



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

Citation: 2011 TMOB 58
Date of Decision: 2011-03-29

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Cafe Iceberry Co., Ltd. against registration
No. TMA584,310 for the trade-mark ICEBERRY WAVE
in the name of Coca-Cola Ltd.**

[1] On December 19, 2008, at the request of Cafe Iceberry Co., Ltd. (the Requesting Party), the Registrar forwarded a notice pursuant to section 45 of the *Trade-marks Act*, R.C.S. 1985, c. T-13 (the Act) to Coca-Cola Ltd. (the Registrant), the registered owner of the trade-mark ICEBERRY WAVE, registration No. TMA584,310 (the mark).

[2] The trade-mark ICEBERRY WAVE is registered for use in association with the following wares:

(1) Sports beverage, namely non-alcoholic, non-carbonated, fruit-flavoured beverage and preparations for making the same;

and services:

(1) Advertising services, promotional services and marketing services, namely, retail store based advertising programs, retail store and special-event based product sampling programs, product sample distribution programs and coupon programs all related to the distribution and sale of sports beverages.

[3] Section 45 of the Act requires the registered owner of the trade-mark to show whether the trade-mark has been used in Canada in association with each of the wares and/or services listed on 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. Thus, the relevant period in which use must be shown is between December 19, 2005 and December 19, 2008.

[4] What qualifies as use of a trade-mark is defined in s. 4 of the Act, the relevant portions of which are reproduced below:

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] In response to the s. 45 notice, the Registrant furnished the affidavit of Paul Gallagher, the Senior Manager, Dasani, Powerade and Energy of Coca-Cola Ltd. Written representations were filed by both parties; an oral hearing was not requested.

[6] Section 45 proceedings are summary and administrative in nature [see *Saks & Co. v. Canada (Registrar of Trade Marks)* (1989), 24 C.P.R. (3d) 49 (F.C.T.D.) and *Ridout & Maybee LLP v. Omega SA*, 2005 FCA 306, 39 C.P.R. (4th) 261], and the purpose of the proceedings is to remove registrations which have fallen into disuse [*Burke-Robertson v. Carhartt Canada Ltd.* (1994), 82 F.T.R. 55, 56 C.P.R. (3d) 353 (T.D.)], in other words, to remove the “dead-wood” from the register [*Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289]. In *Performance Apparel Corp. v. Uvex Toko Canada Ltd.*, 2004 FC 448, 31 C.P.R. (4th) 270 (*Performance Apparel*), Justice Russell speaks of the balance between evidentiary overkill and the statutory requirement to show use such that the Registrar is able to form an opinion on the “use” within the context of s. 45. The burden of proof is not a heavy one and no specific type of evidence is required [*Cinnabon v. Yoo-hoo of Florida Corp.* (1998), 82 C.P.R. (3d) 513 and *Philip Morris Inc. v. Imperial Tobacco Ltd.* (1987), 13 C.P.R. (3d) 289]. An affidavit must contain a clear statement of use for the relevant period in association with each of the wares and must provide sufficient facts to permit the Registrar to conclude that the trade-mark is in use in association with each ware [*Performance Apparel*].

[7] Mr. Gallagher's affidavit states that Coca-Cola has used the ICEBERRY WAVE trade-mark by itself or through its licensees, in the normal course of trade, in association with the wares during the Relevant Period. According to Mr. Gallagher, the normal course of trade for the Registrant constitutes the production and/or distribution of the wares by the Coca-Cola Bottling Company (CCBC) under license from the Registrant. This is sufficient to establish the existence of a licence [see *Nissan v. MAAX Canada Inc.* (2007), 65 C.P.R. (4th) 99 (T.M.O.B.)]. Mr. Gallagher describes the terms of the licence:

CCBC is licensed by [the Registrant] to prepare ICEBERRY WAVE Products in accordance with specifications and instructions furnished by [the Registrant]. All use of [the mark] by CCBC is subject to strict control of [the Registrant] with respect to the character and quality of the Wares. I have knowledge of these quality policies, which regulate and define specific levels of performance that must be met by CCBC in the manufacture, distribution and sale of the Wares. Such standards include quality auditors who conduct and monitor external and internal auditing programs, ensuring conformance to manufacturing and distribution policy, as well as standards for concentrate, syrup and finished product. Random testing of product samples is conducted on a monthly basis.

From this description, it is clear that the requirement that the Registrant maintains control over the character and quality of the wares bearing the mark is satisfied [*Mantha & Associés/Associates v. Central Transport Inc.* (1995), 64 C.P.R. (3d) 354 (F.C.A.)]. I am satisfied as to the existence of a licence and that the use of the mark by CCBC is use which is in conformity with s. 50(1) of the Act and as such enures to the Registrant.

[8] Mr. Gallagher's affidavit attaches labels for sports beverage products; the mark appears clearly on the labels. Mr Gallagher states that the labels are "representative of the manner in which [the mark] was used in Canada on ICEBERRY WAVE Products, in the normal course of trade, during the Relevant Period." Eleven invoices from July 2008 are provided to demonstrate sales of the wares (listed as ICEBRY WV) to distributors in Canada. Canadian sales data for the years 2006 through 2008 is provided and it appears that sales in Canada for the relevant period numbered over 700,000 cases (of 12 units each). Upon reviewing this evidence, I am satisfied that use of the mark in Canada has been shown in association with the wares: "Sports beverage, namely non-alcoholic, non-carbonated, fruit-flavoured beverage" for the relevant period.

[9] The entirety of the evidence demonstrating use relates exclusively to sports beverage products. No evidence which would allow the Registrar to make a conclusion of use of the mark

on the wares “preparations for making [sports beverages]” is advanced in Mr. Gallagher’s affidavit. Nor were any arguments in this regard advanced in the written representations. In light of the above, I am not able to conclude that use of the mark in association with this ware has been shown.

[10] Mr. Gallagher’s affidavit provides no evidence which would allow the Registrar to conclude that the mark was used in Canada in association with the registered services for the relevant period. No claims to the use of the mark with respect to the registered services are advanced in the written representations submitted on behalf of the Registrant.

[11] Having regard to the evidence as a whole, I am satisfied that there was use of the mark within the meaning of s. 45 and 4(1) of the Act in association with the wares: “Sports beverage, namely non-alcoholic, non-carbonated, fruit-flavoured beverage”. I am not prepared to conclude that use of the mark in association with “preparations for making the same” has been shown. Likewise, I am not prepared to conclude that use of the mark in association with the registered services has been shown. Special circumstances have not been advanced to excuse such non-use.

[12] In view of all of the foregoing, pursuant to the authority delegated to me under s. 63(3) of the Act, and in compliance with the provisions of s. 45 of the Act, the registration will be amended to delete the following wares: “and preparations for making the same” as well as the services in their entirety: “advertising services, promotional services and marketing services, namely, retail store based advertising programs, retail store and special-event based product sampling programs, product sample distribution programs and coupon programs all related to the distribution and sale of sports beverages”.

P. Heidi Sprung
Member, Trade-marks Opposition Board
Canadian Intellectual Property Office