



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 62

Date of Decision: 2019-07-11

IN THE MATTER OF A SECTION 45 PROCEEDING

DLA Piper (Canada) LLP

Requesting Party

and

Huer Foods Inc.

Registered Owner

TMA693,130 for PUFFIES

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA693,130 for the trademark PUFFIES (the Mark), owned by Huer Foods Inc.

[2] The Mark is currently registered in association with “sugar confectionery, candy, licorice”.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete “candy, licorice”.

INTRODUCTION

[4] On July 17, 2017, the Registrar of Trademarks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Huer Foods Inc. (the Owner), of registration

No. TMA693,130. The notice was sent at the request of DLA Piper (Canada) LLP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between July 17, 2014 and July 17, 2017, in association with each of the goods specified in the registration. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[6] The relevant definition of use in the present case is set out in section 4(1) of the Act as follows:

4(1) A trademark is deemed to be used in association with goods if, at the time of the transfer of the property in or possession of the goods, in the normal course of trade, it is marked on the goods themselves or on the packages in which they are distributed or it is in any other manner so associated with the goods that notice of the association is then given to the person to whom the property or possession is transferred.

[7] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is low [*Woods Canada Ltd v Lang Michener* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co Ltd v Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trademark in association with each of the goods specified in the registration during the relevant period [*Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448; *John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] In response to the Registrar's notice, the Owner furnished the affidavit of Ryan Storey, the President of the Owner, sworn October 15, 2017, together with Exhibits A to D.

[9] Neither party filed written representations or requested an oral hearing.

THE EVIDENCE

[10] Mr. Storey describes the Owner as a distributor of gummy, confectionary, candy and healthy snack products. He attests that the Owner distributes these products to retailers across Canada, in particular, grocery stores, drug stores, convenience stores, and discount and specialty stores.

[11] Mr. Storey states that for almost the entirety of the relevant period, the Mark had ceased being used in the normal course of trade in Canada in association with the registered goods, which he collectively refers to as “the Goods”. He explains that “[t]he market for confectionary products is cyclical and the demand for the specific Goods sold under the [Mark] was not, in my view, sufficient at the time”.

[12] During this period of non-use, Mr. Storey attests that manufacturers of the Goods improved their production processes to increase profitability. He states that as a result of these improvements and with increasing demands by consumers for marshmallow or foam confectionary, the Owner decided to resume selling the Goods.

[13] In this regard, Mr. Storey attests that on or about February 11, 2016, he engaged in discussions with the Owner’s supplier, Dare Foods Limited, to produce the Goods for sale in association with the Mark. However, he states that production could not begin at that time because, as “[t]he Goods sold under the [Mark] are a sugar-based confection that consists of sugar, water and gelatin which is whipped to a spongy consistency”, “humidity levels during warmer months of the year prevent the production of Goods.” Mr. Storey states that an order was shipped on July 4, 2017 to the Owner, and attaches supporting documentation with respect to this order under Exhibits A and B. Exhibit A consists of copies of a purchase order, an invoice, two bills of lading, a shipping manifest, and a receiving sheet for the order. The goods listed in these documents are variously described as “MM Strawberries” and confectionery. Exhibit B consists of a photograph and a sample of the actual goods, strawberry flavoured marshmallows, in a 200g cup. The Mark is prominently displayed on the packaging for these goods.

[14] Mr. Storey then identifies K & K Food Services as a distributor to whom the Owner sells the Goods, who in turn sells the goods to retail outlets such as gas stations and convenience

stores. He attaches as Exhibit C to his affidavit, an invoice dated July 7, 2017, showing what he describes as the “first sale of the Goods during the Relevant Period”. The invoice shows a sale of 20 cases of “PUFFIES (12 X 200 G) CUP”. He further attaches as Exhibit D, a photograph of cups of marshmallows bearing the Mark displayed in a convenience store. Mr. Storey identifies the location of the photograph as a Chevron gas station convenience store in Whistler, British Columbia, taken by an employee of the Owner’s distributor. He states that the products shown in the picture were part of the July 7, 2017, invoiced order.

[15] Lastly, Mr. Storey states that the Owner has no intention of abandoning the Mark in association with the Goods, with the exception of licorice. He attests that there is no use of the Mark in association with “licorice” during the relevant period.

ANALYSIS AND REASON FOR DECISION

[16] At the outset, as Mr. Storey attests that the Owner intends to abandon the Mark in association with “licorice” and has not used the Mark in association with licorice during the relevant period, “licorice” will be deleted from the registration.

[17] With respect to the remaining goods, while Mr. Storey asserts use of the goods collectively, I note that the attached exhibits show sales only of strawberry flavoured marshmallows. With respect to the invoices shown in Exhibit C, it is well established that evidence of a single sale in the normal course of trade will suffice to show use in respect of goods, as long as it follows the pattern of a genuine commercial transaction and is not seen as being deliberately manufactured or contrived to protect the registration of the trademark [see *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 8 FTR 310, 13 CPR (3d) 289]. In the present situation, I see nothing that would persuade me that such activities were not normal commercial transactions between the Owner and the distributor. Further, I note that the Mark is clearly displayed on the Goods as shown in Exhibits B and D. Therefore, I find that the evidence presented in Mr. Storey’s affidavit is sufficient to establish that there were sales of strawberry flavoured marshmallows during the relevant period in the normal course of trade.

[18] However, given that use evidenced in association with one specific good cannot serve to maintain multiple goods within the statement of goods, the Owner is required to provide

evidence of use for *each* of the registered goods [see *John Labatt; Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD)]. In this respect, I am guided by the judgment in *John Labatt*, in which the Federal Court – Appeal Division stated at para 13:

Specification of the wares other than beer suggest, 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.

[19] As such, evidence of use of marshmallows is insufficient to maintain the registration for both “sugar confectionery” and “candy”. Given that Mr. Storey states in his affidavit that the Owner’s goods “are a sugar-based confection”, and that a plain reading of “sugar confectionery” would imply a more specific category of goods than the more general category of “candy”, I accept that use of the Mark in association with strawberry flavoured marshmallows is sufficient to maintain “sugar confectionery”, but not “candy”. Therefore, the Owner has failed to demonstrate use of the Mark in association with “candy”, and no special circumstances have been brought forth to excuse the absence of such use.

DISPOSITION

[20] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the good “licorice” and “candy” in compliance with the provisions of section 45 of the Act.

[21] The amended statement of goods will read as follows:

Sugar confectionery.

G.M. Melchin
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

**TRADEMARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE No Hearing Held

AGENT(S) OF RECORD

Fasken Martineau DuMoulin LLP

FOR THE REGISTERED OWNER

DLA Piper (Canada) LLP

FOR THE REQUESTING PARTY

