



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

**Citation: 2013 TMOB 137**  
**Date of Decision: 2013-08-27**

**IN THE MATTER OF A SECTION 45 PROCEEDING  
requested by McMillan LLP against registration  
No. TMA280,831 for the trade-mark OLD TYME  
JAMAICAN in the name of Good-O Beverage Company**

[1] At the request of McMillan LLP (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 12, 2011 to Chatham Imports, Inc, the former owner of registration No. TMA280,831 for the trade-mark OLD TYME JAMAICAN (the Mark). The registration for the Mark was assigned to Good-O Beverage Company (the Registrant) with an effective date of April 7, 2003. Thus, I am satisfied that the Registrant was the owner of the Mark during the Relevant Period.

[2] The Mark is registered for use in association with the wares “ginger beer; sodas including, sorrel, cola champagne and cream soda; jams and hot sauces”.

[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 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 between January 12, 2008 and January 12, 2011.

[4] For the purposes of this decision, the relevant definition of “use” is set out in section 4(1) 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.

[5] It is well established that mere assertions of use are not sufficient to demonstrate use in the context of a section 45 proceeding [*Plough (Canada) Ltd v Aerosol Fillers Inc* (1980), 53 CPR (2d) 62 (FCA)]. Although the threshold for establishing use in these proceedings is quite low [*Woods Canada Ltd v Lang Michener et al* (1996), 71 CPR (3d) 477 (FCTD)], and evidentiary overkill is not required [*Union Electric Supply Co 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 wares or services specified in the registration during the relevant period.

[6] In response to the Registrar's notice, the Registrant filed the affidavit of Thomas Rayman Bedessee, the Vice President of Bedessee Imports Ltd. (Bedessee), the Registrant's importer/distributor sworn on behalf of the Registrant. Only the Registrant filed a written argument; an oral hearing was not held.

[7] In his affidavit, Mr. Bedessee sets out the normal course of trade for sales of the wares in Canada. Specifically, Mr. Bedessee states that the Registrant sells its wares to his company, Bedessee, which is the Canadian distributor for products sold under the Mark. As an importer and distributor, Bedessee receives products for sale in Canada already bearing the labels depicting the Mark. Bedessee sells the wares to retailers in West Indian, West African, Latin American and Oriental specialties stores as well as to traditional grocery stores and supermarkets. These stores then sell the wares to the general public. Bedessee also sells the wares to bakeries and food processors who use them for production of their own products. Finally, Mr. Bedessee asserts that Bedessee also sells most of the wares on its website ([www.bedessee.com](http://www.bedessee.com)), which it started in 1999.

[8] Mr. Bedessee's affidavit is made up of two main types of evidence: sample products/labels and invoices.

### Registrant Concedes Non-Use

[9] In his affidavit, Mr. Bedessee states that the Registrant did not use the Mark in association with the wares “jams and hot sauces” during the relevant period. Furthermore, no special circumstances have been demonstrated that would excuse the absence of the use of the Mark in association with the these wares.

### Did the Registrant use the Mark in the normal course of trade in association with the remaining wares during the Relevant Period?

[10] Mr. Bedessee attaches to his affidavit photos of bottles of ginger beer, cream soda and cola champagne which he states are representative of those sold during the relevant period (Exhibits B – D).

[11] Mr. Bedessee also attaches to his affidavit a copy of a label which he states is representative of the labels attached to bottles of ginger beer sold in Canada in association with the Mark during the relevant period (Exhibit E). Mr. Bedessee points out that the name of the Registrant is clearly visible on the label. He also confirms that the labels used on the other types of soda sold by the Registrant are identical to the one attached at Exhibit E except that they would identify the specific type of soda in question.

[12] I note that all of the labels in evidence feature the Mark as part of a design mark. A registration for a word mark is not jeopardized by the use of a design, provided of course that the registered word mark remains recognizable. I am satisfied that the Mark is recognizable in the design mark which is displayed on the product labels.

[13] Mr. Bedessee attaches to his affidavit copies of invoices which I am satisfied evidence sales of sodas (cola champagne and cream soda) from Bedessee to retailers in Canada in association with the Mark from 2009 and 2010 (Exhibits F, G). Mr. Bedessee notes that the invoices accompany the wares at the transfer of possession.

[14] I note that there are no specific references in the evidence to “sorrel” soda. In fact, the invoices cover only “cola champagne” and “cream soda” sodas. Furthermore, Mr. Bedessee’s statements with respect to the representative nature of the sample bottles and labels refer only to

the evidence being representative of “sodas, including cola champagne and cream soda”. In its written argument the Registrant submits that “sorrel” should be maintained as part of the statement of wares as it is included within the general category of “soda” for which evidence of use has been adduced. However, in light of the complete absence of any mention of “sorrel” even in the statements regarding the representative nature of the evidence and its absence from the invoices, I find that the Registrant has failed to evidence use of the Mark in Canada during the Relevant Period in association with sorrel soda.

[15] Based on the foregoing, I am satisfied that the Registrant has evidenced use of the Mark in association with the wares “ginger beer; sodas including, cola champagne and cream soda” in the normal course of trade in Canada during the Relevant Period.

#### Disposition

[16] In view of the foregoing, pursuant to the authority delegated to me under section 63(3) of the Act and in compliance with the provisions of section 45 of the Act, the registration will be amended to delete the wares “...sorrel ...; hot sauces and jams”.

[17] The amended statement of wares will read as follows:

Ginger beer; sodas including, cola champagne and cream soda

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Andrea Flewelling  
Member  
Trade-marks Opposition Board  
Canadian Intellectual Property Office