



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2020 TMOB 14
Date of Decision: 2020-02-06

IN THE MATTER OF A SECTION 45 PROCEEDING

The Coca-Cola Company

Requesting Party

and

**Meenaxi Enterprise, Inc. DBA Meenaxi
Enterprise, Inc. a New Jersey
Corporation**

Registered Owner

TMA871,633 for THUMS UP

Registration

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA871,633 for the trademark THUMS UP (the Mark), owned by Meenaxi Enterprise, Inc. DBA Meenaxi Enterprise, Inc. a New Jersey Corporation.

[2] The Mark is registered for use in association with the following goods: Colas; Concentrates, syrups or powders used in the preparation of soft drinks; Soft drinks, namely, sodas.

[3] For the reasons that follow, I conclude that the registration ought to be maintained with respect to “Colas” and “Soft drinks, namely, sodas”, but amended to delete the remaining goods.

THE PROCEEDINGS

[4] On May 25, 2017, the Registrar of Trademarks sent a notice under section 45 of the *Trade-marks Act*, RSC 1985, c T-13 (the Act) to Meenaxi Enterprise, Inc. DBA Meenaxi Enterprise, Inc. a New Jersey Corporation (the Owner). The notice was sent at the request of The Coca-Cola Company (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 May 25, 2014 and May 25, 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 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. The evidence in a section 45 proceeding need not be perfect; indeed, a registered owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act [see *Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184 at para 2]. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [per *Diamant* at para 9].

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Anil Gandhi, the Vice-President of the Owner (the Affiant), sworn on December 20, 2017, together with Exhibits A to D.

[9] Neither party filed written representations. However, both parties requested and attended an oral hearing.

THE EVIDENCE

[10] The Affiant is the Vice-President of the Owner.

[11] The Affiant states that the Owner used the Mark continuously in Canada for many years, including during the relevant period. More specifically, the Affiant states that the Owner “has manufactured for it, and sells, colas, and soft drinks, namely sodas, in association with the Mark, to retailers and wholesalers in Canada, and has done so continuously throughout the relevant period.”

[12] In support, the Affiant provides:

- Exhibit A – photos of cola and soda, which the Affiant states are representative of the goods sold by the Owner in Canada during the relevant period. The Mark clearly appears on the bottles of soda and on the can of cola in the photographs.
- Exhibit B – five invoices dated during the relevant period which the Affiant states are representative of sales of the goods by the Owner to wholesalers and retailers in Canada during the relevant period. The product description column in the invoices indicates sales of Thums Up soda and cola.
- Exhibits C and D- five invoices dated prior to and one invoice dated after the relevant period respectively, which the Affiant states are representative of sales of the goods by the Owner to wholesalers and retailers in Canada. Once again, the product description column in the invoices indicates sales of Thums Up soda and cola.

[13] The Affiant concludes the affidavit by explaining that the name of each customer on the invoices has been “expurgated” for privacy reasons, but the city and postal code has been retained to show that the customers are located in Canada. The Affiant further confirms that each of the invoices in evidence were paid within a few weeks from the date of each invoice.

ANALYSIS AND REASONS FOR DECISION

[14] To begin with, I note that the affidavit and supporting exhibits are completely silent with respect to the goods described as “Concentrates, syrups or powders used in the preparation of soft drinks”. At the oral hearing, the Owner conceded that the evidence does not show use of the

Mark in association with these goods, and that the registration ought to be amended to delete these goods accordingly. As such, “Concentrates, syrups or powders used in the preparation of soft drinks”, will be deleted from the registration.

[15] With respect to the remaining registered goods “Colas” and “Soft drinks, namely, sodas” however, I accept that the Owner has shown use of the Mark in association with these goods in Canada during the relevant period. The Mark clearly appears on the packaging for each of these goods, and the invoices clearly show that such goods were sold in Canada during the relevant period. Furthermore, the Affiant has attested to the Owner’s normal course of trade, and I see nothing in the evidence to suggest that the sales demonstrated were not *bona fide* sales in the normal course of trade as described by the Affiant.

[16] At the oral hearing, the Requesting Party submitted that the evidence was ambiguous as to whether the use shown enured to the benefit of the Owner and, as such, the Owner had not satisfied its *prima facie* threshold to establish use. Specifically, referring to paragraph four of the affidavit, wherein the Affiant attests that the Owner has the goods “manufactured for it”, the Requesting Party argued that such language was ambiguous as to whether a license existed between the Owner and the manufacturer or whether the Owner was merely acting as a distributor of another party’s goods. This, the Requesting Party argued, is further made unclear, as the labels on the bottles in the Exhibit A photographs of the goods do not indicate the source of the goods. The Requesting Party submitted that it would have been a simple matter for the Owner to have produced a complete label showing the source of the goods. Consequently, the Requesting Party submitted, having regard to the foregoing and as the Owner has a duty to provide the best evidence due to the absence of cross-examination, the evidence is ambiguous and unreliable as to whether the use shown enured to the Owner’s benefit. Thus, it is the Requesting Party’s position that the registration ought to be expunged.

[17] The Owner, on the other hand, responded that there is no ambiguity in the statement made by the Affiant that the goods were “manufactured for it”. I agree. Furthermore, the invoices are clear that the goods in question were sold by the Owner. I also note that there is no requirement for the name of the Owner to be displayed in association with the Mark [see *Novopharm Ltd v Monsanto Canada, Inc* (1997), 80 CPR (3d) 287 (TMOB); and *Smart &*

Biggar v Canadian Tire Corporation, Limited, 2017 TMOB 153]. The manufacturer is acting as a supplier of goods, and the Owner remains the first link in the chain of transactions, as the Affiant has made clear that the goods are manufactured on its behalf, to which the evidence clearly shows the Owner is also the seller of the goods in question. As there is nothing inconsistent or ambiguous in the evidence in this regard, I accept that the use shown enured to the benefit of the Owner.

[18] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with “Colas” and “Soft drinks, namely, sodas” in accordance with sections 4 and 45 of the Act.

DISPOSITION

[19] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with section 45 of the Act, the registration will be amended to delete “Concentrates, syrups or powders used in the preparation of soft drinks”.

[20] The amended statement of goods will be as follows:
Colas; Soft drinks, namely, sodas.

Kathryn Barnett
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2020-01-30

APPEARANCES

Amrita V. Singh

For the Registered Owner

Robert A. MacDonald

For the Requesting Party

AGENTS OF RECORD

Bereskin & Parr LLP

For the Registered Owner

Gowling WLG (Canada) LLP

For the Requesting Party