

LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 91

Date of Decision: 2021-05-18

IN THE MATTER OF A SECTION 45 PROCEEDING

Trek Bicycle Corporation

Requesting Party

and

**Lotus Bakeries International und
Schweiz AG**

Registered Owner

TMA897,998 for JC TREK & Design

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to Registration No. TMA897,998 for the trademark JC TREK & Design (the Mark):



[2] During the course of this proceeding, the Registrar updated the registration to record an assignment of the Mark from Natural Balance Foods Limited to Lotus Bakeries International und Schweiz AG. This change of title is not an issue in this proceeding. Accordingly, both entities will be collectively referred to as the “Owner” in this decision.

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

Snack foods and snack bars containing chocolate, oats, fruits, nuts, herbs, natural flavourings and spices; nutritional chocolate, nut and sugar confectionery; low carbohydrate chocolate, nut and sugar confectionery; biscuits; cookies; grain-based food bars containing dried fruit, nuts and natural flavouring; flapjacks; snack foods, namely packaged raisins.

[4] For the reasons that follow, I conclude that the registration ought to be maintained, but only with respect to flapjacks.

THE PROCEEDING

[5] At the request of Trek Bicycle Corporation (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on March 13, 2018.

[6] The notice required the Owner to show whether the Mark 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 March 13, 2015 to March 13, 2018.

[7] The relevant definition of “use” in this case is set out in section 4(1) of the Act as follows:

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.

[8] In the absence of use as defined above, the Mark is liable to be amended or expunged unless the absence of use is due to special circumstances that excuse the absence of use [section 45(3) of the Act].

[9] 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. As such, the evidentiary threshold that the Owner must meet is quite low [*Lang Michener, Lawrence & Shaw v Woods Canada* (1996), 71 CPR (3d) 477 (FCTD) at para 9] and “evidentiary overkill” is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used 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) (*Rainier Brewing*) at para 14].

[10] In response to the Registrar’s notice, the Owner furnished the affidavit of its Director, Isabelle Maes, sworn on October 5, 2018. Both parties submitted written representations, and both parties requested and were represented at an oral hearing.

THE EVIDENCE

[11] With respect to display of the Mark, Ms. Maes provides copies of packaging designs for “Protein Oat Flapjacks” (Exhibit A). A variation of the Mark appears on the packaging designs, which are dated during the relevant period. Ms. Maes indicates that these designs are representative of how the Mark was used in association with the registered goods during the relevant period (para 5).



[12] Regarding transfer of the registered goods, Ms. Maes explains that, during the relevant period, the registered goods were sold to CDC Foods and Tree of Life Canada in the normal course of trade (para 6). She includes copies of documents that relate to bulk purchases by these entities, including sales order confirmations, shipment certificates, a booking confirmation, and a liner bill of lading (paras 7 and 8; Exhibits B and C). These documents are all dated during the relevant period and sent to entities located in Canada. In the “Description” section of the sales order confirmations, various “Flapjack” products are listed alongside the word “Trek”.

ANALYSIS AND REASONS FOR DECISION

[13] The Requesting Party raises four issues in this case: (1) the Mark does not appear as registered; (2) the sales of the goods were not in the normal course of trade; (3) the packaging designs are not sufficient to show use of the Mark within the meaning of the Act; and, (4) the evidence only refers to one good, namely “flapjacks”. I will discuss each of these issues in turn.

Deviation of the Mark

[14] With respect to deviation of the Mark, the Requesting Party notes the following differences in the trademark that appears in the evidence: there is no thick horizontal black band under the word TREK; the silhouette of the hiker with the backpack appears larger than the Mark as registered; the silhouette of the rocky landscape is different in shape and size from the Mark as registered; there is no visible silhouette of a mountain range in the background; there are no vertical black bands on the right and left edges of the design; and, the trademark on the packaging design is “JC’s TREK” while the Mark as registered is “JC TREK”.

The Mark as registered	The trademark in evidence
	

[15] The Requesting Party submits that the vertical black bands make the Mark as registered appear like a snack bar wrapper. The Requesting Party notes that these bands are missing in the trademark that appears in the evidence and, without these bands, the Requesting Party submits that the identity of the trademark has changed. However, in my view, the Mark does not lose its identity and it remains recognizable, despite the differences noted by the Requesting Party [Canada (Registrar of Trademarks) v Cie internationale pour l’informatique CII Honeywell Bull SA (1985), 4 CPR (3d) 523 (FCA) (Honeywell Bull) at para 5].

[16] I come to this conclusion by considering the dominant features of the Mark, which are the word “TREK” in large font on the right side of the design and a person to the left with a backpack who is standing on top of uneven terrain with one foot in front of the other facing towards the right. These dominant features are preserved from the Mark as registered to the trademark that appears in evidence [*Promafil Canada Ltée v Munsingwear Inc* (1992), 44 CPR (3d) 59 (FCA) (*Promafil*) at paras 34 to 36].

[17] Applying the principles set out in *Honeywell Bull* and *Promafil*, I am satisfied that use of the trademark in evidence constitutes use of the Mark as registered.

[18] At the oral hearing, the Requesting Party noted that the Mark only appears in a small corner of the packaging designs and, as a result, the Requesting Party submitted that all of the additional material on the packages must be considered when determining whether the public, as a matter of first impression, would perceive the Mark as being used *per se* [*Nightingale Interloc Ltd v Prodesign Ltd* (1984), 2 CPR (3d) 535 (TMOB) at para 7].

[19] On the bottom of some of the packaging designs, there are four distinct logos – including the Mark. The four logos are separated from the rest of the material on the packaging designs. The logos are also separated from each other by spacing and each logo has a different font and design element. As a result, I find that the Mark would be perceived as being used *per se* as a matter of first impression.

Normal Course of Trade

[20] With respect to the normal course of trade, the Requesting Party relies on *SC Johnson & Son, Inc v Canada (Registrar of Trade Marks)* (1981), 55 CPR (2d) 34 (FCTD) (*SC Johnson*) at para 5 to support its contention that there is no information in the affidavit of Ms. Maes to assist in establishing the nature of the usual purchaser and, by extension, assist in concluding that the sales in this case were in the normal course of trade. However, the only evidence in the *SC Johnson* case was a packaging label and a statement in the affidavit that the goods were transferred. Here, as noted by the Owner, Ms. Maes also provides evidence of transfer by way of sales order confirmations and shipping documents (Exhibits B and C).

[21] Evidence of a single sale can be sufficient to establish use for the purposes of section 45 expungement proceedings, so long as it follows the pattern of a genuine commercial transaction and is not seen as deliberately manufactured or contrived to protect the registration [*Philip Morris Inc v Imperial Tobacco Ltd* (1987), 13 CPR (3d) 289 (FCTD) at para 12]. Further, the law is clear that the use of a trademark at any point along the chain of distribution in Canada is sufficient to demonstrate use as defined in section 4 of the Act [*Manhattan Industries Inc v Princeton Manufacturing Ltd* (1971), 4 CPR (2d) 6 (FCTD) at para 39; *Osler, Hoskin & Harcourt v Canada (Registrar of Trade Marks)* (1997), 77 CPR (3d) 475 (FCTD) at para 30].

[22] When the evidence is considered as a whole, it is clear that the goods follow the chain of distribution from the Owner in the United Kingdom to entities in Canada, and there is nothing to suggest that the evidenced transfers do not follow the pattern of a genuine commercial transaction. As a result, there is sufficient evidence in this case to conclude that the sales were in the normal course of trade.

The Packaging Designs

[23] With respect to the packaging designs, the Requesting Party relies on *Brouillette Kosie v Segafredo Zanetti SpA* (2005), 44 CPR (4th) 468 (TMOB) (*Brouillette Kosie*) at para 18 to support its contention that the packaging designs alone are not sufficient to show use of the Mark within the meaning of the Act. However, as noted by the Owner, the only evidence in the *Brouillette Kosie* case was the packaging design and it was undated. Here, the packaging designs are dated within the relevant period (Exhibit A) and Ms. Maes also provides evidence of transfer by way of sales order confirmations and shipping documents (Exhibits B and C).

[24] As noted by the Requesting Party, Ms. Maes states that these designs are representative of how the Mark was used in association with the registered goods during the relevant period (para 5). The Requesting Party submits that this is a bare assertion of use. The Requesting Party also submits that Ms. Maes has not explicitly shown or stated that the goods were distributed in packaging that displayed the Mark and, because Ms. Maes states that the sales were carried out by way of bulk purchases, the Requesting Party suggests that the goods were distributed in different packaging than the designs provided by Ms. Maes. However, it is necessary to consider the evidence as a whole. When I consider Ms. Maes's statement along with the packaging

designs and the sales documents, which are all dated during the relevant period, I accept that the designs are representative of how the Mark appeared on the packaging and I am satisfied that the goods were distributed in such packaging during the relevant period.

Flapjacks

[25] As a final point, the Requesting Party notes that the packaging designs and the sales order confirmations only refer to “flapjacks” and, as a result, the Requesting Party submits that the Owner has not furnished evidence of use for any of the other registered goods. However, at the oral hearing, the Owner referenced the British and North American definitions for “flapjack” at <https://www.lexico.com/definition/flapjack>:

1 *British* A sweet dense cake made from oats, golden syrup, and melted butter, served in rectangles.

2 *North American* A pancake.

[26] Based on the first definition above, the Owner submits that use has been shown for “flapjacks” in addition to other goods listed in the registration, namely snack foods, snack bars, and grain-based food bars. At the oral hearing, the Owner further submitted that these other registered goods should be maintained because that is how the goods appear on the packaging designs, whereas a “flapjack” may be understood in North America to be a “pancake” based on the second definition above.

[27] However, having distinguished between various goods in the registration, this suggests that the goods are different from each other and it is therefore necessary to provide evidence of use for each of those goods [*Rainier Brewing* at paras 13 and 14]. In this case, the Owner provides evidence of use for “flapjacks” through display of the Mark on the packaging designs that identify the goods as “flapjacks” (Exhibit A) and evidence of transfer by way of the sales order confirmations that also identify the goods as “flapjacks” (Exhibits B and C). The Owner does not provide any such evidence of use in association with any other products.

[28] In addition, as the Owner noted at the hearing, the packaging designs are specifically made for Canada which is evidenced by the bilingual nature of the packages and the word “Canadian” in the description section of the packaging designs. Despite this, the goods are still

identified as “flapjacks” rather than being identified as snack foods, snack bars, or grain-based food bars. As a result, based on the evidence in this case, I find that the Owner has only demonstrated use of the Mark, within the meaning of sections 4 and 45 of the Act, in association with “flapjacks”. As the Owner has not provided any special circumstances excusing non-use of the Mark in association with any of the remaining registered goods, they will be deleted from the registration accordingly.

DISPOSITION

[29] Based on the findings above, 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 goods, except for “flapjacks”.

[30] The registration will now read as follows: Flapjacks.

Bradley Au
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE 2021-04-20

APPEARANCES

Marion Bailey-Canham and Nathan Piche

For the Registered Owner

Christopher T. Dejardin

For the Requesting Party

AGENTS OF RECORD

Gowling WLG (Canada) LLP

For the Registered Owner

Cassan Maclean IP Agency Inc.

For the Requesting Party