



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 025

Date of Decision: 2023-02-14

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Suminter India Organics Pvt. Ltd.

Registered Owner: 1509310 Ontario Limited

Registration: TMA854,722 for WAH

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. TMA854,722 for the trademark WAH (the Mark) registered for use in association with the following goods and services:

Food products, namely, rice (the Goods); and,

Wholesale, retail sale and distribution of food products (the Services).

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

THE PROCEEDING

[3] At the request of Suminter India Organics Pvt. Ltd. (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on April 22, 2021 to the registered owner of the Mark, 1509310 Ontario Limited (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with each of the Goods and Services 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 22, 2018 to April 22, 2021 (the Relevant Period). In the absence of use, the registration is liable to be expunged, unless the absence of use is due to special circumstances.

[5] The relevant definitions of use are 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.

4(2) A trademark is deemed to be used in association with services if it is used or displayed in the performance or advertising of those services.

[6] 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 [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448] and evidentiary overkill is not required [*Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD)]. Nevertheless, sufficient facts must still be provided to allow the Registrar to conclude that the Mark was used in association with the Goods and Services.

[7] In response to the Registrar’s notice, the Owner furnished the Affidavit of Shahab Hassan, sworn on July 8, 2021, together with Exhibits A to G.

[8] Neither party submitted written representations. Only the Owner attended a hearing.

THE EVIDENCE

[9] Mr. Hassan is the President of the Owner doing business as Pak National Foods Distributor (the Owner also does business as PNF and PNF Distributor), a Canadian food distribution company engaged in the wholesale, retail sale and distribution of food products in Canada, the United States and the United Arab Emirates.

[10] Mr. Hassan asserts that the Mark was used by the Owner in association with the Goods and Services in Canada during the Relevant Period.

[11] Mr. Hassan provides, as Exhibit B, an example of packaging for the Goods which displays the Mark. He states that the packaging is representative of how the Mark was displayed on the Goods when they were sold in Canada during the Relevant Period.

[12] Mr. Hassan states that the Owner distributed and sold the Goods to numerous retailers in Canada during the Relevant Period. As Exhibit C, Mr. Hassan provides copies of invoices which include the sale of "Wah Basmati Rice" to various Canadian customers during the Relevant Period. Although the pricing information on the invoices has been redacted, Mr. Hassan states the invoices represent sales of "Wah Basmati Rice" in excess of \$15,000.

[13] Mr. Hassan goes on to state that the Goods are advertised in retail store flyers and by in-store displays. As Exhibit D, he provides copies of flyers distributed by retailers promoting various products including the Goods displaying the Mark as well as photographs showing the Goods displaying the Mark in retail establishments. He states that this material is representative of the advertising for the Goods during the Relevant Period.

[14] Mr. Hassan also asserts that the Owner offered and preformed the Services in Canada in association with the Mark during the Relevant Period. In support of this assertion, he provides Exhibit F which consists of screenshots of two pages from the Owner's website. The first page is entitled "PNF Products" and appears to be under the "Products" tab of the website. Under the heading "Brands that We Work With", a number of brands are displayed including the Mark. There appears to be a button that

says “Shop with Tezmart” but there is no explanation as to its purpose. The second page is entitled “PNF Distribution” and appears to be under the “Distribution” tab of the website. Under the heading, “Distribution Solutions”, there is a description of the distribution services offered but there is no reference on the page to the Mark.

[15] Finally, Mr. Hassan states that the Mark is used in the advertisement of the Services in Canada on the packaging of the Goods. He provides, as Exhibit G, an example of the packaging used in Canada which displays the Mark and states that the Goods are “Imported and Distributed by PNF Distributor” (Exhibit G appears to be the same as Exhibit B).

ANALYSIS AND REASONS FOR DECISION

Goods

[16] The evidence described above clearly shows that the Mark was used in Canada in association with the Goods. In particular, the Owner has provided an example of packaging for the Goods which displays the Mark and has confirmed that the packaging is representative of how the Mark was displayed on the Goods when they were sold in Canada during the Relevant Period. Further, the Owner has provided copies of invoices, which include the sale of the Goods, to various Canadian customers during the Relevant Period. I am satisfied the transactions were in the normal course of trade.

[17] Accordingly, I am satisfied that the Mark was used in Canada by the Owner in association with the Goods during the Relevant Period within the meaning of sections 4(1) and 45 of the Act.

Services

[18] Services should be given a broad and liberal interpretation. As long as some members of the public, consumers or purchasers, receive a tangible and meaningful benefit from the activity, it is a service [*Renaud Cointreau & Co v Cordon Bleu International Ltd* (2000), 11 CPR (4th) 95 (FCTD), aff'd 2002 FCA 11; *Live! Holdings LLC v Oyen Wiggs Green & Mutala LLP*, 2019 FC 1042, aff'd 2020 FCA 120].

[19] During the hearing, the Owner acknowledged that the evidence relating to the Services is not as robust as the evidence relating to the Goods and that its strongest case is in relation to distribution services.

[20] As acknowledged by the Owner at the hearing, there is no explicit reference to the wholesale and retail sale of food products in the evidence, other than in the general description of the Owner's business. That being the case, I am not satisfied that sufficient facts have been provided to enable me to conclude that wholesale and retail sale of food products services were offered or performed in Canada by the Owner in association with the Mark during the Relevant Period.

[21] Accordingly, I am not satisfied that the Owner has established use of the Mark in association with wholesale and retail sale of food products services within the meaning of sections 4(2) and 45 of the Act. As there is no evidence of special circumstances to justify non-use, the registration will be amended accordingly.

[22] The evidence provided by the Owner to support the assertion that the Mark was used in association with the distribution of food products is limited to two exhibits.

[23] Exhibit F consists of two pages which appear to come from different parts of the Owner's website. The first page lists a number of brands including the Mark. The second page provides a description of the "Distribution Solutions" offered by the Owner. However, there is no reference to the Mark on the second page. While Exhibit F shows that the Owner offered "Distribution Solutions", there is nothing to connect the Mark to those services.

[24] Exhibit G is an example of the packaging used in Canada which displays the Mark and states that the Goods were "Imported and Distributed by PNF Distributor". The statement on the back of the packaging, without more information from the Owner, is not sufficient for me to conclude that members of the public, consumers or purchasers, received a tangible and meaningful benefit from a service offered by the Owner - it is simply a statement that the Owner imported and distributed its own product.

[25] Accordingly, I am not satisfied that the Owner has established use of the Mark in association with distribution of food products within the meaning of sections 4(2) and 45 of the Act. As there is no evidence of special circumstances to justify non-use, the registration will be amended accordingly.

DISPOSITION

[26] 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 services “wholesale, retail sale and distribution of food products”.

[27] The registration will be maintained for the goods “food products, namely, rice”.

Robert A. MacDonald
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-01-26

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Michael O'Neill

AGENTS OF RECORD

For the Requesting Party: Bereskin & Parr LLP / SENCRL SRL

For the Registered Owner: Marks & Clerk