

**In the matter of Section 45 proceedings against
Registration No. TMA163,553 for the trade-mark
EVER GREEN & Design**

On October 13, 2005 at the request of The Sunrider Corporation doing business as Sunrider International, the Registrar forwarded the notice prescribed by s. 45 of the *Trade-marks Act* R.C.S. 1985 c-13 (the “Act”) to Shanghai Tian Tan International Trading Co. Ltd. (the “Registrant”) with respect to Registration No. TMA163,553 for the trade-mark EVER GREEN & Design (the “Mark”), illustrated hereafter, registered in association with “tea”.



Pursuant to the provisions of s. 45 of the Act, the registered owner must show, with respect to each of the wares and services specified in the registration, whether the trade-mark was in use in Canada at any time during the three-year period immediately preceding the date of the notice, and if not the date on which it was last used and the reason for the absence of use since that date. The relevant period in this case is anytime between October 13, 2002 and October 13, 2005. What qualifies as use of a trade-mark is defined in s. 4 of the Act.

An affidavit of Tong Kun Lin, sworn on February 23, 2006, was filed in response to the notice. Only the requesting party has filed written representations. Both parties were represented at the oral hearing.

It was established in *Plough (Canada) Ltd. v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.) that assertions of use as a matter of law are insufficient to demonstrate use. A recipient of a s. 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 s. 4(1) 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 C.P.R. (2d) 56 (F.C.T.D.)].

Mr. Lin, who identifies himself as the Director of the IP Department of the Registrant, states that he is generally aware of the Registrant's activities, and more particularly of the facts surrounding the "commercialization in Canada of its teas" (paragraph 2). Mr. Lin deposes, *inter alia*, as follows:

4. *Between 2002-10-13 and 2005-10-03 (hereinafter "the Relevant Period"), My Company has affixed The Trade-Mark to the teas it sold in Canada, in the normal course of trade.*
5. *Illustrative of transactions which occurred in Canada in association with the Trade-mark, I file in bulk as Exhibit ZZ-1 to this my Affidavit two invoices that evidence sales and shipment from My Company to Canadian enterprises of tea bearing The Trade-Mark.*
6. *The Trade-Mark of My Company was used during the Relevant Period and is still in use and The Trade-Mark is an important asset of My Company, as well as its related registration 163553.*

At the oral hearing, the requesting party relied upon the decision *Performance Apparel Corp. v. Uvex Toko Canada Ltd.* (2002), 25 C.P.R. (4th) 284 to argue that Exhibit ZZ-1 is inadmissible because it has not been notarized or commissioned. I consider the fact that the Exhibit ZZ-1 was not properly notarized as a mere technicality as it was properly identified in the affidavit. This situation is clearly distinguishable from the aforementioned decision where the evidence consisted of an affidavit (my emphasis) that had not been sworn/declared and commissioned.

I note that both invoices emanate from the Registrant and are addressed to companies domiciled in Canada. The invoices are dated September 20, 2002 and October 17, 2002 respectively. Given the relevant period, I shall consider the second invoice (the "Invoice") showing the full address of a company domiciled in Vancouver. The Invoice shows four (4) columns. The description "EVER-GREEN" BRAND appears, *inter alia*, in the middle of the second column entitled "Quantities and Descriptions". I also note the description "AS PER S/C NO. TT020615045 DD. SEPT. 20, 2002" at the bottom of the second column. The requesting party argues, and correctly so, that Mr. Lin did not provide any explanation concerning the information appearing on the Invoice and that any ambiguities in the affidavit must be interpreted against the interest of the Registrant [see *Plough (Canada) Ltd., supra*]. However, when considering the Invoice in its

totality, I find it reasonable to conclude that the wares sold under the description “EVER-GREEN” BRAND correspond to tea packed in cartons. The Registrant correctly argued that evidence of a single sale may be sufficient to establish use in the normal course of trade [see *Philip Morris Inc. v. Imperial Tobacco Ltd. et al* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.)]. Although it is not without merit for the requesting party to argue that the Registrant did not provide any explanation with respect to its normal course of trade, I am of the opinion that it would be unreasonable to conclude that the Invoice has been manufactured for the sole purpose of protecting the trade-mark registration.

In view of the above, the issue to be decided becomes whether the Invoice amounts to evidence of use of the Mark in Canada within the meaning of s. 4(1) of the Act. In the decision *Riches, McKenzie & Herbert v. Pepper King Ltd.* (2000), 8 C.P.R. (4th) 471, the Federal Court, Trial Division, held that the Registrar cannot assume that invoices accompany wares in the absence of evidence to that effect. In the present case, there is no clear statement from Mr. Lin that the Invoice accompanied the wares at the time of their sales in Canada. Also, the fact that the Invoice indicates that the goods were shipped to Vancouver does not evidence that the wares were shipped to the same physical place (my emphasis) than the invoice was delivered. Accordingly, I am not willing to infer that the same party who received the wares would have seen the Invoice. Finally, even if I find it reasonable to conclude that the date of October 17, 2002 corresponds to the invoicing date, there is a doubt as to whether the date of September 20, 2002 pertains to an order date or a shipping date raising further ambiguity in the evidence. I therefore find that there is no evidence to conclude that the Invoice accompanied the wares at the time of their sales in Canada.

In view of the above, I come to the conclusion that the affidavit of Mr. Lin amounts to nothing more than a bare assertion of use of the type that was held unacceptable in *Plough (Canada) Ltd., supra*. As the evidence is insufficient to permit me to conclude that the Mark was in use in Canada in association with “tea” pursuant to s. 4(1) of the Act within the relevant period, I conclude that the trade-mark registration ought to be expunged.

Since I have concluded that the Invoice is not sufficient to support the affiant's assertions of use of the Mark, it is not necessary for me to decide whether or not use of "EVER-GREEN" BRAND on the Invoice can be considered use of the trade-mark as registered.

Registration No. TMA163,553 will be expunged in compliance with the provisions of s. 45(5) of the Act.

DATED AT BOUCHERVILLE, QUEBEC, THIS 10th DAY OF MARCH 2008.

Céline Tremblay
Member
Trade-marks Opposition Board