



Canadian Intellectual Property Office

THE REGISTRAR OF TRADEMARKS

Citation: 2023 TMOB 117

Date of Decision: 2023-07-11

IN THE MATTER OF A SECTION 45 PROCEEDING

Requesting Party: Clark Wilson LLP

Registered Owner: Nature's Path Foods Inc.

Registration: TMA549,310 for AMAZON

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. TMA549,310 for the trademark AMAZON (the Mark) in association with "breakfast cereals". The owner of the registration is Nature's Path Foods Inc. (the Owner).

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

PROCEEDING

[3] At the request of Clark Wilson LLP (the Requesting Party), the Registrar of Trademarks issued a notice under section 45 of the Act on February 10, 2022, to the Owner.

[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 February 10, 2019 to February 10, 2022.

[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] It is well established that 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 a registered owner must meet is quite low [*Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448 at para 68] and “evidentiary overkill” is not required [see *Union Electric Supply Co v Canada (Registrar of Trade Marks)* (1982), 63 CPR (2d) 56 (FCTD) at para 3]. That said, mere assertions of use are not sufficient to demonstrate use in the context of section 45 proceedings [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)], and 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 and services specified in the registration during the relevant period [*John Labatt Ltd v Rainier Brewing Co* (1984), 80 CPR (2d) 228 (FCA)].

[7] Where the owner has not shown “use”, the registration is liable to be expunged or amended, unless there are special circumstances that excuse the absence of use.

[8] In response to the Registrar's notice, the Owner filed the affidavit of Arjan Stephens sworn in Vancouver, British Columbia on April 28, 2022 (the Stephens Affidavit). Mr. Stephens is the General Manager of the Owner.

[9] Both parties submitted written representations and participated in an oral hearing.

EVIDENCE

[10] Mr. Stephens describes that the Owner is in the business of manufacturing, selling and distributing food products in Canada and elsewhere. He states that during the relevant period the Owner has used the Mark in Canada in the ordinary course of business in relation to breakfast cereals.

[11] In this regard, Exhibit A to his affidavit is described as images of products showing use of AMAZON on the packaging for breakfast cereals. Exhibit B is described as an image of an in-store display showing AMAZON branded breakfast cereals offered for sale. Mr. Stephens states that during the relevant period the trademark AMAZON was used at least in the manner shown in Exhibits A and B. For ease of reference, reproduced below is an image of the breakfast cereal packaging shown in Exhibit A to the Stephens Affidavit.



[12] Exhibit C to the Stephens Affidavit is described as copies of invoices showing sales in Canada during the relevant period for AMAZON branded breakfast cereals. Exhibit C contains two invoices (dated May 17, 2021 and June 2, 2021) for the sale of various food items to two businesses located in Canada, including items described as “NP EK AMAZON FLAKES CRL CDN 325g”.

ANALYSIS

[13] Based on the evidence of record, certain relevant facts in this case are not in dispute. For example, the Stephens Affidavit (particularly the packaging in Exhibit A in conjunction with the dates of the invoices in Exhibit C) demonstrates that the Owner sold boxes of breakfast cereal bearing the word “AMAZON” in Canada during the

relevant period, and the Requesting Party does not dispute that fact. Nor has the Requesting Party raised any arguments that such sales were not in the Owner's normal course of trade. All this to say, for the purposes of sections 4(1) and 45 of the Act, there is no dispute that the word "AMAZON" appeared on packages of breakfast cereal at the time of transfer to the customer in Canada during the relevant period.

[14] What is in dispute is whether the Owner's depiction of the word "AMAZON" in conjunction with the words "FLAKES" (as seen on the above package) constituted use of the Mark as registered. The Requesting Party argues that the Owner did not use the trademark AMAZON *per se*, and instead used a different trademark, namely, AMAZON FLAKES. The Requesting Party argues that these two trademarks are different and that the latter is an impermissible variation of the former.

[15] The leading jurisprudence for addressing such circumstances is well-established and cited by both parties in this case. In *Nightingale Interloc Limited v ProDesign Limited*, [1984] TMOB No 52, 2 CPR (3d) 535 (*Nightingale*) at paras 7-8, this Board identified the following two principles:

Principle 1

7 Use of a mark in combination with additional material constitutes use of the mark *per se* as a trade mark if the public, as a matter of first impression, would perceive the mark *per se* as being used as a trade mark. This is a question of fact dependent upon such factors as whether the mark stands out from the additional material, for example by the use of different lettering or sizing [...], or whether the additional material would be perceived as purely descriptive matter or as a separate trade mark or trade name: [...]

Principle 2

8 A particular trade mark will be considered as being used if the trade mark actually used is not substantially different and the deviations are not such as to deceive or injure the public in any way [...]

[16] The Federal Court of Appeal in *Canada (Registrar of Trade Marks) v Cie internationale pour l'informatique CII Honeywell Bull SA*, [1985] 1 FC 406, 4 CPR (3d) 523 (FCA) (*Honeywell*) at para 5 expressed the considerations as follows:

The practical test to be applied in order to resolve a case of this nature is to compare the trade mark as it is registered with the trade mark as it is used and determine whether the differences between these two marks are so unimportant that an unaware purchaser would be likely to infer that both, in spite of their differences, identify goods having the same origin.

[17] The Requesting Party puts forward multiple arguments in support of its position that the Owner's depiction of AMAZON FLAKES does not constitute use of the trademark AMAZON. First, the Requesting Party notes that there is no evidence of the Owner ever depicting the word AMAZON in isolation; instead, on the packaging, the words "AMAZON" and "FLAKES" are depicted in the same font, style, and colour, and in a larger and more prominent manner than the descriptive words "FROSTED" and "ORGANIC". Further, the Requesting Party notes that the words "AMAZON FLAKES" are depicted in a similar manner to that seen on the Owner's other brands of cereal (shown in the store display in Exhibit B to the Stephens Affidavit), including "KOALA CRISP", "PANDA PUFFS", "GORILLA MUNCH" and "CHEETAH CHOMPS", and argues that this suggests that the trademark being conveyed to the consumer is similarly a two-word trademark AMAZON FLAKES rather than AMAZON. The Requesting Party also argues that the particular placement of the "®" symbol on the packaging (closest to the letter "S" of the word "FLAKES") conveys to consumers that the trademark being used is AMAZON FLAKES rather than AMAZON *per se*.

[18] Despite able arguments by the Requesting Party as set out above, I find myself unable to agree with the Requesting Party on this issue. In particular, I agree with the Owner that the word "FLAKES" on the cereal packaging will likely be understood by consumers as being purely descriptive (as contemplated in the first principle in *Nightingale*). While the Requesting Party argued that there is no evidence of record in this proceeding that "FLAKES" would be understood as purely descriptive in association with breakfast cereals, I am permitted to take judicial notice of dictionary definitions [see *Tradall SA v Devil's Martini Inc*, 2011 TMOB 65 at para 29], and one of the definitions of the word "flake" in the *Canadian Oxford Dictionary*, 2nd Ed is "(in *pl.*) any of various kinds of flaked breakfast cereal, esp. cornflakes." The images of the cereal itself on the product packaging suggest that it is indeed comprised of flakes.

[19] While I accept the Requesting Party's argument that certain trademarks comprised of multiple words can include descriptive terms (see for example, the trademarks discussed in *Kellogg Canada Inc v Weetabix of Canada Ltd*, 2002 FCT 724, 20 CPR (4th) 17 (FCTD)), I do not consider that to be dispositive in the present case. Given the highly descriptive nature of the word "FLAKES" in association with breakfast cereal, and given that the word "AMAZON" is unlikely to be perceived as descriptive in association with breakfast cereal, I agree with the Owner that the word "AMAZON" on its packaging is likely to be perceived as the distinctive and dominant element rather than the word "FLAKES".

[20] In this context, I do not consider that the Owner's addition of the descriptive word "FLAKES" has created a new and different trademark that would deceive or injure the public (as contemplated in the second principle from *Nightingale*), or that would suggest to consumers a different source or origin from the registered Mark (as discussed in *Honeywell*).

[21] Also, I consider this case to be distinguishable from *Riches, McKenzie & Herbert v Pepper King Ltd* (1999), 1 CPR (4th) 408 (TMOB), rev'd on a different ground (2000) 8 CPR (4th) 471 (FCTD), cited by the Requesting Party, wherein the Registrar found that the depiction of VOLCANO HOT did not constitute use of the trademark VOLCANO *per se* in association with hot pepper sauce. In that case, the product label in issue depicted the mark VOLCANO HOT directly above the description "HOT PEPPER SAUCE", which in my view would increase the likelihood that a consumer would perceive VOLCANO HOT as being a unitary trademark, as otherwise the word "HOT" following "VOLCANO" would be redundant.

[22] I note that both sides argued that the placement of the "®" symbol on the Owner's packaging supported their respective positions. The Requesting Party argued that the placement of the symbol closest to the letter "S" in the word "FLAKES" suggested that consumers would perceive the trademark as AMAZON FLAKES. The Owner argued that same location of the symbol, to the lower right of the word AMAZON, would convey to consumers that the trademark is AMAZON *per se*, in the same way the

“TM” symbol was placed to the lower right of the ENVRIOKIDZ composite design trademark at the top of the package. Ultimately, based on the evidence of record, I consider the placement of the “®” symbol to be ambiguous and I do not consider it to favour either party to any meaningful degree. In any event, I would not have considered the placement of the “®” symbol, alone, to have been dispositive.

[23] Similarly, I do not consider the depiction of AMAZON FLAKES on the invoices in Exhibit C to the Stephens Affidavit to provide much insight into which trademark the Owner was using. The Requesting Party argued the fact that AMAZON FLAKES was depicted in all upper case in the invoices suggested the trademark being used was AMAZON FLAKES. However, this is not persuasive given that essentially the entire item description in the invoice, including the descriptive term “CRL” (which I understand to refer to “cereal”) is in upper case.

[24] Taking all of the above into account, given the highly descriptive nature of the word “FLAKES” in association with breakfast cereal, I do not consider that the Owner has used a different trademark to that which it registered, or to the extent that it has, it is a permissible variation. Therefore, I conclude that the Owner has used the Mark in Canada in association with the goods during the relevant period for the purposes of sections 4 and 45 of the Act.

DISPOSITION

[25] 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.

Timothy Stevenson
Member
Trademarks Opposition Board
Canadian Intellectual Property Office

Appearances and Agents of Record

HEARING DATE: 2023-06-01

APPEARANCES

For the Requesting Party: David Bowden

For the Registered Owner: Mihaela Hutanu

AGENTS OF RECORD

For the Requesting Party: Clark Wilson LLP

For the Registered Owner: Oyen Wiggs Green & Mutala LLP