

SECTION 45 PROCEEDINGS
TRADE-MARK: CINNAMINT
REGISTRATION NO.: 524,644

On February 15, 2005, at the request of Wm. Wrigley Jr. Company, the Registrar forwarded the notice prescribed under Section 45 of the Trade-Marks Act to Cadbury Adams USA LLC, the registered owner of the above-referenced trade-mark registration.

The trade-mark CINNAMINT is registered for use in association with the following wares:

“chewing gum”.

Section 45 of the Trade-marks 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. The relevant period in this case is any time between February 15, 2002 and February 15, 2005.

In response to the notice, the affidavit of Graham Kaufman together with exhibits has been furnished. Each party filed a written argument. An oral hearing has not been requested in this case.

Mr. Kaufman states that he is a Senior Brand Manager at Cadbury Adams Canada Inc.

(hereinafter CACI) and that since 1994 he has been involved in the sale and marketing of chewing gum products by CACI and its predecessors. He submits that as such, he is personally familiar with all of the information set out in his affidavit.

He explains that CACI is the licensee of the registered owner and that the trade-mark CINNAMINT was one of hundreds of marks acquired by the registered owner on March 30, 2003 from Warner-Lambert Company LLC (the predecessor-in-title). He indicates that the predecessor-in-title licensed the use of the trade-mark to Pfizer Canada Inc. (formerly Warner-Lambert Canada Inc.) and that such licensee manufactured and sold CINNAMINT brand gum in Canada under the control of Warner-Lambert Company LLC up until the assignment of the trade-mark. He adds that following the assignment in 2003 his company began selling the wares in association with the trade-mark throughout Canada and he confirms that the current owner controls the character and quality of the chewing gum sold under the trade-mark. He states that such control is exercised through periodic review and approval of such chewing gum, the packaging, the advertising, and site inspections.

He provides as Exhibit A a package of chewing gum bearing the trade-mark, which he states is typical of those sold throughout Canada until the assignment of the trade-mark in 2003 and as Exhibit B, he provides a display box bearing the trade-mark. He specifies that following the assignment of the trade-mark in 2003, CACI continued to use such printed materials for some time.

He states that in the ordinary course of trade CINNAMINT chewing gum has been sold either directly to Canadian retail stores by his company and its predecessors, or to distributors who then sell to Canadian retail stores. As Exhibit C he attaches a sales catalogue, effective March 1 to April 30, 2003, from a distributor for his company, listing the chewing gum associated with the trade-mark. As Exhibit D he provides purchase orders and invoices for the wares.

The requesting party's main argument is that the registrant's evidence is ambiguous in that it does not allow the Registrar to properly conclude whether the use of the mark is use of the mark by the proper owner. It submits that the evidence should either clearly show use of the mark in Canada by Warner-Lambert Company LLC (and/or its licensee Pfizer Canada Inc.) during the relevant period but prior to the assignment date, that is from February 15, 2002 to March 30, 2003, or by Cadbury Adams USA LLC (and/or its alleged licensee CACI) during the relevant period but after the assignment date, that is from March 30, 2003 to February 15, 2005.

Having considered the evidence, I am satisfied that it shows that sales of the wares occurred during the year 2004. The issue is whether the use shown accrues to Cadbury Adams USA LLC. As pointed out by the requesting party all of the invoices identify "Adams" as the seller of the product. Moreover, the packaging furnished as Exhibit A and the display box furnished as Exhibit B bear markings and indicia referencing Adams and Adams Canada. In the case of Exhibit A, ADAMS is identified as a division of Pfizer Canada Inc. (formerly Warner-Lambert Canada Inc.) and also appears as a trade-mark. In the case of Exhibit B, Adams Canada is identified as a division of Warner Lambert Company.

Concerning the packaging and display box, Mr. Kaufman has explained that following the assignment of the trade-mark to the current owner, the packaging and display box shown in Exhibits A and B were used by CACI for some time. Consequently, although the packaging and display box refer to the predecessor-in-title and licensee, we have sworn testimony to the effect that after the assignment of the trade-mark such materials were used by CACI for some time. As for the fact that Canadian consumers were presented with a name other than that of the registered owner or CACI when they purchased the wares as stated in *Lin Trading Co. Ltd. v. CBM Kabushiki Kaisha also trading as Japan CBM Corp. et al.*, 21 C.P.R. (3d) 417, this does not mean that the registered owner has not used the mark in the normal course of trade (see also *Swabey Ogilvy Renault v. Golden Brand Clothing (Canada) Ltd.*, 10 C.P.R. (4th) 274 and 17 C.P.R. (4th) 516). Consequently, the fact that the packaging for the wares still bear the name of the predecessor-in-title (and its licensee) may affect the distinctiveness of the registered owner's mark, however, this is not a matter to be dealt with in a Section 45 proceeding.

Concerning the fact that the invoices bear the name "Adams" (as well as the trade-mark ADAMS & Design), I agree that it would have been preferable if Mr. Kaufman had addressed the matter. However, having regard to the evidence as a whole, in particular the affiant's sworn testimony to the effect that after the assignment it is CACI that began selling the wares marked with the trade-mark throughout Canada, the fact that the new owner seems to have purchased hundreds of marks from the predecessor (which likely would have included the trade-mark ADAMS & Design), and given that the names of the current owner and licensee include the word "Adams", I am prepared to infer that the name "Adams" on the invoices is now in reference to CACI. As

Mr. Kaufman has clearly sworn that the character and quality of the wares were under the control of Cadbury Adams USA LLC (paragraphs 3, 4 and 5 of the affidavit), I accept that the use shown accrued to Cadbury Adams USA LLC, the current registered owner.

In view of the above, I conclude that the trade-mark registration ought to be maintained.

Registration No. 524,644 will be maintained in compliance with the provisions of Section 45(5) of the Act.

DATED AT GATINEAU, QUEBEC, THIS 8TH DAY OF MARCH 2007.

D. Savard
Senior Hearing Officer
Section 45 Division