



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

Citation: 2010 TMOB 117
Date of Decision: 2010-07-13

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Fasken Martineau DuMoulin LLP against
registration No. TMA540,291 for the trade-mark
OPTIMA in the name of Cascades Canada Inc.**

[1] At the request of Fasken Martineau DuMoulin LLP (the Requesting Party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on October 25, 2007 to Atlantic Packaging Products Ltd. (Atlantic), the registered owner of the above-referenced trade-mark registration at that time. I note that the Canadian Intellectual Property Office recorded Cascades Canada Inc. (the Registrant) as owner of the registration on December 8, 2009, following an assignment of August 28, 2009 from Atlantic, the predecessor in title.

[2] The trade-mark OPTIMA (the Mark) is registered for use in association with “bathroom tissues, paper towels and paper napkins” (the registered wares).

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or 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 any time between October 25, 2004 and October 25, 2007 (the Relevant Period).

[4] “Use” in association with wares is set out in s. 4(1) and (3) 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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

[5] In response to the Registrar's notice, the Registrant furnished the affidavit of Paul Neale, together with Exhibits 1 through 13. Mr. Neale states that he is the General Sales Manager, Consumer Products Division, of Atlantic and that he has held that position since 1997. Both parties filed written submissions and were represented at an oral hearing.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a s. 45 proceeding [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Moreover, in the case of wares, it is not the Registrar's or the Court's function to find and set standards of the normal course of trade [*Philip Morris Inc. v. Imperial Tobacco Ltd. et al.* (1987), 17 C.P.R. (3d) 237 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], 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 or services specified in the registration during the relevant period.

[7] With respect to the manner in which the Mark was associated with the registered wares, Mr. Neale produces three photographs of paper towels as Exhibits 2 to 4. The affiant states that Atlantic has been continuously selling Optima branded paper towels marked in the manners shown since 2001 to the present time. I note that the Mark can be clearly seen on all three individual packagings of paper towels. In paragraph 26 of his affidavit, Mr. Neale explains that in addition to the plastic wrapping of the individual packages depicted in these photographs, the Mark also appears on the corrugated boxes containing the packages at the time that the possession of the wares is transferred to the customer.

[8] The Requesting Party submits that these photographs are undated and that “since the photographs depict different labels, it cannot be ascertained from the Neale affidavit if or when these labels were used”. First, even though the photographs are undated, Mr. Neale clearly states that these are representative of the paper towel products sold from 2001 to the time that the affidavit was drafted, thus I am satisfied that they are representative of the manners in which the Mark appeared on the packaging of the paper towel products during the Relevant Period. Second, even though three different photographs of paper towel products are presented, I note that all three rolls of paper towels shown are clearly wrapped in packagings bearing the Mark; the only differences being the various sizes, the number of sheets and the patterns imprinted. When these photographs are viewed in conjunction with the invoices issued during the Relevant Period attached as Exhibits 7 and 8 discussed below, I am satisfied that the Mark was shown in association with various types of paper towel products during the Relevant Period.

[9] With respect to the normal course of trade, contrary to the Requesting Party’s submission, Mr. Neale’s affidavit along with the promotional brochure attached as Exhibit 1 clearly provides that, among other things, Atlantic is in the business of selling consumer towel and tissue products, including Optima branded paper towels, to various retail outlets, including grocery and convenience stores, as well as distributors to retail outlets in Canada and the United States.

[10] In terms of sales of the registered wares during the Relevant Period, Mr. Neale states that for the period between April 2006 and February 2007, Atlantic’s Optima branded paper towels grossed over \$2.1 million in Canadian orders. In support, representative lists of sales orders and selected invoices documenting the sales of individually wrapped paper towels bearing the Mark from 2005 to 2007 are attached as Exhibits 6 through 8. I note that the documents produced as Exhibit 6 show the sales of paper towels identified as “Optima SAS” (Select A Size) in 2006 and 2007 to entities with American shipping and billing address; a similar list of sales orders with selected invoices issued to entities with Canadian billing and shipping addresses are produced as Exhibits 7 and 8 for products identified as “Optima SAS” and “Optima”. Mr. Neale specifies that each individual package of paper towel rolls is wrapped in a packaging on which appeared the Mark, as seen in the earlier exhibits.

[11] One of the arguments made by the Requesting Party during the oral hearing was that there is a “disconnect” between the photographs of paper towels and the evidence of sales provided for the Relevant Period. Specifically, it contends that the lists of sales orders and the invoices do not depict the manner in which the Mark appears on the products, thus the Registrant has not established the sale of paper towels bearing the Mark during the Relevant Period. Having reviewed the evidence, I cannot agree with the Requesting Party’s submission. The sample lists of sales orders and the corresponding invoices do not purport to evidence the manner in which the Mark appears on the packagings of the paper towels. They simply support Mr. Neale’s assertions that Atlantic sold Optima branded paper towels in the normal course of trade during the Relevant Period. The “link” between these sales and the photographs attached as Exhibits 2 to 4 can be found in Mr. Neale’s affidavit where he repeatedly and unequivocally refers to the paper towels shown in the attached photographs as the products documented in these sales transactions. These assertions are corroborated by mentions of “Optima” in the lists of sales orders as well as in the descriptions of items in the invoices. When the evidence is considered in its entirety, I am satisfied that the evidence of sales during the Relevant Period pertains to Optima branded paper towels as shown in the photographs attached as Exhibits 2 to 4.

[12] The Requesting Party also submits that Atlantic failed to provide the breakdown of the annual sales figures for the paper towels, such as the number of units and the cost per unit, thus there is no documentary evidence to substantiate these sales figures. As the Requesting Party has correctly pointed out, it is well established that there is no one particular type of evidence required to show use of a trade-mark [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483 (F.C.T.D.)]. Furthermore, the evidence of a single sale in the normal course of trade may be sufficient to show use of a trade-mark [*Philip Morris Inc. v. Imperial Tobacco Ltd. et al.* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.)]. In the present case, Atlantic has provided plenty of sample invoices to substantiate Mr. Neale’s assertions of sales of Optima branded paper towels during the Relevant Period to Canadian customers. Consequently, I am satisfied that Atlantic has sold paper towels wrapped in a packaging bearing the Mark in the normal course of trade in Canada within the Relevant Period.

[13] On a separate note, the Requesting Party questions the evidence of export sales provided by Mr. Neale’s affidavit and the invoices attached as Exhibit 6. Since I am satisfied that Atlantic

has provided sufficient evidence of sales of paper towels in Canada during the Relevant Period, for the purpose of this proceeding, it will not be necessary for me to decide whether there is also sufficient evidence of export sales of the same wares in the same time period.

[14] In terms of the remaining registered wares for which no evidence has been provided, namely bathroom tissues and paper napkins, citing *Countryside Cannery Co. v. Canada* (1981), 55 C.P.R. (2d) 25 (F.C.T.D.), the Registrant argues that when use is shown in association with one type of wares, the Registrar should not amend the registration to remove the other types of wares if they are closely analogous to the one shown. The Registrant goes on to explain that bathroom tissues and paper napkins are closely analogous to paper towels and that they have overlapping functions. While I agree that these are all tissue products and that one type of tissue could probably replace another under certain circumstances, it does not for that reason imply that the Registrant has shown use of the Mark in association with all the wares specified in the subject registration. Moreover, whether the Registrant could successfully oppose an application to register a similar trade-mark for bathroom tissue or paper napkins based on its use of the Mark in association with paper towels has no bearing on the Registrant's requirement to show use of the Mark with respect to each of the wares specified in the registration in a s. 45 proceeding.

[15] Besides, the facts of this case are distinguishable from those in the *Countryside Cannery Co.* case. Specifically, in the cited case, the trade-mark was registered for "canned fruit and vegetables" and the registered owner furnished evidence of use with respect to "canned tomatoes". The question became whether the use of the trade-mark in association with "canned tomatoes" was use with "canned fruits" or "canned vegetables" *given that a tomato is considered as a vegetable in popular usage but a fruit in the botanical sense*. Here, we are not confronted with the evidence of use of a product that might qualify as multiple registered wares, nor are we here to debate the language used in the statement of wares. Even if "bathroom tissues", "paper towels" and "paper napkins" are closely related to each other in nature, they are clearly manufactured and sold by Atlantic as three distinct products, thus one cannot be considered as another for the purpose of this proceeding.

[16] In the present case, the evidence pertains to the use of the wares registered as "paper towels" only. The fact remains that there is absolutely no indication that Atlantic has

manufactured or sold Optima branded bathroom tissues or paper napkins at any time during the Relevant Period. In fact, according to Atlantic's own promotional brochure attached as Exhibit 1, among all the different types of consumer towel and tissue products shown, the only products bearing the Mark are the paper towels. Products identified as "table napkins" and "bathroom tissues" are sold under such brand names as "Atlantic" and "April Soft". Since no evidence of use has been provided for these two wares, nor have special circumstances been advanced to excuse non-use, they ought to be deleted from the registration.

[17] In view of the foregoing, I am satisfied that there was use of the Mark within the meaning of s. 45 and 4(1) of the Act on "paper towels" during the Relevant Period. Accordingly, and pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the following wares: "bathroom tissue, ... and paper napkins" in compliance with the provisions of s. 45 of the Act.

P. Fung
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office