



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

Citation: 2014 TMOB 173
Date of Decision: 2014-08-25

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Bereskin & Parr against registration
No. TMA731,893 for the trade-mark TIMMY’S COFFEE
SERVICE in the name of Timmy’s Coffee Service Inc.**

[1] At the request of Bereskin & Parr (the Requesting Party), the Registrar of Trade-marks issued a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) on February 9, 2012 to Timmy’s Coffee Service Inc. (the Owner), the registered owner of registration No. TMA731,893 for the trade-mark TIMMY’S COFFEE SERVICE (the Mark).

[2] The notice required the Owner to furnish evidence showing that the Mark was in use in Canada, in association with each of the wares and services specified in the registration, at any time between February 9, 2009 and February 9, 2012. If the Mark had not been so used, the Owner was required to furnish evidence providing the date when the Mark was last used and the reasons for the absence of use since that date.

[3] The Mark is registered for use in association with “coffee supply services” and the following wares: (1) Coffee, coffee substitutes, mugs, coffee grinders, coffee pots, coffee makers, filters for coffee makers, and dairy creamers; (2) Bakery goods, namely, bread, cakes, muffins, pastries, and pies.

[4] The relevant definitions of use with respect to wares and services are set out in sections 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.

4(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 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)]. Although the threshold for establishing use in these proceedings is quite 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)], sufficient facts must still be provided to permit the Registrar to arrive at a conclusion of use of the trade-mark in association with each of the wares and services specified in the registration during the relevant period. With respect to services, the display of the Mark on advertising is sufficient to meet the requirements of section 4(2) when the trade-mark owner is offering and prepared to perform those services in Canada [*Wenward (Canada) Ltd v Dynaturf Co* (1976), 28 CPR (2d) 20 (TMOB)].

[6] In response to the Registrar's notice, the Owner furnished the affidavit of Mr. Rocco Carone, President of the Owner, sworn on September 7, 2012. Only the Requesting Party filed written representations; an oral hearing was not held.

The Owner's Evidence

[7] In his affidavit, Mr. Carone attests that the Owner began business in 2007 with the intention of selling coffee and providing coffee supply services. He attests that the Owner began advertising its services online and "made sales to local businesses" of "small volumes of coffee". He explains that the Owner later licensed the Mark to the ON-A-BUN restaurant, a business in which Mr. Carone is a "partner". He attests that the Mark is licensed "for the purposes of coffee supply services and for the sale of coffee, tea, and other hot beverages" and that On-A-Bun began using the Mark "on or about December 2011 or January 2012".

[8] In support of his assertion of use of the Mark during the relevant period, Mr. Carone includes eleven exhibits with his affidavit, as follows:

- Exhibit A consists of an undated screenshot from the Owner’s website, *www.timmyscoffee.ca*, which Mr. Carone attests advertised the Owner’s coffee supply services during the relevant period. Mr. Carone explains that the website has been “in this form for several years” and that it has not changed significantly since 2007. The website provides contact information and outlines the coffee services being offered. I note that the Mark is displayed prominently on the page. Also displayed under the heading “Coffee Brands Available” are the logos of four large coffee retailers: Timothy’s, Starbucks, Country Style and Tim Hortons.
- Exhibit B consists of printouts from the CIRA and Networks Solutions ‘whois’ websites that Mr. Carone attests show the creation date of the Owner’s website as being in 2007.
- Exhibit C is a blank invoice which Mr. Carone attests is representative of the invoices that the Owner gave to customers when it provided coffee delivery services and sold coffee-related wares. At the top of this sample invoice is a sticker displaying “Timmy’s Coffee Service Inc.” in a bold font above the Owner’s address and contact information. Mr. Carone attests that this sticker was placed on the invoices given to customers. He explains that the sticker was not placed on the invoices kept for the Owner’s records, as shown in the following exhibits.
- Exhibits D, E, and F are the Owner’s copies of three completed invoices from the relevant period. Mr. Carone attests that the original invoices, which displayed the Mark, were sent to the Owner’s customers, namely Progressive Finishing and Liboys Barber Shop. The invoices show the sale of coffee, coffee pods, creamers, sugar, and sleeves of cups. The invoice at Exhibit E also indicates that a coffee machine was rented out for two months and that free tea samples were provided. Similarly, the invoices at Exhibits D and F indicate that coffee machine rentals and a package of stir sticks were provided at no cost. Again, although these exhibited invoices do not display the Mark, Mr. Carone explains that the customer copies bore the Mark, as shown in Exhibit C.

- Exhibits G, H, and I are photographs that Mr. Carone attests show the On-A-Bun restaurant's above-the-counter menu board. The Mark is displayed on a section of the board next to a list of "hot beverages", including coffee. Mr. Carone attests that the menu board "has been in this form since at least January 2012, and possibly December 2011."
- Exhibit J is a copy of a menu that Mr. Carone attests was also used at On-A-Bun. Similar to the previous exhibit, the Mark is displayed in the "hot beverages" section of the menu. However, Mr. Carone provides no details regarding when or where this menu was displayed to customers.
- Exhibit K is a series of printouts from the On-A-Bun accounting system. These include summaries of sales and "printouts of customers' receipts which show how a receipt would have looked to a customer." The printouts show that at least 200 large sized cups of coffee were sold during the relevant period by On-A-Bun. Such sales were shown on the customer receipts as "LG Timmy's Coffee Service".

Use of the Mark in Association with Coffee Supply Services

[9] The Requesting Party submits that the invoices at Exhibits C through F do not to prove that the Mark was displayed on the invoices provided to customers and that, in any event, the invoices display a trade-name rather than the Mark.

[10] With respect to the first issue, as noted above, I accept Mr. Carone's explanation of the Owner's normal course of trade with regard to the invoices. In particular, I accept that the Owner added a sticker displaying "Timmy's Coffee Service Inc." to those invoices that were given to customers, while keeping plain invoices for its own records. As for whether this constitutes display of the Mark, it has been established that in the context of services, a trade-mark appearing at the top of an invoice is sufficient to show use [see *Tint King of California Inc v Registrar of Trade-marks et al* (2006), 56 CPR (4th) 223 (FC) at paragraph 35].

[11] Furthermore, whether display of a trade-name constitutes trade-mark use depends on the circumstances of each particular case [*Bereskin & Parr v Kleen-Flo Tumbler Industries Ltd*, 2010 CarswellNat 3505 (TMOB) at paragraph 10]. As stated in *Consumers Distributing Co/Cie Distribution aux Consommateurs v Toy World Ltd*, 1990 CarswellNat 1398 (TMOB), "trade-

mark and trade-name usage are not necessarily mutually exclusive” [at paragraph 14]. In this case, I find that customers would perceive “Timmy’s Coffee Service Inc.” as both the business name and as a trade-mark used in association with the “coffee supply services” provided. Indeed, especially in the limited context of this section 45 proceeding, it is hard to conclude that the Owner’s name was not used for the purpose of “distinguishing ... services performed by him from those ... performed by others” within the meaning of “trade-mark” per section 2 of the Act. Therefore, in applying the principles as set out in *Canada (Registrar of Trade Marks) v Cie internationale pour l’informatique CII Honeywell Bull, SA* (1985), 4 CPR (3d) 523 (FCA) and *Promafil Canada Ltée v Munsingwear* (1992), 44 CPR (3d) 59 (FCA), I consider the addition of “Inc.” in this case to be only a minor deviation from the Mark as registered.

[12] In any event, even if the invoices do not demonstrate performance of the services in association with the Mark, they do constitute evidence that the Owner was willing and able to perform the coffee supply services advertised on its website.

[13] However, the Requesting Party submits that “the evidence does not show that the mark as registered has been used” and that customers would view the trade-mark as displayed on the website as the design-mark TIMMY’S rather than the word mark TIMMY’S COFFEE SERVICE. Relying on *Novopharm Ltd v Novo Nordisk A/S* (2005), 41 CPR 4th 188 (TMOB), it further submits that separating words with a trade-mark symbol (TM) can be fatal and that, in this case, the trade-mark symbol separates the word TIMMY’S from COFFEE SERVICE.

[14] While placement of a trade-mark symbol *can* be fatal, I do not find it to be so in this case. Here, the trade-mark symbol does not break up the three words as was the case in *Novopharm*; instead, the symbol appears to the right of all three words that make up the Mark. Furthermore, so long as the trade-mark remains recognizable, word marks are not limited to a particular colour or font [see *Ashenmil v 1161428 Ontario Ltd* (2009) 76 CPR (4th) 471 (TMOB)]. In the present case, the Mark remains recognizable on the website despite the word TIMMY’S appearing in a different font and colour than COFFEE SERVICE.

[15] As such, even if I were not prepared to accept that the invoices given to customers constituted display of the Mark in the performance of the Owner’s coffee supply services, the

invoices do demonstrate that the Owner was able to and did perform the services advertised on the Owner's website in association with the Mark during the relevant period.

[16] In view of the foregoing, I am satisfied that the Owner has demonstrated use of the Mark in association with "coffee supply services" within the meaning of sections 4 and 45 of the Act.

Use of the Mark in Association with the Wares

[17] As noted by the Requesting Party, the Owner has not furnished any evidence with regard to the following wares: coffee substitutes; mugs; coffee grinders; coffee pots; filters for coffee makers; and bakery goods, namely, bread, cakes, muffins, pastries, and pies. Furthermore, as the Owner has not furnished evidence of special circumstances justifying non-use of the Mark, the registration will be amended to delete these wares.

[18] With respect to the remaining wares, namely coffee, coffee makers, and dairy creamers, as noted above, these wares appear on the invoices at Exhibits D, E, and F. Again, I accept the Owner's explanation with respect to the use of stickers to display the Mark on the invoices given to customers. Further, there is also evidence of sales of coffee by the licensee, On-A-Bun, during the relevant period.

[19] However, in contrast to the services discussed above, I agree with the Requesting Party that the invoices do not constitute use of the Mark in association with any of the wares. As the Mark is displayed at the top of the invoice, it is not sufficiently associated with the wares described in the body of the invoice [see *Tint King, supra*]. In this respect, Mr. Carone does not provide sufficient detail regarding the nature of the coffee and other items supplied to conclude that customers would associate the Mark with those wares. The wares may have displayed other trade-marks. Indeed, the Owner's website suggests that the Owner merely supplied the coffee of others (*e.g.* Tim Hortons or Starbucks). As transfers of coffee makers and dairy creamers are only evidenced through these invoices, I find that the Owner has not provided sufficient evidence to show use of the Mark in association with such wares.

[20] With respect to coffee, however, as noted above, Mr. Carone also indicates in his affidavit that the Mark was used in association with the sale of coffee through its licensing

agreement with On-A-Bun. First, I note that the print-outs furnished at Exhibit K are sufficient for me to conclude that coffee was sold by On-A-Bun.

[21] With respect to the licensing agreement, the Requesting Party submits that more than bare assertions are required to show that a licensing agreement exists. It also submits that the corporate structures of On-A-Bun and the Owner are unclear because Mr. Carone described himself merely as a “partner” of the On-A-Bun business. The Requesting Party argues that corporations do not have “partners” and therefore the requisite elements of control are unclear.

[22] However, I note that an owner does not need to show an actual license agreement and instead needs only to show that control was exercised over the character and quality of the wares at issue [see *Wells’ Dairy Inc v UL Canada Inc* (2000), 7 CPR 4th 77 (FCTD)]. The evidence must be considered as a whole [*Kvas Miller Everitt v Compute (Bridgend) Limited* (2005), 47 CPR (4th) 209 (TMOB)] and inferences can be properly drawn from the evidence provided [*Eclipse International Fashions Canada Inc v Shapiro Cohen* (2005) 48 CPR (4th) 223 (FCA)].

[23] While Mr. Carone could have been more precise with his language, his use of the term “partner” should not be read as narrowly or technically as argued by the Requesting Party. In my view, Mr. Carone has sufficiently explained the licensing relationship such that use of the Mark by the On-A-Bun restaurant enures to the benefit of the Owner. Upon review of the affidavit as a whole, it is clear that Mr. Carone is, at a minimum, a controlling mind for both the Owner and On-A-Bun, which is sufficient for this proceeding [see *Petro-Canada v 2946661 Canada Inc* (1998), 83 CPR (3d) 129 (FCTD)].

[24] Similar to its submissions with respect to the Owner’s website, the Requesting Party also argues that the trade-mark as displayed on the On-A-Bun menu board does not show use of the Mark, as a customer would be likely to view TIMMY’S as a stand alone design-mark. As discussed above, word marks are not limited to a particular colour or font so long as the trade-mark remains recognizable, as it does in this case. Further, the positioning of the Mark on the menu board immediately next to the price list for coffee and other “hot beverages” is sufficient to associate the Mark with such wares sold by On-A-Bun.

[25] In any event, I note that the receipt print-outs at Exhibit K, which display the Mark, would also support the conclusion that the Mark was used by On-A-Bun in association with coffee, enuring to the benefit of the Owner. Although the Requesting Party submits that it is generally the practice of coffee shops *not* to provide receipts to customers, I am not prepared to take judicial notice of such an assertion.

[26] In view of the foregoing discussion of the registered wares, I am satisfied that the Owner has demonstrated use of the Mark within the meaning of sections 4 and 45 of the Act in association with the wares “coffee” only.

Disposition

[27] 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 with respect to the services and amended to delete the entirety of wares (2) and the following from wares (1): coffee substitutes, mugs, coffee grinders, coffee pots, coffee makers, filters for coffee makers, and dairy creamers.

[28] The statement of services will be “Coffee supply services” and the amended statement of wares will be “Coffee”.

Andrew Bene
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office