



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 060

Date of Decision: 2023-03-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Wises Professional Corporation

Registered Owner: ZOE International Distributing Inc.

Registration: TMA664,612 for JAYS

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. TMA664,612 for the trademark JAYS (the Mark), owned by ZOE International Distributing Inc. (the Owner).

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

THE PROCEEDING

[3] At the request of Wises Professional Corporation (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on March 23, 2022.

[4] The notice required the Owner to show whether the Mark had 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 23, 2019, to March 23, 2022.

[5] The Mark is registered for use in association with “Tobacco and tobacco accessories, namely rolling papers, rolling machines, cigarettes, cigars, cigarette tobacco, pipes.”

[6] The relevant definition of use in the present case 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] It is well accepted 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 Registrar of Trade Marks* (1982), 63 CPR (2d) 56 (FCTD)]. However, 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.

[8] In response to the Registrar’s notice, the Owner furnished the affidavit of Demetra Georganas, Chief Executive Officer for the Owner, sworn on June 23, 2022. Both parties submitted written representations; no oral hearing was held.

THE EVIDENCE

[9] Ms. Georganas states that the Owner does business under the business name “HBI Canada”, and that records prepared in the ordinary course of business display that name rather than Zoe International Distributing Inc. She states that the Owner is in the business of manufacturing and wholesale distribution of smoking accessories, and that

accessories displaying the Mark that were sold during the relevant period included “rolling papers, pre-rolled cones, rolling trays and incense sticks” [para 7]. As Exhibits A and B, respectively, she attaches excerpts from the Owner’s yearly catalogs for 2019 and 2021. Ms. Georganas states that these excerpts accurately depict the use of the Mark on the labelling, marking and packaging for rolling papers sold in Canada during the relevant period [para 10]. The catalogs show packaging for rolling papers displaying the words “JUICY JAY’S”, with “JUICY” in large coloured letters and “JAY’S” in smaller black letters, both set in front of a droplet image. The ® symbol appears after “JUICY” in each of these images; in some instances, it also appears after “JAY’S”. For ease of reference, I will refer to this formulation (with or without the ® appearing after JAY’S) as the Logo, an example of which is shown below:



[10] As Exhibit C, Ms. Georganas attaches a number of invoices dated during the relevant period showing sales from HBI Canada to Canadian retail customers. Among the items listed for sale are rolling papers identified as “JUICY JAY’S”.

REASONS FOR DECISION

[11] The Requesting Party submits that display of the Logo does not amount to display of the Mark as registered, that the rolling papers shown in evidence are for cannabis rather than tobacco, that the Owner has not demonstrated use of the Mark in association with each of the goods, that the evidence does not establish that HBI Canada is the Owner, and that the Owner has not provided evidence establishing that any alleged sales were in the normal course of trade.

[12] With respect to the latter two submissions, I note that an affiant’s statements are to be accepted at face value and must be accorded substantial credibility in a section 45 proceeding [*Oyen Wiggs Green & Mutala LLP v Atari Interactive Inc*, 2018 TMOB 79 at

para 25]. In this case, I see no reason not to take Ms. Georganas' sworn statements at face value. Accordingly, I accept that the Owner does business under the name "HBI Canada" and that any references to that entity in evidence are references to the Owner. Similarly, based on Ms. Georganas' statements at paragraphs 8 through 12 of her affidavit, I accept that the transactions evidenced in the Exhibit C invoices are transfers in the normal course of trade, and that the "JUICY JAY'S" rolling papers listed in those invoices would have been sold in the packaging depicted in Exhibits A and B.

[13] However, I concur with the Requesting Party that the Owner's evidence and written submissions do not refer to the registered goods "rolling machines, cigarettes, cigars, cigarette tobacco, pipes." As there is no evidence of special circumstances excusing non-use of the Mark in association with these goods, they will be deleted from the registration. Each remaining submission will be considered in turn.

Use of the Mark as registered

[14] If a trademark is used in combination with additional words or features, use will be considered when 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)]. This is a question of fact which is dependent on whether the mark stands out from additional material, for example, by the use of different lettering, sizing, or whether the additional material would be perceived as clearly descriptive or as a separate trademark or tradename [*Nightingale*; see also *88766 Canada Inc v National Cheese Co* (2002), 24 CPR (4th) 410 (TMOB)].

[15] The Requesting Party submits that the evidence shows use of a composite trademark rather than the Mark as registered, and in particular, that the dominant feature "JAYS" is not preserved given the differences in appearance and meaning between the Mark as registered compared to how it is used. In support, the Requesting Party cites the following cases:

- *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA* (1985), 4 CPR (3d) 523 (FCA) (*CII Honeywell Bull*),

in which the display of “CII HONEYWELL BULL” did not amount to use of the trademark “BULL”.

- *Cassels, Brock & Blackwell v Relton Corp*, [2003] TMOB No 6 (*Relton*), in which the display of “CONCRETE-TERMITE” did not amount to use of the trademark “TERMITE”.
- *Riches, McKenzie & Herbert v Pepper King Ltd* (2000), 8 CPR (4th) 471 (FCTD) (*Pepper King*), in which the display of “VOLCANO HOT” did not amount to use of the trademark “VOLCANO”.
- *Prince v Andres Wines Ltd*, 2004 FC 812 (*Andres Wines*), in which display of a coat of arms design incorporating the words “IN VINO VERITAS” did not amount to use of the word mark “IN VINO VERITAS”.
- *88766 Canada Inc v Coca-Cola Ltd/Coca-Cola Ltée* (2006), 52 CPR (4th) 50 (TMOB), and *Coca-Cola Ltd v Southland Corp* (2001), 20 CPR (4th) 537 (TMOB) (collectively, *Coca-Cola*), in which the display of a “COCA-COLA CLASSIC” design did not amount to use of the trademark “CLASSIC”.

[16] The Requesting Party submits that the composite mark “JUICY JAY’S” is different in appearance and sound from the Mark, and conveys a different meaning as the public would likely perceive JUICY JAY’S as a reference to a person named Jay whose products “are full of juice or succulent” [para 15]. The Requesting Party contends that the dominant element of the Logo is “JUICY” due to its larger size and more colourful font, while the smaller “JAY’S” does not stand out on its own as a distinctive element. Further, the Requesting Party submits that the appearance of the ® symbol adds further ambiguity since it most often appears only beside “JUICY”; where it appears next to “JAY’S”, the Requesting Party’s position is that a consumer would likely interpret the second registration symbol to be associated with the LOGO or the words “JUICY JAY’S”.

[17] The Owner submits that the cases cited by the Requesting Party are distinguishable from the present case because the Mark appears in a different font and size than the additional material, unlike *Honeywell Bull*, *Pepper King*, and *Relton*; because the Mark can be visually separated from the additional material, unlike *Andres*

Wines, and because the placement of the ® symbol does not suggest that the entire Logo is a single trademark, unlike *Coca-Cola*. The Owner refers to the cases of *Epic Aviation, LLC v Imperial Oil Limited*, 2020 TMOB 103 (*Epic Aviation*), in which the trademark “EPIC” was found to stand out despite being in a smaller, monochromatic font as compared to the larger, more colourful additional word “MOBIL”, and to *Fasken Martineau Dumoulin LLP v Gentec*, 2022 FC 327, in which the trademark “IQ” stood out from the additional word “PODZ” due to different colouring, lettering, size, and the placement of the ® symbol.

[18] In this case, I concur with the Owner that the Mark stands out from the additional material due to its different lettering and sizing [for similar conclusions where a word mark was found to stand out despite being smaller than the surrounding material, see *Epic Aviation; Prollenium Medical Technologies, Inc v Teoxane, SA*, 2016 TMOB 191 at paras 18-21; *Rogers Media Inc v La Cornue*, 2019 TMOB 63 at paras 39-49]. I also concur with the Owner that the Mark remains recognizable and does not lose its identity despite the addition of the apostrophe [for a similar conclusion, see *Labrador II, Inc v Ren’s Feed and Supplies Ltd*, 2016 TMOB 181 at para 32].

[19] Finally, the Requesting Party refers to *1673030 Alberta Inc v Zoe International Distributing Inc*, 2016 TMOB 140, an expungement proceeding involving the same Owner and relating to the trademark “JUICY”. The Requesting Party states that in that case, the Owner had submitted that the word “JAY’S” “is descriptive of the particular product” and “is not a dominant feature”. Both the Requesting Party and Owner refer to submissions made by the Owner that do not appear in the final decision in that case; as these submissions are not in evidence, I cannot consider them. In any event, there is nothing in that case suggesting that “JAYS” cannot be considered a trademark in its own right, and even if there were, it is trite law that each case must be decided on its own facts and merits.

Use of the Mark in association with “Tobacco and tobacco accessories”

[20] The Requesting Party submits that Ms. Georganas identified the Owner’s goods as “smoking accessory products” and that the advertisements in the exhibited catalogs

state that the rolling papers are “designed to enhance the natural flavours of your herb” and are “like adding candy to your herb”. The Requesting Party asks me to take judicial notice that “herb” is slang for cannabis, rather than tobacco. I am not prepared to take judicial notice that “herb” is slang for “cannabis”; in any event, I note that Ms. Georganas states at paragraph 7 of her affidavit that the rolling papers “are used for rolling and smoking tobacco”. Accordingly, I am satisfied that use of the Mark in association with the rolling papers shown in evidence amounts to use in association with the registered goods “Tobacco and tobacco accessories, namely rolling papers”.

[21] In maintaining the registration for “Tobacco”, I note that in the *Zoe International* case referenced above, involving the trademark “JUICY” and a similar statement of goods registered by the same owner, the Board found that “the statement of goods is most coherent if the word ‘namely’ is interpreted as referring to ‘tobacco and tobacco accessories’ as a whole and not to ‘tobacco accessories’ alone” [para 11].

DISPOSITION

[22] In view of all of the foregoing, 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 “rolling machines, cigarettes, cigars, cigarette tobacco, pipes”.

[23] The amended registration will be as follows:

Tobacco and tobacco accessories, namely rolling papers

G.M. Melchin
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: No hearing held

AGENTS OF RECORD

For the Requesting Party: Wises Professional Corporation

For the Registered Owner: DLA Piper (Canada) LLP