



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2021 TMOB 189

Date of Decision: 2021-08-26

IN THE MATTER OF A SECTION 45 PROCEEDING

**Norton Rose Fulbright Canada LLP/
S.E.N.C.R.L., S.R.L.**

Requesting Party

and

Christian Lutz Wolff

Registered Owner

TMA758,447 for Chef Siggy's

Registration

INTRODUCTION

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA758,447 for the trademark Chef Siggy's (the Mark).

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

THE PROCEEDING

[3] At the request of Norton Rose Fulbright Canada LLP/ S.E.N.C.R.L., S.R.L. (the Requesting Party), the Registrar of Trademarks issued a notice on October 1, 2019, pursuant to section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) to the owner of the registration, Mr. Christian Lutz Wolff.

[4] The notice required the Owner to show whether the Mark was 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 such use since that date. In this case, the relevant period for showing use is between October 1, 2016 and October 1, 2019.

[5] Although the Mark was originally registered in association with a variety of foodstuffs, the Owner voluntarily amended the registration after the issuance of the notice. The Mark is now registered in association with “spices” only.

[6] In response to the Registrar’s notice, the Owner submitted the affidavit of Christian Lutz Wolff (the Owner), sworn on February 3, 2020.

[7] No written representations were filed and no oral hearing was requested.

SUMMARY OF THE OWNER’S EVIDENCE

[8] In his affidavit, the Owner states that he is the president, sole director and sole shareholder of Spice Lab Inc. (the Licensee). He explains that the Licensee is a processor and distributor of spices, gravy powders, thickening agents, batters and other seasonings and cooking powders, and has held a licence to use the Mark since March 6, 2007.

[9] He also states that the Licensee displays the Mark on its website, invoices, business-related correspondence and product packaging; in support, he provides printouts of the

Licensee's website, representative invoices as well as photographs of product packaging, all of which display the Mark.

ANALYSIS AND REASONS FOR DECISION

[10] The relevant definition of use in association with goods 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.

[11] The invoices provided by the Owner are dated within the relevant period and evidence sales of spices to customers in Canada. While the invoices are issued by the Licensee, I am satisfied that any use of the Mark by the Licensee enures to the benefit of the Owner pursuant to section 50(1) of the Act. Indeed, the Owner is the sole officer of the Licensee, and the Owner explicitly states that "use of the Mark by the Licensee has been under [his] authority" and that he always had direct control of the character and quality of the goods associated with the Mark.

[12] I am also satisfied that the Mark was displayed on product packaging at the time of transfer. In this regard, the Owner not only provides representative examples of the product packaging bearing the Mark, but also specifically provides a photograph of "Nitro – Cajun Blend" and "Prairie Alberta Steak" product packaging, together with an invoice dated within the relevant period for those two products. The Owner attests that this evidence is representative of the way spices were packaged and sold during the relevant period.

[13] I note that the word "Spice" is displayed below the Mark on the exhibited product packaging. However, I find that "spice" would be perceived as clearly descriptive, and that the public would perceive the Mark being used *per se* despite this addition [for similar conclusions,

see *Borden Ladner Gervais LLP v Romulo Flores*, 2021 TMOB 151 at para 13; and *Nelligan O'Brien Payne LLP v Beacon Law Corporation*, 2018 TMOB 4 at paras 18-19].

DISPOSITION

[14] In view of the above, I conclude that the Owner has shown use of the Mark in association with “spices” within the meaning of sections 4 and 45 of the Act. Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be maintained.

Eve Heafey
Hearing Officer
Trademarks Opposition Board
Canadian Intellectual Property Office

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

HEARING DATE No hearing held

AGENTS OF RECORD

Adrian H. Lambert

For the Registered Owner

Norton Rose Fulbright Canada LLP/
S.E.N.C.R.L., S.R.L.

For the Requesting Party