



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

Citation: 2010 TMOB 92
Date of Decision: 2010-06-23

**IN THE MATTER OF A SECTION 45 PROCEEDING
requested by Ridout & Maybee LLP against registration
No. TMA634,505 for the trade-mark CELEBRATION
DEL MONDO in the name of Les Produits Paklab
Inc./Paklab Products Inc.**

[1] At the request of Ridout & Maybee LLP (the requesting party), the Registrar of Trade-marks forwarded a notice under s. 45 of the *Trade-marks Act* R.S.C. 1985, c. T-13 (the Act) on April 24, 2008 to Les Produits Paklab Inc./Paklab Products Inc. (the registrant), the registered owner of the above-referenced trade-mark.

[2] The trade-mark CELEBRATION DEL MONDO (the Mark) is registered for use in association with “winemaking kits” (the registered wares).

[3] Section 45 of the Act requires the registered owner to show whether the trade-mark has been used in Canada in association with each of the wares or services 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 such use since that date. In this case, the relevant period for showing use is any time between April 24, 2005 and April 24, 2008 (the relevant period).

[4] “Use” in association with wares is set out in s. 4(1) and (3) of the Act:

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.

[...]

(3) A trade-mark that is marked in Canada on wares or on the packages in which they are contained is, when the wares are exported from Canada, deemed to be used in Canada in association with those wares.

In this case, s. 4(1) applies.

[5] In response to the Registrar's notice, the registrant furnished the statutory declaration of Maurizia Mariani sworn on June 3, 2008, together with Exhibits "1" through "5". Ms. Mariani states that she is a director of the registrant. Neither party filed written submissions; an oral hearing was not requested.

[6] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of s. 45 proceedings [*Plough (Canada) Ltd v. Aerosol Fillers Inc.* (1980), 53 C.P.R. (2d) 62 (F.C.A.)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd. v. Lang Michener* (1996), 71 C.P.R. (3d) 477 (F.C.T.D.) at 480], and evidentiary overkill is not required [*Union Electric Supply Co. Ltd. v. Registrar of Trade Marks* (1982), 63 C.P.R. (2d) 56 (F.C.T.D.)], 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 or services specified in the registration during the relevant period. In addition, the entire burden is with the registrant [*88766 Inc. v. George Weston Ltd.* (1987), 15 C.P.R. (3d) 260 (F.C.T.D.)] and any ambiguities in the evidence are to be interpreted against the registrant [*Plough (Canada) Ltd. v. Aerosol Fillers Inc., supra*].

[7] At the outset of her statutory declaration, Ms. Mariani states that the registrant is in the business of selling winemaking kits and has been carrying on business in Canada since 1975; it has done so under the name of "Advintage Distribution" since 2002. In support, a print-out from Le Registraire des entreprises CIDREQ database dated May 16, 2008 showing a list of the registrant's business names registered in Quebec, including "Advintage Distribution", is attached as Exhibit "1". Consequently, I am prepared to accept any mention of "Advintage Distribution" in the evidence as a reference to the registrant.

[8] With respect to the registrant's normal course of trade and its sale of the registered wares, Ms. Mariani provides that the registrant has been selling winemaking kits bearing the Mark to retailers across Canada *within the last three years*. In support, the affiant attaches a copy of an undated brochure given to retailers for publicity purposes, an extract of the registrant's undated *current* catalogue of winemaking kits *currently* available for purchase, and a copy of a blank order form revised in November 2006 as Exhibits "2", "3" and "4"; I note that the Mark appears on all the documents in reference to winemaking kits. In addition, a copy of a heavily redacted invoice prepared by Advintage Distribution after the relevant period, namely on May 27, 2008, for various winemaking kits is produced as Exhibit "5". According to Ms. Mariani, the invoice shows that "winemaking kits bearing [the Mark] have been sold in Canada *within the last three years*" [emphasis added]. I would point out that all of the customer's information (including the billing and shipping addresses) has been removed from the invoice; there is also no indication that the transaction was made in Canadian dollars or that a G.S.T. or a P.S.T. amount has been charged.

[9] Having reviewed the evidence, I am unable to conclude that winemaking kits were sold in Canada within the relevant period for the following reasons. Even though the Mark can be clearly seen in a photograph of a winemaking kit in the attached brochure, it is well established that evidence of advertising is generally not sufficient as evidence of use for wares [see *BMW Canada Inc. v. Nissan Canada Inc.* (2007), 60 C.P.R. (4th) 181 (F.C.A.)]. Similarly, in the case of the catalogue and the order form, while these publications support Ms. Mariani's assertions that winemaking kits bearing the Mark are available for purchase in the normal course of trade, they do not evidence the transfer of the registered wares *per se*.

[10] More importantly, when the brochure and the catalogue are viewed in conjunction with Ms. Mariani's statements, it is unclear whether they were distributed during the relevant period or alternatively, whether they are representative of those distributed in that same period of time. In that regard, with respect to the catalogue, Ms. Mariani consistently refers to it as a list of winemaking kits that are *currently* available for purchase, not one that was given or representative of one that was given to customers during the relevant period.

[11] Such ambiguity persists in Ms. Mariani's discussion of the registrant's sales of the winemaking kits and the attached invoice. She made several general statements pertaining to the registrant's *current* business practices and sales that took place sometime *within the last three years*, without making a clear connection with the sales of the registered wares during the relevant period. In fact, on a fair reading of the statutory declaration in conjunction with the only documentary evidence produced in this respect, namely a copy of an invoice that was issued shortly after the relevant period, it would appear that Ms. Mariani's use of the term *within the last three years* encompasses a period of time that is subsequent to the relevant period. Furthermore, nothing suggests that the exhibit is representative of transactions that took place during the relevant period or that the sales transaction for the winemaking kits documented in this particular invoice actually took place sometime within the relevant period, in line with the principle of continuity of use [see *Boutique Progolff Inc. v. Marks & Clerk* (1993), 54 C.P.R. (3d) 451 (F.C.A.)].

[12] While there is no one particular type of evidence required in s. 45 proceedings [*Lewis Thomson & Sons Ltd. v. Rogers, Bereskin & Parr* (1988), 21 C.P.R. (3d) 483 (F.C.T.D.)] and evidence of a single sale in the normal course of trade may be sufficient to show use of a trademark [*Philip Morris Inc. v. Imperial Tobacco Ltd. et al.* (1987), 13 C.P.R. (3d) 289 (F.C.T.D.)], there must be sufficient facts presented to allow the Registrar to reasonably infer that the wares were sold in the normal course of trade in Canada within the relevant period. In the present case, Ms. Mariani repeatedly discusses the registrant's business in an elusive timeframe by using such terms as "currently" and "within the last three years", suggesting that her statements are not confined to the relevant period in question. In support of these ambiguous statements, she produces exhibits that are either undated or subsequent to the relevant period without indicating whether these documents are representative of the registrant's business activities during the relevant period. As for the blank order form, the only document with a date that falls within the relevant period, it does not evidence actual sales. No other information that points to the sales of the registered wares during the relevant period (such as sales figures) is provided. While it might appear that winemaking kits were sold shortly after the end of the relevant period, the evidence fails to address the registrant's sales during the relevant period. When the evidence is viewed in its entirety, given the ambiguity in Ms. Mariani's statutory declaration and the lack of pertinent

supporting documentary evidence, I am unable to infer that winemaking kits bearing the Mark were actually sold in the normal course of trade in Canada *during the relevant period*.

[13] As I have concluded that the registrant failed to establish the sale of the winemaking kits in the normal course of trade in Canada during the relevant period, I need not decide whether the registrant provided sufficient evidence regarding the manner in which the trade-mark has been associated with the registered wares during the relevant period.

[14] In view of the foregoing, and considering that no special circumstances excusing the absence of use of the Mark during the relevant period were advanced in this case, pursuant to the authority delegated to me under s. 63(3) of the Act, it is my conclusion that registration No. TMA634,505 for the trade-mark CELEBRATION DEL MONDO ought to be expunged from the Register for failure to show use in compliance with the provisions of s. 45 of the Act.

P. Fung
Hearing Officer
Trade-marks Opposition Board
Canadian Intellectual Property Office