



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

Citation: 2012 TMOB 21
Date of Decision: 2012-02-08

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Gowling Lafleur Henderson LLP against
registration No. TMA574,275 for the trade-mark KING'S
in the name of TEN REN TEA CO., LTD.**

[1] At the request of Gowling Lafleur Henderson 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 June 22, 2009, to Ten Ren Tea Co., Ltd., the registered owner (the Registrant) of registration No. TMA574,275 for the trade-mark KING'S (the Mark).

[2] The Mark is registered for use in association with the following wares:

Tea, tea bags, tea leaves, cakes, tea-based fillings for cakes and pies, cocoa, coffee, cookies.

[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. In this case, the relevant period for showing use is any time between June 22, 2006 and June 22, 2009 (the Relevant Period).

[4] The relevant definition of “use” in the present case is set out in s. 4(1) of the Act as follows:

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.

[5] It is well established that the purpose and scope of s. 45 of the Act is to provide a simple, summary, and expeditious procedure for removing deadwood from the register. While 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.* (1979), 45 C.P.R. (2d) 194, aff'd (1980), 53 C.P.R. (2d) 63 (F.C.A.)], the threshold for establishing use in these proceedings is quite low [*Lang, Michener, Lawrence & Shaw v. Woods Canada Ltd.* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.)], and evidentiary overkill is not required [*Union Electric Supply Co. v. Canada (Registrar of Trade Marks)* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)]. However, 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.

[6] In response to the Registrar's notice, the Registrant furnished the affidavit of Chi-Wen Liu. While both parties filed written submissions, the Requesting Party was the sole party represented at an oral hearing.

[7] In his affidavit, Mr. Liu identifies himself as the Vice Director of the Registrant, having held this position since September 1, 2000. Mr. Liu explains that the Registrant manufactures, distributes and exports products including tea, to Asia, North America and other countries. Further to this, he explains that the Registrant sells oolong tea under the Mark and that during the Relevant Period the Registrant exported the tea from Taiwan and then sold the tea under the Mark in Canada.

[8] As evidence of such use, Mr. Liu provides the following:

- Exhibit A: photocopies of a flattened box for tea. One side panel of the box contains the words "Ten Ren King's Tea", followed below by a description of the product. The same side panel indicates that the Registrant packed the product and that Ten Ren Tea Co. (Toronto) Ltd. is the Canadian importer.

- Exhibit B: a copy of an Export Customs Declaration, which Mr. Lui explains is required by the government of Taiwan for the export of the product to Canada. The declaration, dated within the Relevant Period, documents the export of 3,600 units of tea by the Registrant to Canada. The buyer listed on this document is Ten Ren Tea Co., (Ontario) Ltd. One of the products identified for export on this document is “Oolong Tea (103 King’s Tea)”.
- Exhibit C: a copy of the Packing List that accompanied the shipment of tea detailed in Exhibit B. The first product identified on this list is “Oolong Tea (103 King’s Tea)”. Ten Ren Tea Co., (Ontario) Ltd. appears as the purchaser.
- Exhibit D: a copy of an invoice in respect of the shipment of tea documented in Exhibits B and C. Again, I note that Ten Ren Tea Co., (Ontario) Ltd. appears as the purchaser.

[9] Mr. Liu concludes his affidavit by stating that “each unit of the 3600 units of King’s tea that was shipped to Canada as detailed in Exhibits B, C, and D, was contained in a package as evidenced in Exhibit A.”

[10] The Requesting Party points out that the affidavit of Mr. Liu makes no attempt to establish that the Registrant has used the Mark with anything other than tea. As I agree with this submission, and special circumstances have not been brought forth to excuse the absence of such use, the following analysis will be restricted to whether use of the Mark has been shown solely in association with “tea” [*John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.)].

[11] The Requesting Party has two main arguments: the first being that the Registrant has not evidenced use of the Mark as registered, and the second being that there is no evidence of any sales in Canada by the Registrant or a licensee in the Registrant’s normal course of trade.

[12] More specifically, with regard to the first argument, the Requesting Party submits that the packaging in Exhibit A only shows the word “King’s” within the phrase “Ten Ren King’s Tea”, wherein the word “King’s” is neither separated nor distinguished from the remaining words. Based on the same reasoning, the Requesting Party argues that the word “King’s” within the

descriptive phrase “Oolong Tea (103 King’s Tea)” as appearing in the remaining exhibits does not demonstrate use of the Mark as registered.

[13] With respect to the product packaging, I note that the Registrant’s full company name appears twice on the packaging in relative proximity to the words “Ten Ren King’s Tea”, clearly identifying the Registrant as the source of the product. Accordingly, I agree with the Registrant that a consumer would perceive the words “Ten Ren” in “Ten Ren King’s Tea” as an abbreviation of the Registrant’s name and a reference to the source of the goods, as a separate trade-mark or trade-name, and not part of the trade-mark *per se*. I note of further influence to the perception of the average consumer in this regard, is the appearance of “TenRen’sTEA” in repeated fanciful script at the top of the box, wherein “TenRen” is visually differentiated from the word TEA. Lastly, the descriptive word “tea” following “King’s” serves to identify the product contained in the packaging and similarly, would not be perceived as forming part of the trade-mark *per se* [*Nightingale Interloc Ltd. v. Prodesign Ltd.* (1984), 2 C.P.R. (3d) 535 (T.M.O.B.)]. Thus, unlike the situation in *Registrar of Trade-marks v. Compagnie Internationale pour l’Informatique CII Honeywell Bull*, this is not an instance wherein the consumer would perceive “Ten Ren King’s Tea” on the packaging as a composite mark, but rather, would identify “King’s” as a trade-mark in its own right [*Mantha & Associates v. Old Time Stove Co. Inc.* (1990), 30 C.P.R. (3d) 574 (T.M.O.B.); *Comstock Ltd. v. Commodity Quotations Inc.* (1997), 83 C.P.R. (3d) 240 (T.M.O.B.)].

[14] As I have already concluded that the product packaging in Exhibit A provides evidence of use of the Mark as registered, I need not consider the appearance of the Mark in the remaining exhibits.

[15] With respect to the Requesting Party’s second argument, it submits that Mr. Lui offers no explanation in his affidavit as to the relationship between the Registrant and the entity (namely, Ten Ren Tea Co. (Ontario) Ltd.) listed as the importer and purchaser of the Registrant’s tea in Exhibits B, C, and D. Consequently, the Requesting Party argues that it is unclear from the evidence if Ten Ren Tea Co. (Ontario) Ltd. is a licensee of the Mark, if such sales are in the Registrant’s normal course of trade, or even what the Registrant’s normal course of trade might be. Furthermore, the Requesting Party submits that there is added confusion and uncertainty

since Exhibit A indicates that Ten Ren Tea Co. (Toronto) Ltd. is the importer, not Ten Ren Tea Co. (Ontario) Ltd., and no explanation as to what, if any, relationship exists between the Registrant, Ten Ren Tea Co. (Toronto) Ltd. and Ten Ren Tea Co. (Ontario) Ltd.

[16] However, Mr. Lui clearly describes the Registrant's normal course of trade, indicating that the Registrant is a foreign manufacturer and exporter of tea. Furthermore, having regard to the evidence in its entirety, the relationship between the Registrant and Ten Ren Tea Co. (Ontario) Ltd. is evident; Exhibits B, C, and D clearly identify Ten Ren Tea Co. Ltd. as the foreign manufacturer, seller and exporter of the tea, while Ten Ren Tea Co. (Ontario) Ltd. is the Canadian importer and purchaser. I see nothing to suggest that these documents do not represent a *bona fide* commercial transaction in the Registrant's normal course of trade. The fact that the product packaging in Exhibit A identifies Ten Ren Tea Co. (Toronto) Ltd. as the importer of the Registrant's tea is insufficient to call into question the evidence as a whole. In fact, the evidence shows that Ten Ren Tea Co. (Toronto) Ltd. and Ten Ren Tea Co. (Ontario) Ltd. share the same address, suggesting at the very least, that these companies are related.

Disposition

[17] In view of the above, I conclude that use of the Mark has been shown for the wares described as "tea", within the meaning of s. 45 and s. 4 of the Act during the Relevant Period. Accordingly, pursuant to the authority delegated to me under s. 63(3) of the Act, the registration will be amended to delete the wares "*tea bags, tea leaves, cakes, tea-based fillings for cakes and pies, cocoa, coffee, and cookies*" in compliance with the provisions of s. 45 of the Act.

Kathryn Barnett
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office