



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

Citation: 2013 TMOB 33
Date of Decision: 2013-02-21

**IN THE MATTER OF A SECTION 45
PROCEEDING requested by Bereskin & Parr
LLP against registration No. TMA368,933 for the
trade-mark WOMAN & CHILD DESIGN in the
name of Sing-Lin Foods Corporation**

[1] At the request of Bereskin & Parr LLP (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 January 12, 2011 to Sing-Lin Foods Corporation (the Registrant), the registered owner of registration No. TMA368,933 for the trade-mark WOMAN & CHILD DESIGN (the Mark), shown below:



[2] The Mark is registered for use in association with “*pasta products, namely noodles*” (the Wares).

[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 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 use since that date. In this case, the relevant period for showing use is between January 12, 2008 and January 12, 2011 (the Relevant Period).

[4] The relevant definition of “use” 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 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 section 45 of the Act is to provide a simple, summary and expeditious procedure for removing deadwood from the register. It was established in *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA) that assertions of use as a matter of law are insufficient to demonstrate use. A recipient of a section 45 notice must put forward evidence showing how it has used the trade-mark in order that the Registrar may assess if the facts qualify as use of the trade-mark pursuant to section 4 of the Act. However, it has also been held that evidentiary overkill is not required when use can be shown in a simple, straightforward fashion [see *Union Electric Supply Co v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)].

[6] In response to the Registrar’s notice, the Registrant furnished the affidavit of Wei-Chao Chen. Both parties filed written argumentation, however, only the Registrant attended an oral hearing.

[7] In his affidavit, Mr. Chen explains that he is the President of the Registrant, and has held this position since 1991.

[8] With respect to the manner in which the Mark is associated with the Wares, Mr. Chen explains that the Mark appears on all of the packages of the Wares sold in Canada. In support, he attaches sample packages under Exhibit A. He states that these samples are representative of the packages that were used for the sale of Wares during the Relevant Period.

[9] With respect to commercial transfers of the Wares in Canada, Mr. Chen provides approximate sales figures for the years 2008, 2009, and 2010. The sales figures are not insubstantial. In addition, Mr. Chen attaches a number of invoices which he states show sales in Canada of the Wares by the Registrant in 2008, 2009, and 2010.

[10] The above-noted sales transactions/commercial transfers are not at issue. Rather, the Requesting Party argues that it is the manner in which the Mark appears on the sample packages in Exhibit A that is problematic. In short, the Requesting Party asserts that the Chen Affidavit does not establish “use” of the *registered mark* during the Relevant Period within the meaning of section 4 of the Act.

[11] To explain, the Requesting Party submits that to begin with two of the four images of sample packages in Exhibit A are too small and unclear and, as such, they are ambiguous. I agree. However, I note that these images appear to follow the pattern of the registered mark, with the exception of an addition of a small red rectangle or carpet appearing as a background to the Chinese characters. Had these images been clearer, and it was evident that the main features of the Mark remained substantially the same, I expect that I would have found the addition of the red rectangle or carpet to be inconsequential.

[12] With respect to the remaining sample packages, they display the following images:



In both images, the curtain in the background appears in the colour red, as does the symbol preceding the word WU-MU.

[13] With respect to the above images, the Requesting Party outlines the differences between the images above when compared to the registered mark. First, the Requesting Party points out that unlike the registered mark, the above images include a rectangular curtain hanging on a curtain rod. Further to this, unlike the registered mark, the above images include the lettering WU-MU and an additional circle and triangle design to the left of the wording WU-MU. Lastly, the Requesting Party submits that there are differences in the facial expressions of the woman and child, and in the pattern on the woman's kimono.

[14] The Requesting Party argues, applying the test for deviation from *Canada (Registrar of Trade-marks) v Cie International pour l'informatique CII Honeywell Bull* (1985), 4 CPR (3d) 523 at 525 (FCA), that given all of the differences noted above, the mark used does not constitute use of the registered trade-mark.

[15] The test outlined in the *Honeywell Bull* case is stated on page 525 as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[16] It was also stated in the *Honeywell Bull* case, that where the trade-mark used deviates from the mark as registered, the question to be asked is whether the mark was used in such a way that it did not lose its identity and remained recognizable in spite of the differences.

[17] In deciding this issue, one must look to see if the “dominant features” have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) at 59 (FCA)].

[18] Lastly, it has also been held that the use of a trade-mark in combination with additional words or features constitutes use of the registered mark if the public, as a matter of first impression, would perceive the trade-mark *per se* as being used. This too is a question of fact which is dependent on whether the trade-mark stands out from the additional material, for example, by the use of different lettering or sizing or whether the additional material would be perceived as clearly descriptive matter or as a separate trade-mark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[19] In the present case, I agree with the Registrant that the dominant features of the registered trade-mark, namely, the woman, the child, and the Chinese characters have effectively been preserved in the above-displayed images. While there are differences in the facial expressions of the woman and child, and in the pattern on the woman’s kimono, I find these differences to be minor. Indeed, I find these differences to be comparable to the differences between the thin penguin and the corpulent penguin that were found to be acceptable in *Promafil, supra*.

[20] With respect to the addition of the red curtain and curtain rod, again, I would agree with the Registrant that this inclusion does not impact the overall impression of the mark. The curtain simply forms a background, wherein the dominant elements of the mark are at the forefront. The mark retains its identity and remains recognizable in spite of this difference.

[21] Lastly, with respect to the inclusion of the word WU-MU, and the circle and triangle design, the Registrant submits that these elements would either be viewed by consumers as separate trade-marks [see *Nightingale, supra*] or as minor additional features which do not detract from the overall appearance of the mark. Once again, I agree.

[22] Overall, I find the dominant features of the Mark have been preserved [*Promafil, supra*], the Mark has not lost its identity and remains recognizable, and consumers would still be likely to infer that both, in spite of their differences, identify goods having the same origin [*Honeywell Bull, supra*].

Disposition

[23] Accordingly, in view of the aforementioned, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained in compliance with the provisions of section 45 of the Act.

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