

SECTION 45 PROCEEDINGS
TRADE-MARK: SHAKERS CLASSIC COCKTAILS
REGISTRATION NO: TMA 537,167

On September 13, 2005, at the request of Boughton Law Corporation (the “requesting party”), the Registrar forwarded a notice under section 45 of the *Trade-marks Act* to Kittling Ridge Ltd., the registered owner of the above referenced trade-mark (the “registrant”).

The trade-mark SHAKERS CLASSIC COCKTAILS is registered for use in association with the wares:

“Distilled alcoholic beverages, namely vodka and/or rum based cocktails”.

Section 45 of the *Trade-marks Act*, R.S.C. 1985, c. T-13, 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. In this case, the relevant period for showing use is any time between September 13, 2002 and September 13, 2005.

“Use” in association with wares is set out in subsection 4(1) of the *Trade-marks Act*:

A trade-mark is deemed to have been 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.

Special provisions relating to the export of wares are contained in subsection 4(3) of the *Act* and do not apply in the present proceedings.

In response to the Registrar's notice, the affidavit of John Hall, President and CEO of Kittling Ridge Ltd., together with exhibits was furnished. The registrant filed written submissions; an oral hearing was not held in this case.

In the affidavit, Mr. Hall states that as the President and CEO of Kittling Ridge, he has personal knowledge of the sales, marketing, distribution and promotional history of the registrant; in the normal course of trade Kittling Ridge markets, promotes, distributes and sells the subject wares in Canada.

Exhibit A consists of photographs of the front and back of a bottle of Pina Colada and of a bottle of Strawberry Daquiri; the subject trade-mark appears clearly on the neck label and the main label affixed to the bottles. The main label of each bottle also contains other reading material including the words "RUM COCKTAIL AU RHUM". Exhibit C consists of photographs of boxes in which the wares are shipped; the subject trade-mark is displayed on the side of the box. Mr. Hall states that wares as shown in Exhibit A were sold continuously in Canada during the relevant period, packed in boxes as depicted in Exhibit C.

With respect to the trade-mark as used on the labels and the packaging, I note that in the trade-mark as used the word "CLASSIC" appears above the two words "SHAKERS COCKTAILS". It is therefore possible that some might read the mark as CLASSIC SHAKERS COCKTAILS; however, overall I do not find that the mark as used differs substantially from the mark as registered. I find that the dominant features have been preserved and that the mark as used remains recognizable as the registered trade-mark *per se* (*Canada (Registrar of Trade-marks) v. Cie International pour l'informatique CII Honeywell Bull* (1985), 4 C.P.R. (3d) 523 at 525 (F.C.A); *Promafil Canada Ltée v. Munsingwear Inc.*, 44 C.P.R. (3d) at 59 (FCA)).

In his affidavit Mr. Hall asserts use of the subject trade-mark throughout the relevant period and attaches, as Exhibit B, copies of sales documents for a shipment of the subject wares to the Liquor Control Board of Ontario ("LCBO") in 2003. These documents

include a purchase order from the LCBO dated April 30, 2003; the corresponding invoice from the registrant to the LCBO and the packing list - both dated May 5, 2003; and a Short Shipment Notification dated May 2, 2003. I note that all of these documents list Shakers Pina Colada and Shakers Strawberry Daquiri, and that on this occasion 328 cases were sold by the registrant; all of these documents are dated within the relevant period. It appears on a fair reading of the affidavit as a whole, taking into consideration the affiant's assertion of continuous use during the relevant period, that these documents evidence but one example of regular sales by the registrant of the subject wares to the LCBO during the relevant period.

To show "use", evidence of a single sale is sufficient as long as it does not appear to be contrived (*Phillip Morris Inc v. Imperial Tobacco Ltd. et al.*, 17 C.P.R. (3d) 237). Although the evidence is not overwhelming in this case, it does not appear to be contrived and I conclude that the registrant has used the mark SHAKERS CLASSIC COCKTAILS in the normal course of trade for "rum based cocktails".

With respect to the wording of the statement of wares as "vodka and/or rum based cocktails", I note that although the conjunctive "and" is present (which might require evidence of use on both vodka and rum based cocktails - see *John Labatt Ltd. v. Rainier Brewing Co.* (1984), 80 C.P.R. (2d) 228 (F.C.A.)), the disjunctive "or" is also used. This issue is similar to the one in *LIDL Stiftung & Co. KG v. Joseph Rutigliano & Sons, Inc.* (unreported) (December 2, 2005; TMA 492,874 BARESI). In that case, evidence of the use of the mark in association with "canned olives" was sufficient to maintain "canned or processed olives". In arriving at this conclusion, Hearing Officer Bradbury commented that while it is unusual for wares to be listed in this manner [i.e. disjunctively], it was presumably accepted because "olives"[by itself] is a sufficiently specific ordinary commercial term. Similarly, in the current case, presumably the wares as described with "and/or" were accepted since "distilled alcoholic beverages, namely cocktails" [by itself] is a sufficiently specific ordinary commercial term. Consequently, I conclude that showing use of the mark in association with either "vodka based cocktails" or "rum based

cocktails” is sufficient to maintain the entire phrase “distilled alcoholic beverages, namely vodka and/or rum based cocktails” on the Register.

In view of the foregoing, I am satisfied that there was use of the subject trade-mark within the meaning of section 45 and subsection 4(1) of the Act. Accordingly, TMA 537,167 for SHAKERS CLASSIC COCKTAILS will be maintained on the Register in compliance with the provisions of subsection 45(5) of the *Trade-marks Act*, R.S.C. 1985, c. T-13.

DATED AT GATINEAU, QUEBEC, THIS 6th DAY OF DECEMBER 2007.

P. Heidi Sprung

Member, Trade-marks Opposition Board