



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

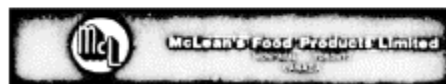
**Citation: 2014 TMOB 269**  
**Date of Decision: 2014-12-01**

**IN THE MATTER OF A SECTION 45  
PROCEEDING requested by McMillan LLP  
against registration No. TMA180,699 for the  
trade-mark MCLEAN'S & Design in the name  
of Produits Alimentaires Berthelet Inc.**

[1] On November 27, 2012 at the request of McMillan LLP (the Requesting Party) the Registrar forwarded a notice (the notice) under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Produits Alimentaires Berthelet Inc. (the Registrant), concerning registration No. TMA180,699 for the trade-mark MCLEAN'S & Design (the Mark) as shown below:

**McLean's**

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[2] Registration No. TMA180,699 covers:

Food products namely; coconut, cake mixes, marshmallow, icing and icing bases, toppings, cherries, marmalade, jams, jelly powders, mincemeat, puddings, cake and pie fillings, spices, shortenings, meringue powder, cocoa powders, hot chocolate powder, food coloring, flavored syrups, dessert sauces, gravy bases, instant gravy mixes, ice cream bases, flavored bases and concentrates for non-carbonated drinks, instant potatoes, potato white, thickening for pie fillings, dehydrated onions, sweet relish, mustard, soup bases, nuts, fruit acids, starch and/or fruit based

fillings used in the bakery industry, emulsions, essences and flavorings, monosodium glutamate, sauces for meat, bar BQ sauce and prepared bread, bun, roll, doughnut and waffle mixes (the Wares).

[3] In response to the notice, the Registrant filed the affidavit of Alain Breault together with Exhibits AB-1 to AB-3.

[4] The parties filed written representations and no hearing was held.

[5] For the reasons that follow I conclude that registration TMA180,699 ought to be expunged from the register.

### The law

[6] The notice requires the Registrant to show whether the Mark had been used in Canada in association with the Wares 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. The relevant period in this case is any time from November 27, 2009 to November 27, 2012 (the Relevant Period).

[7] Section 45 proceedings are simple, expeditious and serve the purpose of clearing the register of “deadwood”; as such, the threshold test to establish use of the Mark is quite low [see *Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)].

[8] A simple allegation of use of the Mark is not sufficient to evidence its use in association with the Wares within the meaning of section 4(1) of the Act. There is no need for evidentiary overkill. However, any ambiguity in the evidence filed shall be interpreted against the owner of the Mark [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (4th) 62 (FCA)].

[9] I therefore must determine if I am satisfied that the evidence to be described afterward enables me to conclude that the Mark had been used by the Registrant in Canada in association with the Wares during the Relevant Period. As it will appear from a detailed summary of the evidence there is no evidence of use of the Mark during the Relevant Period. Therefore I must determine if the Registrant has established special circumstances that would justify the non-use of the Mark during the Relevant Period [see section 45(3) of the Act].

### The evidence

[10] Mr. Breault describes himself as the Registrant's Vice-President and its duly authorized representative. He alleges that during the Relevant Period the Mark was put into reserve by the Registrant. Thereafter on January 23, 2013 the Board of Directors adopted a resolution to resume use of the Mark in association with the Wares. A copy of that resolution has been filed (Exhibit AB-01). However the resolution adopted stipulates that the administration will examine the possibility of using the Mark when it will review in 2013 its portfolio of marks associated with sweet products.

[11] He states that the Mark will be advertised amongst more than 130 clients in at least 5 Canadian provinces as it appears from the Registrant's sales report (Exhibit AB-02). I note that the purpose of that report is to support the allegation that sales would occur in at least 5 Canadian provinces and not to establish sales of the Wares in association with the Mark.

[12] He alleges that the advertising of the Mark will be important following distribution agreements that are the subject of ongoing negotiations for many months or have been concluded for the sale of the Wares in association with the Mark. I note that no copy of the agreements reached has been filed and we have no indication with whom and when such agreements would have been concluded.

[13] He alleges that the Mark is part of a family of registered trade-marks and he filed a copy of the certificate of registrations of those marks (Exhibit AB-03). He further states that the Mark, being part of a family of trade-marks associated with the component "McLean", must be considered as an important historical trade-mark as its use goes back to 1894.

[14] Mr. Breault concludes his affidavit by stating that there is sufficient evidence of the real intention and good faith of the Registrant to use the Mark in Canada in association with the Wares.

### Analysis of the Registrant's evidence

[15] As it appears from the description of the evidence, there is no proof of use of the Mark in Canada in association with the Wares during the Relevant Period. The fact that there has been no use of the Mark in Canada during the Relevant Period does not necessarily mean that its

registration will be expunged from the register. The registration of a trade-mark could be maintained if the Registrant sets out reasons excusing non-use of the Mark. As stated earlier, it is up to the Registrar based on the evidence of record to determine whether requisite “special circumstances” exist to excuse the non-use of the Mark in association with some or all of the Wares [see section 45(3) of the Act].

[16] The applicable test, when dealing with special circumstances excusing non-use, has been laid out in *Canada (Registrar of Trade Marks) v Harris Knitting Mills Ltd* (1985), 4 CPR (3d) 488. Three important criteria must be considered:

- 1) The length of time during which the trade-mark has not been used;
- 2) Whether the registered owner's reasons for not using its trade-mark were due to circumstances beyond its control; and
- 3) Whether there exists a serious intention to shortly resume use.

[17] There is no mention of the last date of use of the Mark in Canada. Under these circumstances, the date of last use is presumed to be the date of the registration of the Mark [see *GPS (UK) Ltd v Rainbow Jean Co* 1984, 58 CPR (3d) 535]. In the present case the Mark was registered on February 14, 1969. Therefore, there would have been a period of more than 40 years between the date of last use of the Mark and the commencement date of the Relevant Period.

[18] Moreover, Mr. Breault does not provide any reasons as to why there has been non-use of the Mark in Canada in association with any of the Wares for a period of at least a period of 7 years. Therefore I cannot determine if the reasons for non-use of the Mark during the Relevant Period were due to circumstances beyond the Registrant’s control. This defect in the Registrant’s evidence is fatal [see *Scott Paper Ltd v Smart & Biggar* (2008), 65 CPR (4th) 303], but there is yet another anomaly in the Registrant’s evidence.

[19] Indeed, there is no indication as to when the Registrant intends to resume use of the Mark in Canada in association with the Wares. Mr. Breault states that some distribution agreements have been concluded without specifying when those agreements were reached, with whom and when the use of the Mark would resume in Canada in association with the Wares in light of those agreements.

[20] The Registrant's written representations are limited to the allegation that the evidence filed demonstrates the Registrant's intention to use the mark in Canada in association with the Wares during the subsequent months after the date of the Registrar's notice.

[21] The Registrant has not met the criteria established by the case law that serve to determine if there have been special circumstances justifying non-use of the Mark during the Relevant Period.

### Conclusion

[22] For all these reasons I conclude that the Registrant failed to prove use of the Mark in Canada in association with the Wares during the Relevant Period and has not proven the existence of "special circumstances" within the meaning of section 45(3) of the Act justifying non-use of the Mark in Canada in association with the Wares during that period.

### Disposition

[23] Pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA180,699 will be expunged in compliance with the provisions of section 45 of the Act.

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Jean Carrière  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office