

SECTION 45 PROCEEDINGS  
TRADE-MARK: SEAFRESH  
REGISTRATION NO: TMA 112,433

At the request of Johnston Wassenaar LLP (the “requesting party”) the Registrar forwarded a notice under section 45 of the *Trade-marks Act* on April 21, 2004 to High Liner Foods Incorporated/Les Aliments High Liner Incorporée, the registered owner of the above-referenced trade-mark.

The trade-mark SEAFRESH is registered in association with “*fresh and frozen fish*”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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 April 21, 2001 and April 21, 2004.

“Use” in association with wares is set out in subsections 4(1) and 4(3) of the *Trade-marks 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.

In response to the Registrar’s notice, the registrant furnished the affidavit of Claire E. Milton. Both the requesting party and the registrant filed written representations and were represented at an oral hearing.

In her affidavit, Claire E. Milton explains that she is corporate counsel for the registrant, having held this position since 1997. She then states, “by virtue of my position, and having reviewed High Liner’s business records, I have personal knowledge of the matters set out herein.”

She explains that the registrant is in the business of processing and marketing high quality seafood, frozen pasta, and other food products. With respect to the subject mark, she states “High Liner has used the trade-mark SEAFRESH continuously in the ordinary course of business in Canada in association with fish (the “SEAFRESH Products”) during the three year period immediately preceding April 21, 2004 (the “Material Period”).

With respect to the manner in which the trade-mark was associated with the SEAFRESH Products at the time of transfer, Ms. Milton has attached as Exhibit “B” to her affidavit, photographs of sample packaging. She clearly states that this packaging was “used during the Material Period in connection with SEAFRESH Products.” I note that the trade-mark SEAFRESH can be clearly seen on the packaging in all instances, and as the requesting party has commented, appears stylized in connection with design elements. In particular, I note the trade-mark appears with either a non-distinct design (namely, a fanciful depiction of a fish with waves) or simply within a rectangular border with waves on the bottom. However, I do not consider these inclusions to be fatal. In my view, the word SEAFRESH is overwhelmingly prominent in relation to the design elements, capable of being recognized as a trade-mark in its own right, to the extent that the continued commercial impression remains the same and consumers would be likely to infer that both the registered mark and the mark as used, in spite of their differences, identify goods having the same origin [see *Promafil Canada Ltée v. Munsingwear Inc.* (1992), 44 C.P.R. (3d) 59 (F.C.A.) and *Compagnie Internationale pour l'Informatique CII Honeywell Bull v. Registrar of Trade Marks* (1985), 4 C.P.R. (3d) 523 (F.C.A.)].

The requesting party has also commented that the packaging shows the Mark with additional wording, such as “fillets” or “FRY-O-PAK”, and argues that the addition of these words is not insignificant. This is particularly so, it contends, as the registered

trade-mark is not identified through the use of a <sup>TM</sup> symbol or other such indicia. Setting aside that there is no requirement for such marking, the additional words appear adequately spaced apart from the Mark, such that consumers would not perceive these words as forming part of the Mark itself, but rather, would be more likely to perceive these words as descriptive (“fillets”) or a separate trade-mark (“FRY-O-PAK”). I would add that there is nothing that prohibits two trade-marks from being used concurrently on such packaging (*A.W. Allen Ltd v. Warner-Lambert Canada Inc.* 6 C.P.R. (3d) 270).

In paragraph five of her affidavit, Ms. Milton then explains that the registrant, as part of its normal course of trade, distributes the SEAFRESH Products under the subject mark to retailers and distributors throughout Canada. She attaches as Exhibit “C”, a “representative sample of invoices demonstrating sales of the SEAFRESH Products during the Material Period.” She explains that reference is made to the trade-mark SEAFRESH in the invoices with the abbreviation “SF” under the category heading, “Description”. I note that all twenty-two invoices are dated within the relevant period, sixteen of which clearly show that the registrant made sales in relation to “SF” products in Canada. The remaining invoices include sales of “SF” products to American entities during the relevant period, and as I am satisfied that such wares were marked in Canada prior to their export, the requirements of s. 4(3) of the Act would appear to be satisfied in this instance.

Lastly, Ms. Milton provides significant annual sales figures for SEAFRESH Products, which she states were made by her company in Canada between 2001 and April, 2004. The reliability of the sales figures has been challenged by the requesting party, in view of the fact that the invoices attached to support the affiant’s claim of sales in Canada were a combination of American and Canadian invoices. However, even if I am incorrect in concluding that the sales to American entities satisfy s. 4(3) of the Act, I accept the remaining sixteen representative invoices as evidence of bona-fide commercial transfers of the wares in Canada; consequently, I need not consider the sales figures. In any event, given that sixteen of the representative invoices in evidence clearly show sales in Canada,

I would find it reasonable to conclude that at least a portion of the sales figures provided would represent sales in Canada as well.

Having summarized the evidence, I will now have regard to what I consider to be the most relevant submissions of the parties. The main argument of the requesting party, as I understand it, is that the registrant has failed to establish that it has used the subject mark in Canada in association with the wares covered in the registration during the relevant period. In this regard, it points out that the Milton affidavit refers only to “fish”, as opposed to the more specifically defined wares, namely, “fresh and frozen fish”, as listed in the subject registration. Further to this, it argues that the evidence of use is in association with “processed seafood products,” such wares not being covered by the subject registration. It draws this conclusion from the list of ingredients on the sample packaging provided under Exhibit “B”, as well inferences drawn from abbreviated product descriptions listed on the invoices in Exhibit “C”.

Upon review of the evidence, I agree that there is no evidence of use of the Mark in association with “fresh fish”. I draw this conclusion not only from Ms. Milton’s conspicuous lack of specific reference to “fresh” fish in the affidavit, but also from inferences, due to the ingredients listed on the sample packaging, as well as the abbreviated product descriptions in the invoices, namely, BTTD and BRD, that the evidence refers to breaded, battered or otherwise prepared fish. Given that the definition of “fresh” as it appears in the *Merriam-Webster Online Dictionary* is: “not altered by processing < *fresh* vegetables >”, such wares do not appear to qualify as fresh. This conclusion would also appear to be consistent with the affiant’s attestation at paragraph two of the affidavit that the registrant is in the business of *processing* high quality seafood [my emphasis].

However, contrary to the requesting party’s position, I do not necessarily consider such wares to be mutually exclusive of “frozen fish”. Despite any apparent processing or alteration, it is clear from the packaging that the contents refer to fish or fish fillets. The word “fillet”, used in its common and ordinary sense, as defined in *The American*

*Heritage® Dictionary of the English Language, Fourth Edition (2006)* is: “A strip or compact piece of boneless meat or fish, ...”; “fillet” is also defined in the *Canadian Oxford Dictionary* as “a fleshy boneless piece of meat from near the loins or the ribs. ( in full fillet steak ) the undercut of a sirloin. a boned longitudinal section of a *fish*”(emphasis mine). Additionally, in the packaging at page 3 of Exhibit B, “minced fish or fish fillets (Pollock or cod or haddock or sole)” is listed as the first ingredient. Consequently, I find it reasonable to infer that consumers would consider the main ingredient to be fish.

Furthermore, given the highly perishable nature of fish, the type of packaging in evidence, and the distance of transport to purchasers as evidenced by the invoices, I find it reasonable to accept that such wares would be in frozen form. As such, I am prepared to accept, given the intent and purpose of s. 45, that the evidence supports use in association with “frozen fish”.

Interestingly, the registrant argues that as “frozen fish” and “fresh fish” are of the same general category of wares, namely, “fish”, evidence of use in association with “frozen fish” is sufficient to maintain “fresh fish” as per the requirements of Section 45. In support of this proposition, it has relied on the cases of *Countryside Cannery Co. v. Canada (Registrar of Trade Marks)* (1981), 55 C.P.R. (2d) 25 (F.C.T.D.), *Rideout & Maybee LLP v. Omega SA* (2004), 39 C.P.R. (4<sup>th</sup>) 261 (F.C.), and *Saks & Co. v. Canada (Registrar of Trademarks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.)]

With respect to the registrant’s contentions however, it is my view that the particular facts of this case do not permit me to draw such a conclusion. Although the evidence of use is described in the affidavit as “representative”, as previously discussed, I see no evidence of use in association with “fresh fish”. Moreover, the above-noted cases the registrant relies upon to support its position that use with frozen fish is sufficient to maintain the registration intact, are distinguishable in the following respects:

- i. The question as to whether “fish” could be considered fresh or frozen is not a difficult one; despite such products being highly related, the distinction is clear;

- ii. The registration only consists of two wares and the requirement to demonstrate use with each of the wares would not have placed an unreasonable burden on the registrant;
- iii. No specific statement has been provided in the affidavit clearly attesting to use in association with *each* of the registered wares nor is there a sufficient factual basis on which such use can be inferred; and
- iv. The registration is not in respect of the broader category of wares, namely, “fish”.

At the oral hearing, counsel for the registrant advanced an additional argument, stating that the word “and” in the statement of wares is not being used in the conjunctive sense, but rather as joint or several, such that the wares in the registration should be read as a unitary statement of goods. Counsel added further, that in accordance with *Ridout & Maybee v. Omega S.A.* (2005), 43 C.P.R. (4<sup>th</sup>) 18 (F.C.A.), the validity of the wording of the registration is not at issue. However, on a plain reading of the registration, I am of the opinion that the word “and” is being used as a conjunction. Furthermore, given that fish cannot be both fresh *and* frozen, it is evident that the wares in question are distinct from one another.

Having regard to the foregoing, it is my view that the present case is analogous to the decision of *John Labatt Ltd. v. Rainier Brewing Co. et al* (80 C.P.R. (2d) 228 (F.C.A.)). Consequently, the principles enunciated in this case are more apt to apply. In that case, the judge stated the following:

Specification of the wares other than beer suggests, in the absence of proof to the contrary, that each is indeed different in some degree from the others and from “beer” itself, as otherwise the words “ale, porter, stout, malt beverages, malt syrup and malt extracts” are superfluous.

And further at p. 236:

The fact that the other wares specified fall within a group of wares that are in some way related to beer is not sufficient, in my view, to preserve the registration intact.

That could only be done if the respondent had also shown that the trade mark is in use in Canada with respect to each of these other wares.

Similarly, in the present case, while the wares in question are related, a distinction between fresh fish and frozen fish has clearly been made in the registration. Thus, it is my view that use in association with “frozen fish” alone, barring any evidence or statements of fact that would permit me to conclude otherwise, is not sufficient to maintain the registration in respect of both fresh *and* frozen fish.

Lastly, in addition to the argument that the registrant has failed to establish that it has used the subject mark in Canada in association with the wares covered in the registration, the requesting party argues that it is not clear from the evidence that the goods emanated from the registrant. In this regard, it points out that the Milton affidavit states at paragraph 5, “my company distributes” as opposes to “sells”. Further, it argues that the identity or place of business of the company by or for whom the product was manufactured or produced or distributed for resale is not shown on the product packaging in Exhibit “B”, nor does High Liner’s name appear on the packaging.

However, I find the absence of the registrant’s name on the packaging is not a relevant consideration as the invoices at Exhibit “C” clearly show that the wares emanated from the registrant.

In view of all of the foregoing, and taking into consideration the well-known principle that s.45 is a summary procedure designed to clear the register of trade-marks that are “deadwood”, I am satisfied that there was use of the subject trade-mark for the wares described as “*frozen fish*”; use has not been shown for the wares described as “*fresh fish*” and there is no evidence of any special circumstances excusing the absence of use. Registration No. TMA 112,433 will therefore be amended to delete “*fresh fish*” from the statement of wares for failure to show use pursuant to Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 16<sup>TH</sup> DAY OF JANUARY 2009.

K. Barnett  
Hearing Officer  
Trade-marks Opposition Board