



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 092

Date of Decision: 2023-05-30

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Method Law Professional Corporation

Registered Owner: S & F Food Importers Inc.

Registration: TMA580,660 for POLKA DESIGN

INTRODUCTION

[1] This is a summary expungement proceeding under section 45 of the *Trademarks Act*, RSC 1985, c T-13 (the Act) with respect to registration No. TMA580,660 for the trademark POLKA DESIGN shown below (the Mark) registered for use in association with (1) Sauerkraut. (2) Cream crackers, jams and jellies, hazelnut spread, honey, candies, sauerkraut, cookies and wafers.

POLKA

[2] For the reasons that follow, I conclude that the registration ought to be maintained with respect to sauerkraut. The registration will be amended to delete the remaining goods.

THE PROCEEDING

[3] At the request of Method Law Professional Corporation (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on August 4, 2021 to the registered owner of the Mark, S & F Food Importers Inc. (the Owner).

[4] The notice required the Owner to show whether the Mark was used in Canada in association with the registered goods 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 August 4, 2018 to August 4, 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 definition of use is set out in section 4(1) of the Act:

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] 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. The evidence in a section 45 proceeding need not be perfect; the Owner need only establish a *prima facie* case of use within the meaning of sections 4 and 45 of the Act. This burden of proof is light; evidence must only supply facts from which a conclusion of use may follow as a logical inference [*Diamant Elinor Inc v 88766 Canada Inc*, 2010 FC 1184].

[7] In response to the Registrar's notice, the Owner submitted the affidavit of Felix Gershgorin, the Vice President of Purchasing with the Owner and the affidavit of Brian Zeng, a licensed Private Investigator.

[8] Both parties submitted written representations. A hearing was held which the Owner attended.

ANALYSIS AND REASONS FOR DECISION

No Use of Registered Goods (2) other than Sauerkraut

[9] Mr. Gershgorin's affidavit does not provide any evidence of use of the Mark in association with cream crackers, jams and jellies, hazelnut spread, honey, candies, sauerkraut, cookies and wafers during the Relevant Period. In paragraph 7 of his evidence, Mr. Gershgorin explains that the Mark was applied to jars containing sauerkraut "since at least as early as 1983, including during the Relevant Period, and was used as early as 2003 for the remaining goods in its registration." Mr. Gershgorin's remaining evidence and Mr. Zeng's evidence does not speak about the remaining registered goods. As there is no evidence that the Mark was used in association with the remainder of registered goods (2) in compliance with section 4(1) of the Act or that there were special circumstances excusing non-use, the registration will be amended to delete these goods.

Use of the Mark is Shown for Sauerkraut

[10] Mr. Gershgorin's evidence shows that the Mark was used in association with sauerkraut during the Relevant Period. In particular, Mr. Gershgorin provides a picture of the Mark displayed on the front of a jar of sauerkraut which he attests shows how the Mark appeared on the jars during the Relevant Period (para 7, Exhibit C).

Mr. Gershgorin's affidavit also includes an invoice showing sales in Canada to Metro Inc. Food Basics and Loblaws Inc. of POLKA brand sauerkraut during the Relevant Period which displays the Mark on the label (para 11, Exhibits F-G).

Use of the Mark Enures to the Owner

[11] The Requesting Party submits that the evidence of use does not enure to the Owner as it is only an importer of POLKA branded sauerkraut. The Requesting Party points to the following evidence:

- (a) The Owner's website describes it as an importer and it imports several third party brands (Exhibit A):

S&F was founded in 1976 as a food & beverage importer and distributor bringing products from around the world into the Canadian market...

- (b) The photograph of the delivery truck in Mr. Gershgorin's affidavit shows that it uses a house mark on its products (Exhibit E).
- (c) The Owner has not provided the full label of the POLKA branded products which would allow it to be determined if a third party manufacturer is listed on the back of the label (see, for example, Exhibit C).

[12] The evidence is sufficient for the Owner to meet its *prima facie* burden that use of the Mark enures to it. First, Mr. Gershgorin attests that the Owner owns the Canadian registration for the Mark. Second, I do not find the fact that the Owner has a house mark and also distributes third party products to result in the inference that the POLKA trademark is owned by another party. Third, section 45 proceedings are not intended to provide an alternative to the usual *inter partes* attack on a trademark [*United Grain Growers v Lang Michener*, 2001 FCA 66]. As noted by the Federal Court of Appeal in *Ridout & Maybee LLP v Omega SA* 2005 FCA 306, the validity of the registration is not in dispute in section 45 proceedings. Issues of ownership are more properly dealt with by way of application to the Federal Court pursuant to section 57 of the Act. Further, the Owner's role as a distributor is not inconsistent with its asserting use of the Mark; the question of whether products sold by the Owner were manufactured by others is inconsequential in this proceeding [*GNR Travel Centre Ltd v CWI, Inc*, 2023 FC 2].

[13] Indeed, a trademark owner relying on its own sales in Canada is not required to demonstrate control pursuant to section 50 of the Act – that requirement only exists when an owner seeks to benefit from the use of its trademark by a licensee [for a similar conclusion see *Marks & Clerk v Tritap Food Broker, a division of 676166 Ontario Limited*, 2017 TMOB 35 at para 20].

DISPOSITION

[14] 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 maintained with respect to (1) sauerkraut and (2) sauerkraut and amended to delete the registered goods (2) cream crackers, jams and jellies, hazelnut spread, honey, candies, cookies and wafers.

Natalie de Paulsen
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: May 29, 2023

APPEARANCES

For the Requesting Party: No one appearing

For the Registered Owner: Paul Lomic and [Sabrina Salituro](#)

AGENTS OF RECORD

For the Requesting Party: Michelle L. Wassenaar (Method Law
Professional Corporation)

For the Registered Owner: Paul Lomic (Lomic Law)