. 45 proceedings regarding registration TMA367415, wherein Senior Hearing Officer Savard stated at page 7, "The requesting party has argued that the evidence does not show that this was the case during the relevant period. Although I agree that Mr. Bérubé could have been more specific I am prepared to accept on a fair reading of the affidavit that the trade-mark was so displayed during the relevant period." I believe that a similar approach can be applied to the present evidence.

3. Given the indication in some of the exhibits that Wake-Up Coffee is the distributor, I am not concerned by the appearance of its name on the invoices. [*Manhattan Industries v. Princeton Manufacturing Ltd.*, 4 C.P.R. (2d) 6 (F.C.T.D.)] The invoices cover a variety of coffees and nuts and typically list a single entity as both the party sold to and shipped to. The registered trade-mark does appear near the top of the invoices, as do a number of other trade-marks. However, it is not clear that such display of the mark at the top of the invoice qualifies as use in accordance with s. 4(1), which requires that the mark be so associated with the wares that notice of the association is given at the time of the transfer of the property in or possession of the wares. In a similar fact situation in *Shapiro Cohen v. Norton Villiers Ltd.* (2001), 16 C.P.R. (4th) 573 at 575, Senior Hearing Officer Savard made the following comments:

I note that at the top of each invoice several trade-marks are listed, namely: AP RACING & Design, NORTON & Design, MZ & Design and ROTAX. However, such marking at the top of the invoices does not constitute use of any of these trade-marks or of the trade-mark NORTON in the manner required by s. 4(1) of the Act as none of the trade-marks, including the trade-mark NORTON, is so associated with a particular item as to provide the required association between the trade-mark and any particular ware sold.

I am therefore not prepared to find that the invoices show use of the trade-mark in accordance with s. 4. I do however accept the invoices as evidence that corroborates Mr. Jarawan's statement that relevant sales occurred during the material time period.

Having considered the evidence, I am satisfied that the trade-mark AL-RIFAI ROASTERY

(MAHMASAT) was in use in Canada in association with each of the registered wares by means of its display on their packaging and that sales of these wares occurred during the material three-year period in the registrant's normal course of trade. Registration No. TMA530,273 will therefore be maintained in accordance with the provisions of s. 45(5) of the Act.

DATED AT TORONTO, ONTARIO THIS 16th DAY OF JANUARY 2006.

Jill W. Bradbury
Member
Trade-marks Opposition Board