



# Canadian Intellectual Property Office

## **THE REGISTRAR OF TRADEMARKS**

**Citation:** 2025 TMOB 118

**Date of Decision:** 2025-05-29

## **IN THE MATTER OF A SECTION 45 PROCEEDING**

**Requesting Party:** Gowling WLG (Canada) LLP

**Registered Owner:** Original Image Co., Ltd.

**Registration:** TMA676,402 for MACH

### **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. TMA676,402 for the trademark MACH (the Mark), owned by Original Image Co., Ltd. (the Owner).

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

### **THE RECORD**

[3] At the request of Gowling WLG (Canada) LLP (the Requesting Party), the Registrar of Trademarks issued a notice to the Owner under section 45 of the Act on August 16, 2024. The notice required the Owner to show whether the Mark had been

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 use since that date. In this case, the relevant period for showing use is August 16, 2021, to August 16, 2024.

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

(1) Dietary and nutritional supplements, namely, herbs, herbal extracts, plants, plant extracts and phytonutrients.

[5] The relevant definition of “use” in the present case 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 furnished the affidavit of Satoshi Yoshida, President of the Owner, sworn on November 15, 2024. Only the Owner filed written representations; no oral hearing was held.

## **EVIDENCE**

[7] Mr. Yoshida states that during the relevant period, the Owner imported a blend of herbs, herbal extracts, plants, plant extracts, and phytonutrients, which he defines as the “MACH Substance”, from Japan to the United States through its licensee and distributor, Shaklee Corporation (Shaklee). He states that any use of the Mark by Shaklee was subject to the terms and conditions set out in a written licence agreement with an effective date of January 1, 2005.

[8] Mr. Yoshida states that during the relevant period, the MACH Substance was used as the main ingredient to manufacture a dietary supplement called “NutriFeron”, which was then sold to end consumers in Canada directly by Shaklee or by distributors who purchased the product from manufacturers contracted by Shaklee. As Exhibit B, he

attaches copies of product labels that are representative of the labels used on the NutriFeron product when it was offered and sold to Canadian distributors and end consumers in Canada during the relevant period. I note that in the nutritional information section of the label, it includes a heading for “MACH® Patented Blend of Interferon-Boosting Plant Extracts” including pumpkinseed extract, safflower flower extract, Asian plantain seed extract, and Japanese honeysuckle flower extract.

[9] Finally, Mr. Yoshida states that the “gross sales for goods sold in Canada under the [Mark] in association with the NutriFeron dietary supplement, from September 1, 2021, to June 30, 2024 [...] exceeded USD\$750,000”.

### **ANALYSIS**

[10] I am satisfied that the Owner has shown use of the Mark in association with the registered goods within the meaning of sections 4 and 45 of the Act. In this respect, I note that Mr. Yoshida has provided figures showing significant sales by its licensee of the NutriFeron dietary supplement in Canada during the relevant period, and has clearly attested that any use of the Mark in association with the registered goods by Shaklee is subject to the control of the Owner by way of a licence, such that any use of the Mark by Shaklee would enure to the Owner pursuant to section 50(1) of the Act [see *Empresa Cubana Del Tabaco Trading v Shapiro Cohen*, 2011 FC 102 at para 84].

[11] I further note that Mr. Yoshida has provided copies of the product label for the NutriFeron dietary supplement that are representative of how that label appeared during the relevant period. I am satisfied that the display of the Mark in the nutritional information section, identifying an ingredient compound, would amount to display of the Mark in association with the registered goods. In this respect, I am mindful that nothing in the Act requires a trademark to be used in association with a “stand-alone” product; use within the meaning of the Act may be established where a Mark is used in association with an ingredient or component of a complete product [see *Gowling, Strathy & Henderson v Tundra Knitwear Ltd* (2001), 13 CPR (4th) 559 at para 7; *Gowling WLG (Canada) LLP v Pelican International Inc*, 2016 TMOB 144 at paras 16-18]. Furthermore, there is nothing in the Act that precludes a trademark owner from

using more than one trademark at the same time in association with the same goods [AW Allen Ltd v Warner-Lambert Canada Inc (1985), 6 CPR (3d) 270 (FCTD)].

[12] As the Owner has provided evidence of sales of the registered goods in association with the Mark, in the normal course of trade in Canada during the relevant period, by a licensee subject to the requisite control pursuant to section 50(1) of the Act, I am satisfied that the Owner has shown use of the Mark within the meaning of sections 4 and 45 of the Act.

**DISPOSITION**

[13] 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 maintained.

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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:** Gowling WLG (Canada) LLP

**For the Registered Owner:** Marks & Clerk