

SECTION 45 PROCEEDINGS
TRADE-MARK GLOBE & Design
REGISTRATION NO.: 373,330

On April 23, 1996, at the request of Davis & Company, the Registrar forwarded a Section 45 notice to Kavanagh Foods Ltd., the registered owner of the above-referenced trade-mark registration.

The trade-mark GLOBE & Design (reproduced below) is registered for use in association with "(1) Food products namely breakfast cereals, processed cereals, cereal-derived food bars, dried fruits and nuts, and honey".



In response to the Registrar's notice, the registrant furnished the affidavit of Jack G. Beach, President of Kavanagh Foods Ltd. Both parties filed a written submission. A re-executed affidavit by Jack G. Beach was submitted on April 30, 1997. The requesting party submitted that such re-executed affidavit should not be treated as a substitute for the previously filed affidavit of Jack G. Beach, but rather as a supplement to Mr. Beach's original affidavit and that it objected to any attempt by the registrant to withdraw Mr. Beach's original affidavit since it contained admissions against interest by the registrant, which admissions, it states, have been removed from the resworn affidavit. The agents for the registrant in their letter of April 25, 1997 agreed that the original affidavit could remain on file. In the circumstances, I conclude that both affidavits are of record in this proceeding.

Concerning the alterations that were made to paragraph 4 of the first Beach affidavit, I agree that, strictly speaking, the changes ought to have been initialled by Mr. Beach and the person before whom the affidavit was taken. However, I am satisfied that the resworn affidavit resolves the

matter.

Concerning use of the trade-mark, from my reading of paragraphs 4 and 8 of the re-executed affidavit, it would seem that the trade-mark used to appear on labelling of the registrant's food products from time to time in the manner shown by the labels attached as Exhibit A, and that the most recent use of labels bearing the trade-mark occurred on or about November 1994. From paragraphs 5, 6, 7 and 8, it seems that since after November 1994, the trade-mark has only been used on printed matter distributed by the registrant as well as on its invoices. I would state here that such manner of use after November 1994, as shown by Exhibits Band C, would not appear to be use of the trade-mark for wares.

Concerning Exhibit A (the labels bearing the trade-mark), I note that four invoices have also been included as part of that exhibit. Two of them bear dates in November 1994. The two others bear dates in 1992 which is prior to the relevant period, that is between April 23, 1993 and April 23, 1996. Consequently, the 1992 invoices are irrelevant in showing use of the trade-mark during the relevant period.

However, concerning the November 1994 invoices, although they show the customer's address to be in San Diego, California, U.S.A., they also show that the wares ordered were shipped to Richmond, B.C., and Surrey, B.C., respectively. Both invoices show a sale of fifty "5kg/GOLD LABEL Quick Minute Oats". The one dated November 28 also shows a sale of "GREENAWAY Valu PK Honey alm". Exhibit A does not appear to contain labels referring to "GREENAWAY Valu PK Honey alm". However, it does include a specimen packaging for the "5kg GOLD LABEL Quick Minute Oats" and based on the evidence as a whole, and particularly the affiant's statement that the most recent use of the trade-mark on labels occurred in November 1994, and the fact that the November 1994 invoices and the label were submitted together as part of Exhibit A, I am prepared to accept that such packaging represents the manner the trade-mark appeared in

association with the quick minute oats when sold by the registrant on November 28 and 30, 1994.

I reproduce below, for convenience, a copy of one side of the packaging:

5 kg



OATMEAL CEREAL

Item
4327

The requesting party questions whether the use of the trade-mark in close proximity of the registrant's name and in a relatively obscure location on the label of such packaging, constitutes trade-mark use. It submits that such use is more analogous to a trade-name identifying the registrant and does not serve to distinguish the wares themselves.

Although I agree with the requesting party that the trade-mark does not appear prominently on the packaging reproduced above, and although I agree that it is not the dominant mark or the only trade-mark on the packaging, I cannot agree with its contention that the use shown is not trade-mark use. The trade-mark as registered appears on the label of the packaging and although it appears close to the registrant's name, I cannot conclude that such use would be perceived as use of a "trade-name" rather than as a trade-mark, particularly considering that the trade-mark consists of design matter. Concerning the fact that other trade-marks appear more prominently on the label of such packaging (i.e. GREEN A WAY and GOLD LABEL), this is not prohibited by

the Trade-marks Act. In this regard, I rely on the case *A. W. Alien Ltd v. Warner-Lambert Canada Inc.*, 6 C.P.R.(3d) 270.

The requesting party also raised the fact that the packaging does not have a "UPC" code, which it states is a necessity in this day and age. It further argued that the invoices do not refer to the item number appearing on the packaging enclosed, but refer to another code and that, therefore, the invoices cannot be linked to the packaging.

Concerning the absence of a "UPC" code on the quick minute oats packaging, I find the matter to be irrelevant. Concerning the fact that the item number appearing on the packaging does not coincide with the code designation on the invoices, I am of the view that it is quite possible that the order code for the product may be different from the item number appearing on the packaging. Although it would have been preferable if Mr. Beach had clearly stated that the minute oat product sold on November 28 and 30, 1994 was sold in bags bearing a label identical to the label shown on the packaging of Exhibit A, I am of the view that the inference can be made for the reasons I have mentioned earlier, namely in view of his statement concerning the most recent use of the trade-mark on labels having occurred on or about November 1994 and the fact that the two invoices have been submitted with the labels as part of Exhibit A rather than with the majority of invoices which have been submitted as Exhibit B.

Concerning the other labels submitted as part of Exhibit A, the evidence fails to show that products bearing those labels were sold during the relevant period. Furthermore, as pointed out by the requesting party, two of them bear the name "Northern Gold Foods (U.S.A.)", which company is not the registrant.

Pursuant to Section 45(1) of the Trade-marks Act, the onus was on the registrant to show use of the registered mark in association with each of the registered wares at any time between April 23, 1993 and April 23, 1996. Although the evidence in this case is not overwhelming and it is not as precise as it could have been, I conclude that the invoices dated November 28 and 30, 1994 show sales of "Quick Minute Oats" and that the packaging for such wares attached as part of Exhibit A

shows the manner the trade-mark appeared in association with such wares on those dates. I am also satisfied that the sales appear to have been made in Canada in the registrant's normal course of trade and that they appear to be *bona fide* sales. Such evidence in my view is sufficient to satisfy the requirements of Section 45 with respect to the wares "food products namely breakfast cereals". In this regard, see *Quarry Corp. Ltd v. Bacardi & Co. Ltd.*, 72 C.P.R.(3d) 25.

Concerning the remaining wares, the registrant has conceded in its written submissions that the evidence did not show use of the trade-mark in association with "cereal-derived food bars, dried fruits and nuts, and honey". Consequently, such wares will be deleted from the registration.

Concerning the wares "processed cereals", I also conclude that they ought to be deleted from the registration. What I have found is that the evidence shows use of the trade-mark with "quick minute oats" which product, in my view, would clearly be considered a "breakfast cereal". In order to maintain the wares "processed cereals", the registrant would have had to show use with cereals other than breakfast cereals (see *Sharp Kabushiki Kaisha v. 88766 Canada Inc.*, 72 C.P.R.(3d) 195), which it has failed to do.

Consequently, in view of the evidence furnished, I conclude that the statement of wares in the trade-mark registration ought to be amended to read:

"Food products namely breakfast cereals."

Registration No. 373,330 will be amended accordingly, in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 23RD DAY OF

March 1998.



D. Savard
Senior Hearing Officer
Section 45 Division