



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADEMARKS

**Citation: 2020 TMOB 79**

**Date of Decision: 2020-06-30**

**IN THE MATTER OF A SECTION 45 PROCEEDING**

**Hoa Pin Wei Biotech & Food Co., Ltd.**

**Requesting Party**

**and**

**Hai Pa Wang International Group Corp.**

**Registered Owner**

**TMA516,937 for HAI PA WANG  
DESIGN**

**Registration**

**INTRODUCTION**

[1] At the request of Hoa Pin Wei Biotech & Food Co., Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) on February 13, 2018, to Hai Pa Wang International Group Corp. (the Owner), the registered owner of registration No. TMA516,937 for the trademark HAI PA WANG DESIGN (the Mark), shown below:



[2] The Mark is registered for use in association with the following goods:

Seafood in general; meat; bacon; butter; cheese in general; chicken, meat, and fish croquettes; crystallized fruits; salad dressing; edible oil; fish in general for food purposes; fish and chips; fish fillets; processed edible seaweed; shellfish in general; meat extract; meat jellies; meat paste; meat-based spreads; fruit preserves; frozen fruits; dried fruits; canned fruits; jellies; fruit pulps; preserved fruits in general; ham; jams; milk; pickles; sausages; soup mixes; soups; cooked vegetables; dried vegetables; dried seafood; dried meat; preserved vegetables; yogurt; shrimp balls; fish balls; cuttlefish balls; steamed dumplings, shrimp dumplings, fish dumplings, cuttlefish dumplings, ravioli, buns, bean-jam buns, meat buns, taro-jam buns, sesame-jam buns, steamed bread, rice balls, bean meal, biscuits, bread, rolls (bread), cereal based snack food, ready to eat cereal derived food bars, processed cereals, seasonings in general, frozen confections, ice cream, flavoured ices, farina, flour, meat pies, noodles, pastries, pasties, pies, puddings, sandwiches, hamburger sandwiches, processed wheat, yeast, tarts, and twist.

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

[4] The notice required the Owner to show whether the Mark has been used in Canada in association with 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 use since that date. In this case, the relevant period for showing use is February 13, 2015, to February 13, 2018.

[5] 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.

[6] It is well established that bare statements that a trademark is in 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) (*John Labatt*)].

[7] In response to the Registrar's notice, the Owner furnished the affidavit of Ming Chin Yeh, affirmed September 11, 2018. Both parties filed written representations. No oral hearing was held.

#### THE OWNER'S EVIDENCE

[8] The affiant is President of Volumes Enterprise Ltd. (Volumes), a Taiwan-based distributor that exports products manufactured by the Owner into Canada. He states that during the relevant period, Volumes exported 480 kg of frozen milkfish balls, 330 kg of frozen fish dumplings, 247.5 kg of frozen fish dumplings with cuttlefish, and 144 kg of frozen icy shredded mango, all bearing the Mark. As Exhibit A, he attaches photographs of each such good. I note that the packaging for the icy shredded mango displays the date "2017-06-23". The goods display a logo in the following configuration (the Logo):



[9] The affiant states that the additional Chinese characters appearing at the top of the Logo translate to "expertly frozen and processed".

[10] As Exhibits B and C, respectively, he attaches receipts for products purchased by Volumes from the Owner, and export declarations showing export of the aforementioned goods from Kaohsiung, Taiwan, to Vancouver, along with English translations where relevant. While the Mark does not appear on either document, the abbreviation "FIG" appears next to the aforementioned goods; the affiant states that this is short for "figure", indicating the Mark. He states that these goods were sold to consumers in Canada.

## ANALYSIS

[11] The Requesting Party submits that use of the Logo does not constitute use of the Mark as registered, and that the Owner has not used the Mark in association with any of the registered goods. Each submission will be considered in turn.

### Display of the Mark as Registered

[12] The Requesting Party submits that the additional Chinese characters appearing on the Logo constitute a departure from the Mark as registered. In response, the Owner submits that the dominant feature of the Mark is the band featuring three characters at the centre of the circle, and that the additional characters are merely descriptive language that would not mislead an unaware purchaser.

[13] In considering whether the display of a trademark constitutes display of the trademark as registered, the question to be asked is whether the trademark was displayed in such a way that it did not lose its identity and remained recognizable, in spite of the differences between the form in which it was registered and the form in which it was used [*Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA)]. In deciding this issue, one must look to see whether the “dominant features” of the registered trademark have been preserved [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) (*Promafil*)]. The assessment as to which elements are the dominant features and whether the deviation is minor enough to permit a finding of use of the trademark as registered is a question of fact to be determined on a case-by-case basis.

[14] Further, the use of a trademark in combination with additional words or features constitutes use of the registered trademark if the public, as a matter of first impression, would perceive the trademark *per se* as being used. This is a question of fact which is dependent on whether the trademark stands out from the additional material, such as by the use of different lettering or sizing, or whether the additional material would be perceived as clearly descriptive matter or as a separate trademark or trade name [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB); 88766 *Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[15] Comparing the Mark to the Logo used by the Owner during the relevant period, in my view, the Mark did not lose its identity and remains recognizable. The dominant features of the Mark, namely, the banner displaying three large characters and the circular design, remains present in the Logo used by the Owner. I agree with the Owner that these six additional characters are descriptive, and I further note their smaller relative size to the dominant characters in the center band of the Logo. The dominant features having been preserved, I accept that display of the Logo constitutes display of the Mark as registered for those goods on which it appears.

Use in Association with each of the Registered Goods

[16] In its written submissions, the Owner submits that because the evidence shows use of the Mark in association with frozen milkfish balls, frozen fish dumplings, frozen fish dumplings with cuttlefish, and icy shredded mango, the registration should be maintained with respect to the following registered goods: “Seafood in general”, “crystallized fruits”, “fish in general for food purposes”, “fish fillets”, “shellfish in general”, “frozen fruits”, “preserved fruits in general”, “fish balls”, “cuttlefish balls”, “fish dumplings”, and “cuttlefish dumplings”.

[17] For its part, the Requesting Party submits that the “icy mango” product shown in Exhibit A is not one of the registered goods, and that the other exhibited photographs are undated and therefore do not show use of the Mark, citing *Mincov Law Corp v GC jewellers*, 2016 TMOB 106. Further, the Requesting Party submits that because the receipts and export declarations do not display the Mark, they cannot provide evidence of use of the Mark in association with the registered goods.

[18] It is well established that use evidenced with respect to one specific good cannot serve to maintain multiple goods in a registration; having distinguished particular goods in the registration, the Owner was obligated to furnish evidence with respect to each of the listed goods accordingly [per *John Labatt*]. In particular, where use in association with a specific good could potentially support two goods in a registration, the more specific good will be maintained over the more generalized [*Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD) at paras 14-16]. Bearing these principles in mind, I disagree with the Requesting Party’s submission that the icy shredded mango or other exhibited products cannot be correlated with

any of the registered goods. I find that frozen milkfish balls correspond most logically to the registered goods “fish balls”; that frozen fish dumplings correspond to “fish dumplings”; that frozen fish dumplings with cuttlefish correspond to “cuttlefish dumplings”, and that icy shredded mango corresponds to “frozen fruits”. As the Owner chose to list these registered goods separately from the more generalized goods in the registration (such as “Seafood in general”), the implication is that the more generalized goods refer to products other than those shown in evidence.

[19] Finally, I am satisfied that the Owner has established that these four registered goods were transferred in the normal course of trade in Canada during the relevant period, based on the affiant’s sworn statements that such goods were exported to Canada during the relevant period, and based on the documentary evidence attached as Exhibits B and C, which confirms that these items were sold in Canada during the relevant period and that they displayed the Mark.

[20] Accordingly, I am satisfied that the Owner has established use of the Mark only in association with the registered goods “fish balls”, “fish dumplings”, “cuttlefish dumplings”, and “frozen fruits” within the meaning of sections 4 and 45 of the Act. I am not satisfied that the Owner has demonstrated use of the Mark in association with any of the remaining registered goods within the meaning of sections 4 and 45 of the Act. As there is no evidence of special circumstances before me, the registration will be amended accordingly.

#### DISPOSITION

[21] In view of all of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the following registered goods:

Seafood in general; meat; bacon; butter; cheese in general; chicken, meat, and fish croquettes; crystallized fruits; salad dressing; edible oil; fish in general for food purposes; fish and chips; fish fillets; processed edible seaweed; shellfish in general; meat extract; meat jellies; meat paste; meat-based spreads; fruit preserves; [...], dried fruits; canned fruits; jellies; fruit pulps; preserved fruits in general; ham; jams; milk; pickles; sausages; soup mixes; soups; cooked vegetables; dried vegetables; dried seafood; dried meat; preserved vegetables; yogurt; shrimp balls; [...], cuttlefish balls; steamed dumplings, shrimp dumplings, [...], ravioli, buns, bean-jam buns, meat buns, taro-jam buns, sesame-jam buns, steamed bread, rice balls, bean meal, biscuits, bread, rolls (bread), cereal based

snack food, ready to eat cereal derived food bars, processed cereals, seasonings in general, frozen confections, ice cream, flavoured ices, farina, flour, meat pies, noodles, pastries, pasties, pies, puddings, sandwiches, hamburger sandwiches, processed wheat, yeast, tarts, and twist.

[22] The amended statement of goods will be as follows:

Frozen fruits; fish balls; fish dumplings, cuttlefish dumplings.

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

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

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**HEARING DATE** No Hearing Held

**AGENTS OF RECORD**

Fillmore Riley LLP

For the Registered Owner

Mark W. Timmis

For the Requesting Party