



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

Citation: 2016 TMOB 6
Date of Decision: 2016-01-14

IN THE MATTER OF A SECTION 45 PROCEEDING

Julia Wine Inc.

Requesting Party

and

Stentiford Pty Ltd.

Registered Owner

TMA752,995 for the trade-mark OLIVIA

Registration

[1] At the request of Julia Wine Inc. (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 January 3, 2014 to Estate Licencing Pty Ltd (Estate), the registered owner of record at the time of registration No. TMA752,995 for the trade-mark OLIVIA (the Mark).

[2] The Mark is registered for use in association with wines (the Goods).

[3] The notice required the owner to furnish evidence showing that the Mark was in use in Canada, in association with the Goods, at any time between January 3, 2011 and January 3, 2014 (the Relevant Period). 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.

[4] The relevant definition of use with respect to 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.

[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 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 goods and services specified in the registration during the relevant period [see *Uvex Toko Canada Ltd v Performance Apparel Corp*, 2004 FC 448, 31 CPR (4th) 270]. Evidence of a single commercial sale can be sufficient to establish use of the trade-mark [see *Philip Morris Inc v Imperial Tobacco Ltd* 1987 CarswellNat 607, 13 CPR (3d) 289 (FCTD)].

[6] It should be noted that Estate executed an assignment of trade-mark rights in the Mark in favour of Stentiford Pty Ltd. (Stentiford) (Estate and Stentiford will be collectively referred to as the Owner), effective May 11, 2013, which was recorded on the register on August 1, 2014. The assignment of the Mark is not at issue.

[7] In response to the Registrar's notice, the Owner furnished the statutory declaration of Gavin James Lyell Hogg. Neither parties filed written representations, nor requested a hearing.

The Owner's Evidence

[8] I will only refer to what I consider the most pertinent portion of Mr. Hogg's statutory declaration and the Exhibits referred thereto. I wish to point out that numerous documents attached to Mr. Hogg's statutory declaration are invoices or reconciliation statements dated prior to the Relevant Period [see Exhibit GH-7].

[9] Mr. Hogg has been a wine maker with over 20 years' experience in the Australian wine industry. He is a director, officer and owner of Stentiford and prior to May 11, 2013, he was also a director, officer and owner of Estate. He explains that Kopparossa Wines is generally used as a trade name by and for Stentiford. He provides some general corporate information concerning Estate and Stentiford and the relationship that existed between them prior to May 12, 2013.

[10] Mr. Hogg attests that up until May 11, 2013, Estate was the corporate entity that was used to own registered intellectual property, including the Mark. Also, Estate and Stentiford essentially had an unwritten agreement whereby Estate authorized Stentiford to use the Mark on wine globally, for wine produced under his oversight in his capacity as director of Stentiford. It was then decided in early 2013 that Stentiford would simply take over the ownership of the Mark itself.

[11] Mr. Hogg states that the delay between the actual assignment of the Mark and its recordal on the register, from Estate to Stentiford, was due to a miscommunication, as the trade-mark counsel was not instructed to record the transfer until 2014.

[12] Mr. Hogg states that the Mark has been used in association with the Goods in Canada since at least November 2009 and continuous sales have been made since that time, including during the Relevant Period. He filed as Exhibit GH-3 photocopies of labels and illustrations of bottles bearing the Mark.

[13] Mr. Hogg explains that the Goods are labelled in Australia and primarily imported to Canada and sold in Canada through Advintage Brands Inc. (Advintage), an import agency

company located in Calgary, Alberta. Advintage uses the export services provided by APW International Pty Ltd. (APW) to import the Goods in Canada for resale.

[14] Mr. Hogg filed, as part of Exhibit GH-4, extracts captured from the Internet Archive ‘Wayback Machine’ of the Advintage website, as of 28 July 2013, located at *www.advintagebrands.com*, which demonstrates that it did offer for sale the Goods bearing the Mark. He also filed as Exhibit GH-5, examples of promotional material associated with the Goods bearing the Mark including wine clearance specials and price lists provided by Advintage dated August 2013, October 2013 and November 2013.

[15] Finally, Mr. Hogg filed as Exhibit GH-7, examples of business records from the exporter, APW, namely wholesale invoices and reconciliation statements from 2006-2013 demonstrating sales of the Goods in association with the Mark, wherein Goods were received by Advintage in Alberta, Canada.

[16] Part of Exhibit GH-7 is an invoice dated June 28, 2013 for the sale of 192 cases (12 bottles each) of Goods to Advintage and delivered to the Alberta Liquor and Gaming Commission.

Analysis of the evidence

[17] Mr. Hogg has provided pictures of bottles of wine bearing the Mark. He has stated that the labels bearing the Mark are affixed to the bottles prior to being shipped from Australia to Canada. He has explained in detail the chain of transfer of property of the Goods from the Owner to a Canadian importer, namely, Advintage. He has provided proof of transfer of property, from the Owner to Advintage, of the Goods labelled with the Mark during the Relevant Period. Although such sale was made ‘F.O.B. Adelaide’, as stated in *Sim & McBurney v Przedsiębiorstwo Handlu Zagranicznego Argos* 2001 CarswellNat 3622,20 CPR (4th) 360, once the Goods bearing the Mark are received by Advintage in Canada, this constitutes use within the meaning of section 4(1) of the Act , as part of the chain took place in Canada.

[18] In all, I am satisfied that the Owner has shown use of the Mark in Canada in association with the Goods during the Relevant Period within the meaning of section 4(1) of the Act.

Disposition

[19] Pursuant to the authority delegated to me under section 63(3) of the Act, registration TMA752,955 will be maintained in compliance with the provisions of section 45 of the Act.

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Jean Carrière
Member
Trade-marks Opposition Board
Canadian Intellectual Property Office

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

No hearing held.

Agents of Record

Macpherson Leslie & Tyerman LLP

For the Registered Owner

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For the Requesting Party