



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2019 TMOB 73

Date of Decision: 2019-07-19

IN THE MATTER OF A SECTION 45 PROCEEDING

Zaika Foods

Requesting Party

And

Punjab Trading Incorporated

Registered Owner

TMA634,833 for Chakki Fresh

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA634,833 for the trademark Chakki Fresh (the Mark), owned by Punjab Trading Incorporated.

[2] The Mark is currently registered in association with “All types of flours, namely flour from wheat, corn, peas and rice; spices.”

[3] For the reasons that follow, I conclude that the registration ought to be maintained.

INTRODUCTION

[4] At the request of Zaika Foods (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) on April 11, 2017, to Punjab Trading Incorporated (the Owner), the registered owner of the Mark.

[5] The notice required the Owner to show whether the trademark has been used in Canada in association with each of the goods 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 such use since that date. In this case, the relevant period for showing use is April 11, 2014 to April 11, 2017.

[6] The relevant definition of use for goods is set out in section 4 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 [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[8] On November 10, 2017, the Owner furnished the affidavit of Rakesh Sharma, the managing director of the Owner, sworn on November 10, 2017. Both parties filed written representations. No oral hearing was requested.

[9] As a preliminary matter, I note that in its written representations, the Requesting Party makes reference to facts not in evidence. These submissions will be disregarded [*Ridout & Maybee LLP v Encore Marketing International Inc* (2009), 72 CPR (4th) 204 (TMOB)]. In addition, I note that the Requesting Party makes representations regarding the validity of the trade-mark, which are beyond the scope of section 45 proceedings, and therefore will also be disregarded [*Ridout & Maybee srl c Omega SA*, 2005 FCA 306].

THE OWNER'S EVIDENCE

[10] Mr. Sharma states that he is responsible for overseeing the sales, marketing, licensing and distribution of goods bearing the Mark in Canada, and that he has held his current position since 2002. He explains that the Mark has continually been used in Canada by the Owner in association with the registered goods since as early as 2005.

[11] According to Mr. Sharma, the Mark is used on packaging for various food product brands owned by the Owner. As Exhibit A, he attaches photographs of sample packaging bearing the Mark for different types of flour and spices, including chick pea flour, sweet corn flour, rice flour, cumin powder, red chilli powder, tandoori masala, and turmeric powder. Mr. Sharma states that this packaging is representative of how the Mark was displayed on the Owner's goods during the relevant period. In some cases in Exhibit A, the Mark is followed by the word "atta"; Mr. Sharma explains that this word translates to "flour" in Hindi and Punjabi, and attaches a printout from the Google Translate service as Exhibit B to confirm this translation.

[12] Mr. Sharma states that in the ordinary course of trade during the relevant period, the Owner sold goods bearing the Mark directly to South Asian specialty stores, traditional grocery stores, supermarkets, and general stores in Canada, as well as to distributors who then sold to Canadian retail stores. As an example, he states that the Owner sold goods bearing the Mark to entities called New Asian Spice Market and Indian Spice Market during the relevant period. As Exhibit C, he attaches six invoices, all dated within the relevant period. Each invoice is addressed to one of the two aforementioned entities, displays the Owner's name as "ptifoods" in the letterhead along with an address and other contact information, and includes multiple items identified by the Mark, including corn flour, coriander powder, cumin powder, garam masala powder, turmeric powder, red chilli powder, cracked wheat, rice flour, and "atta". Mr. Sharma states that "SHAKTI CHAKKI FRESH ATTA" on the invoice refers to flour from wheat.

[13] Further, Mr. Sharma states that goods bearing the Mark were ordered by a retailer and distributor called Oriental Food Mart, who operates a store called Al Premium that purchases food products to be sold at selected Walmart stores. As Exhibit D, he attaches purchase orders from Oriental Food Mart dated March 2017 for items identified by the Mark. Each purchase

order is accompanied by a corresponding invoice from the Owner for items identified by the Mark.

[14] Mr. Sharma attests that revenue generated by the Owner from goods bearing the Mark during the relevant period exceeded \$150,000. Finally, as Exhibits E and F, respectively, he attaches screenshots from a television advertisement and sample posters, both of which were used to advertise goods bearing the Mark during the relevant period.

ANALYSIS

[15] As discussed above, a significant portion of the Requesting Party's arguments concern the purported descriptiveness of the Mark. The Requesting Party states that it does not raise this issue to challenge the validity of the trademark but instead to show how its use as a trademark is "ambiguous." However, it is well established that section 45 proceedings are not intended to determine substantive rights such as ownership, distinctiveness, descriptiveness or abandonment of a registered trade-mark [see *United Grain Growers Ltd v Lang Michener*, 2001 FCA 66 and *Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD)]. In *United Grain Growers* at para 14, the Federal Court of Appeal wrote as follows:

No words in section 45 direct the Registrar to re-examine whether the registered trade-mark is used for the purpose of distinguishing, or so as to distinguish, wares. Rather, the Registrar's duty under section 45 is only to determine, with respect to the wares specified in the registration, whether the trade-mark, as it appears in the Register, has been used in the three years prior to the request.

Accordingly, I cannot consider the Requesting Party's arguments concerning whether the phrase "Chakki Fresh" is being used descriptively or to distinguish the registered goods.

[16] In the course of making arguments regarding the allegedly descriptive nature of the Mark, the Requesting Party notes that the Mark often appears in conjunction with other elements; for instance, being followed by the word "ATTA" on some of the images of packaging in Exhibit A, and being preceded by "PTI" on the invoices provided in Exhibit C. This is a question of deviation. In response, the Owner argues that there is nothing in the legislation that prohibits the use of two or more trademarks simultaneously, and cites *Mantha & Associates v Old Time Stove Co* (1990), 30 CPR (3d) 574 (TMOB), in which the use of BEAUMONT CHALET was held to

be the use of two separate trademarks. The Owner submits that the present case is analogous as the trademark PTI refers to the parent brand of all the Owner's products, or, alternatively, the Owner's trade name, whereas the Mark refers to a line of flours and spices within this parent brand.

[17] In *Mantha & Associates*, the Registrar considered the use of the registered mark BEAUMONT in conjunction with other words designating sub-brands of the Beaumont line of products (for example BEAUMONT CHALET) to be the use of two different marks, and maintained the registration for BEAUMONT. Similarly, in *Comstock Ltd v Commodity Quotations Inc* (1997), 83 CPR (3d) 240 (TMOB), the Registrar found that usage of S&P COMSTOCK was actually usage of two different trade-marks. In reaching its conclusion, the Registrar distinguished that case from *Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB), noting that S&P appeared to be the applicant's house mark and trade name. As well, the Registrar did not consider *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) to be applicable, as that case involved a composite mark whereas S&P COMSTOCK was a case of two different marks.

[18] Applying the reasoning of the above cases to the present situation, I am satisfied that the average buyer would understand that "PTI" is either the Owner's house mark or trade name and thus view "Chakki Fresh" as a mark separate from "PTI" [for similar outcomes, see *Brooks v Ranpro Inc*, 2011 TMOB 74; *Gowling Lafleur Henderson LLP v Ten Ren Tea Co*, 2012 TMOB 21; *Bennett Jones LLP v Pirelli Tyre SpA*, 2013 TMOB 37]. In this regard, I note that the Owner's trade name "ptifoods" appears at the top of the page, along with an address and other contact information. Moreover, the photographs attached in Exhibit A show the Mark used alone, further reinforcing the perception that the use of PTI CHAKKI FRESH constitutes a use of two distinct trademarks.

[19] The Requesting Party also submits that some of the pictures attached as exhibits to Mr. Sharma's affidavit appear to have been digitally modified, and suggests that the lettering on the package shown in Exhibit A may have been replaced with new lettering. In my view, there is no merit to this line of argument. There is nothing in evidence that suggests to me that any images

have been digitally modified or that otherwise calls into question the good faith of the affiant, especially given the numerous examples of use of the Mark provided in the Sharma affidavit.

[20] Finally, the Requesting Party argues that the photographs of “sample” packaging do not establish use of the Mark in association with the registered goods since Mr. Sharma provided no pictures of the actual packaging of the goods, nor evidence that the goods were shipped to retailers. In addition, he argues that there is no evidence that the transactions shown in the invoices actually occurred. However, as noted by the Owner, Mr. Sharma states in his affidavit that these samples “are representative of how the Trademark was displayed on Goods in Canada sold during the Relevant Period.” Similarly, Mr. Sharma states that the sample invoices provided in Exhibit C are “representative” of transactions conducted with the two retailers and “show that each of the Goods bearing the [Mark] were sold and shipped to Canadian customers during the Relevant Period.” In view of these sworn statements, I am satisfied that the materials attached in Exhibits A and C are reflective of how the Mark was used in commercial transactions during the relevant period. In any event, there is nothing in evidence to suggest that the sample packaging and sales were not genuine.

[21] As the Owner’s evidence contains examples of use of the Mark in association with flours made from wheat, corn, chick peas, and rice, as well as various spices, I am satisfied that the Owner has demonstrated use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act.

DISPOSITION

[22] Accordingly, 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.

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

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

AGENTS OF RECORD

Bereskin & Parr LLP/S.E.N.C.R.L., s.r.l.

For the Registered Owner

Zaid Sayeed (Argent Law)

For the Requesting Party