



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

Citation: 2016 TMOB 140
Date of Decision: 2016-08-12

IN THE MATTER OF A SECTION 45 PROCEEDING

1673030 Alberta Inc. Requesting Party

and

ZOE International Distributing Inc. Registered Owner

TMA665,399 for JUICY Registration

[1] At the request of 1673030 Alberta Inc. (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 April 11, 2014 to ZOE International Distributing Inc. (the Owner), the registered owner of registration No. TMA665,399 for the trade-mark JUICY (the Mark).

[2] The Mark is registered for use in association with the following goods: “Tobacco and tobacco accessories, namely rolling papers, rolling machines, cigarettes, cigars, cigarette tobacco, pipes.”

[3] Section 45 of the Act requires the registered owner of a trade-mark to show whether it has been used in Canada in association with each of the goods 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 April 11, 2011 to April 11, 2014.

[4] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods 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 section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in section 45 proceedings is quite low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd 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 goods specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co et al* (1984), 80 CPR (2d) 228 (FCA)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Demetra Georganas, Controller of the Owner, sworn on October 3, 2014 in Vancouver, British Columbia. Both parties filed written representations; an oral hearing was not requested.

The Owner's Evidence

[7] In her affidavit, Ms. Georganas attests that the Owner is a Vancouver-based business operating under the names "HBI Canada" and "HBI Distributing Canada". She explains that the Owner manufactures and sells tobacco and tobacco accessories, "including cigars and products for the 'roll your own' or 'make your own' markets such as tobacco papers, rolling papers, rolling machines, cigarette tubes, filters, etc." She states that the Owner is a wholesaler that sells its products to various retailers, who in turn sell to consumers.

[8] Ms. Georganas asserts that the Owner used the Mark in Canada during the relevant period by selling "products that are prominently marked with or associated with the JUICY Mark to Canadian customers". In support, Ms. Georganas attaches to her affidavit various catalogue pages that depict particular registered goods, such as "rolling papers", "rolling machines", and two types of "cigars", which she attests are representative of those sold during the relevant period. She also attaches invoices, dated within the relevant period, showing sales of such goods

to Canadian customers. In each case, I note that the invoices identify the seller as “HBI Canada”. Although the invoices do not display the Mark, Ms. Georganas asserts that they are representative of the sale of goods bearing the Mark.

[9] In particular, attached to Ms. Georganas’ affidavit are the following exhibits:

- Exhibit A is a printout from the British Columbia Registry Services showing that the Owner registered the business name “HBI Distributing Canada” on September 30, 2002.
- Exhibit B consists of two pages which Ms. Georganas attests are excerpts from the Owner’s 2014 product catalogue. The pages advertise various flavors of packaged cigars identified as “Bluntarillos”. On one of the pages, the product is described as “smaller [than] a classic Blunt sized cigar but larger than a typical Cigarillo”. I note that “JUICY®” appears twice on that same page, including above a list of various types of “Bluntarillo” flavors. The Bluntarillo cigar packaging shown on the pages display the logo shown below:



- Exhibit C consists of three invoices showing sales of various goods, including “Bluntarillo cigars”, from HBI Canada to customers located in Canada. Ms. Georganas confirms that the invoices are representative of the sales of Bluntarillo cigars bearing the logo reproduced above. According to Ms. Georganas, the cigars are identified on the invoices by product codes starting with “RILLO”.
- Exhibit D is a page that Ms. Georganas attests is from the Owner’s 2012 catalogue. The page advertises various flavors of “FATMOUTH CIGARILLOS”. I note that “JUICY®” appears throughout the page, including above a list of cigar flavors. Underneath a

“FATMOUTH CIGARILLO” logo, the depicted cigar packages also display the logo reproduced below:



- Exhibit E consists of three invoices showing sales of various goods, including “JUICY FAT MOUTH CIGARS” from HBI Canada to customers located in Canada. Ms. Georganas confirms that the invoices are representative of the sales of such cigars bearing the logo depicted in the Exhibit D catalogue and reproduced above.
- Exhibit F consists of four pages which Ms. Georganas attests are excerpts from the Owner’s 2014 product catalogue. The pages advertise different types of packaged “flavored paper” that Ms. Georganas confirms are “rolling papers”. Again, “JUICY ®” appears on two of the pages, including as part of the slogan: “Because many many Juicy® smokers asked us to!” The depicted rolling paper packages display the logo reproduced below; I note that the registered trade-mark symbol appears next to the word JUICY:



- Exhibit G consists of three invoices showing sales of various goods, including various “JUICY JAYS” flavoured paper products, from HBI Canada to customers located in Canada. Ms. Georganas attests that the invoices are representative of sales of the registered good “rolling papers” bearing the logo depicted in the Exhibit F catalogue pages and reproduced above.

- Exhibit H is a page which Ms. Georganas attests is from the Owner’s 2014 product catalogue. The page advertises several different brands of packaged “cigar rollers” that Ms. Georganas attests are the registered good “rolling machines”. One of the depicted products is identified as a “JUICY® cigar roller”. The packaging of this product bears the logo shown below:



- Exhibit I consists of three invoices showing sales of various goods, including “JUICY JAYS CIGAR ROLLER BOX” from HBI Canada to customers located in British Columbia and Ontario. Ms. Georganas confirms that the invoices show sales of the “JUICY® CIGAR ROLLER” depicted in the Exhibit H catalogue page and bearing the logo reproduced above.

Preliminary Matter

[10] As a preliminary matter, I note that, in her affidavit, Ms. Georganas asserts that the Owner sold “tobacco” in association with the Mark because “Cigars consist of tobacco filler wrapped in a tobacco wrapper, and are tobacco products under Canada’s *Tobacco Act*”. In view of the articulation of the statement of goods, I consider it unnecessary to determine whether the evidence relates to “tobacco” as a separate good.

[11] In this respect, I note that the statement of goods begins with “Tobacco and tobacco accessories”, followed by “namely”, and then a mixed list of specific tobacco products and tobacco accessories. In my view, the statement of goods is most coherent if the word “namely” is interpreted as referring to “tobacco and tobacco accessories” as a whole and not to “tobacco accessories” alone.

Analysis

[12] In its written representations, the Requesting Party submits that there are inconsistencies in the evidence with respect to the identity of the Owner, arguing that any use shown is not that of the Owner. In this respect, it notes that the invoices and catalogues refer to “HBI Canada”, whereas the registry page at Exhibit A refers only to “HBI Distributing Canada”. As such, the Requesting Party suggests that the Owner and HBI Canada are, in fact, different entities.

[13] However, Ms. Georganas clearly states that the Owner “does business under the names HBI Canada and HBI Distributing Canada”. This statement is sufficient to establish that “HBI Canada” is a trade name of the Owner and that any reference to HBI Canada in the evidence is a reference to the Owner. As submitted by the Owner, whether such trade name use complies with any provincial regulations is beyond the scope of a section 45 proceeding [see *Lewis Thomson & Son Ltd v Rogers Bereskin & Parr* (1988), 21 CPR (3d) 483 (FCTD)].

[14] Accordingly, I accept that the exhibited invoices are sufficient to show transfers by the Owner in the normal course of trade of the registered goods “cigars”, “rolling papers” and “rolling machines” during the relevant period.

[15] The key issue in this case is whether the Mark was displayed on such goods at the time of transfer. In this respect, the Requesting Party submits that the Owner did not use the Mark *as registered*, arguing that JUICY was used “as part of a composite mark, and/or merely as a descriptive adjective”. In support of its position that the registration should be expunged accordingly, the Requesting Party cites the following cases: *Wellcome Inc v Kirby Shapiro Eades & Cohen* (1983), 73 CPR (2d) 13 (FCTD) and *Hortilux Schreder RV v Iwasaki Electric Co*, 2013 FC 1034, 117 CPR (4th) 99.

[16] In response, the Owner submits that the Mark is used across a range of tobacco products and accessories. It asserts that “having a reference to a particular product in proximity to the JUICY mark does not mean that the JUICY mark is replaced with a composite mark and is not being used as registered”. Furthermore, the Owner notes that, in its catalogues, for example, JUICY is often displayed next to a registered trade-mark symbol, thus conveying the notion to consumers that JUICY is a trade-mark.

[17] In this case, given the absence of further particulars, I do not consider display of “JUICY®” in the exhibited catalogues as constituting use of the Mark in association with the displayed products *per se*. As presented, the catalogue pages appear to be in the nature of advertisements for the Owner’s tobacco-related products only. As such, the issue is whether the logos displayed on the product packaging, as shown above, constitute display of the Mark as registered.

[18] In this respect, it is well established that where the trade-mark as used deviates from the trade-mark as registered, the question to be asked is whether the trade-mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade-marks) v Cie International pour l’informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see if, as a question of fact, the “dominant features” of the registered trade-mark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA)].

[19] First, with respect to the Mark as registered, as it constitutes the only element of the Mark, the word JUICY is the dominant feature.

[20] With respect to the trade-marks as used, the Owner submits that the word JUICY stands out from the additional material, such as the terms “BLUNTARILLO”, “CIGARS” and “JAY’S”. The Owner further submits that, in each case, given that the additional material is descriptive of the particular product, such material is not a dominant feature. For example, as noted above, “Bluntarillo” cigars are described in the exhibited catalogue as being “smaller [than] a classic Blunt sized cigar but larger than a typical Cigarillo”. As such, although “Bluntarillo” appears to be an invented word, it is still descriptive of the cigars. In any event, I note that, in this case, the “JUICY CIGARS” product shown at Exhibit D also relates to the registered good “cigars”, with the word “CIGARS” being a clearly descriptive element.

[21] In addition, as submitted by the Owner, the display of a registered trade-mark symbol next to a trade-mark can help customers identify it as such [see, for example, *Canadian Council of Professional Engineers v Ardex Inc* (2001), 13 CPR (4th) 554 (TMOB) and *Fasken Martineau DuMoulin LLP v AGF Management Ltd* (2003), 29 CPR (4th) 411 (TMOB)]. Applied to this

case, I agree with the Owner that the registered trade-mark symbol next to the word JUICY in the “JUICY JAY’S” logo reproduced above indicates to the Owner’s customers that JUICY is used as a trade-mark and not, as suggested by the Requesting Party, as a descriptive adjective of the products. This impression is reinforced by similar display of “JUICY” with the registered trade-mark symbol throughout the Owner’s catalogues, as described above.

[22] In any event, with respect to the trade-marks as used on the packaging, reproduced above, notwithstanding that JUICY is a dictionary word, I agree with the Owner that, given its font, size, color and location – being the first portion of the trade-mark – JUICY stands out from the additional material in each case.

[23] As such, in applying the principles set out in *Honeywell Bull* and *Promafil*, I find that the dominant feature of the Mark as registered, namely the word JUICY, has been maintained and that the added material in each case constitute minor deviations. Accordingly, I find that use of the trade-marks, as reproduced above, constitutes use of the Mark *per se*.

[24] In view of all of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods “cigars”, “rolling papers” and “rolling machines” within the meaning of sections 4 and 45 of the Act.

[25] However, as noted by the Requesting Party, Ms. Georganas’ affidavit is silent throughout with respect to the remaining registered goods. In particular, she provides no evidence of sales or transfers of “cigarettes”, “cigarette tobacco” or “pipes” in association with the Mark, during the relevant period or otherwise. The Owner provides no explanation concerning such omission in its written representations.

[26] As well, the Owner furnished no evidence of special circumstances excusing such non-use of the Mark. The registration will be amended accordingly.

Disposition

[27] 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 “cigarettes”, “cigarette tobacco” and “pipes” from the statement of goods.

[28] The amended statement of goods will read as follows: “Tobacco and tobacco accessories, namely rolling papers, rolling machines and cigars.”

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office

TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD

HEARING DATE: No Hearing Held

AGENTS OF RECORD

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For the Registered Owner

Field LLP

For the Requesting Party