

SECTION 45 PROCEEDINGS
TRADE-MARK: ROSE BRAND
REGISTRATION NO. 317,328

On September 21, 1995, at the request of Thai Indochine Trading Inc., represented by the firm Deeth Williams Wall, the Registrar forwarded a Section 45 notice to Multifoods Inc., the registered owner of the above-referenced trade-mark registration.

The trade-mark ROSE BRAND is registered for the following wares: “pickles, pickled beets, mustard pickles; hot dog, hamburger, corn and tomato relishes”.

In response to the Registrar’s notice, the registrant furnished the affidavit of John McPherson, Group Product Manager for the registrant. Both parties filed written submissions and were represented at an oral hearing.

In his affidavit, Mr. McPherson has conceded that the trade-mark has not been in use in association with pickled beets and tomato relish. Accordingly, these wares will be deleted from the registration.

Concerning the evidence of use, Mr. McPherson has provided copies of invoices which he has stated represent sales in the ordinary course of the registrant’s business. Mr. McPherson has submitted that “each of the “ROSE” products that is identified on the invoices had a label that used the trade-mark that is the subject matter of Exhibit A”, (Exhibit A consisting of a copy of the registration page).

As Exhibit C, he has submitted labels showing the manner the registrant is using and has used the trade-mark as stated in his affidavit.

The requesting party’s main arguments are: (1) that the labels do not show use of the trade-mark as registered; (2) that there is no clear evidence that the labels (Exhibit C) represent the labels used with the wares when the wares were transferred; (3) that it is unclear whether the use is in the normal course of trade, and (4) that the use may not be by the registered owner.

Having reviewed the evidence, I am satisfied that it shows sales, by the registrant, in the normal course of trade of the wares “pickles, mustard pickles, hot dog, hamburger, and corn relishes”. However, I do agree with the requesting party, that the use shown is not use of the trade-mark as registered.

I reproduce below, for convenience, a copy of one of the labels produced as Exhibit C:

Concerning the labels, the requesting party submits that the public would perceive the mark to be the word ROSE, or the word ROSE together with the design of a rose, or would perceive the whole label as being the trade-mark. It submits that the word “brand” as it appears thereon, would not be perceived as part of the trade-mark but would be taken as an indicator similar to the symbol R and the letters tm, indicating that the word ROSE is the trade-mark. It submits that such impression is reinforced by the fact the the invoices only refer to the trade-mark as “ROSE”.

The registrant, on the other hand, submits that the words ROSE BRAND appear on the labels and it relies on the case Promafil Canada Ltee v. Munsingwear Inc., 44 C.P.R. (3d) 59, in stating that the dominant impression of the mark as registered is still maintained.

While I agree that both words forming the registered trade-mark appear on the labels, I tend to agree with the requesting party that the public would probably not perceive the words ROSE BRAND “per se” as one of the trade-marks on the labels. The words ROSE BRAND on the labels appear with additional matter and while it has been established in Nightingale Interloc Ltd. v. Prodesign Ltd., 2 C.P.R. (3d) 535 at 538, that use of a mark in combination with additional material can constitute use of the mark “per se”, this would only be the case if the public, as a matter of first impression, would perceive the mark “per se” as being used as a trade-mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, e.g. by the use of different

lettering or sizing, or whether the additional material would be perceived as purely descriptive matter.

In the present case, I am of the view, that the public may see the words “marque ROSE brand” as one trade-mark but would probably not perceive the words ROSE BRAND “per se” as the trade-mark being used. The words ROSE BRAND “per se” do not stand out from the additional matter. The words “brand” and “marque” appear in the same style and are of the same size of lettering while the word ROSE alone stands out. In my view, the words “marque” and “brand” as used on the labels, would be perceived as either generic matter or components of the marks appearing on the labels such as the mark “marque ROSE brand”. As I am of the view that the public would probably not recognize the registered trade-mark “per se” on the labels, I conclude that the trade-mark has been used in such a way as to have lost its identity (see in this regard, Munsingwear, supra, and Compagnie Internationale pour l’Informatique CII Honeywell Bull v. Registrar of Trade-marks, 4 C.P.R. (3d) 523). Consequently, I am not satisfied that the use shown constitutes use of the registered trade-mark.

Therefore, I conclude that the evidence fails to show use of the trade-mark as registered and that, consequently, the trade-mark registration ought to be expunged from the register.

Registration No. 317,328 will be expunged in compliance with the provisions of Section 45(5) of the Trade-marks Act.

DATED AT HULL, QUEBEC, THIS 31st DAY OF December, 1996.

D. Savard
Senior Hearing Officer
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