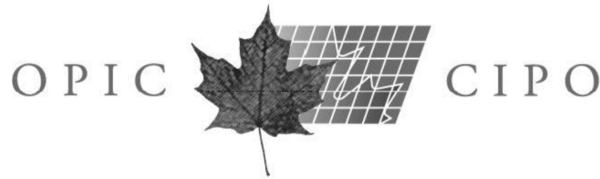

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADE-MARKS

Citation: 2011 TMOB 35
Date of Decision: 2011-03-08

IN THE MATTER OF A SECTION 45 PROCEEDING requested by Bereskin & Parr Intellectual Property Law LLP against registration No. TMA550,101 for the trade-mark LIFEMAX in the name of Raj Sukul

[1] On August 21, 2007, at the request of Bereskin & Parr Intellectual Property Law LLP (the Requesting Party), the Registrar forwarded a notice under s.45 of the *Trade-marks Act* R.C.S. 1985, c. T-13 (the Act) to Raj Sukul (the Registrant), the registered owner of the trade-mark LIFEMAX, registration No. TMA550,101 (the mark).

[2] The trade-mark LIFEMAX is registered for use in association with the following wares:

> (1) Food and beverages, namely nutraceuticals and functional foods namely, fruit juices, vegetable juices, breakfast cereals, non-alcoholic carbonated beverages, pasta, tofu, prepared frozen meals, snacks namely, candy bars, fruit bars, fruit and nut mixes, candy coated puffed grains, crackers, pretzels; food supplements, namely vitamin and mineral supplements;

and services:

> (1) Wholesale distribution of food products and nutraceuticals.

[3] Section 45 of the 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. Thus, the relevant period in which use must be shown is between August 21, 2004 and August 21, 2007.

[4] What qualifies as use of a trade-mark is defined in s. 4 of the Act, the relevant portions of which are reproduced below:

> 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.
>
> (2) A trade-mark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[5] In response to the s. 45 notice, the affidavit of Raj Sukul was furnished. Written representations were not filed by the requesting party or the registered owner. An oral hearing was not requested in this case.

USE OF TRADE-MARK ON WARES

[6] Section 45 clearly indicates that use is to be shown "with respect to each of the wares or services specified in the registration". However, the summary and administrative nature of proceedings under s. 45 of the *Trade-marks Act* and consequent concerns over evidentiary overkill suggest that in some instances it is not necessary to show use for every registered ware and service to prevent removal from the register [see *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.), *Ridout & Maybee LLP v. Omega SA*, 2005 FCA 306, 39 C.P.R. (4th) 261 and *Gowling Lafleur Henderson LLP v. Neutrogena Corporation* (2009), 74 C.P.R. (4th) 153 (TMOB)]. This concept is appropriately applied to cases where the there is a long list of wares and where the statement of wares is organized such that demonstration of use for a number of goods within a category can be sufficient to show use for the entire category. In contrast to this line of reasoning, there are cases where the court has required evidence of use for every ware listed in order to prevent its removal [see *John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228, (F.C.A.)]. However, Justice Russell speaks of the balance between evidentiary overkill and the obligation to show use to the extent

that the Registrar is able to form an opinion on the "use" within the context of s. 45, in *Performance Apparel Corp. v. Uvex Toko Canada Ltd.*, 2004 FC 448, 31 C.P.R. (4th) 270 [*Performance Apparel*]. In these circumstances, an affidavit must contain a clear statement of use within the relevant period in association with each of the wares and must provide sufficient facts to permit the Registrar to conclude that the trade mark is in use in association with each ware.

[7] In the present case, Mr. Sukul's affidavit makes the following somewhat ambiguous statement: "I have been using the trade-mark LIFEMAX in association with wares and services in Canada in the ordinary course of trade since at least as early as August 13, 2001 with respect to the registered wares". He fails to state clearly and comprehensively that use of the mark has been in association with *all* (or each) of the wares specified in the registration, as s. 45 would require. For example, Mr. Sukul provides a label that he states is "a sample of the type of labels which appear on all food products" and "a sampling of invoices" demonstrating sales which "do not represent all of the food products which were distributed in Canada". Ambiguity is created by the fact that the evidence reveals that Registrant sells wares that are not listed in the registration, and therefore the affiant's blanket statements throughout the affidavit regarding "all food products" cannot be interpreted as necessarily referring to each or all of the registered wares.

[8] Mr. Sukul's affidavit is accompanied by ten invoices from Maplegrove Food and Beverage Corp. (Maplegrove) to Canadian retailers. Mr. Sukul's affidavit states that a license agreement exists between himself and Maplegrove; this is sufficient to establish the existence of a licence, see *Nissan v. MAAX Canada Inc.* (2007), 65 C.P.R. (4th) 99 (T.M.O.B.). He further states that the use of the mark "was directly or indirectly in his control, under the terms of the license, which also included the right to inspect such use from time to time." I am satisfied that the use of the mark by Maplegrove is use which is in conformity with s. 50(1) of the Act and as such enures to the registrant.

[9] The Maplegrove invoices are dated between March 2006 and May 2007 and include products which may be categorized as soup cubes, fruit juices and pastas; I note that soup cubes are not included in the statement of wares as registered. Mr. Sukul's states that "items included

in these invoices would have also borne the trade-mark LIFEMAX" and provides a sample label for fruit juice; LIFEMAX appears clearly on the label. Having regard to the evidence provided, I am satisfied that use of the mark in Canada has been shown in association with fruit juices and pastas for the relevant period. In this regard I note that the fruit juices are identified as "fortified" and I find it reasonable to accept, in conjunction with the affiant's statements in this regard and the affidavit as a whole, that these wares were "nutraceuticals and functional foods."

[10] Although Mr. Sukul's affidavit states that the evidence provided is representative of other products bearing the mark, as noted above, the fact that the supporting evidence relates exclusively to fruit juices and pastas and that there is no clear statement of use with respect to the other wares, creates ambiguity. It is well established that ambiguities in the evidence are to be interpreted against the registered owner's interests (*Aerosol Fillers Inc. v. Plough (Canada) Ltd.* (1979), 45 C.P.R. (2d) 194 (F.C.T.D.) aff'd at (1980), 53 C.P.R. (2d) 62 (F.C.A.)). Accordingly, in the presence of evidence demonstrating use on a very limited number of the registered wares and in the absence of a clear statement of use for each of the wares, the registration cannot be maintained with respect to wares for which use has not been demonstrated.

USE OF TRADE-MARK ON SERVICES

[11] Mr. Sukul states: "I am in the business of the wholesale distribution of food products and nutriceuticals" and "I source the food products from producers and canneries in various countries and all products have labels applied". No evidence is provided to show that the mark is displayed in the performance or advertising of the registered services as s. 4(2) requires. As determined above, the Maplegrove invoices demonstrate the sale of goods (stated to bear the mark) to Canadian retailers and distributors; however, the mark itself does not appear on the invoices, thus these invoices do not show the use of the mark in association with the registered services [see *Tint King of California Inc. v. Canada (Registrar of Trade Marks)*, 56 C.P.R. (4th) 223 (F.C.); *Groupe Nexio Inc. v. Samsung Electronics Co.* (2008), 68 C.P.R. (4th) 268 (T.M.O.B.)]. No other evidence is provided which would allow the Registrar to conclude that the mark was used in Canada in association with the services of "wholesale distribution of food products and nutraceuticals" during the relevant period.

<u>DISPOSITION</u>

[12] Having regard to the evidence as a whole, I am satisfied that there was use of the mark within the meaning of s. 45 and 4(1) of the Act in association with the wares: “food and beverages namely nutraceuticals and functional foods namely, fruit juices, pasta.” I am not prepared to conclude that use of the mark in association with “food and beverages, namely nutraceuticals and functional foods namely, vegetable juices, breakfast cereals, non-alcoholic carbonated beverages, tofu, prepared frozen meals, snacks namely, candy bars, fruit bars, fruit and nut mixes, candy coated puffed grains, crackers, pretzels; food supplements, namely vitamin and mineral supplements” has been shown. Likewise, I am not prepared to conclude that use of the mark in association with the services: “wholesale distribution of food products and nutraceuticals” has been shown. No evidence of use has been provided for these wares or services, nor have special circumstances been advanced to excuse non-use.

[13] Pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the following wares: *“vegetable juices, breakfast cereals, non-alcoholic carbonated beverages, tofu, prepared frozen meals, snacks namely, candy bars, fruit bars, fruit and nut mixes, candy coated puffed grains, crackers, pretzels; food supplements, namely vitamin and mineral supplements”* and the services: *“Wholesale distribution of food products and nutraceuticals.*” in compliance with the provisions of s. 45 of the Act.

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P. Heidi Sprung
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office