



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

Citation: 2016 TMOB 146
Date of Decision: 2016-08-25

IN THE MATTER OF A SECTION 45 PROCEEDING

BCF S.E.N.C.R.L./BCF LLP

Requesting Party

and

LULU ISLAND WINERY

Registered Owner

**TMA799,407 for CHINA HOUSE LULU
ISLAND WINERY**

Registration

[1] This decision pertains to a summary expungement proceeding with respect to registration No. TMA799,407 for the trade-mark CHINA HOUSE LULU ISLAND WINERY (the Mark), owned by Lulu Island Winery (the Owner).

[2] The Mark is registered in association with the following goods and services:

Goods: (1) Wine, wine boxes, corkscrews, corks, wine glasses, goblets, decanters, pitchers, carafes, wine bottles, pouring tips, bottle stoppers, dessert glasses. (2) T-shirts, aprons, shoes, sweatshirts, long-sleeve shirts, golf shirts, jackets, ties, baseball caps, hats, shorts, pants, socks, scarves, bandannas. (3) Lapel pins, rings, earrings (4) Wine charts, namely aroma wheels (5) Journals, phone books, cook books, wine guides, wine checklists, calendars, business cards. (6) House wares, namely bowls, coolers, cups, dishes, plates, platters, pitchers, three tiered servers, oil and vinegar stands, cutting boards, napkins, table cloths, picnic napsacks. (7) wine nitrogen preservers, wine tasting kits, thermometers, wine bottle carriers, wine cooler bags, wine attache bags. (8) Kitchenwares and utensils namely wine bottle holders, funnels, filter pourers, stoppers, trays, spoon rests, stand, drip receptacles, foil cutters, coasters, trivets, decorative accessories, namely bells, plaques, glass bead ornaments, bird houses, candles,

hand painted candles, oil, wick candles, candle holders, candlebras, wine bottle decanting candles, vases, picture frames, stands, lamps. (9) Greeting cards, post cards, posters, shelf talkers

Services: (1) Operation of a winery and retail store, the sale of wine, wine related accessories, namely cork screw removers, bottle stoppers, pouring tips and ice buckets, glassware, namely wine glasses, grappa glasses, dessert glasses and decanters, home kitchen decorations, namely fancy vinegar oil bottles and fancy chili pepper bottles, home bath decorations, namely scented candles and fancy bath oils.

[3] For the reasons that follow, I conclude that the registration ought to be amended to delete all of the registered goods other than “wine”, and all of the registered services.

The Proceeding

[4] On February 5, 2015, the Registrar of Trade-marks sent a notice under section 45 of the *Trade-marks Act* RSC 1985, c T-13 (the Act) to the Owner. The notice was sent at the request of BCF S.E.N.C.R.L./BCF LLP (the Requesting Party).

[5] The notice required the Owner to furnish evidence showing that it had used the Mark in Canada, at any time between February 5, 2012 and February 5, 2015 (the Relevant Period), with respect to each of the goods and services specified in registration No. TMA799,407. 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.

[6] The relevant definition of “use” in association with goods is set out in section 4(1) of the Act as follows:

4(1) A trade-mark 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.

[7] The use of a trade-mark in association with services is governed by section 4(2) of the Act, which provides that a trade-mark is used in association with services if it is used or displayed in the performance or advertising of those services.

[8] In response to the Registrar's notice, the Owner furnished the affidavit of John Chung Nan Chang, sworn on April 28, 2015.

[9] Only the Requesting Party filed written representations; a hearing was not requested.

[10] 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. The criteria for establishing use are not demanding and an overabundance of evidence is unnecessary. Nevertheless, sufficient facts must be presented to allow the Registrar to conclude that the Mark was used in association with each of the goods and services specified in the registration at any time during the Relevant Period [see *Performance Apparel Corp v Uvex Toko Canada Ltd*, 2004 FC 448, 31 CPR (4th) 270]. Mere statements of use are insufficient to prove use of the Mark [see *Aerosol Fillers Inc v Plough (Canada) Ltd* (1980), 53 CPR (2d) 62 (FCA)].

The Owner's Evidence

[11] Mr. Chang states that he is the founder and President of Lulu Island Winery Ltd. (subsequently referred to in his affidavit as the "Company") and the owner of registration No. TMA799,407 for the Mark [para 1 of the affidavit].

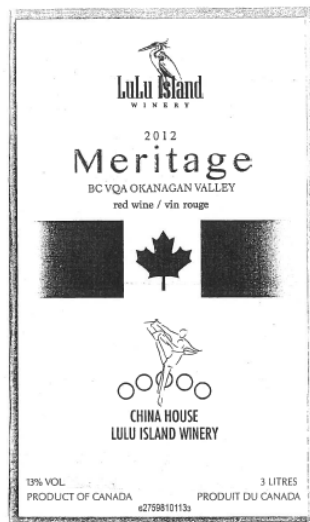
[12] Mr. Chang states that he has been the President and director of the Company since 2007 and has operated a winery called "Lulu Island Winery" for over eight years. He asserts that the winery is open to the public to sell and taste various varietals of wine produced by Lulu Island Winery [paras 2 to 4 of the affidavit].

[13] Mr. Chang asserts that the Company was incorporated on March 16, 2007 under the laws of British Columbia. He provides a copy of the Certificate of Incorporation, as Exhibit A to his affidavit [para 5 of the affidavit].

[14] In paragraph 6 of his affidavit, Mr. Chang asserts that he is aware that the application for the Mark was filed in the name of "Lulu Island Winery". He goes on to state: "I will be amending the name of the Registrant to include the corporate designation. Therefore, the owner of the [Mark] is 'Lulu Island Winery Ltd.'"

[15] Mr. Chang asserts that the Company operates a winery located in Richmond, British Columbia, and has been selling wine in association with the Mark. The wines, including red and white table wines, fruit wines and icewines, branded with the Mark are produced on site at Lulu Island Winery using grapes from the Okanagan and the Fraser Valley; they are sold over the counter at Lulu Island Winery. Mr. Chang provides a copy of the “Liquor Control and Licensing Branch Distillery License”, as Exhibit B to his affidavit [paras 8 to 10 of affidavit]. I note that the license has been issued to the Company.

[16] Mr. Chang asserts that the Mark is prominently displayed on labels affixed to the bottles of wine. He provides a copy of a label, which I reproduce below, as Exhibit D to his affidavit. He asserts that the label is used and has been used during the Relevant Period [para 13 of the affidavit].



[17] I note that Exhibit D also includes a photograph of a bottle of wine bearing the label.

[18] Mr. Chang provides copies of “Liquor Distribution Branch order forms” dated within the Relevant Period, as Exhibit E to his affidavit. He asserts that these show the quantity, unit selling price and stock number of “meritage” wine sold under the Mark. Mr. Chang explains that all wines sold under the varietal name “meritage” are CHINA HOUSE LULU ISLAND WINERY wines [paras 14 and 15 of the affidavit].

[19] Mr. Chang provides copies of “CSA Store Markups from the Liquor Distribution Branch” dated within the Relevant Period, as Exhibit F to his affidavit. Mr. Chang explains that this documentation identifies a universal product code (UPC) that corresponds and is found at the bottom of the label affixed to the bottle of CHINA HOUSE LULU ISLAND WINERY wine [paragraph 16 of the affidavit]. I have confirmed that the UPC shown on the above-reproduced label is listed on the CSA Store Markups.

Preliminary Remarks

[20] There is no indication in the record that the register has been amended to reflect Lulu Island Winery *Ltd.* as the name of the owner of registration No. TMA799,407.

[21] Based on a fair reading of the affidavit as a whole, I conclude that “Lulu Island Winery” is merely the trade name under which Lulu Island Winery Ltd. does business. Noting that the Requesting Party made no submissions in this respect, for the purposes of the present proceeding, I accept that any demonstrated use of the Mark is that of the Owner.

Analysis - Goods

[22] Based on my reading of its written representations, the Requesting Party seems to acknowledge that the Owner has provided sufficient evidence to allow the Registrar to conclude that the Mark was used in association with “wine” during the Relevant Period.

[23] Indeed, the evidence in this case shows the Mark displayed on a label affixed to bottle of wines (Exhibit D) and Mr. Chang affirms that this label was used on bottles of wines during the Relevant Period.

[24] Furthermore, I am satisfied that the order forms and CSA Store Markups (Exhibits E and F) provide sufficient evidence of transfers of wine bearing the Mark in the normal course of trade in Canada. In reaching this conclusion, I am mindful of Mr. Chang’s assertion that all wines sold under the varietal name “meritage” are CHINA HOUSE LULU ISLAND WINERY wines.

[25] As such, I am satisfied that the affidavit of Mr. Chan sets out sufficient facts to demonstrate use of the Mark, within the meaning of sections 4(1) and 45 of the Act, in association with “wine”.

[26] However, I am not satisfied that the affidavit of Mr. Chan demonstrates use of the Mark, in association with any of the other registered goods, within the meaning of sections 4 and 45 of the Act.

[27] In the absence of representations from the Owner, suffice it to say that I agree with the Requesting Party that the affidavit is completely silent concerning the use of the Mark in association with any registered goods other than “wine”. Furthermore, there is no evidence of special circumstances excusing the non-use of the Mark in association with such goods during the Relevant Period.

[28] Accordingly, the registered goods other than “wine” will be deleted from the statement of goods of the registration.

Analysis – Services

[29] Similarly, absent representations from the Owner, I agree with the Requesting Party that there is not any evidence showing use of the Mark in association with the registered services within the meaning of sections 4(2) and 45 of the Act.

[30] Indeed, Mr. Chang does not reference use of the Mark in association with the registered services, nor does he provide any facts for me to conclude that the Mark was used in association with the registered services during the Relevant Period. Furthermore, there is no evidence of special circumstances excusing the non-use of the Mark in association with the registered services during the Relevant Period.

[31] Accordingly, the statement of services will be deleted from the registration.

Disposition

[32] Pursuant to the authority delegated to me under section 63(3) of the Act, registration No. TMA799,407 will be amended to delete all of the registered goods other than “wine”, and all of the registered services, in compliance with the provisions of section 45 of the Act.

[33] Accordingly, the amended statement of goods will read: “Wine.”

Céline Tremblay
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

**TRADE-MARKS OPPOSITION BOARD
CANADIAN INTELLECTUAL PROPERTY OFFICE
APPEARANCES AND AGENTS OF RECORD**

HEARING DATE: No Hearing Held

AGENTS OF RECORD

Fasken Martineau Dumoulin LLP

For the Registered Owner

BCF S.E.N.C.R.L./BCF LLP

For the Requesting Party