



LE REGISTRAIRE DES MARQUES DE COMMERCE  
THE REGISTRAR OF TRADE-MARKS

**Citation: 2014 TMOB 238**  
**Date of Decision: 2014-11-03**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by Nelligan O'Brien Payne LLP. against  
registration No. TMA715,008 for the trade-mark  
Estrella's Design in the name of Estrella Enterprises Inc.**

[1] This is a decision involving a summary expungement proceeding with respect to registration No. TMA715,008 for the trade-mark Estrella's Design shown below (the Mark), owned by Estrella Enterprises Inc.

[2] The Mark is registered for use with the following wares and services:

Wares:

Salad dressings, cakes, cheesecakes, breads, deli meats, cooked meats, marinated meats, smoked meats, soups, sandwiches, salads, coffee, soft drinks, cooking oils, vinegars, spreads, seasonings, spices and wines; plastic bags and paper bags, glass and plastic bottles, glass and plastic jars, and wooden and plastic barrels; cups, napkins, tray liners, place mats, labels, ribbons, magazines, menus, brochures, and pamphlets; pants, hats, shirts, shoes, coats, and jackets, briefcases, backpacks, notebooks, cards, and pens, keychains, golf balls, aprons, and dolls, toys, table cloths, flatware, cookware, and knives, neon and pylon signs, decals, and billboards.

Services:

Restaurant, retail sale and wholesale of food and beverage products related to cafe, delicatessen and restaurant services.

[3] On June 15, 2012, at the request of Nelligan O'Brien Payne LLP (the Requesting Party), the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to Estrella Enterprises Inc. (the Registrant). The notice required the Registrant to provide evidence showing that the Mark was in use in Canada, at any time between June 15, 2009 and June 15, 2012 (the relevant period), in association with each of the wares and services specified in the registration. If the Mark had not been so used, the Registrant was required to furnish evidence providing the date when the Mark was last in use and the reasons for the absence of use since that date.

[4] The relevant definitions of use are set out in section 4(1) and 4(2) of the Act as follows:

4(1) A trade-mark is deemed to be used in association with wares if, at the time of the transfer of the property in or possession of the wares, in the normal course of trade, it is marked on the wares themselves or on the packages in which they are distributed or it is in any other manner so associated with the wares that notice of the association is then given to the person to whom the property or possession is transferred.

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

[5] 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 clearing the register of "deadwood". The criteria for establishing use are not demanding and an overabundance of evidence is not necessary. However, sufficient facts must be provided to allow the Registrar to conclude that the trade-mark was used in association with each of the registered wares and/or services listed in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp* (2004), 31 CPR (4th) 270 (FC)]. Furthermore, bare statements of use are insufficient to prove use [see *Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)].

[6] In response to the Registrar's notice, the Registrant provided the affidavit of Michael Estrella, the President of the Registrant, sworn on November 27, 2012. Neither party to the proceeding filed written submissions or requested an oral hearing.

[7] For the reasons that follow, I conclude that the registration ought to be maintained with respect to the services in their entirety; however, I conclude that the registration will be maintained in part with respect to the wares.

### The Evidence

[8] In his affidavit, Mr. Estrella indicates that the Registrant is a restaurant located in Langley, British Columbia. Moreover, at this location, the Registrant offers the retail sale of food and beverage products in the context of café, delicatessen and restaurant services. Mr. Estrella also states that the Registrant provides catering services within the Metro Vancouver area. As per Mr. Estrella's affidavit, I note that my use of the term "the Restaurant" throughout is a collective reference to the Registrant's above-noted business and associated services.

[9] As evidence of use of the Mark, Mr. Estrella attaches Exhibits A through GG. In summary, the relevant exhibits include:

- A printout from the Registrant's website (Exhibit D) and an online order form (Exhibit E), both of which clearly display the Mark. Consistent with these exhibits, Mr. Estrella states that the website provides information to customers regarding the wares and services available in Canada, as well as a means to purchase the wares.
- Photographs of packaging or labelling for wares bearing the Mark identified by Mr. Estrella as representative of salad dressings, cheesecakes and cakes, breads, deli meats, cooked meats, marinated meats, and smoked meats (Exhibits F-K); soups (Exhibit N); salads, vinegars, spreads, seasonings, and spices (Exhibits P-T). In each instance, Mr. Estrella clearly states that the photograph is representative of these packaged/labelled wares which were made and sold every week by the Restaurant or through its website, every year from August 2001 to the date of his affidavit.
- Labels bearing the Mark identified by Mr. Estrella to be representative of the labels "used at the Restaurant" (Exhibit U). Although some labels are generic, most clearly identify specific wares, many of which appear in the above-noted photographs.
- Copies of an invoice/work order and bank deposit for a sale in Canada during the relevant period of cooked meats, marinated meats, and smoked meats (Exhibits L and M), stated by Mr. Estrella to have been packaged with a label bearing the Mark as per Exhibit K. In addition to sales to individual customers, Mr. Estrella states that such meats are sold as whole beef briskets to other restaurants, which is consistent with the sale evidenced in Exhibits L and M.

- A copy of a representative newspaper advertisement dated within the relevant period (Exhibit V). The advertisement clearly displays the Mark, identifies ESTRELLA'S as a deli and café, and indicates the availability of retail sales of food products related to delicatessen services.
- The in-house menu and take-out menu (Exhibit W). I note that the Mark is clearly displayed on the menus.
- Photographs of business signage, a pylon sign, and a business decal displayed on the door to the entrance of the Restaurant (Exhibit X, Exhibit Y, and Exhibit Z). I note that the Mark is clearly displayed on the signage and decal, which Mr. Estrella clearly states were displayed every year from August 2001 to the date of his affidavit.
- Copies of invoices/work orders and deposit slips dated within the relevant period, stated by Mr. Estrella to indicate sales within Canada of sandwiches, salads, cakes and cheesecakes, napkins, soft drinks, bread, restaurant meats, cooked meats, marinated meats, and smoked meats (Exhibits AA, BB, and CC).
- A copy of catering order logs of 2010 and 2011 (Exhibit DD), which show the sale of a variety of food items.
- A sample gift certificate bearing the Mark for the Registrant's restaurant and delicatessen, and a gift certificate log showing gift certificate purchases during the relevant period (Exhibits EE and FF).

### Analysis

#### *Services*

[10] I am satisfied that the Registrant has furnished sufficient evidence to show use of the Mark in association with each of the registered services. The Mark is clearly displayed on signage for the Registrant's restaurant and delicatessen (Exhibits X and Y), on a decal displayed on the entrance to the Registrant's restaurant and delicatessen (Exhibit Z), on the in-house and take-out menus (Exhibit W), on gift certificates (Exhibit EE), and on an advertisement in a Vancouver newspaper for the restaurant and delicatessen (Exhibit V). Furthermore, the Mark appears on the website which Mr. Estrella indicates provides information to customers regarding the services available in Canada (Exhibit D). It is clear the Registrant used the Mark in both the advertisement and the performance of the services during the relevant period.

[11] Accordingly, the registration will be maintained with respect to the services.

## *Wares*

[12] With respect to some wares (in particular, cooking oils, wooden and plastic barrels, brochures, pamphlets, billboards, coffee, soft drinks, plastic and paper bags, cups, napkins, tray liners, place mats, ribbons, pants, hats, shirts, shoes, coats, jackets, briefcases, backpacks, notebooks, cards, pens, keychains, golf balls, aprons, dolls, toys, table cloths, flatware, cookware, knives, wines), there is either no evidence whatsoever, simply a mere statement of use, no evidence that the Mark was associated with such goods at their time of transfer, or a mere statement of intention to use the Mark in association with these wares provided by the Registrant. Moreover, there are no special circumstances which would excuse the absence of use [see *Smart & Biggar v Canada (Attorney General)* (2006) 58 CPR (4th) 42 (FC)]. Consequently, all the aforementioned wares will be deleted from the register.

[13] Although Mr. Estrella provides copies of photographs of glass and plastic bottles, glass and plastic jars, labels, magazines, menus, neon and pylon signs, and decals bearing the Mark (Exhibits F, K, Q, R, S, T, U, V, W, X, Y, Z), there is no evidence that these wares were the subject of a transfer in the normal course of trade.

[14] In *Renaud Cointreau & Cie v Cordon Bleu International Ltd* (1993), 52 CPR (3d) 284 (TMOB) (affirmed by the Federal Court in 188 FTR 29), the Registrar stated the word “trade” in section 4(1) of the Act “contemplates some payment or exchange for the wares supplied or at least that the transfer of the wares be a part of a dealing in the wares for the purpose of acquiring goodwill and profits from the marked goods.” Although Mr. Estrella provides a statement that the Restaurant has sold in Canada glass and plastic bottles and jars, there is no evidence provided by the Registrant that these wares were sold independently from the contents of the glass and plastic bottles and jars. Nor is this a situation in which customers would attribute value to the glass and plastic bottles and jars such that they could be perceived as separate wares from the contents [see *Impenco Ltd v Kabushiki Kaisha Hattori Seiko* (1999), 4 CPR (4th) 374 (FC)].

[15] Accordingly, having regard to the absence of evidence demonstrating that these wares were the subject of a transfer in the normal course of trade as required by section 4(1) of the Act, these wares will also be deleted from the registration.

[16] With respect to the remaining wares (salad dressings, cakes, cheesecakes, breads, deli meats, cooked meats, marinated meats, smoked meats, soups, sandwiches, salads, vinegars, spreads, seasonings, and spices), Mr. Estrella provides consistent sworn statements regarding the appearance of the Mark on the packaging for such goods as well copies of photographs of packaging or labelling on which the Mark is clearly displayed (Exhibits F, G, H, I, J, N, P, Q, R, S, T).

[17] In addition, the invoices provided by the Registrant clearly show sales of a variety of these remaining wares, in the normal course of trade to Canadian purchasers during the relevant period (Exhibits L, AA, and BB). Mr. Estrella provides specific sworn statements indicating when and where these wares were made, packaged and sold by the Registrant, as well as the manner of sale of these wares, i.e. – whether they were sold at the restaurant location, through the website, or through the Registrant’s catering services. Moreover, the catering order logs (Exhibit DD) show an itemized list of wares sold through this service.

[18] Accordingly, having regard to the evidence as a whole, I am satisfied that use of the Mark pursuant to sections 4(1) and 45 has been shown with respect to these remaining wares.

### Disposition

[19] 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 services will be maintained in their entirety; however registration No. TMA715,008 will be amended to delete the following wares from the register:

coffee, soft drinks, cooking oils, wines, plastic bags and paper bags, glass and plastic bottles, glass and plastic jars, wooden and plastic barrels, cups, napkins, tray liners, place mats, labels, ribbons, magazines, menus, brochures, and pamphlets; pants, hats, shirts, shoes, coats, and jackets, briefcases, backpacks, notebooks, cards, and pens, keychains, golf balls, aprons, and dolls, toys, table cloths, flatware, cookware, and knives, neon and pylon signs, decals, and billboards.

[20] Accordingly, the amended statement of wares will read as follows:

Salad dressings, cakes, cheesecakes, breads, deli meats, cooked meats, marinated meats, smoked meats, soups, sandwiches, salads, vinegars, spreads, seasonings, spices.

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Kathryn Barnett  
Hearing Officer  
Trade-marks Opposition Board  
Canadian Intellectual Property Office