



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

Citation: 2012 TMOB 32
Date of Decision: 2012-02-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Ridout & Maybee LLP against registration
No. TMA499,642 for the trade-mark PRIYA & Design in
the name of Ushodaya Enterprises Private Limited**

[1] At the request of Ridout & Maybee LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on December 14, 2009, to Ushodaya Enterprises Private Limited, the registered owner (the Registrant), of registration No. TMA499,642 for the following trade-mark (the Mark):



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

Pickles and chutneys of all varieties, jellies, jams, sauces for cooking and accompanying fruit, meat and vegetables, marmalades, preserved and cooked fruits and vegetables, eggs, egg powder, milk, flavoured milk, chocolate milk, rose milk butter, buttermilk, yoghurt, processed cheese, cottage cheese, cheddar cheese, ghee, bread, biscuits, cakes, wafers, cookies, pastries, nuts namely plain, roasted, salted and spiced cashew, peanuts, roasted and salted peanuts, roasted and spiced peanuts, aromatic betel nut pieces, edible oils, edible fats, spices in the form of whole spices, ground spices, spice pastes, curry masala pastes, culinary pastes namely, ginger

paste, ginger garlic paste, green chilli paste, tomato green chilli paste, green chilli ginger paste, green chilli garlic paste tamarind paste and onion paste.

[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/or services listed on 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 use since that date. In this case, the relevant period for showing use is any time between December 14, 2006 and December 14, 2009 (the Relevant Period).

[4] The relevant definition of “use” in the present case is set out in s. 4(1) of the Act as follows:

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 the purpose and scope of s. 45 of the Act is to provide a simple, summary and expeditious procedure for clearing the register of non-active trade-marks. As such, the evidentiary threshold that the registered owner must meet is quite low. The expression “clearing deadwood” has been often used to describe such proceedings [see *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.)]. A recipient of a s. 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to s. 4 of the Act. However, evidentiary overkill is not required in order to properly reply to a s. 45 notice [see *Union Electric Supply Co. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)]. As stated by Mahoney J. in *Union Electric, supra*, “[u]se must be shown, not examples of all uses”.

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Reddy Jogannagari Jagan Mohan (the Affiant), Senior Manager – Exports, of the Foods Division of the Registrant. Both parties filed written arguments and were represented at an oral hearing.

[7] In the affidavit, the Affiant explains that the Registrant is a manufacturer and exporter of a wide range of food products associated with the Mark. With respect to the ordinary course of trade, the Affiant explains that the Registrant exports food in packages bearing the Mark, selling to Canadian distributors for distribution to retail stores and other distributors. Specifically, the Affiant states that the Mark has been so used in Canada in association with “pickles and chutneys of all varieties, spices in the form of whole spices, ground spices, spice pastes, curry masala pastes, and culinary pastes, namely, ginger, ginger paste, green chilli ginger garlic paste, tomato green chilli paste, green chilli ginger paste, tamarind paste and onion paste” (the PRIYA wares).

[8] I note that the affidavit is silent with respect to “jellies, jams, sauces for cooking and accompanying fruit, meat and vegetables, marmalades, preserved and cooked fruits and vegetables, eggs, egg powder, milk, flavoured milk, chocolate milk, rose milk butter, buttermilk, yoghurt, processed cheese, cottage cheese, cheddar cheese, ghee, bread, biscuits, cakes, wafers, cookies, pastries, nuts namely plain, roasted, salted and spiced cashew, peanuts, roasted and salted peanuts, roasted and spiced peanuts, aromatic betel nut pieces, edible oils, and edible fats”. As there is neither evidence nor submissions with respect to use of the Mark in association with these wares or of special circumstances that would excuse the absence of such use, these wares will be deleted from the registration.

[9] With respect to evidence of the manner in which the Mark appears on product packaging, the Affiant provides, as Exhibit A, photographs of labelled products and photocopies of product labels. The Affiant indicates that the packaging shown is for pickles and chutneys, spices, spice pastes, curry masala pastes and culinary pastes. I note that the Mark clearly appears on the product labels. Furthermore, the exhibit appears to show representations of all of the PRIYA wares, with the exception of the specific wares described as “whole spices” and “onion paste”.

[10] With respect to evidence of sales transactions of the PRIYA wares bearing the Mark, the affiant provides as Exhibit B, a representative sampling of invoices and shipping documents. I note that the invoices reflect transactions that took place within the Relevant Period and clearly show sales made by the Registrant of a variety of the PRIYA wares to a distributor located in Mississauga, Ontario.

[11] To illustrate the representative nature of the invoices in Exhibit B, the Affiant provides a table at paragraph six of the affidavit to link the sale of such goods to the wares as registered. For example, the Affiant links the wares “spice pastes” with a particular invoice dated November 14, 2009, for “Pulihora paste”.

[12] The Requesting Party has challenged many aspects of the Registrant’s evidence. To begin with, the Requesting Party submits that there is no evidence that the PRIYA wares entered the Canadian market-stream through retail channels where Canadians could purchase such wares. However, the Registrant is correct in its submission that a sale includes a sale to a distributor and that it is not necessary to show transactions along the entire chain to the ultimate consumer in order to satisfy the requirements of s. 4 of the Act [*LIN Trading Co. v. CBM Kabushiki Kaisha* (1988), 21 C.P.R. (3d) 417 (F.C.A.)].

[13] The remaining arguments of the Requesting Party allege gaps and ambiguities in the evidence with respect to certain individual wares, namely, “whole spices”, “spice pastes”, “curry masala pastes”, and “culinary pastes”.

[14] With respect to “whole spices”, I agree with the Requesting Party that the Registrant has not provided any evidence of use. “Whole spices” are neither depicted in Exhibit A, nor do any of the invoices in Exhibit B show sales of such wares. Contrary to the Registrant’s submission, I find no basis to accept that use of the Mark in association with “ground spices” extends to cover “whole spices”, as these wares are separately listed in the statement of wares [*John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.)]. Furthermore, this is not a registration that involves a long list of wares such that providing evidence of use with respect to “whole spices” would have required evidentiary overkill.

[15] With respect to “spice pastes” and “curry masala pastes”, the Requesting Party argues that the evidence is ambiguous as to whether the items listed as “Pulihora paste” and “Biryani masala paste” in the table in paragraph six of the affidavit qualify as “spice pastes” and “curry masala pastes” respectively, as indicated by the Affiant. In this vein, the Requesting Party argues that the “Pulihora paste” (shown in Exhibit A), appears to be a dish rather than a paste, and that the Affiant has not described how “Biryani masala paste” is the same as “curry masala paste”.

[16] However, while Pulihora may be a dish, the evidence clearly shows that the Registrant's product is a paste that is added to other ingredients to make the Pulihora dish. Consequently, I see nothing ambiguous with respect to the Affiant's characterization of such wares and accept "Pulihora paste" as representative of "spice pastes". Similarly, absent evidence to the contrary, I see no reason to question whether "Biryani masala paste" properly falls within the category of "curry masala paste".

[17] Lastly, with respect to "culinary pastes", the Requesting Party points out that the representative transaction listed in the table at paragraph six of the affidavit refers to "red chilli without garlic". It argues that not only is it unclear whether this ware is a paste, it is not a ware that is included in the subject registration. Consequently, the Requesting Party contends that the Registrant has failed to provide evidence in support of "culinary pastes" during the Relevant Period.

[18] However, I note that Exhibit A provides ample depictions of products that I would consider as representative of *each* of the "culinary pastes" listed in the registration, with the exception of "onion paste". While it is true that the registration technically does not include "red chilli without garlic", I have no difficulty accepting that this product falls squarely within the general category of wares described as "culinary pastes". In fact, a depiction of a jar of red chilli paste is included in a grouping of registered "culinary paste" wares in Exhibit A. Furthermore, as the invoices are merely *representative*, they do not constitute the only sales made during the Relevant Period. Accordingly, bearing in mind the summary nature and purpose of s. 45 proceedings, I am prepared to infer, from the evidence as a whole, that "culinary pastes, namely, ginger paste, ginger garlic paste, green chilli paste, tomato green chilli paste, green chilli ginger paste, green chilli ginger garlic paste, and tamarind paste" bearing the Mark were sold in Canada during the Relevant Period.

Disposition

[19] In view of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the following wares, "jellies, jams, sauces for cooking and accompanying fruit, meat and vegetables, marmalades, preserved and cooked fruits and vegetables, eggs, egg powder, milk, flavoured milk, chocolate milk, rose milk butter,

buttermilk, yoghurt, processed cheese, cottage cheese, cheddar cheese, ghee, bread, biscuits, cakes, wafers, cookies, pastries, nuts namely plain, roasted, salted and spiced cashew, peanuts, roasted and salted peanuts, roasted and spiced peanuts, aromatic betel nut pieces, edible oils, edible fats, spices in the form of whole spices, and onion paste” in compliance with the provisions of s. 45 of the Act. The amended statement of wares will read as follows:

Pickles and chutneys of all varieties, ground spices, spice pastes, curry masala pastes, culinary pastes namely, ginger paste, ginger garlic paste, green chilli paste, tomato green chilli paste, green chilli ginger paste, green chilli garlic paste tamarind paste.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

