



LE REGISTRAIRE DES MARQUES DE COMMERCE
THE REGISTRAR OF TRADEMARKS

Citation: 2022 TMOB 060

Date of Decision: 2022-03-29

IN THE MATTER OF A SECTION 45 PROCEEDING

Rowand LLP

Requesting Party

and

Aliments Tousain Inc.

Registered Owner

TMA295,842 for DUBON

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. TMA295,842 for the trademark DUBON (the Mark).

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

Foodstuffs, namely soups and sauces, soup bases, canned soups, canned vegetables, canned tomatoes, snails and snail shells, canned liver and pate, canned truffles, canned fish, canned olives, oils for cooking and salads, preserved capers, gherkins, pickles, onions and jellies, salad dressing, mustard, vinegar, food colourings and extracts, water, flour, sugar, dried beans, cheese, preserved peppers, preserved fruits and nuts, nuts in

dried form, bakery products - namely, baking chocolate, glazes, almond and praline pastes, crystallized flowers and seeds; biscuits and spices (the Goods)

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

THE PROCEEDING

[4] On January 15, 2021, at the request of Rowand LLP (the Requesting Party), the Registrar of Trademarks issued a notice pursuant to section 45 of the Act to Aliments Tousain Inc. (the Owner). The notice required the Owner to show whether the Mark was 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 the Mark 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 January 15, 2018 and January 15, 2021 (the Relevant Period).

[5] The relevant definition of “use” 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.

[6] In response to the Registrar’s notice, the Owner submitted the affidavit of Mr. Dikran Markarian, its President and sole shareholder, sworn on March 24, 2021.

[7] No party submitted written representations and no oral hearing was held.

THE OWNER’S EVIDENCE

[8] Mr. Dikran explains that the Owner is incorporated in Québec and imports and distributes food products to retail stores, supermarkets, online vendors, restaurants, food service distributors as well as processors and manufacturers. He states that the Owner sells various food products under various trademarks, including the Mark since at least 1983 [paras 4 to 7].

[9] Mr. Dikran states that the Owner has sold in excess of \$100M of the Goods since 1983, which includes the Relevant Period. He states that the Owner has sold the following food products associated with the Mark in Canada during the Relevant Period: canned fish, canned tomatoes, canned vegetables, canned olives, mustard, sauces, snails, snail shells, oils for cooking and salads, dried beans, and spices [paras 8, 9 and 10].

[10] In support, Mr. Dikran attaches the following relevant exhibits to his affidavit:

- Exhibit “B”: Nineteen invoices from the Relevant Period issued by the Owner to customers in Canada. The products listed in English on the invoices are accompanied by the Mark and are as follows: “Crushed Tomatoes, Kalamata Olives Whole Large, Grainy Dijon Mustard, Pesto, Mustard Dijon-White Wine, Mustard Dijon-Green Pepper, Mustard Dijon-Honey/Balsamic, Mustard Dijon-Blackcurrant, Mustard Dijon-Basil, Mustard Dijon-Old Style, Mustard Dijon, Mayonnaise, Canola Oil, Lentils Dupuy, Snails Helix V.L. France, Forest Mix Dried, and Olives Kalamata Pitted”.

The products listed in French on the invoices are also accompanied by the Mark and are as follows: “Coquille Escargot T.G., Thon Pale Morex Eau, Artichaut Quart, Riz Etuve #1, Olive Verte Colossal Grece, Olive Kalamata Denoy Large, Escargot T.G. France, Moutarde Dijon-Vin Blanc, Moutarde Dijon-A L’ancienne, Moutarde Dijon-Estragon, Moutarde Dijon-Poivre Vert, Huile Canola, Pleurote Sechee, Jus-Citron, Jus-Lime, Artichaut Coeur, Estragon Au Vinaigre, and Huile Arachide” [Translation: Snail Shell, Pale Tuna in Water, Artichoke Quart, Parboiled Rice #1, Green Olive Large Greece, Olive Kalamata Pitted Large, Snail T.G. France, Dijon Mustard-White Wine, Dijon Mustard-Old Style, Dijon Mustard-Tarragon, Dijon Mustard-Green Pepper, Canola Oil, Dried Oyster Mushroom, Helix Snails France, Lemon Juice, Lime Juice, Artichoke Heart, Tarragon in Vinegar, and Peanut Oil].

Mr. Dikran explains that the invoices represent the sale of several of the Goods by the Owner to customers in Canada during the Relevant Period [para 11].

- Exhibit “C”: Fifteen photographs of food products displaying the Mark on their label or packaging identifying the following products: Sunflower Oil, Canola Oil, Dijon Mustard Old Style, Dijon Mustard Hot Dijon, Tarragon Leaves in Vinegar, Crushed Tomatoes, Peanut Oil, Whole Shiitake, Lemon Juice, Greek Green Olives, Greek Kalamata Olives, White Kidney Beans, Snails, and Light Tuna Chunks.

Mr. Dikran explains that the photographed products are representative of the packaging of the Goods sold during the Relevant Period in Canada. He states that the photographed products include canned fish, canned tomatoes, canned olives, mustard, snails, oils for cooking and salads, dried beans, sauces, and spices [paras 12 and 13].

[11] In paragraph 10 of his affidavit, Mr. Dikran provides the following table explaining the correlation between the invoices and some of the Goods.

| Food products as listed in the Registration | Food products listed in the invoices | Invoice No. | Invoice Date |
|--|---|--------------------|---------------------|
| Canned fish | Thon pale morcx eau 170 g | 536523 | 2020-05-07 |
| | Thon pale morcx eau 1.88kg | 541927 | 2021-01-13 |
| | Thon pale morcx eau 1.88kg | 540256 | 2020-10-27 |
| Canned tomatoes | Crushed tomatoes 2.84 L | 541638 | 2020-12-22 |
| Canned vegetables | Artichaut quart 2.42 L | 540256 | 2020-10-27 |
| | Artichaut quart 2.42 L | 538764 | 2020-08-20 |
| | Artichaut coeur (5/7) 398ml | 531178 | 2019-10-09 |
| Canned olives | Kalamata olives whole large 2kg | 539896 | 2020-10-08 |
| | Olive verte colossal Grece 370ml | 540144 | 2020-10-20 |
| | Olives Kalamata denoy. Large 10kg | 541927 | 2021-01-13 |
| | Olives Kalamata pitted 10kg | 528043 | 2019-06-17 |
| Mustard | Grainy Dijon mustard 800ml | 539896 | 2020-10-08 |
| | Mustard Dijon-white wine 190ml | 537959 | 2020-07-13 |
| | Mustard Dijon-green pepper 190ml | | |
| | Mustard Dijon-honey balsamic 190ml | | |
| | Mustard Dijon-blackcurrant 190ml | | |
| | Mustard Dijon-basil 190ml | | |
| | Mustard Dijon-old style 190ml | | |
| | Mustard Dijon 375ml | | |
| | Moutarde Dijon-vin blanc 190ml | 532629 | 2019-11-27 |

| | | | |
|-----------------------------|--------------------------------------|--------|------------|
| | Moutarde Dijon-à l'ancienne 190ml | | |
| | Moutarde Dijon-estragon 190ml | | |
| | Moutarde Dijon-poivre vert 190ml | | |
| | Mustard Dijon 1L (pail) | 540526 | 2020-11-09 |
| | Dijon Mustard 4.75L | 528043 | 2019-06-17 |
| Sauces | Pesto 1kg | 539896 | 2020-10-08 |
| | Pesto 1kg | 541927 | 2021-01-13 |
| Snails | Escargot t.g. France 8dz | 532629 | 2019-11-27 |
| | Snails Helix v.l. France 8dz | 540526 | 2020-11-09 |
| Snail shells | Coquilles escargot TG 96dz (approx.) | 540511 | 2020-11-09 |
| Oils for cooking and salads | Canola oil (pail) | 538135 | 2020-07-17 |
| | Huile canola (carton) 16L | 528395 | 2019-06-27 |
| | Huile canola (carton) 16L | 541836 | 2021-01-08 |
| | Huile arachide 16L (chaudiere) | 539669 | 2020-09-28 |
| | Huile tournesol 16L (chaudiere) | 541450 | 2020-12-15 |
| Dried beans | Lentils Dupuy (dark green) 10kg | 538135 | 2020-07-17 |
| Spices | Estragon au vinaigre 650g | 539669 | 2020-09-28 |

ANALYSIS AND REASONS FOR DECISION

[12] Although the threshold for establishing use in in the context of section 45 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 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)]. In this case, the evidence establishes that the Mark has been used by the Owner during the Relevant Period with some, but not all, of the Goods.

[13] In the table above, Mr. Dikran correlates the products sold by the Owner with the following Goods: canned fish, canned tomatoes, canned vegetables, canned olives, mustard, sauces, snails, snail shells, oils for cooking and salads, dried beans, and spices. Given the Exhibit B invoices are showing sales of these Goods in the Relevant Period in Canada by the Owner and the Exhibit C photographs are showing how the Mark appeared on such Goods, I am satisfied

that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act for the aforementioned Goods.

[14] In the absence of evidence showing use of the Mark for the remaining Goods, not even a bare assertion of use regarding such Goods by Mr. Dikran in his affidavit, or special circumstances to justify the absence of use, the remaining Goods will be deleted from the registration.

DISPOSITION

[15] Accordingly, pursuant to the authority delegated to me under section 63(3) of the Act, the registration will be amended to delete the following Goods in compliance with the provisions of section 45 of the Act:

Soups, soup bases, canned soups, canned liver and pate, canned truffles, preserved capers, gherkins, pickles, onions and jellies, salad dressing, vinegar, food colourings and extracts, water, flour, sugar, cheese, preserved peppers, preserved fruits and nuts, nuts in dried form, bakery products - namely, baking chocolate, glazes, almond and praline pastes, crystallized flowers and seeds; and biscuits.

[16] The amended statement of Goods will read as follow:

Foodstuffs, namely sauces, canned vegetables, canned tomatoes, snails and snail shells, canned fish, canned olives, oils for cooking and salads, mustard, dried beans; and spices.

Martin Béliveau
Chairperson
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

No Agent Appointed

For the Registered Owner

Rowand LLP

For the Requesting Party