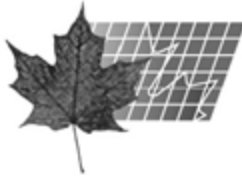


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LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 41

Date of Decision: 2021-03-09

IN THE MATTER OF A SECTION 45 PROCEEDING

Natural Stuff Inc.

Requesting Party

and

**Boulangerie Vachon Inc. / Vachon
Bakery Inc.**

Registered Owner

TMDA37,702 for HOSTESS

Registration

INTRODUCTION

[1] This is a decision under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMDA37,702 for the trademark HOSTESS (the Mark), which is owned by Boulangerie Vachon Inc. / Vachon Bakery Inc. (the Owner).

[2] The Mark is registered for use with rolls, cakes and biscuits.

[3] For the reasons that follow, the registration is maintained for cakes.

THE PROCEEDINGS

[4] At the request of Natural Stuff Inc. (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on April 6, 2017.

[5] While Natural Stuff Inc. requested a section 45 notice issue for rolls, in accordance with the Act at the time, the notice required the Owner to show whether the trademark has been used in Canada 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 6, 2014 to April 6, 2017.

[6] The relevant definition of use 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] In the absence of use as defined above, pursuant to section 45(3) of the Act, a trademark is liable to be expunged, unless the absence of use is due to special circumstances.

[8] Although it is well established that 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 Canada (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 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)].

[9] In response to the Registrar's notice, the Owner furnished the affidavit of Christine Labelle, sworn on November 2, 2017. Only the Owner filed written representations. Both parties attended an oral hearing.

THE EVIDENCE

[10] Ms. Labelle is the Vice President National Sales of the Owner. In this role, she is responsible for managing the HOSTESS brand in Canada.

[11] Ms. Labelle attests that the Mark was used in connection with the registered goods in Canada during the relevant period (para 2). With respect to the Owner's normal course of trade for these products, she explains that the Owner sells the registered goods to Canadian retailers, including Loblaw, No Frills, Walmart, Metro Ontario and Sobeys, which then sell the registered goods to Canadian consumers (para 4).

[12] Regarding display of the Mark, Ms. Labelle attaches as Exhibit B to her affidavit representative images of packaging used throughout the relevant period for Twinkies – Golden Cakes with Creamy Filing, Chocolatey Cupcakes – Chocolate Cakes with Creamy Filing and Chocolatey Icing, King Dons – Individually Wrapped Cakes, and Marshmallow Square. The Mark is displayed on the right side or at the top of each package.

[13] Ms. Labelle states that Canadian sales of goods branded with the Mark, including Twinkies, Cupcakes, KingDons and Marshmallow Square, were \$8,800,000 in 2014-15, \$9,000,000 in 2015-16, and \$9,400,000 in 2016-17 (para 5). In addition, she attaches representative invoices showing the sale of goods branded with the Mark, including Cupcakes, Twinkies and KingDons, to retailers in Canada during the relevant period. By way of example, Invoice #4441102 is dated 14/04/09 and shows a sale of 24 BX of 7 77550 01352 KING.DON.F08, which I infer to mean 24 boxes of KingDons. These products were shipped to an address in Newfoundland.

ANALYSIS

Bread and Sliced Bread

[14] Ms. Labelle includes evidence in her affidavit of use of the Mark with bread and sliced bread. This evidence is not relevant as these products do not fall under the scope of this registration.

Cakes

[15] Ms. Labelle provides photographs showing how the Mark is displayed on packaging of various cakes sold under the brand names KingDons, Cupcakes and Twinkies which are representative of the manner in which the Mark was displayed during the relevant period. Ms. Labelle also provides invoices during the relevant period sent to retailers in Canada. At the hearing, the Requesting Party conceded that the evidence shows use of the Mark in Canada with cakes. Accordingly, I am satisfied that the Owner has demonstrated use of the Mark with cakes within the meaning of sections 4(1) and 45 of the Act.

Rolls and biscuits

[16] The Owner submits that it has also demonstrated use of the Mark with rolls and biscuits. The Owner submits that Twinkies are rolls and Marshmallow Square are biscuits based on dictionary definitions of the words rolls and biscuits and the appearance of the products on the packaging. The Owner included definitions from www.merriam-webster.com/dictionary/ for biscuits and rolls with its case law filed before the hearing. The dictionary definitions include the following relevant meanings which were referenced at the hearing:

biscuit	<p>1a US : a small quick bread made from dough that has been rolled out and cut or dropped from a spoon While both types of biscuit use the same handful of ingredients and are quick to prepare, drop biscuits don't rely on any of the finicky steps rolled biscuits require to get them just right.— Sandra Wu</p> <p>b British : cookie The children were divided into groups of five seated round a table and each one was given a chocolate biscuit.— H. Colin Davis</p>
roll	<p>2 : something that is rolled up into a cylinder or ball or rounded as if rolled rolls of fat ...</p> <p>c : any of various food preparations rolled up for cooking or serving cabbage rolls a sushi roll especially : a small piece of baked yeast dough</p>

[17] Ms. Labelle does not identify Twinkies or Marshmallow Square as rolls or biscuits apart from her assertion that the Mark has been used with “rolls, cakes, and biscuits” which she attaches images of packaging of. Nor are rolls or biscuits identified in the exhibits. In contrast, the package of Twinkies includes the description “Golden Cakes with Creamy Filling”.

[18] In the absence of evidence from Ms. Labelle, the Owner’s proposed characterization of Twinkies as rolls and Marshmallow Square as biscuits is speculative. The Marshmallow Square does not appear to either be a cookie or a quick bread. The Twinkies do not appear to be something that is rolled into a cylinder or ball or have been rolled up for cooking or serving.

[19] While one is not to be “astutely meticulous when dealing with [the] language used” when interpreting the statement of goods [*Aird & Berlis LLP v Levi Strauss & Co*, (2006), 51 CPR (4th) 434 at para 17], I do not find that Twinkie brand cakes can sustain registration of the Mark with respect to rolls simply based on the fact that a Twinkie has rounded edges as shown on the packaging. Rather there is clear evidence that Twinkies are cakes, as identified on the packaging [see *Lang Michener LLP v Frito-Lay North America, Inc*, 2009 CanLII 90371 (CA TMOB)]. Further, the Owner’s submission that Twinkies are rolls whereas KingDons and Cupcakes are cakes places too much weight on the different brand names of these products. These are not different goods as both KingDons and Twinkies are identified on their packaging as cakes (e.g., “Golden Cakes with Creamy Filing” and “Individually Wrapped Cakes”).

[20] At the hearing, the Owner provided several cases to support its contention that there is use for rolls and biscuits. However, these are distinguishable from the present case. The cases cited by the Owner can be generally distinguished as follows:

- There was only one good in the registration and the affiant identified the good in evidence as the good in the registration [*David Michaels v Agros Trading Confectionary Spolka Akcyjna*, 2018 TMOB 157; *Molson Canada v Kaiserdom-Privatbrauerei Bamberg Worner KG* (2005), 43 CPR (4th) 313 (TMOB) (*Molson*)]. Here, there are three goods in the registration (cakes, rolls, and biscuits) and there is evidence of use for different cakes (Twinkies, KingDons, and Cupcakes) and Marshmallow Square.

- There was evidence that the goods fell under the registration [see, for example, *Molson; Epic Aviation, LLC v Imperial Oil Limited*, 2020 TMOB 103; *Smart & Biggar v Diversey Inc*, 2012 TMOB 3; *MLT Aikins LLP v Shafer-Haggart Ltd*, 2019 TMOB 23; *Aird & Berlis LLP v Levi Strauss & Co*, 2006 FC 654]. Here, there is no evidence that Marshmallow Square are biscuits or Twinkies are rolls other than Ms. Labelle’s statement that the Mark has been used with “rolls, cakes, and biscuits” which she attaches images of packaging of (Exhibit B).

[21] In its written representations, the Owner also submits that a finding of use for cakes should extend to biscuits because they fall under the same general category of goods. The Owner submits that, where the goods in a registration have been logically and properly characterized, there is no requirement to furnish either direct evidence or documentary proof regarding every item in each category [*Saks & Co v Canada (Registrar of Trade Marks)* (1989), 24 CPR (3d) 49 (FCTD)]. In *Saks*, however, there was a long list of goods and services with 28 categories with additional items listed under those categories. In the present case, there are only three goods in the registration and there is no evidence that cakes, rolls, and biscuits constitute a general category of goods in the Owner’s trade. As a result, having distinguished particular goods in the registration, the Owner must provide some evidence of use with respect to each of the listed goods [*Rainier Brewing; Sharp Kabushiki Kaisha v 88766 Canada Inc* (1997), 72 CPR (3d) 195 (FCTD)].

[22] Accordingly, I am not satisfied that the Owner has demonstrated use of the with rolls or biscuits within the meaning of sections 4(1) and 45 of the Act. As the Owner furnished no evidence of special circumstances excusing non-use of the Mark in with these goods, they will be deleted from the registration.

DISPOSITION

[23] Based on the above findings, 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 all of the registered goods except for cakes.

[24] The amended statement of goods will now read: Cakes.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-01-29

APPEARANCES

Mark Evans For the Registered Owner

Yuri Chumak For the Requesting Party

AGENTS OF RECORD

Smart & Biggar LLP For the Registered Owner

Dickinson Wright LLP For the Requesting Party