



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

Citation: 2013 TMOB 16
Date of Decision: 2013-01-31

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Medrel GmbH against registration
No. TMA392,620 for the trade-mark AFRIKANA
BRAND in the name of Bedessee Imports Ltd.**

[1] At the request of Medrel GmbH (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 September 17, 2010 to Bedessee Imports Ltd. (the Registrant), the registered owner of registration No. TMA392,620 for the trade-mark AFRIKANA BRAND (the Mark).

[2] The Mark is registered for use in association with the wares: “Cassava: frozen, ground, flour, gari, starch; oils: palm, palm kernal [*sic*], coconut, ghee butter/vegetable; mustard, soft drinks, noodles, canned fish/meat, spices/curry powder in whole and ground, syrup and drink mixes namely drink concentrate such as mauby drink mix, sea moss drink mix, sea moss drink mix, and fruit flavour drink mix; flours: plantain, yam, pumpkin seed whole/ground, fish and seafood; fresh, frozen and dried sauces, condiments and pickles, peas and beans of all kind and ground and whole or canned tomatoes: canned, paste, sauce; whole soups and concentrate; essence and extract, white and yellow corn meal and flour vegetables canned and frozen”.

[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 September 17, 2007 and September 17, 2010 (the Relevant Period).

[4] The relevant definition of “use” with respect to wares is set out in section 4 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 a section 45 proceeding [*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 et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co 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 Registrant filed the affidavit of Rayman Bedessee, Vice-President of the Registrant, sworn on April 15, 2011. Both parties filed written arguments, however, an oral hearing was not held.

[7] In his affidavit, Mr. Bedessee sets out the Registrant’s normal course of trade for sales of the Wares in Canada. Specifically, Mr. Bedessee states that the Registrant sells the Wares to retailers in West Indian, West African, Latin American and Oriental specialties stores as well as to traditional grocery stores and supermarkets. These stores then sell the Wares to the general public. The Registrant also sells the Wares to bakeries and food processors who use them for production of their own products. Finally, Mr. Bedessee asserts that the Registrant also sells most of the Wares on its website (www.bedessee.com), which it started in 1999.

[8] Mr. Bedessee’s affidavit is made up of three main types of evidence: sample products and labels, invoices and sales figures.

[9] Having reviewed both the evidence of record and the submissions of the parties, I find that there are two main issues that must be assessed in order to determine whether the Registrant has satisfied its obligations under section 45(1) of the Act. Firstly, there is a deviation in use issue as the Mark appears on the products and labels in evidence in a manner which differs from the Mark as registered. Secondly, there is an issue regarding which of the Wares the Registrant has established use with during the Relevant Period.

Deviation in Use

[10] In his affidavit, Mr. Bedessee provides sample products and labels (Exhibits A – K). I note that the Mark appears on the products and labels in the following design format:



[11] The Requesting Party submits that this design mark as it is displayed on the products and labels in the Registrant's evidence differs so significantly from the Mark as registered that the evidence cannot support a finding of use of the Mark during the Relevant Period.

[12] The Requesting Party relies on two decisions of the Registrar in support of its submissions on this point [*Smart & Biggar v Mennen Co* (1994), 55 CPR (3d) 398 (TMOB) in which use of the trade-mark SPORT did not support the registration for the trade-mark SPORTSTICK; and *Borden & Elliot v 282880 Alberta Ltd* (1994), 52 CPR (3d) 411 (TMOB) in which the use of a variation of a design mark was found not to support the registration]. I note that each case is to be determined on its own facts. I have reviewed these cases and I note that the facts therein can be distinguished from the present case. Specifically, I note that the differences between the marks as registered and as used in the cited cases are more substantial than the differences in the present case.

[13] In its written argument, the Registrant responds to the Requesting Party's submissions on the issue of deviation in use. The Registrant points to the jurisprudence which provides that when assessing deviations in use the Registrar must determine "whether the additional material would

be perceived as merely descriptive matter or as a separate trade-mark or trade name” [see *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB)] and whether “the differences are so unimportant as not to mislead an unaware purchaser” [see *Promafil Canada Ltee v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)]. Furthermore, the test to be applied is set out in *Registrar of Trade-marks v Compagnie Internationale pour l’Informatique CII Honeywell Bull, Societe Anonyme et al* (1985), 4 C.P.R. (3d) 523 (FCA) as follows:

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.

[14] In the present case, there are two main differences between the Mark as used and the Mark as registered, namely:

- (a) the Mark appears on the labels in a design form with visual emphasis placed on the word AFRIKANA which appears in a stylised font with the word BRAND featured below in much smaller font; and
- (b) the Mark features the additional word MARQUE located above the word AFRIKANA and the ® symbol located after the word AFRIKANA.

[15] Given that the Mark as registered is a word mark, the Registrant is permitted to use it in any form, including in a manner which places more visual emphasis on one of the component words.

[16] The word MARQUE which has been added to the Mark is clearly descriptive, and in fact is a literal translation into French of the word BRAND.

[17] With respect to the placement of the ® symbol, the Registrant submits that any submissions regarding this issue are technical arguments which should not be considered under section 45. Specifically, the Registrant submits that the prominence to be given to one particular trade-mark including or excluding the ® symbol does not affect the analysis under section 45 of the Act [see *Rogers, Bereskin & Parr v Keds Corp* (1986), 9 CPR (3d) 260 (FCTD)]. I agree.

[18] Based on the foregoing, I am satisfied that the differences between the Mark as registered and as applied to the products and labels in evidence are not sufficient to mislead an unaware purchaser into believing that the source of the Wares differs.

[19] Having accepted that the Mark as it appears on the products and labels in evidence constitutes use of the Mark as registered, I will now assess the evidence to determine which, if any, of the Wares, the Registrant has established use of in the normal course of trade during the Relevant Period.

Use of the Mark in Association with the Wares

[20] In its written argument, the Registrant concedes non-use of the Mark with the following wares during the Relevant Period:

...; [oils:] ... ghee butter/vegetable; mustard, ..., noodles, [canned] ...meat, spices/curry powder in whole and ground, ..., [flours:] ... pumpkin seed whole/ground, ...and seafood; fresh, frozen and dried sauces, condiments and pickles, peas and beans of all kind and ground and whole or canned tomatoes: canned, paste, sauce; ...; essence and extract, ..., and flour vegetables canned and frozen

[21] No special circumstances have been demonstrated that would excuse the absence of the use of the Mark in association with the above wares for which non-use was conceded.

[22] I will now move on to assess whether the Registrant has established use of the Mark in association with the remaining wares, namely:

Cassava: frozen, ground, flour, gari, starch; oils: palm, palm kernal [*sic*], coconut...; ..., soft drinks, ..., canned fish..., ... syrup and drink mixes namely drink concentrate such as mauby drink mix, sea moss drink mix, sea moss drink mix, and fruit flavour drink mix; flours: plantain, yam, ..., fish ...; ...; whole soups and concentrate; ... white and yellow corn meal ...

[23] Mr. Bedessee provides samples of some of the Wares as well as images of labels placed on various products which he states are representative of the following products sold in Canada in association with the Mark in the Relevant Period:

- (a) a can of palm nut soup (Exhibit A);

- (b) a bottle of cassava flour (Exhibit B);
- (c) a bottle of plantain flour (Exhibit C);
- (d) an image of a label which is representative of the labels attached to bags of flour (cassava) (Exhibit D);
- (e) an image of label which is representative of the labels attached to bags of flour (plantain) (Exhibit E);
- (f) an image of a label which is representative of labels attached to bags of flour (yam) (Exhibit F);
- (g) an image of a label which is representative of labels attached to bags of cassava (ground) (Exhibit G);
- (h) a bag of corn meal (Exhibit H);
- (i) a bottle of sorrel syrup (Exhibit I);
- (j) an image of a label which is representative of labels attached to boxes of fish (frozen and smoked catfish) (Exhibit J); and
- (k) an image of a bottle of strawberry syrup (Exhibit K).

[24] I note that Mr. Bedessee is very clear with respect to each of the exhibits attached to his affidavit that the packaging and labels he provides are representative only of the specific product to which the packaging or label applies (e.g. with respect to cassava (ground) Mr. Bedessee states “Exhibit G is a copy of an image of a label which is representative of labels attached to bags of cassava (ground) and used in Canada in association with the trade-mark AFRIKANA BRAND during the Relevant Period.”) (paragraph 12).

[25] While no particular level of sales is required to meet the requirements of section 45, I note that the Registrant has provided sales figures for the years 2007 – 2009 which are not insubstantial, including sales of red palm oil; soft drinks; flour (plantain); flour (cassava); cassava (ground); syrup (sorrel); syrup (mauby); and corn meal. With respect to these sales figures, Mr. Bedessee asserts that they relate only to sales made in the normal course of trade.

[26] In support of the sales figures, Mr. Bedessee attaches to his affidavit sample invoices which cover sales of the following wares in the following years:

- (a) invoices for flour (plantain); flour (cassava); cassava (gari); oil (red palm); corn meal; syrup (sorrel); syrup (mauby) sold in 2007 (Exhibit L);
- (b) invoices for flour (plantain); flour (cassava); cassava (gari); corn meal; oil (coconut); oil (white palm); oil (red palm); syrup (mauby); syrup (sorrel); fish (frozen catfish) sold in 2008 (Exhibit M);
- (c) invoices for flour (plantain); flour (cassava); cassava (gari); corn meal; syrup (mauby); syrup (sorrel); soft drink (Irish moss vanilla drink); soft drink (Irish moss peanut drink); and oil (red palm) sold in 2009 (Exhibit N).

[27] I am satisfied that the evidence clearly establishes use of the Mark in the normal course of trade during the Relevant Period in association with the wares set out below. For these wares, the Registrant has provided representative packaging/labels which display the Mark as well as evidence of sales in the normal course of trade (e.g. invoices and/or sales figures):

- (a) flour (cassava) (Exhibits B, D, L, M, N);
- (b) flour (plantain) (Exhibits C, E, L, M, N);
- (c) cassava (ground) (Exhibits G);
- (d) corn meal (Exhibits H, L, M, N);
- (e) fish (frozen) (Exhibit J, M).

[28] With respect to the following wares, I have not been provided with any evidence to support Mr. Bedessee's bald assertions of use (i.e. no sample packaging/labels, invoices or sales figures):

- (a) cassava: frozen, starch;
- (b) canned fish.

[29] In its written argument, the Registrant submits that the evidence of flour (cassava) and cassava (ground) should be sufficient to support a finding of use of the Mark in association with cassava (frozen) and cassava (starch). This submission is based in part on evidence which is not of record. Specifically, I note that in its written argument the Registrant submits that these are "each forms of cassava used for cooking purposes" and that "starch cassava shares a similar texture with ground, gari and flour cassava". These are facts which are not in the evidence.

[30] I refuse to accept the Registrant's submissions on this point. Section 45 requires the owner to provide evidence of use of the Mark with each of the wares covered by the registration. This is not a case where the list of wares is long and where the statement of wares is organized such that demonstration of use for some of the goods within a category can be sufficient to show use for the entire category [see *Saks & Co v Canada (Registrar of Trade-marks)* (1989), 24 CPR (3d) 49 (FCTD)].

[31] In its written argument, the Registrant submits that the evidence of use of the Mark in association with fish (frozen) supports use of the Mark in association with "canned fish". I disagree. In this regard, I note that Mr. Bedessee makes it very clear that the sample label he provides is:

representative of labels attached to boxes of fish (frozen and smoked catfish) and used in Canada in association with the trade-mark AFRIKANA BRAND during the Relevant Period. The wording "keep frozen" appears on the label. (paragraph 15)

[32] Thus, I refuse to accept the sample label for frozen fish as being representative of the manner in which the Mark appears on canned fish.

[33] In the absence of evidence of use of the Mark in compliance with section 4(1) of the Act, I am unable to find that the Registrant used the Mark in association with "cassava: frozen, starch" and "canned fish" during the Relevant Period.

[34] With respect to the following wares, I have been provided with evidence showing that the Mark is displayed on the products (Exhibits A, F) however, I have not been provided with any evidence of sales of the wares (i.e. no invoices or sales figures).

- (a) whole soups and concentrate;
- (b) flour (yam).

[35] In the absence of evidence of sales in the normal course of trade, I am unable to find that the Registrant used the Mark in association with "whole soups and concentrate" and "flour (yam)" during the Relevant Period.

[36] With respect to the wares “cassava (gari); “oils: palm, palm kernal [*sic*], coconut”; and “soft drinks”, the Registrant provides evidence of sales in the normal course of trade (i.e. sales figures and/or invoices), however, Mr. Bedessee does not provide any sample packaging/labels for these wares.

[37] Mr. Bedessee does provide sample invoices and states that these accompany the wares at the time of transfer of possession (Exhibits L, M, N). However, I note that these invoices display AFRIKANA rather than the Mark (AFRIKANA BRAND). Applying the principles set out above, I find that AFRIKANA is significantly different from AFRIKANA BRAND and as a result these invoices would not be sufficient to support use of the Mark in association with these wares [see *Nightingale, supra*; *Promafil, supra*; and *Honeywell, supra*]. All of that being said, I note that Mr. Bedessee does make the sworn statement that “AFRIKANA is shown on the invoices as an abbreviation of AFRIKANA BRAND, the trade-mark which is used on the wares” (paragraph 18, emphasis is mine).

[38] Considering the evidence as a whole, including the evidence of many sample labels (all of which consistently show the Mark in the same design format) and this sworn statement, I am willing to accept that the Registrant has established use of the Mark with “cassava (gari); “oils: palm, palm kernal [*sic*], coconut”; and “soft drinks” in the normal course of trade during the Relevant Period.

[39] Lastly, Mr. Bedessee provides a sample label for sorrel syrup (Exhibit I), as well as evidence of sales of sorrel syrup in the normal course of trade during the Relevant Period (Exhibits L, M, N). Mr. Bedessee also makes the sworn statement that the syrups referred to in his affidavit (i.e. mauby, sorrel and strawberry) are also intended for use as drink mixes. Jurisprudence indicates that it is improper to engage in an overly meticulous analysis of the specification of wares for the purposes of section 45 [see, for example, *Loro Piana SPA v Canadian Council of Professional Engineers (CCPE)*, 2009 FC 1096]. Based on the foregoing, I am satisfied that the evidence of sales of sorrel syrup in association with the Mark are sufficient to support a finding of use of the wares “syrup and drink mixes namely drink concentrate such as mauby drink mix, sea moss drink mix, sea moss drink mix, and fruit flavour drink mix” in the normal course of trade during the Relevant Period.

[40] Based on the evidence of record and for the reasons set out in the paragraphs above, I am satisfied that the Registrant has established use of the Mark in association with the following wares in the normal course of trade during the Relevant Period:

Cassava: ...ground, flour, gari, ...; oils: palm, palm kernal [*sic*], coconut, ...; ..., soft drinks, ..., ..., syrup and drink mixes namely drink concentrate such as mauby drink mix, sea moss drink mix, sea moss drink mix, and fruit flavour drink mix; flours: plantain, ..., fish ...; ...; white and yellow corn meal ...

Disposition

[41] In view of the foregoing, 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 wares "... frozen, ..., starch; ..., ghee butter/vegetable; mustard, ..., noodles, canned fish/meat, spices/curry powder in whole and ground, ..., yam, pumpkin seed whole/ground, ... and seafood; fresh, frozen and dried sauces, condiments and pickles, peas and beans of all kind and ground and whole or canned tomatoes: canned, paste, sauce; whole soups and concentrate; essence and extract, ...and flour vegetables canned and frozen".

[42] The amended statement of wares will read as follows:

Cassava: ground, flour, gari; oils: palm, palm kernal [*sic*], coconut, soft drinks, syrup and drink mixes namely drink concentrate such as mauby drink mix, sea moss drink mix, sea moss drink mix, and fruit flavour drink mix; flours: plantain, fish; white and yellow corn meal

Andrea Flewelling
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office